

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of 25 May 2011**

Case Number: T 1996/09 - 3.2.06

Application Number: 98101917.7

Publication Number: 0858791

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:

Absorbent article

Patentee:

KAO CORPORATION

Opponent:

KIMBERLY-CLARK WORLDWIDE, INC.

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

RPBA Art. 13(1)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Late-filed requests - not clearly allowable - not admitted"

Decisions cited:

-

Catchword:

-



Case Number: T 1996/09 - 3.2.06

DECISION
of the Technical Board of Appeal 3.2.06
of 25 May 2011

Appellant I:
(Patent Proprietor)

KAO CORPORATION
14-10, Nihonbashi
Kayaba-cho 1-chome
Chuo-ku
Tokyo (JP)

Representative:

Vossius & Partner
P.O. Box 86 07 67
D-81634 München (DE)

Appellant II:
(Opponent)

KIMBERLY-CLARK WORLDWIDE, INC.
401 North Lake Street
Neenah WI 54956 (US)

Representative:

Chiva, Andrew Peter
Dehns
St Bride's House
10 Salisbury Square
London EC4Y 8JD (GB)

Decision under appeal:

Interlocutory decision of the Opposition
Division of the European Patent Office posted
28 July 2009 concerning maintenance of the
European patent No. 0858791 in amended form.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: G. de Crignis
K. Garnett

Summary of Facts and Submissions

I. European patent No. 0 858 791, granted on application No. 98 101 917.7, was maintained in amended form by the decision of the opposition division posted on 28 July 2009.

II. The opposition division considered the patent to disclose the invention in a manner sufficiently clear and complete for it to be carried out by a skilled person (Article 100 (b) EPC) and held the subject-matter of claim 1 to be novel (Article 54 EPC) over D1 WO-A-96/12460.

The subject-matter of claim 1 of the main request was found to lack an inventive step (Article 56 EPC) whereas the subject-matter of claim 1 of the first auxiliary request, which included the subject-matter of granted claim 2, was found to include an inventive step (Article 56) when starting from the closest prior art disclosed in D1.

Claim 1 as maintained reads as follows:

"An absorbent article comprising a liquid-permeable surface to be brought into contact with the skin, a liquid-impermeable surface not to be brought into contact with the skin, and a liquid retentive absorbent body (4) interposed between said liquid-permeable surface and said liquid-impermeable surface, said absorbent body (4) comprising at least an absorbent member (6) and an elastic member (7), wherein said absorbent member (6) and said elastic member (7) are joined into a unitary body by at least two joining means selected from the group consisting of adhesive application, groove-making pressing, embossing and thermal bonding, said absorbent member (6) comprising at least a

fiber aggregate and a superabsorbent polymer, said fiber aggregate comprising the same fiber or different fibers, characterized in that said elastic member (7) satisfying the following conditions (1) and (2), and comprising thermally fusible fibers as a major component:

(1) a fiber orientation ratio of said elastic member is less than 5.0 and

(2) a bending stiffness of said elastic member is of 4.9×10^{-4} Ncm to 1.9×10^{-2} Ncm (0.05 to 2.0 gfcm)."

III. On 7 October 2009 both the appellant I (patent proprietor) and the appellant II (opponent) filed an appeal against this decision and on the same day paid the appeal fee. Statements setting out the grounds of appeal of the appellants were received at the European Patent Office on 7 December 2009.

IV. In a communication annexed to summons to oral proceedings, the Board in particular commented on the parametrical features and referred to the Table of the patent in suit and the impact of the claimed features on novelty and inventive step.

V. Oral proceedings were held on 25 May 2011. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main, first, second or third auxiliary requests, all requests being filed during the oral proceedings. The respondent requested that the decision under appeal be set aside and that the patent be revoked.

Claim 1 of the main request differs from the above cited claim 1 upheld by the opposition division in that

- the elastic member is additionally specified as being a nonwoven fabric;
- the methods are additionally specified for determining the fibre orientation ratio and the bonding stiffness of the elastic member such as described in the description;
- the subject-matter of originally filed claim 2 is added to the claim which reads:
"wherein said absorbent member (6) and said elastic member (7) are joined into a unitary body by at least two joining means selected from the group consisting of adhesive application, groove-making pressing, embossing and thermal bonding";
- this latter feature is additionally limited to at least two "*different*" joining means [*emphasis added*].

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the subject-matter is limited to a sanitary napkin and in that the absorbent member and the elastic member are joined into a unitary body "only by a combination of a uniting means selected from the group consisting of adhesive application, embossing and thermal bonding and a uniting means by groove-making pressing".

Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in that the absorbent member and the elastic member are joined into a unitary body only by a combination of a uniting means "by adhesive application and a uniting means by groove-making pressing".

Claim 1 of the third auxiliary request differs from claim 1 of the previous requests and reads:

"A sanitary napkin comprising a liquid-permeable surface being a suction heat-bonded nonwoven fabric to be brought into contact with the skin, a liquid-impermeable surface being a moisture-permeable sheet of polyethylene not to be brought into contact with the skin and a liquid retentive absorbent body (4) interposed between said liquid-permeable surface and said liquid-impermeable surface, the combination being joined into a one body by groove-making pressing, said absorbent body (4) being formed by an absorbent member (6) and an elastic member (7), said absorbent member (6) being an absorbent sheet having a total basis weight of 100 g/m² and a thickness of 0.8 mm, the absorbent sheet comprising a fiber aggregate having a basis weight of 80 g/m² made up of 97 parts by weight of cross-linked pulp, obtained by treating wood pulp with a cross-linking agent, and 3 parts by weight of polyvinyl alcohol binder fiber, and having 20 g/m² superabsorbent polymer particles incorporated therein, said elastic member (7) being formed by three-dimensionally crimped PP/PE core/sheath type conjugate fibers having a fineness of 1.5 deniers and a length of 7 mm formed into a web by an air-laid method, followed by thermal bonding to obtain a non-woven fabric having a basis weight of 30 g/m² and a thickness of 0.7 mm measured under a load of 0.5 g/cm², wherein said absorbent member (6) and said elastic member (7) being joined into a unitary body by covering said absorbent member (6) with said elastic member (7), the facing surfaces of said two members being adhered by a hot melt adhesive being applied spirally at a

basis weight of 10 g/m² with a width of 40 mm to obtain said absorbent body (4),

wherein said elastic member (7) satisfies the following conditions (1) and (2):

(1) a fiber orientation ratio of said elastic member is less than 5.0, being measured as described in paragraphs [0048] and [0096], and

(2) a bending stiffness of said elastic member is of 4.9×10^{-4} Ncm to 1.9×10^{-2} Ncm (0.05 to 2.0 gfc_m), being measured with the method as described in paragraphs [0097] and [0098]."

VI. The arguments of the appellant I (patent proprietor) may be summarised as follows:

Since the requests were filed in response to the objections set out by appellant II and the Board, they should be admitted into the proceedings.

Claim 1 now required the absorbent member and the elastic member to be joined into a unitary body by at least two different joining means which should be selected from a specific group which was claimed. Such subject-matter was originally disclosed in paragraphs [0063] and [0064], which referred with regard to the uniting means generally to the absorbent body and was not limited to a sanitary napkin.

Claim 1 of the auxiliary request 1 and 2 further specified the combination of uniting means to be selected in consistency with the disclosure in paragraphs [0063] and [0064]. The embodiments of Figures 3 and 4 were accordingly no longer in the scope

of the claims and the subject-matter of claim 1 was limited to a sanitary napkin.

Claim 1 of auxiliary request 3 was limited to a sanitary napkin in accordance with example 3. It thus was limited to the embodiment shown in Figure 4 and fulfilled the requirements of Article 123(2) EPC.

VII. The appellant II (opponent) essentially argued as follows:

The late-filed requests should not be admitted as they were not clearly allowable.

The subject-matter of claim 1 of the main request was not disclosed in the application as originally filed insofar as the claimed combination of features was concerned (Article 123(2) EPC). The disclosure in paragraphs [0063] and [0064] concerned only sanitary napkins.

The subject-matter of claim 1 of the first and second auxiliary request was not disclosed in the application as originally filed insofar as the claimed combination of features was concerned (Article 123(2) EPC) because the disclosure in paragraphs [0063] and [0064] was related to the design of the absorbent body shown in Figures 1 and 2.

Concerning the subject-matter of claim 1 of auxiliary request 3, not all features of example 3 - in particular concerning the design shown in Figure 4 - were included and accordingly the claimed combination was not originally disclosed.

Reasons for the Decision

1. The appeal is admissible.
2. *Late-filed requests*

All current requests were filed during the oral proceedings, hence at the latest possible stage in the proceedings. According to Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA), it lies within the discretion of the Board to admit such late filed requests into the proceedings. In order to be admitted the requests should at least meet the requirements of Article 123(2) EPC, which is not the case for any of these requests, as set out below. Hence, the Board does not admit these requests into the proceedings.

3. *Main request - Amendments*

- 3.1 The subject-matter of claim 1 includes the feature that for joining the absorbent member and the elastic member into a unitary body two different joining means are to be selected from a specific group of joining means. Concerning the disclosure of such subject-matter, appellant I relied upon the original description, page 14, second and third paragraph, which are consistent with paragraphs [0063] and [0064] of the patent in suit.

3.2 Paragraph [0063] specifies:

"In the production of the sanitary napkin shown in Figures 1 and 2, the uniting means for joining the absorbent member 6 and the elastic member 7 is not limited to a combination of the joint with an adhesive and the groove-making pressing as described above, and other combinations of uniting means can be used."

Paragraph [0064] specifies further:

"That is, at least two uniting means can be selected from the group consisting of adhesive application, groove-making pressing, embossing and thermal bonding. In particular, a combination of a uniting means selected from the group consisting of adhesive application, embossing and thermal bonding and a uniting means by groove-making pressing is used. More specifically, a combination of groove-making pressing and embossing (in this case the embossing is applied to a part or the entire surfaces of the absorbent member 6 and the elastic member 7) and a combination of groove-making pressing and thermal bonding (in this case thermal bonding is conducted in a part or the whole surfaces of the absorbent member 6 and the elastic member 7) can be used suitably."

3.3 It is not in any doubt that these paragraphs are to be considered in combination. Hence, the patent in suit refers with regard to two different joining means specifically to sanitary napkins whereas claim 1 refers to absorbent articles in general. There is no other disclosure in the originally filed application of absorbent articles being joined in the manner defined in claim 1. Accordingly, the requirements of Article 123(2) EPC are not met.

4. *Auxiliary request 1 - Amendments*

4.1 The subject-matter of claim 1 is limited to a sanitary napkin and further specifies that the absorbent member and the elastic member are joined into a unitary body "only by a combination of a uniting means selected from the group consisting of adhesive application, embossing and thermal bonding and a uniting means by groove-making pressing".

4.2 Concerning the original disclosure of this amended feature, the appellant I referred to paragraph [0064], which is cited above.

4.3 Although the amended wording is present in this paragraph, it has to be taken into account that the wording of claim 1 includes in the preamble the feature that the "absorbent body (4) [is] comprising at least an absorbent member (6) and an elastic member (7)" without any further specification of these two members. Hence, neither the relative position nor the extension of these two members is specified in claim 1 whereas the embodiment disclosed in paragraphs [0063] and [0064] is limited to a sanitary napkin in accordance with Figures 1 and 2. Figure 2 includes an absorbent member (6) being superposed upon an elastic member (7) of identical dimensions. Hence, only for such an embodiment is the claimed combination of uniting means originally disclosed.

4.4 The position and extension of the elastic member and the absorbent member are specifically disclosed for each of the embodiments disclosed in the patent in suit.

The embodiment shown in Figures 1 and 2 refers to an elastic member below the absorbent member whereas the embodiments shown in Figures 3 and 4 disclose the possibilities that the elastic member can be completely covered by the absorbent member or vice versa.

4.5 Concerning the uniting means, the embodiments are disclosed as being specifically different. Concerning the embodiments shown in Figures 3 and 4, the first uniting means corresponds to covering all the member and is combined with a second uniting means, which is either joining by applying an adhesive to the entire surfaces to be joined or by groove-making pressing. Concerning the embodiment shown in Figures 1 and 2, the uniting means are disclosed in the above cited paragraphs [0063] and [0064].

4.6 When now claiming an absorbent member and an elastic member of any relative extensions in combination with the specific uniting means relating to one specific embodiment the claim contains added subject-matter. Accordingly, the requirements of Article 123(2) EPC are not met, the request is not clearly allowable and is not admitted into the proceedings.

5. *Auxiliary Request 2 - Amendments*

5.1 Claim 1 according to the second auxiliary request differs from claim 1 according to the first auxiliary request in that the joining of the absorbent member and the elastic member is further specified as being effected by a combination of adhesive application and groove-making pressing. The subject-matter of claim 1 is not limited with regard to the size and position of

- the elastic member and the absorbent member in relation to each other.
- 5.2 According to the application as filed the uniting means of adhesive application and groove-making pressing are to be applied for a sanitary napkin having the absorbent member and the elastic member arranged in a specific manner (the absorbent member (6) being superposed upon an elastic member (7) of identical dimensions) which is disclosed for the embodiment shown in Figures 1 and 2 and described in paragraphs [0063] and [0064] (cited above) whereas the embodiments shown in Figures 3 and 4 are to be united via covering and adhesive application (paragraph [0068]).
- 5.3 There is no disclosure of an embodiment whose absorbent member and elastic member are variable concerning their positions and extensions (such as shown in Figures 3/4) but joined by adhesive application and groove-making pressing as first and second uniting means.
- 5.4 Hence, the amendments to claim 1 lead to subject-matter which is not disclosed in the application as filed, contrary to the requirement of Article 123(2) EPC.
6. *Auxiliary Request 3 - Amendments*
- 6.1 Claim 1 of the third auxiliary request differs from claim 1 of the previous requests in that the subject-matter is limited to a sanitary napkin including the elastic member of example 3.
- 6.2 According to example 3 (see paragraphs [0088 - 0090]) the absorbent member and the elastic member are

combined according to the arrangement shown in Figure 4 in which the absorbent member is covered around all its edges and on all surfaces with the elastic member, and the elastic and absorbent members are joined by a hot-melt adhesive which is spirally applied in the claimed manner.

- 6.3 The amendments to claim 1 do not limit the subject-matter to the design of the absorbent member and the elastic member disclosed for example 3 and shown in Figure 4. However, only for such specific design is the claimed specific hot-melt adhesive application disclosed. Accordingly the claimed subject-matter is not disclosed in the application as filed, contrary to the requirement of Article 123(2) EPC.

Order

For these reasons it is decided that:

1. The decision is set aside.
2. The patent is revoked.

The Registrar

The Chairman

M. Patin

P. Alting van Geusau