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**Datasheet for the decision
of 11 May 2012**

Case Number: T 0011/10 - 3.2.06

Application Number: 02005323.7

Publication Number: 1260203

IPC: A61F13/15

Language of the proceedings: EN

Title of invention:

Apparatus and method for manufacturing wearing articles

Patent Proprietor:

Zuiko Corporation

Opponent:

SCA Hygiene Products AB

Relevant legal provisions:

EPC Art. 123(2)
RPBA Art. 13 (1)

Keyword:

Main request: Claim 1 - unallowable intermediate
generalisation
Auxiliary requests I - III: filed during oral proceedings -
not admitted



Case Number: T0011/10 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 11 May 2012

Appellant: SCA Hygiene Products AB
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted 2
November 2009 concerning maintenance of the
European Patent No. 1260203 in amended form.**

Composition of the Board:

Chairman: M. Harrison
Members: G. de Crignis
K. Garnett

Summary of Facts and Submissions

I. By way of its interlocutory decision posted on 2 November 2009, the opposition found that European Patent No. 1 260 203 in an amended form met the requirements of the European Patent Convention (EPC).

Claim 1 in the form found allowable by the opposition division reads as follows:

"An apparatus for manufacturing wearing articles, comprising:

- a) a pair of nip rolls (1,1) for nipping a first web (W1) and a first and a second elastic member (X);
- b) a first and a second moving section movable in a direction crossing the first web (W1); and
- c) a first and a second guide head (5a,6a) formed on the first and the second moving section for feeding the first and the second elastic member (X) at a position upstream of a position at which the first web (W1) is nipped,
- d) wherein the radius of at least one of the pair of nip rolls (1,1) is 15 mm to 35 mm, and
- e) a distance D between a plane including axes of the pair of nip rolls (1,1) and a point at which the first and the second guide head (5a,6a) release the first and the second elastic member (X) is 30 mm or less

characterized in that

- f) the first and the second moving section each comprise a pair of pulleys (15a,16a) and a belt (15, 16) looped over said pair of pulleys (15a, 16a) and each of said pairs of pulleys (15a,16a) is driven by a servomotor (51)."

II. On 22 December 2009 the appellant (opponent) filed an appeal against this decision. A statement setting out

the grounds of appeal was received at the European Patent Office on 24 February 2010. Reimbursement of the appeal fee was also requested.

- III. In a communication annexed to the summons to oral proceedings, the Board indicated that further discussion was needed regarding the question as to whether the requirement of Article 123(2) EPC was met in regard to further features of paragraph [0062] such as the "fittings" disclosed therein, and that

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also appeared to represent an appropriate starting point for the discussion of inventive step.

- IV. Oral proceedings were held on 11 May 2012.

The appellant's requests were solely that the decision under appeal be set aside and that the patent be revoked.

The respondent requested that the appeal be dismissed, or alternatively that the decision under appeal be set aside and the patent be maintained on the basis of one of the first to third auxiliary requests filed during the oral proceedings, or alternatively that the case be remitted to the opposition division for further examination.

- V. Claim 1 of auxiliary requests I to III differs from claim 1 of the main request in that feature (b) reads as follows:

"b) a first and a second moving section movable in a direction of the width of the first web (W1);"

and in that after feature (f) the following is added:

"wherein a first fitting (11) is mounted on the first belt (15) and a second fitting (12) is mounted on the second belt (16), so that they can be reciprocated in the direction of the width of the web (W1), a first arm (5) is connected to first fitting (11) and a second arm (6) is connected to second fitting (12), the first arm (5) having the first guide head (5a) and the second arm (6) having the second guide head (6a), wherein rotational energy of the respective servomotor is transmitted to the respective guide head (5a, 6a) via the pulleys (15a, 16a), belts (15, 16), fittings (11, 12) and arms (5,6)."

Claim 1 of auxiliary requests II and III includes in features (a) and (b) the additional specification of not only a first but also a second web, and the further feature was added to feature (f) that the servomotor (51) is "controlled by a controller (50) generating a control signal based on the positional information of the webs (W1, W2), the trace information of the elastic members (x) and the rotation information of the servomotor,".

In claim 1 of auxiliary request III it is additionally specified in feature (e) that "the first and second elastic member are placed in a cyclic fashion".

VI. The arguments of the appellant may be summarised as follows:

The subject-matter of claim 1 was limited to the second embodiment disclosed in paragraphs [0061] and [0062]. The apparatus disclosed in these paragraphs included a

first mover which forced the first arm to reciprocate in the direction of the width of a first web and a second mover which forced the second arm to reciprocate in the direction of the width of a second web. However, claim 1 did not refer to first or second mover nor to a second web (Article 123(2) EPC). Moreover, the requirement for the movers to reciprocate in the direction of the width of the first and second web was not included in claim 1. Additionally, consistent with the disclosure in paragraph [0062], Figures 7 and 8 illustrated the second embodiment and showed fittings mounted on the belt. No other possibility was disclosed for allowing the first mover and the second mover to position the guide heads so as to feed the elastic members in the claimed position. Therefore, the requirement of Article 123(2) EPC was not met.

The late-filed auxiliary requests I to III should not be admitted into the proceedings. They were filed during the oral proceedings subsequent to the main request not being allowed, and some of the objections to which it was a response had already been discussed during the written phase of the appeal proceedings. Considering the amendments, the subject-matter concerning the transmission of the rotational energy of the servomotor lacked clarity (Article 84 EPC) and was not disclosed (Article 123(2) EPC). It was not correct that rotational energy was transmitted to the guide head, pulleys, belts, fittings and arms; the rotational energy of the servomotor was converted into a reciprocating movement of the belts. Concerning the amendment in claim 1 of auxiliary request III that the first and the second elastic members were placed in a cyclic fashion, such feature represented a method step and put no clear limitation on the claimed apparatus (Article 84 EPC). Moreover, the inventive step

arguments would need to be shifted from starting from D2 as closest prior art to starting from D1 as closest prior art. The request for remittal was not justified.

VII. The arguments of the respondent may be summarised as follows:

The subject-matter of claim 1 was limited to the second embodiment. It was clear from Figure 7 and the description that the "movers" specified in paragraphs [0061] and [0062] were identical to the first and second moving sections referred to in claim 1. No necessity existed for defining a second web or a reference concerning the direction of the first and second moving sections being movable since "crossing the first web" would be clearly understood by the skilled person to mean crossing in the width direction. Additionally, Figure 7 in combination with Figure 8B illustrated that the direction of the first web was the same as the direction of the second web.

Paragraphs [0062] and [0064] disclosed that the pulleys might be rotated with a servomotor which was controlled by a controller. However, a controller was implicitly present. Concerning the fittings on the belts, the skilled person would not consider these parts as mandatory since the term "fitting" had no clear meaning and was anyway not disclosed as being important or necessary. The requirements of Article 123(2) EPC were met.

Auxiliary requests I to III should be admitted. They were filed in order to overcome the raised objections. Some of these objections were raised only in the oral proceedings and therefore could not have been remedied earlier. No change of case was being made and the

appellant should have expected, because the features were anyway under discussion during the written proceedings, that these features might be added into the claims. No extra documents had to be considered. In the event that discussion of the amended subject-matter could not be addressed directly, remittal of the case to the department of first instance was requested.

Reasons for the Decision

1. *Article 123(2) EPC*

1.1 In claim 1 according to the main request the apparatus has been limited to the apparatus of the second embodiment, which includes first and second elastic members, first and second moving sections and first and second guide heads, as well as feature (f), which provides that: "the first and the second moving section each comprise a pair of pulleys (15a, 16a) and a belt (15, 16) looped over said pair of pulleys (15a, 16a) and each of said pairs of pulleys (15a, 16a) is driven by a servomotor (51)."

1.2 These amendments relate to the originally filed description, page 17, line 22 to page 18, line 17, which corresponds literally to paragraphs [0060] to [0062] of the published patent specification.

1.3 Paragraph [0061] refers to the second embodiment as shown in Figure 7 and states that "the apparatus of this embodiment includes a first mount component A and a second mount component B. The first mount component A includes a first mover 13 and a first arm 5 for guiding at least one elastic member X to a position near the

contact position of nip rolls 1,1. The second mount component B includes a second mover 14 and a second arm 6 for guiding at least one elastic member X to a position near the contact position of nip rolls 1,1. The first mover 13 forces the first arm 5 to reciprocate in the direction of the width of a first web W1. The second mover 14 forces the second arm 6 to reciprocate in the direction of the width of a second web W2."

- 1.4 Paragraph [0062] refers to Figure 8A and specifies that "each of the movers 13 and 14 includes a pair of pulleys 15a, 15a (16a, 16a) and a belt 15 (16) looped over said pair of pulleys 15a, 15a (16a, 16a). One of the pair of pulleys 16a, 16a of the second mover is rotated with a motor 51 shown in Figure 7. Although not shown, the first mover 13 is also rotated with a similar motor. The motor 51 is controlled by a controller 50 placed inside or outside the manufacturing apparatus. First and second fittings 11 and 12 are mounted on the belts 15 and 16, respectively, so that they are reciprocated in the direction of the width of the webs W1 and W2."
- 1.5 Comparing the term "first and second mover" in these paragraphs with the term "first and second moving section" in claim 1, the terms can be accepted as being the same, in particular with regard to the apparatus illustrated in Figures 7 and 8.
- 1.6 Concerning feature (b) of claim 1 and the reference to a first and a second moving section movable in a direction crossing the first web, paragraph [0061] does not specify this feature in such a general manner. The wording cited under point 1.3 above discloses specifically that the first and the second "mover" (=

moving sections) force the arms of the corresponding guide heads to reciprocate in the direction of the width of the (corresponding) web. However, claim 1 specifies also the direction of crossing the web as being obliquely to the width direction, something which is not disclosed in the application as filed. For this reason alone, the requirement of Article 123(2) EPC is not met.

1.7 With regard to feature (f) of claim 1, the wording of this feature is also not disclosed in such a general manner. Figures 7 and 8 illustrate specifically that each driven pair of pulleys drives a belt and that each belt has a fitting thereon for attachment, by way of arms 5 and 6 respectively, to the guide heads. Although a skilled person might be capable of developing alternatives for implementing a force-transmitting connection between the guide heads and the belts holding the guide heads in place, a direct and unambiguous disclosure of any such alternative is not present. Hence, the claimed subject-matter includes, for example, further connective possibilities which are not disclosed in this specific context and thus this subject-matter extends beyond the content of the application as filed. Therefore, the wording of feature (f) represents an undisclosed selection of only certain of the corresponding features disclosed in combination for the second embodiment.

1.8 The main request is therefore not allowable.

2. *Auxiliary requests I to III*

2.1 Auxiliary requests I to III were filed during the oral proceedings after the finding of the Board that the main request was not allowable for reasons which also

applied to auxiliary requests I to III then on file. Hence, current auxiliary requests I to III, which were filed after the communication of the Board sent with the summons to oral proceedings, replaced the auxiliary requests previously on file. 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 allow the respondent to amend its case after it has filed its reply to the appeal grounds. This discretion is to be exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

- 2.2 Claim 1 of all the auxiliary requests I to III differs from claim 1 of the main request *inter alia* in that first and second arms connected to respective first and second fittings mounted on the first and second belts respectively are defined.
- 2.3 The respondent's arguments in support of admitting the new requests into proceedings, namely that the objections under Article 123(2) EPC, including further objections raised during the oral proceedings, were overcome by the further definitions added to claim 1 and that these amendments could have been expected, do not overcome the fact that no auxiliary request attempting to deal with the matter of Article 123(2) EPC raised in the Board's communication (including *inter alia* the inclusion of the fittings) was submitted earlier. The amendments change the case significantly with regard to inventive step, since as also stated by the appellant, a different problem/solution approach would be required, starting from a different document, whereby it was apparent that the previously stated problem to be solved no longer applied.

2.4 Hence, consideration of auxiliary requests I to III filed during the oral proceedings would have been contrary to the requirement of procedural economy, taking also into account the fact that the respondent had not taken the opportunity to respond to the preliminary opinion of the Board concerning disclosure of certain features (e.g. "fittings") by filing an auxiliary request which took this matter into account; indeed the respondent chose instead, in regard to the aspect of "fittings", to confine its written response to the Board's communication, and to the written response of the appellant, to arguments that "fittings" were not essential.

2.5 The Board thus exercised its discretion under Article 13(1) RPBA not to admit these requests into proceedings. As a result of this, it was not necessary to examine the additional clarity objections and further objections concerning lack of disclosure put forward by the appellant.

3. *Request for remittal*

3.1 For reasons of procedural economy, and although Article 111(1) EPC permits remittal, there is no absolute right to have an issue decided upon by two instances and the question of remittal thus lies within the discretion of the Board. According to Article 11 RPBA, a Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.

3.2 In the present proceedings, no fundamental deficiencies in the first instance proceedings have been identified by the parties and none are considered present by the

Board. No other special reasons for remittal have been presented either. It is also noted that the appellant protested against remittal on the basis that the respondent had already had ample opportunity, in several responses, to have made amendments corresponding to auxiliary requests I to III but instead had chosen to file amendments relating to other aspects.

- 3.3 The Board found that remittal was not justified in the present case, since the respondent had been able to put forward its arguments in proceedings at both first and second instances and had used the opportunity to file further requests in the written part of the procedure. Since the main request was already found not to be allowable by the Board, there was no further request in the proceedings which could have been the subject of further examination. To have admitted auxiliary requests I to III as filed during oral proceedings and then send the case back to the opposition division for further examination of such requests would also run counter to the considerations in Article 13(3) RPBA regarding the admittance of requests made after the parties had been summoned to oral proceedings in particular in regard to the matter of a fundamentally altered problem/solution approach with regard to the consideration of inventive step as discussed under item 2.3 above.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:



M. Patin

M. Harrison

Decision electronically authenticated