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**Datasheet for the decision
of 23 July 2013**

Case Number: T 1433/10 - 3.2.06

Application Number: 98300647.9

Publication Number: 861642

IPC: A61F13/15

Language of the proceedings: EN

Title of invention:

Disposable body fluids absorbent garment with disposal
securing means

Patent Proprietor:

UNI-CHARM CORPORATION

Opponent:

Paul Hartmann AG

Relevant legal provisions:

EPC Art. 83

Keyword:

Sufficiency of disclosure - reproducibility (no)



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1433/10 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 23 July 2013

Appellant:
(Patent Proprietor)

UNI-CHARM CORPORATION
182 Shimobun,
Kinsei-cho
Kawanoe-shi
Ehime-ken (JP)

Representative:

Sperling, Rüdiger
Staeger & Sperling
Partnerschaftsgesellschaft
Sonnenstraße 19
80331 München (DE)

Respondent:
(Opponent)

Paul Hartmann AG
Paul-Hartmann-Straße 12
89522 Heidenheim (DE)

Representative:

Dreiss
Patentanwälte
Postfach 10 37 62
70032 Stuttgart (DE)

Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 10 May 2010
revoking European patent No. 861642 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: K. Garnett
Members: G. de Crignis
G. Kadner

Summary of Facts and Submissions

- I. The appellant (patent proprietor) filed an appeal against the opposition division's decision revoking European patent No. 0 861 642.
- II. The patent in suit is concerned with a disposable absorbent garment having disposal securing means which satisfy certain holding force requirements. In its decision, the opposition division found *inter alia* that the patent failed to guide the skilled person to a particular holding force measuring test such as to enable repeatable results to be obtained and that hence it did not to meet the requirement of Article 83 EPC.
- III. The appellant requested in its statement of grounds of appeal maintenance of the patent as granted, or on the basis of auxiliary requests 1 to 3 filed therewith.
- IV. In a communication annexed to the summons to oral proceedings, the Board indicated that it also considered a test method to be indispensable.
- V. Oral proceedings were held before the Board on 23 July 2013.

The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted, alternatively on the basis of one of the first to third auxiliary requests filed with the grounds of appeal, alternatively on the basis of the fourth auxiliary request filed during the oral proceedings.

The respondent requested that the appeal be dismissed.

- VI. Claim 1 as granted reads as follows:

"A disposable body fluids absorbent garment (1) having a skin-contactable surface (2) intended to be in contact with the skin of a wearer, through which body fluids discharged by the wearer is absorbed by the garment, and a skin-non-contactable surface (3B) provided with disposable securing means (16) being stretchable at least in one direction in order to be secured around the garment which has been rolled up for disposal, characterised in that:

the disposal securing means comprise a substantially non-stretchable first strip section (17) having inner and outer surfaces (17A, 17B) and first and second end portions (17C, 17D), a substantially non-stretchable second strip section (18) having inner and outer surfaces (18A, 18B) and first and second end portions (18C, 18D), and a third strip section (19) having inner and outer surfaces (19A, 19B) and proximal and free end portions (19C, 19D) wherein the free end portion (19D) is provided on the inner surface of the third strip section with a securing region (25) and including a stretchable extent (27) defined between the proximal and free end portions (19C, 19D);

the first and second strip sections (17, 18) have the respective inner surfaces (17A, 18A) bonded to the skin-non-contactable surface (3B) so that these two strip sections are longitudinally aligned with each other and have their respective first end portions (17C, 18C) longitudinally opposed to each other, the first end portion (17C) of the first strip section (17) is connected to the second strip section (18) between the first and second end portions (18C, 18D) of the second strip section, the third strip section (19) has the proximal end portion (19C) connected to at least one of the respective first end portions of the first and second strip sections, and the securing region (25)

provided on the free end portion (19D) is separably held against the outer surface (17A) of the first strip section in the proximity of its second end portion (17D); and the first, second and third strip sections (17, 18, 19) have holding forces, respectively, sufficient to remain held against the skin-non-contactable surface against a stretching stress generated in the third strip section (19) as the third strip section is peeled off from the first strip-section (17) in the proximity of the second end portion (17D) of the first strip section, stretched and held against the skin-contactable surface (3B) over the securing region (25), and the holding forces are selected so that the holding force of the first strip section (17) is equal to or higher than the holding force of the second strip section (18)."

Independent claim 4 reads:

"A disposable body fluids absorbent garment (1) having a skin-contactable surface (2) intended to be in contact with the skin of a wearer, through which body fluids discharged by the wearer is absorbed by the garment, and a skin-non-contactable surface (3B) provided with disposable securing means (16) being stretchable at least in one direction in order to be secured around the garment which has been rolled up for disposal, characterised in that:

the disposal securing means (16) comprises a substantially non-stretchable strip section (17) having inner and outer surfaces (17A, 17B) and first and second end portions (17C, 17D), and a stretchable strip section (19) having inner and outer surfaces (19A, 19B) and proximal and free end portions (19C, 19D) wherein the free end portion (19D) is provided on the inner surface of the of the stretchable strip section with a

securing region (25) and having a stretchable extent defined between the proximal and free end portions and the first strip sections (17) is bonded in the proximity of the first and second end portions (17C, 17D) spaced apart from each other to the skin-non-contactable surface (3B);
the stretchable strip section has its proximal end portion (19C) connected to the first end portion (17C) of the first strip section and the securing region (25) provided on the free end portion (19D) is separably held against the non-stretchable strip section (17) in the proximity of its second end portion (17D); and
the stretchable strip section (19) and the non-stretchable strip section (17) have holding forces, respectively, sufficient to remain held against the skin-non-contactable surface against a stretching stress generated in the stretchable strip section (19) as the stretchable strip section is peeled off from the non-stretchable strip section (17), stretched and held against the skin-non-contactable surface, and the holding force generated in the proximity of the second end portion (17D) of the non-stretchable strip section (17) is equal to or higher than the holding force generated in the proximity of the first end portion (17C) of the non-stretchable strip section (17)."

The final paragraphs of claim 1 and claim 4 of auxiliary requests 1 to 3 are identical in wording to the final paragraphs of claims 1 and 4 respectively of the main request. Only these paragraphs are relevant for this decision. Therefore it is not necessary to set out the differences in the other parts of claims 1 and 4 of auxiliary requests 1 to 3.

Auxiliary request 4 consists of a single claim, corresponding to claim 4 of the main request.

VII. The appellant argued essentially as follows:

Although all arguments put forward with regard to claim 1 also applied to claim 4, focus was given to claim 1. As to this, it was not necessary to disclose a test method for determining the relationship of the holding forces. The skilled person could easily check whether the second strip section peeled off before the first strip section. Only such a relationship was claimed. To meet the claimed relationship, the skilled person knew he could either adapt the area of the strip sections or adapt the adhesive with regard to the required holding forces. Hence, the skilled person could provide at least one garment according to claim 1 which would satisfy the requirement of Article 83 EPC.

The skilled person had to apply reasonable test conditions. The direction of pulling was thus irrelevant since only the result concerning the claimed relationship was required. Even assuming that the direction of pulling was relevant, evaluation in three test directions - peeling in one direction, peeling in the opposite direction and in the z-direction - would be enough to validate that the relationship applied. Such tests could not be seen as an undue burden.

The above arguments applied equally to auxiliary requests 1 to 3.

Auxiliary request 4 should be admitted into the proceedings. It was limited to one claim which was identical to claim 4 of the main request. The parties and the board were therefore in a position to discuss this claim. The final feature in claim 1 of this claim referred to the holding forces being "generated in the

proximity" of the different strip sections, which made a difference to the wording in claim 1 of the main request and of auxiliary requests 1 to 3.

VIII. The respondent argued essentially as follows:

The patent in suit did not indicate how to determine the claimed relationship of the holding forces. The skilled person could not establish reliably and reproducibly whether such relationship applied. This objection concerned the main request and also as auxiliary requests 1 to 3.

Auxiliary request 4 should not be admitted. The same arguments as put forward with regard to the main request applied and such a request could have been filed earlier.

Reasons for the Decision

1. Main Request - Claim 1 - sufficiency of disclosure

1.1 The disclosure of the patent in suit as well as the subject-matter of claim 1 is directed to a disposable garment. This garment is claimed in particular in relation to disposal securing means having various structural features as well as an additional characteristic which concerns the use/disposal of the garment. The objection concerning sufficiency of disclosure is related to this latter characteristic which is set out in the final feature of claim 1.

1.2 Claim 1 specifies in its final feature the relationship of the holding forces of the first and second strip sections of the disposal securing means:

"the holding forces are selected so that the holding force of the first strip section (17) is equal to or higher than the holding force of the second strip section (18)."

This requirement is linked to the preceding feature which requires that:

"the first, second and third strip sections (17, 18, 19) have holding forces, respectively, sufficient to remain held against the skin-non-contactable surface against a stretching stress generated in the third strip section (19) as the third strip section is peeled off from the first strip-section (17) in the proximity of the second end portion (17D) of the first strip section, stretched and held against the skin-contactable surface (3B) over the securing region (25)".

Hence, these features concern requirements relating to the disposal securing means when the garment is used.

1.3 Accordingly, the skilled person must be capable of establishing these requirements in order to verify reliably and reproducibly whether these characteristics apply for a specific garment. Hence these use-criteria can be considered as a required characteristic of the garment.

1.4 These requirements concern the holding forces of the strip sections: a first requirement is that when the third strip section is peeled off, stretched and held

- in the claimed way, the first and second strip sections have holding forces which (a) are sufficiently great that these sections remain held against the skin-non-contactable surface and (b) satisfy the second requirement concerning the relationship of the holding forces of the first and the second strip sections.
- 1.5 The skilled person needs to verify whether the claimed relationship applies for such a garment. Since no test method is specified in the patent in suit, all suitable test methods can be considered as to whether they would lead to consistent results with regard to the claimed relationship and could be chosen by the skilled person.
- 1.6 The holding force can concern either peel strain or shear strain. The claimed relationship for the first and second strip section is not defined with regard to either one or the other of these forces.
- 1.7 Hence, a test procedure for assessing the holding forces would in particular need to specify which type of strain should underlie the claimed relationship of the holding forces. Thus, in order to verify the claimed relationship of the holding forces and to choose an appropriate test method, test conditions have to be specified which concern the direction and amount of stress applied when peeling off the third strip section.
- 1.8 The holding forces as regards peel strain and shear strain are independent of each other and can yield completely different results, something which has to be taken into account in a test method, for example by reference to the direction in which the force is applied during the determination.

- 1.9 Such difference in test results results from the angle of stretching when determining the holding force:
 - 1.9.1 When stretching the third strip section in a test procedure in the direction P (shown in Figures 2 and 4: parallel or at an acute angle to the first strip section), the resultant holding force of the first strip section is mainly limited to the holding force at the line of peel and concerns only the peeling force; whereas for the holding force of the second strip section the complete adhesive area is in play and concerns the shearing force. Hence, when peeling in direction P, the relationship of the holding forces concerns mainly the peel force of the first strip section and the shear force of the second strip section.
 - 1.9.2 When stretching the third strip section in a test procedure in the opposite direction to direction P, the second strip section undergoes a peeling force (at the line of peel) whereas the first strip section is under the effect of a shearing force over its whole adhesive area.
 - 1.9.3 Accordingly, completely contradictory results could be obtained for the claimed relationship.
- 1.10 Hence, the test condition concerning the angle of peeling is decisive for the result obtained for the claimed relationship. A reliably reproducible result for the relationship of the holding forces can only be obtained by defining whether it is to be established under shearing or peeling stress and by defining the angle of peeling or shearing.

- 1.11 No technical information whatsoever is present in the patent in suit concerning a test method, test conditions or exemplary evidence. Without a disclosure as to whether shear or peel forces should underlie the claimed relationship of the holding forces of the first and second strip sections, the skilled person does not know how to obtain a reliable and reproducible result.
- 1.12 The appellant argued that in order to satisfy the requirement of Article 83 EPC it would be sufficient if the skilled person could provide at least one garment which fell under the scope of claim 1. It would be technically feasible to make such an article as the requirement of $H1 \geq H2$ would always be achievable by adjusting the type of glue used or the area to be glued. It would be possible to determine via the test procedure whether the second strip section would become detached from the skin-non-contactable surface while the first strip section still remained attached. Where different results were possible with different directions of stretching, the skilled person could test whether the claimed relationship was met in all three directions (peeling in either of the opposite directions and in the z-direction). Such tests would not represent an undue burden.
- 1.12.1 However, the arguments as set out above apply in relation to such a test method, namely that the results would be contradictory, depending on the direction of stretching. The direction of the stress, peeling or shearing would again need to be defined for such a test.
- 1.12.2 Additionally, claim 1 does not refer to the holding force as allowing the second strip section to detach from the skin-non-contactable surface. To the contrary,

it includes the requirement that all three strip sections should remain held against the skin-non-contactable surface. Thus, the test method would need to include test conditions which take into account such characteristic.

- 1.12.3 Concerning the argument that the invention is sufficiently disclosed because at least one article falling under the scope of the claim could be manufactured, according to the Case Law of the Boards of Appeal (see Section II.A.3(c)), the disclosure of one way of performing an invention is only sufficient if it allows the invention to be performed over the whole range claimed. Additionally it is explained that as regards a functional definition - in this case a use-definition of an article - such disclosure is acceptable so long as all alternatives are available and achieve the desired result - which is not the case here.
- 1.13 Although the Board had pointed to the issue of lack of a test method in its communication, no test results providing evidence for the claimed relationship were submitted.
- 1.14 Accordingly, the skilled person is not in a position to know with certainty whether, in relation to such disposal securing means, a particular relationship of the holding means of the first and second strip sections falls inside or outside the scope of the claim due in particular to the fact that the nature of the holding force underlying the relationship is not specified. For this reason, there is no clear and unambiguous teaching making it possible for the skilled person to ascertain whether any particular article

falls within the scope of the claim. Thus, the requirements of Article 100(b) EPC are not met.

2. *Auxiliary Requests 1 to 3*

The subject-matter of claim 1 of these requests does not differ in the decisive paragraph from the subject-matter of claim 1 of the main request. Thus, the assessment of the subject-matter of this claim does differ from that already considered when discussing the subject-matter of claim 1 of the main request and, therefore, the objections raised in relation to sufficiency of disclosure are not overcome. The first, second and third auxiliary request are therefore not allowable under Article 83 EPC.

3. *Auxiliary request 4 - admittance*

3.1 According to Article 13(1) Rules of Procedure of the Boards of Appeal, it lies within the discretion of the Board to admit any amendment to a party's case after it has filed its grounds of appeal or reply and states that "the discretion shall 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." Article 13(3) provides that amendments made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the other party cannot reasonably be expected to deal without adjournment of the oral proceedings.

3.2 The subject-matter of the sole claim of this request is identical to the subject-matter of claim 4 as granted. At the beginning of the oral proceedings, the appellant had argued that all arguments set out for claim 1 would

apply for claim 4 as well. Also in the written proceedings, no differing arguments concerning claim 4 were raised. If so, then the request is *prima facie* not allowable for the reasons which apply to the earlier requests. When arguing for its admittance, however, the appellant argued that the words "generated in the proximity" made a difference. If so, this was an entirely new point for which neither the respondent nor the Board was prepared.

3.3 Accordingly, the Board did not admit this late-filed request into the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. H. A. Patin

K. Garnett

Decision electronically authenticated