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**Datasheet for the decision
of 8 April 2014**

Case Number: T 2024/10 - 3.2.06

Application Number: 00305039.0

Publication Number: 1060721

IPC: A61F13/496, A61F13/15

Language of the proceedings: EN

Title of invention:

Disposable diaper

Patent Proprietor:

UNI-CHARM CORPORATION

Opponent:

KIMBERLY-CLARK WORLDWIDE, INC.

Relevant legal provisions:

EPC Art. 54

RPBA Art. 12(4)

Keyword:

Document excluded - no, highly relevant

Novelty - no



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 2024/10 - 3.2.06

**D E C I S I O N
of Technical Board of Appeal 3.2.06
of 8 April 2014**

Appellant: KIMBERLY-CLARK WORLDWIDE, INC.
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
19 July 2010 concerning maintenance of the
European Patent No. 1060721 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, the opposition division found that European Patent No. 1 060 721 as amended met the requirements of the European Patent Convention (EPC).

II. The appellant/opponent filed an appeal against this decision, requesting revocation of the patent, and referred in its grounds of appeal to:

D1 WO-A-96/32083

which had already been cited in the first instance proceedings.

The appellant also filed:

D5 WO-A-96/08224; and

D6 US-A-5601547

with its grounds of appeal in support of its objection concerning lack of novelty of the single claim which had been found allowable by the opposition division.

III. Claim 1 reads as follows:

"A disposable diaper having a front waist region, a rear waist region and a crotch region extending therebetween, at least one of said front and rear waist regions having an edge zone thereof extending in a circumferential direction provided along the full length of said edge zone with an elastic stretchability, wherein:
said at least one waist region comprises a covering zone formed integrally with said crotch region to cover

the waist region of the diaper wearer and an elastic zone attached along an upper edge of said covering zone and, adapted to be elastically stretchable in said circumferential direction; and said elastic zone comprises a first member adapted to be elastically stretchable in said circumferential direction to a length beyond the length of said covering zone and a second member covering said first member, said second member being adapted to be inelastically stretchable to a length beyond the length of said covering zone and to be attached to said edge of said covering zone, characterised in that: said second member comprises a sheet material having a length substantially equal to the length of said covering zone in said circumferential direction and adapted to be inelastically stretchable in said circumferential direction."

- IV. The respondent (patent proprietor) replied to the statement of grounds of appeal, requesting that the appeal be dismissed, saying only, so far as concerned its case: "we maintain all arguments set forth during the opposition proceedings and reserve the right to make further arguments and/or amendments as deemed necessary".

- V. In a communication annexed to the summons to oral proceedings, the Board indicated its preliminary view that it was minded to admit D5 as it appeared *prima facie* to be highly relevant to the issue of novelty and prejudicial to maintenance of the patent.

- VI. In answer to this communication, the respondent filed submissions, setting out its view *inter alia* on D5 and D6.

VII. Oral proceedings were held before the Board on 8 April 2014.

The appellant requested that the decision under appeal be set aside and the patent be revoked.

The respondent requested that the appeal be dismissed.

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

D5 should be admitted into the appeal proceedings, since it was *prima facie* highly relevant to the novelty of the subject-matter of claim 1.

The subject-matter of claim 1 as found allowable by the opposition division lacked novelty over the embodiment shown in Figure 5B of D5. The arrangement of the diaper in D5 was the same as that shown in Figures 1 and 2 of the contested patent. The elastic waistband 32 in Figure 5B provided a waist region having an edge zone in the circumferential direction which had elastic stretchability. The waist region had a covering zone formed integrally with the crotch region. The description of Figures 4A to 4D of D5 disclosed that when the waistband was attached it had a length equal to that of the covering zone. Therefore, the nonwoven covering layers of the waistband (i.e. second member) had a length equal to the length of the covering zone. Inherently, this second member in D5 was elastically and inelastically stretchable in the circumferential direction since the waistband was a gathered elastomeric stretch-bonded laminate (page 10, l. 28 to page 11, l. 15). Claim 1 did not exclude the second sheet being a gathered sheet. This was evident since,

in e.g. claim 3 as granted, gathers were used to shorten the sheet material to a different length. Accordingly, claim 1 lacked novelty over D5.

IX. The respondent essentially argued as follows:

D5 should not be admitted into proceedings because it was not relevant, *prima facie* or otherwise, given a reasonable interpretation claim 1.

Claim 1 was based on claims 1 and 4 as granted. A reasonable interpretation of the claim should take into account that granted claims 3 and 4 referred to two distinct arrangements; these two arrangements were specifically defined in the corresponding description in column 3, l. 30 to 37, and in column 3, l. 37 to 42. When taking into account these definitions, an interpretation of current claim 1 with regard to the second member could only lead to the acknowledgement that in such context:

- "sheet material" meant flat, non-gathered, sheet material;
- "inelastic stretching" began when the material was stretched and did not cover merely straightening of a gathered material;
- gathered material, which, in a gathered state, had the same length as the covering zone, automatically had a length exceeding the length of the covering zone due to the length of material in the gathers.

When considering this reasonable interpretation, the arrangement in claim 1 differed substantially from the disclosure in D5. Hence, D5 should not be admitted into the proceedings.

Reasons for the Decision

1. (Non)admittance of D5

- 1.1 D5 was filed by the appellant with the grounds of appeal. According to Article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA), everything presented by an appellant with its grounds of appeal must be taken into account by the Board if and to the extent it relates to the case under appeal. "Everything" in the present case obviously includes the documentary evidence D5 and the appellant's arguments relating to it. The only relevant exception to this is where the Board, in the exercise of its discretionary power referred to Article 12(4) RPBA, holds such evidence inadmissible on the grounds that it could have been presented in the first instance proceedings.
- 1.2 D5 certainly relates to the appellant's case in the appeal in the sense that the appellant argues that D5 is novelty-destroying for the subject matter of claim 1. Admittedly this case is different from the case on novelty as presented before the opposition division, where the attack was based solely on D1. This, however, is a matter which goes to the Board's discretion to hold the evidence inadmissible.
- 1.3 The question is therefore whether the Board should hold D5 inadmissible on the grounds that it could have been presented in the first instance proceedings. The reason given by the appellant for filing D5 for the first time with the grounds of appeal was that this document had not been discovered previously. The respondent did not challenge this but in the event the Board does not need to go further into this aspect. This is because the

only reason put forward by the respondent for the non-admittance of D5 was its lack of relevance and because the Board, for the reasons given below, does not accept this argument. Further, given that this was the only reason for the non-admittance given by the respondent, the Board does not have to consider any other factors of the kind which in other cases might be relevant to the exercise of the discretion.

1.4 As to its relevance, at the oral proceedings before the Board the discussion with the parties immediately went into detail concerning the disclosure of D5, at the end of which the Board came to the conclusion that D5 was in fact novelty-destroying for the subject matter of claim 1. It is therefore sufficient at this stage to say that D5 is *prima facie* highly relevant; the reasons given below on the issue of novelty for this conclusion explain why.

1.5 Since therefore the Board did not accept the respondent's argument that D5 was irrelevant, the Board decided at the oral proceedings to admit it into the proceedings and thus, in effect, not to exercise its discretion to find it inadmissible.

2. *Novelty*

2.1 D5 discloses a disposable diaper which is of the same general type as claimed. In its overall design, with front waist regions, rear waist regions and crotch region (shown in Figures 1 and 2), this diaper also resembles the disposable diaper illustrated in Figure 1 of the patent in suit. This was not a matter of dispute between the parties.

The diaper according to D5 has a continuous elastic waistband 32 formed from front and rear waistband members 64, 66 (Figures 1 and 3, page 6, l. 8/9). The waistband 32 is laterally and longitudinally coterminous with the lateral sides and longitudinal edge of the chassis (see e.g. Figures 1, 2, 3, 4A to 4D, 5A). Figure 5B shows that the waistband can be attached to the top edge of the chassis such as to extend longitudinally beyond it (page 15, l. 9 to 19). The waistband is formed from a stretch-bonded laminate comprising an elastic member secured to one or more nonwoven fabric layers (page 10, l. 8 to page 11, l. 15). Such non-woven layers are inelastically stretchable, for example via gathers (page 11, l. 1 to 31). The waistband is elongated by approximately 70% and then joined to the chassis (pages 12, 13, Figures 4A- 4D) although it has an elasticity of up to 250% elongation (page 12, l. 19/20). In such a way, the waistband is gathered at the waist border of the pant body (Figure 1, page 11, l. 22 to 31) while maintaining an elastic stretchability. Figure 3 as well as Figures 4A to 4D of D5 disclose that when the waistband is attached to the waist border (see also page 12, l. 35 to 39) it has a length equal to that of the covering zone. Thus, the nonwoven covering layers of the waistband (i.e. the second member) have a length equal to the length of the covering zone. The characteristics of such a stretch-bonded laminate include inelastic as well as elastic stretchability and, accordingly, the waistband member of D5 is stretchable (in both senses) in the circumferential direction.

2.2 Thus, the stretch-bonded laminate in D5 corresponds to the first and second member as defined in claim 1 under consideration, which members are referred to in claim 1 as being elastically stretchable (first member) and as

being adapted to be inelastically stretchable (second member).

2.3 The issue in dispute between the parties concerned the question as to whether D5 included in its disclosure a feature corresponding to the second member, such as defined in the characterising portion of claim 1: "said second member comprises a sheet material having a length substantially equal to the length of said covering zone in said circumferential direction and adapted to be inelastically stretchable in said circumferential direction."

2.4 The respondent submitted that D5 did not disclose a second member as defined in the claim under consideration and argued why the subject-matter of claim 1 should be interpreted differently.

2.4.1 According to the respondent, the granted patent included two distinct arrangements with regard to the characteristics of the second member:

- the first arrangement was defined in granted claim 3 and referred to the second member comprising a sheet material having an initial length beyond the length of the covering zone in the circumferential direction and formed in that direction with gathers; reference was made to col. 3, l. 30 to 37 of the patent;
- the second arrangement was defined in granted claim 4 and referred to the second member comprising a sheet material having a length substantially equal to the length of the covering zone in the circumferential direction and adapted to be inelastically stretchable in that direction;

reference was made to col. 3, l. 37 to 42 of the patent.

2.4.2 Due to the features of granted claims 1 and 4 being combined in current claim 1 (as opposed to the features of claim 3 and claim 1), the respondent argued that only the second arrangement was included in claim 1. According to the respondent, this arrangement would thus be understood as an alternative to the first arrangement in granted claim 3 and therefore it would be clear that, according to claim 1, only the length of the material when laid flat should be considered for determining whether the material sheet had a length substantially equal to the length of the covering zone, and inelastic stretching began only when the second member was already stretched and hence excluded straightening of a gathered structure.

2.4.3 Further, according to the respondent, such understanding should also be obvious from the fact that a gathered material had to have a greater length than a length equal to the length of the covering zone. When applying this interpretation to current claim 1, the skilled person would appreciate that the disclosure in D5 was not directed to such an arrangement and, therefore, that it was not relevant at all.

2.5 However, the Board finds that the claimed subject-matter is not limited to an arrangement according to the respondent's interpretation.

2.5.1 The disclosure in paragraph [0010] (col. 3, l. 1 to 44) of the patent concerns the assembly method of the diaper and is not directly linked to the finished article defined in claim 1.

- 2.5.2 Although the embodiment defined in claim 3 as granted concerns a diaper having a sheet material within the second member whose length extends beyond the length of the covering zone and which is formed with gathers, the embodiment defined in claim 4 as granted does not represent a clear alternative to this, but merely a different embodiment when considering the possibility of gathers. Indeed, claim 3 as granted specifically refers to an "initial length" which is longer than the covering zone length, but that this is shortened by the gathers to a length substantially the same as the length of the covering zone. Claim 1 does not define any "initial" length of the sheet, merely a length. Also, with regard to the cited passage in the description, this refers to the formation of gathers and accordingly their presence when attaching the elastic zone to the waist region is also not excluded in this embodiment.
- 2.5.3 The claim does not define any further characteristics of the second member, nor of the sheet material which is claimed to be comprised within the second member. Consistently with the Board's view, the wording in claim 1, namely "adapted to be inelastically stretchable", also does not specify whether an elastic stretchability is excluded. Hence, the presence of gathers which enable inelastic stretchability is not excluded for the sheet material comprised in the second member, and there is no limitation in claim 1 which enables a different interpretation.
- 2.5.4 Although the respondent also argued that "stretching" excluded merely extending the gathers, on the basis that no material was actually "stretched", this interpretation is contrary to that stated in the patent at column 3, 1. 33 to 36, which says that it is

precisely the gathers which make the sheet substantially stretchable.

2.5.5 In addition, the respondent's argument in support of its interpretation of the length of the second member based on the deletion of granted claim 3 is not persuasive. Merely deleting a granted claim does not by itself add any further limitation to the claim under consideration.

2.6 Accordingly, D5 discloses all the features of claim 1.

2.7 The sole request of the respondent for maintenance of the patent is therefore not allowable and the patent must therefore be revoked.

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. H. A. Patin

M. Harrison

Decision electronically authenticated