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**Datasheet for the decision
of 4 September 2014**

Case Number: T 0059/11 - 3.2.06

Application Number: 02740435.9

Publication Number: 1383453

IPC: A61F13/20

Language of the proceedings: EN

Title of invention:

TAMPON HAVING SPIRALLY SHAPED GROOVES

Patent Proprietor:

Johnson & Johnson GmbH

Opponent:

The Procter & Gamble Company

Headword:

Relevant legal provisions:

EPC 1973 Art. 87(1), 54

EPC Art. 123

RPBA Art. 13(1)

Keyword:

Priority - main request (no)

Novelty - main request (no)

Late-filed auxiliary requests - admitted (yes)

Remittal to the department of first instance - (yes)

Decisions cited:

G 0002/98, T 0241/02

Catchword:



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Case Number: T 0059/11 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 4 September 2014

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
2 November 2010 concerning maintenance of the
European Patent No. 1383453 in amended form.**

Composition of the Board:

Chairman M. Harrison
Members: M. Hannam
W. Ungler

Summary of Facts and Submissions

I. An appeal was filed by the appellant (opponent) against the interlocutory decision of the opposition division, in which it found that European patent No. 1 383 453 in an amended form met the requirements of the EPC. The appellant cited the following documents:

D1 WO-A-02/076357

D2 DM/057770

D3 US-A-5 813 102

The appellant further submitted that the independent claims under consideration did not enjoy a right of priority from

P1 DE 101 14 786

II. In response to the appeal, the respondent (proprietor) requested that the appeal be dismissed and submitted arguments concerning the validity of the priority claimed from P1.

III. The Board issued a summons to oral proceedings including a communication containing its provisional opinion, in which it indicated *inter alia* that the subject-matter of the independent claims appeared not to enjoy a right of priority from P1 and that therefore the subject-matter of these claims seemingly lacked novelty in view of the disclosure in D1.

IV. With letter of 22 July 2014, the appellant indicated that it maintained its request for revocation of the patent but that it would not be attending the scheduled oral proceedings.

- V. With letter of 4 August 2014, the respondent submitted auxiliary requests 1-12.
- VI. Oral proceedings were held before the Board on 4 September 2014, during which the respondent filed a new auxiliary request 1 replacing all auxiliary requests on file.

The appellant's request, contained in its written submissions, was that the decision under appeal be set aside and the European patent No. 1 383 453 be revoked. The respondent requested that the appeal be dismissed or that the patent be maintained on the basis of auxiliary request 1 filed during these oral proceedings. Furthermore, the respondent requested that the case be remitted to the department of first instance for further prosecution.

- VII. Claim 1 of the main request reads as follows:
"Tampon for feminine hygiene, having an insertion end (32), a recovery end (34), a longitudinal axis, the tampon (30) being made of compressed fibrous material and having an outer surface, characterized in that said outer surface of the tampon is at least partially provided with spirally shaped, pressed longitudinal grooves (42)."

Claims 1 and 2 of auxiliary request 1 read as follows:
"1. Tampon for feminine hygiene, having an insertion end (32), a recovery end (34), a longitudinal axis, the tampon (30) being made of compressed fibrous material and having an outer surface, characterized in that said outer surface of the tampon is at least partially provided with spirally shaped, pressed longitudinal grooves (42), wherein the tampon (30) has a core (38) of highly compressed fibrous material from which core

longitudinal ribs (40) extend radially outward at equal circumferential angle intervals and between the insertion end (32) and the recovery end (34) and that are defined by said spirally shaped, pressed longitudinal grooves (42), wherein said longitudinal ribs (40) are at least partially relatively uncompressed compared with the core (38), and wherein the tampon is compressed radially with respect to the longitudinal axis."

"2. Method of producing a tampon, comprising the steps:
- providing a tampon blank (55) of tangled fibrous material having a longitudinal axis;
- compressing the tampon blank (55) and at least partially forming spirally shaped longitudinal grooves (42) at an outer circumferential surface of the tampon (30) in order to enlarge the outer circumferential surface of the tampon (30) having an insertion end (32) and a recovery end (34)
wherein the tampon blank (55) is compressed such that the tampon (30) has a core (38) with a high degree of compression, from which relatively uncompressed longitudinal ribs (40) extend radially outward, wherein said tampon blank (55) is compressed such that said longitudinal ribs (40) are at least partially relatively uncompressed compared with the core (38), wherein the tampon blank (55) is compressed radially with respect to the longitudinal axis, and wherein the tampon blank (55) is compressed such that said longitudinal ribs (40) extend radially outward at equal circumferential angle intervals and between the insertion end (32) and the recovery end (34)."

VIII. The appellant's arguments may be summarised as follows:

Claim 1 (of the main request) did not enjoy a right of

priority from P1 since its subject-matter was not directly and unambiguously derivable therefrom. Claim 1 of P1 presented the broadest disclosure for the tampon disclosed in P1, yet the subject-matter of claim 1 of the opposed patent was broader still since the following features from claim 1 of P1 had been omitted:

- the solid core made of highly compressed fibrous material;
- the recovery tape
- the material being radially compressed with respect to the tampon axis;
- relatively uncompressed ribs; and
- the ribs extending radially outward at equal circumferential angle intervals.

According to G2/98 these features were related to the function and effect of the inventive tampon and so could not be omitted from claim 1 of the main request if the right of priority was to be validly claimed. The recovery tape was presented as being essential in P1, although a skilled person would nevertheless recognise that it might be omitted. However this was not the test to be applied when considering whether priority was valid or not (G2/98, Reasons 9).

With claim 1 of the main request lacking a valid priority claim from P1, D1 represented prior art under Article 54(3) EPC and deprived the subject-matter of claim 1 of novelty (Article 54 EPC).

The combination of claims 1, 2 and 4-6 as originally filed was excised by the applicant during prosecution of the application due to double patenting objections with D1. The only form of claim 1 validly claiming priority from P1 was thus deleted from the application prior to grant.

IX. The respondent's arguments may be summarised as follows:

Regarding the priority claim for claim 1 of the main request, the problem addressed by the patent (see [0007]) and the priority document (page 4, lines 18-24) was the same. The features of claim 1 of P1 omitted in claim 1 of the main request were not essential to solve this problem and thus the priority claim was valid. It was also apparent that the skilled person knew how the claimed tampon should be manufactured i.e. using radially acting jaws to compress grooves into a blank with resultant relatively uncompressed ribs between the grooves. These omitted features were thus implicitly present in the tampon of claim 1. The feature regarding the ribs positioned at equal circumferential intervals could also be omitted whilst validly claiming priority since this feature had no technical effect; an unequal circumferential spacing would also absorb fluids effectively. The recovery tape was not related to the other features in claim 1 of P1, except by it being attached.

When deciding on the validity of the priority, the teaching of the priority document as a whole should be considered, that is the claims, description and drawings, as identified in the Guidelines F-VI, 2.2.

Regarding the auxiliary request, claim 1 was based on claims 1, 2 and 4-6 as originally filed, while claim 2 was based on claims 21, 23 and 25-27 as originally filed. With all dependent claims having been deleted, this request could not be considered complex and should thus be admitted. Even though the opposition division had mentioned the combination of claims comprised in claim 1 replicated that in D1 (and thus would be

subject to an objection of double patenting), this could not be seen as a cut-off point prohibiting this subject-matter from being pursued once more at a later stage when restoring priority, particularly since in contrast to the present claim 1, D1 included a recovery tape in its claim 1.

Reasons for the Decision

1. Main request

1.1 Invalid priority P1

1.2 At least the subject-matter of claim 1 does not enjoy a right of priority (Article 87 EPC 1973) from P1.

1.2.1 The requirement for claiming priority of 'the same invention', referred to in Article 87(1) EPC, means that priority of a previous application in respect of a claim in a European patent application in accordance with Article 88 EPC is to be acknowledged only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole (see e.g. G2/98, Headnote). In the present case, therefore, the question to be answered is whether the subject-matter of claim 1 can be directly and unambiguously derived by the skilled person, using common general knowledge, from P1 as a whole.

1.2.2 P1 discloses a tampon for feminine hygiene in considerable detail, the broadest disclosure of which, however, is present in claim 1 of P1. This claim therefore presents the disclosure source most likely to

present a direct and unambiguous basis for the subject-matter of claim 1 of the main request.

By comparison of claim 1 of P1 and the subject-matter of claim 1 of the main request, the following features, included in claim 1 of P1, are not present in claim 1 of the main request:

- (a) the tampon core being made of highly compressed fibrous material;
- (b) the fibrous material being compressed radially with respect to the tampon axis;
- (c) partially uncompressed longitudinal ribs extend radially outward from the axis;
- (d) the ribs extend outward at equal circumferential angle intervals; and
- (e) a recovery tape.

For claim 1 to validly claim priority from P1, therefore, a basis for the omission of these features must be present in P1 when taking into account the common general knowledge of the skilled person.

- 1.2.3 Regarding the omission of the recovery tape, feature (e) above, the Board finds this not to be problematic, since both the structure and the function of the tape is unrelated to the further features present in claim 1 of P1. The problem being addressed by the tampon of P1 is to reduce the risk of leakage (see page 4, lines 18-24). To this problem, the recovery tape is clearly functionally unrelated as its purpose is to aid removal of the tampon after use.

As concerns the structural interaction of the recovery tape with the tampon, this is not disclosed in any detail, Figs. 1, 14 and 15 simply showing it extending from the recovery end of the tampon, with page 28,

lines 15-21 describing the tape as remaining centrally placed at the recovery end of the tampon due to the manner in which the tampon is pressed during manufacture. It is further noted that the recovery tape is specifically absent from many figures (e.g. Figs. 3 and 9-12) even though these figures provide a clear view of the recovery end of the tampon or the tampon blank at which, if present, the recovery tape would be clearly visible. It thus follows that a structural interaction of the recovery tape with the further features of the tampon of P1 is - taking into account the disclosure of that application as a whole - of such a nature that its omission from the tampon has no effect on these further features. Using the common general knowledge of the skilled person, which the appellant itself acknowledges already would give the first step in this direction (namely its non-essentiality), the recovery tape in this particular case (i.e. in relation to the disclosure in P1) would - due to its lacking structural and functional interrelationship - be understood directly and unambiguously not to be associated with the other features of claim 1 in a way which would result in its removal giving rise to a combination of features which was not disclosed.

Thus, although in Reasons 9 of G2/98 the relationship of features on the function and effect of the invention is to be disregarded when assessing priority, the issue in the present case is not concerned with the effects of the invention in P1, but instead with the disclosure of that application as a whole and the question of how the skilled person reading the document with his common general knowledge understands the structural and functional interrelationship of the specific combination of features in claim 1 of P1.

The recovery tape is thus according to the disclosure of the previous application as a whole structurally and functionally unrelated to the further combination of features in claim 1 of P1, such that its omission alone does not give rise to invalidation of the priority claim, provided that, see *infra*, all other features in the combination of features of claim 1 in P1 remain.

1.2.4 This proviso, of all other features in the combination of features of claim 1 in P1 remaining, is however not met. There is no basis in P1 as a whole for the omission of the above identified features (a) to (d) from claim 1:

(a) The highly compressed nature of the fibrous material of the tampon core allows a greater quantity of fluid to be absorbed, as described on page 5, lines 16-23 of P1. This feature thus has a direct relationship with the above problem being addressed by P1 of reducing the risk of leakage from the tampon, and it is structurally interrelated with the other features of the tampon not least since an essentially continuous body is provided by means of which the structure is obtained. There is also no indication anywhere in the whole disclosure of P1 that this highly compressed nature of the core is merely an optional feature of the tampon. An omission of this feature from the present claim 1 is thus not directly and unambiguously derivable from P1 as a whole.

(b) The omission of the feature from claim 1 regarding the fibrous material being compressed radially with respect to the tampon axis can also not be

directly and unambiguously derived from P1 as a whole. A suggestion that this feature is optional and can thus be omitted from the disclosure in claim 1 of P1 cannot be found in the document. Furthermore the radial compression, as would be evident to the skilled person, provides a circumferentially symmetrical compression enabling the tampon to absorb liquid effectively around its full circumference. This structural interrelation and functional interaction with the performance of the tampon dictates the necessary inclusion of this feature in claim 1 in order for the priority claim to be recognised.

- (c) The partially uncompressed longitudinal ribs extending radially outward from the axis of the tampon have the effect of readily absorbing fluid contacting the tampon (see page 14, lines 7-14 of P1). Even ignoring the structural relationship of the uncompressed ribs (brought about structurally by the manner in which the tampon is manufactured), the partially uncompressed ribs already have a clear functional relationship with the remaining features of the tampon of claim 1 of P1, contributing also to the solution of the problem of reducing the risk of leakage from the tampon. Lacking an indication in P1 that this feature can be omitted from claim 1 of P1, there is no direct and unambiguous disclosure of the tampon of claim 1 without such longitudinal ribs.

- (d) The omission from claim 1 of the feature regarding the ribs extending outward at equal circumferential angle intervals can also not be directly and unambiguously derived from P1 as a whole. The skilled person would understand this

feature as providing a tampon which absorbs liquid consistently well around its full circumference and thus clearly contributes to the function of the tampon as a whole. With no suggestion in P1 as a whole that this feature can be omitted from the tampon, its omission from the present claim 1 cannot be considered to be directly and unambiguously derivable from P1.

1.2.5 The respondent's argument that both the patent and P1 addressed the same problem, and that the omitted features of claim 1 of P1 in claim 1 of the main request could be omitted as they were not essential to solve this common problem, is not relevant. The existence of a common problem to be solved in a claim under consideration and the document from which its priority is claimed is not decisive in finding a priority validly claimed or not. Nor is an identification of features which are not essential to solving this common problem and their deletion an accepted approach to justify a valid priority claim. Rather, as found in G2/98, the priority right can be enjoyed only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole. As shown for the features of claim 1 of P1 omitted from the present claim 1 under point 1.2.4 above, the ability for the skilled person to derive in a direct and unambiguous manner the subject-matter of claim 1 from P1 as a whole is lacking, such that the priority right of claim 1 cannot be recognised.

1.2.6 The respondent's argument regarding the implicit presence of the omitted features in claim 1 due to the skilled person knowing how the claimed tampon would be

manufactured is not persuasive. The present claim 1 is directed to a tampon and is not restricted in any way to a particular method of its manufacture, be that the method disclosed in P1 or any other method of manufacturing such a tampon. Without restriction to a particular method of manufacture it is not possible to implicitly derive, for example, that relatively uncompressed longitudinal ribs will extend radially outward at equal circumferential angle intervals from the tampon axis. Such a feature would possibly be implicitly present in the claimed tampon if, in some way, claim 1 was limited to the very specific method of forming the tampon disclosed in P1. Lacking such specific limitation to the method of manufacture of the tampon used in claim 1, it is not possible to implicitly derive the presence of such a feature.

- 1.2.7 Regarding the respondent's contention that the feature regarding the ribs being positioned at equal circumferential intervals could be omitted as this feature had no recognisable technical effect, the Board finds otherwise. Indeed, as identified under point 1.2.4 (d) above, the skilled person would understand this feature as providing a tampon which absorbs liquid consistently well around its full circumference and thus clearly contributes to the function of the tampon as a whole. The further contention that an unequal circumferential spacing would also absorb fluids effectively may be true, yet this is irrelevant. There is no disclosure of an arrangement other than that of ribs at equal circumferential intervals in the whole of P1, such that the skilled person has no guidance to arrange the ribs on the tampon in any manner other than that suggested in claim 1 of P1 i.e. at equal circumferential intervals.

1.2.8 It thus follows that there exists no basis in P1 as a whole to omit the above identified features from the present claim 1. As a result, the subject-matter of claim 1 cannot be derived directly and unambiguously, using common general knowledge from P1 as a whole and at least the subject-matter of claim 1 thus cannot enjoy the right of priority from P1 (Article 87 EPC 1973).

1.3 *Lack of novelty, claim 1*

The subject-matter of at least claim 1 lacks novelty (Article 54 EPC 1973) over the disclosure of D1.

With claim 1 not enjoying the right of priority from P1, D1 is to be considered as comprised in the state of the art for this claim under Article 54(3) EPC. D1 thus discloses the following features of claim 1, the reference signs in parentheses referring to D1:

Tampon for feminine hygiene (e.g. page 1, lines 1-2; Fig. 1), having an insertion end (32), a recovery end (34), a longitudinal axis (see e.g. Fig. 1), the tampon (30) being made of compressed fibrous material (see e.g. page 14, lines 2-4) and having an outer surface, wherein said outer surface of the tampon is at least partially provided with spirally shaped, pressed longitudinal grooves (42; see also e.g. Fig. 1; sentence bridging pages 14 and 15).

The respondent presented no arguments in support of the novelty of the subject-matter of claim 1 with respect to D1, beyond stating that the claim to priority from P1 was valid, which, as explained above, is not so.

The Board thus finds that the subject-matter of at

least claim 1 lacks novelty (Article 54 EPC 1973), such that the main request is not allowable.

2. *Auxiliary Request 1*

2.1 *Admittance of the request*

The Board exercised its discretion to admit the request into the proceedings (Article 13(1) RPBA).

2.1.1 According to Article 13(1) RPBA, any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. 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.

Comprising solely two independent claims with all dependent claims deleted, and with the two independent claims each consisting solely of a combination of claims as originally filed, the Board found this request not to be of such complexity that it could not be dealt with during the oral proceedings.

As is common practice before the Boards of Appeal, the admittance of the request at this late stage in the proceedings was also dependent upon it *prima facie* overcoming the objections present with regard to the main request and the amendment not giving rise to any new objections.

2.1.2 *Article 123 EPC*

Claim 1 is based on a combination of claims 1, 2 and 4-6 as originally filed, claim 2 on a combination of

claims 21, 23 and 25-27 as originally filed. The subject-matter of claims 1 and 2 thus meets the requirement of Article 123(2) EPC. In comparison to the respective product and method claims 1 and 20 as granted, claims 1 and 2 have been modified through the addition of further features. Claims 1 and 2 thus do not extend the protection conferred compared to the claims as granted, meeting the requirement of Article 123(3) EPC.

2.1.3 *Article 84 EPC 1973*

The Board finds the subject-matter of claims 1 and 2 to meet the clarity and conciseness requirement of Article 84 EPC 1973.

It may be noted here that while the use of the term 'highly' in the expression 'highly compressed fibrous material' might in other contexts be considered unclear, in the present claims 1 and 2 this high compression is contrasted with relatively uncompressed longitudinal ribs. The use of the term 'highly' is thus understood by the skilled person as being highly compressed in a manner not only providing the required absorption characteristics as a result of its compression but at the same time as being high in compression relative to the compression of the longitudinal ribs.

It is further noted that no objections of clarity were raised at any time by the appellant to any of the requests in the proceedings. Therefore, even if the appellant had been present at the oral proceedings, the Board has no reason to expect that an objection in this respect would have been raised to the present claims

either.

2.1.4 *Double patenting/ excised features*

The Board does not accept the appellant's argument that the present claim 1 (i.e. that based on claims 1, 2 and 4-6 as originally filed) may not be re-introduced following its excision by the applicant during prosecution of the application. As also found in T241/02, Reasons 1.4, the grant of a patent does not necessarily constitute a cut-off point excluding any reinsertion of deleted subject-matter in subsequent proceedings; such a reinsertion is governed by the requirement of Article 123(3) EPC, under which the protection conferred by a patent may not be extended in post-grant proceedings. In the present case, therefore, in which claim 1 as granted comprised solely claim 1 as originally filed, the re-introduction of a claim based on claims 1, 2, and 4-6 as originally filed clearly restricts the protection conferred when compared with claim 1 as granted, and is not objectionable.

It is further noted that no decision was taken during prosecution concerning double patenting with regard to D1 and the combination of claims 1, 2 and 4-6. The Board also *prima facie* sees no objection in this regard.

2.1.5 *Priority validity*

The Board finds that amended claim 1 includes all features of claim 1 of P1 which were identified under point 1.2.4 as being necessary in combination for the priority right from P1 to be enjoyed. Similarly, amended claim 2 includes all features required to produce the tampon of claim 1 of P1 as disclosed in

method claim 18 of P1. The Board notes that these amended claims also overcome the objections to a valid priority claim raised by the appellant in respect of the independent claims 1 and 19 of the main request.

The claims of auxiliary request 1 thus enjoy a right of priority from P1.

2.1.6 Novelty

With the claims enjoying a right of priority from P1, D1 is not comprised in the state of the art for the subject-matter of the claims of this request. The same applies to D2.

D3 fails to disclose certain features of the claims of the present request. Specifically with respect to the subject-matter of claim 1, D3 for example fails to disclose a tampon with spirally shaped grooves; with respect to the subject-matter of claim 2, D3 for example fails to disclose the method step of forming spirally shaped grooves.

The subject-matter of claims 1 and 2 is thus novel over D3 (Article 54 EPC 1973).

2.1.7 The request thus *prima facie* overcomes the objections raised to the main request and does not introduce any new objections. The Board thus exercised its discretion to admit the request into proceedings (Article 13(1) RPBA).

2.1.8 The respondent requested that the case be remitted to the department of first instance for further prosecution. This seems equitable in the present case, since the opposition division had, in its interlocutory

decision, considered the priority claim based on P1 to be valid for those particular claims under consideration. In order to provide the parties the possibility of developing arguments on inventive step, in light of the primary reasoning of the interlocutory decision having been removed, and since claim 1 includes a feature which was taken from the application as filed but which was not in the granted product claims (i.e. the feature regarding the longitudinal ribs extending radially outward at equal circumferential angle intervals), remittal of the case is deemed appropriate. It is furthermore noted that the description may indeed require adaptation in order to meet e.g. the further requirement in Article 84 EPC of support of the claims by the description.

2.1.9 The Board thus exercised its discretion under Article 111(1) EPC 1973 to remit the case to the Opposition Division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



I. Aperribay

M. Harrison

Decision electronically authenticated