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**Datasheet for the decision
of 30 September 2015**

Case Number: T 1328/11 - 3.2.06

Application Number: 03745101.0

Publication Number: 1485055

IPC: A61F13/20

Language of the proceedings: EN

Title of invention:

METHOD OF PRODUCING A SHAPED TAMPON

Patent Proprietor:

THE PROCTER & GAMBLE COMPANY

Opponent:

Johnson & Johnson GmbH

Headword:

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

Amendments - added subject-matter (yes)



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1328/11 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 30 September 2015

Appellant: Johnson & Johnson GmbH
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Respondent: THE PROCTER & GAMBLE COMPANY
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Representative: Briatore, Andrea
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
18 April 2011 concerning maintenance of the
European Patent No. 1485055 in amended form.**

Composition of the Board:

Chairman M. Harrison
Members: G. de Crignis
M.-B. Tardo-Dino

Summary of Facts and Submissions

- I. By way of its interlocutory decision, the opposition division found that European Patent No. 1 485 055 as amended met the requirements of the European Patent Convention (EPC).
- II. The appellant (opponent) filed an appeal against this decision and objected to the claims with reference to Articles 84 EPC, 123(2) EPC, 83 EPC, 54 EPC and 56 EPC.

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

- III. The respondent (patent proprietor) requested that the appeal be dismissed.
- IV. In a communication annexed to the summons to oral proceedings, the Board indicated in its preliminary view that the requirements of Articles 123(2) EPC and 84 EPC were considered not to be met. In regard to the requirement of Article 123(2) EPC, the Board stated that no disclosure could be found in the application as filed for a tampon having both an undercut as well as a decreased perimeter in the centre, which was however what the amendment made during proceedings before the opposition division defined.
- V. With letter of 27 August 2015, the respondent announced that the request for dismissal of the appeal was maintained but that it would not attend or be represented at the oral proceedings. With letter of 25 September 2015 the respondent maintained its request that the appeal be dismissed but withdrew its request for oral proceedings. No response was received from the

respondent to the Board's provisional opinion given in the annex to the summons.

- VI. The oral proceedings were subsequently cancelled.
- VII. In accordance with the parties' written submissions, the appellant requested that the decision under appeal be set aside and the patent be revoked, whereas the respondent requested that the appeal be dismissed.

Claim 1 of the sole request reads as follows (*the amendment added during the opposition proceedings appearing in italics*):

"A method of forming a shaped tampon which comprises the steps of:

- a. providing a split cavity mold having an inner surface, an outer surface, a first end, a second end, and an opening located in said second end;
- b. providing a tampon pledget;
- c. transferring said tampon pledget through said opening into said second end of said mold using a transfer member resulting in a tampon mold;
- d. self-sustaining said shaped tampon wherein said shaped tampon has an undercut *and has at least one perimeter in the center of the tampon that is less than both an insertion end perimeter and a withdrawal end perimeter*; and
- e. removing said shaped tampon from said tampon mold."

- VIII. The appellant argued essentially as follows:

Granted claim 1 was amended by the addition of wording defining that the tampon had to have at least one perimeter in the center that was less than both an insertion end perimeter and a withdrawal end perimeter.

However, the term "center" was not defined. In this respect it should also be taken into account that the insertion end was shown in the Figures as being a point in the end portion and thus could not have a perimeter which would be more than the perimeter in a "center" region or point.

The added feature was taken from page 8, last paragraph of the description as originally filed. Accordingly, the requirement of Article 123(2) EPC was not met.

IX. The respondent argued essentially as follows:

The added feature could be clearly understood as it had to be read with the mindset of a skilled person wishing to understand the meaning of the claims and with an eye to the description. The term "undercut" was clearly defined as a "protuberance or indentation which impedes withdrawal from a one piece mold". The terms "center", "withdrawal end" and "insertion end" were relative terms which were understood by the skilled person to refer to a tampon which was narrower in a central portion and broader at the outer portions so that it could not be extracted from a one piece mold.

The cited passage (page 8, last paragraph) in the originally filed description gave a definition of the term "undercut" via the wording of "a protuberance or indentation which impedes withdrawal from a one piece mold". Such an "undercut" was an essential feature of the subject-matter in all independent claims. Hence the added feature was not part of a specific embodiment and could be added to the independent claims in isolation. Hence, the requirement of Article 123(2) EPC was met.

Reasons for the Decision

1. *Article 123(2) EPC*

1.1 The wording of independent claim 1 (and incidentally the other independent claims 5, 6 and 7) was amended to include the feature (cited in italics here) of "wherein said shaped tampon has an undercut *and has at least one perimeter in the center of the tampon that is less than both an insertion end perimeter and a withdrawal end perimeter;*".

1.2 No disclosure of a method of forming a tampon having both an undercut (which is a protuberance or indentation) in addition to a decreased perimeter in the center of the tampon is present in the application as originally filed.

1.2.1 According to the originally filed disclosure in the description (on page 8, last paragraph and on page 18, lines 5 to 17), the term "undercut" is defined as referring to "tampons having a protuberance or indentation that impedes the withdrawal from a one piece mold" and as an example reference is made to "shaped tampons created by the methods of the present invention may have at least one perimeter in the center of the tampon that is less than both an insertion end perimeter and a withdrawal end perimeter". Hence, the decreased perimeter in the center of the tampon represents the undercut but not a further feature. Consistently therewith, all the Figures show a single decreased perimeter in the centre/central region of the tampon. No other position for an undercut is disclosed. Thus, there is no basis in the originally filed

application for the added feature of an undercut (in an unspecified position) in addition to a decreased central region.

1.2.2 The provisional view of the Board in accordance with the foregoing had already been communicated to the respondent with the annex to the summons, and no reply on this matter was received from the respondent. The Board thus confirms its provisional herewith for the reasons given above.

1.3 Accordingly, the subject-matter of claim 1 extends beyond the content of the application as filed, contrary to the requirement of Article 123(2) EPC. The respondent's request is therefore not allowable.

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