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**Datasheet for the decision
of 11 October 2016**

Case Number: T 0069/12 - 3.2.06

Application Number: 01300449.4

Publication Number: 1120097

IPC: A61F13/511, A61F13/84

Language of the proceedings: EN

Title of invention:

Absorbent article containing skin-protective ingredient

Patent Proprietor:

Unicharm Corporation

Opponent:

Procter & Gamble, Inc.

Relevant legal provisions:

EPC Art. 123(2)
RPBA Art. 13(1), 13(3)

Keyword:

Amendments - allowable (no)
Late-filed request - need for additional search (yes)
- amendments after arrangement of oral proceedings



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Case Number: T 0069/12 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 11 October 2016

Appellant: Procter & Gamble, Inc.
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
1 November 2011 concerning maintenance of the
European Patent No. 1120097 in amended form.

Composition of the Board:

Chairman M. Harrison
Members: G. de Crignis
W. Ungler

Summary of Facts and Submissions

- I. By way of its interlocutory decision, the opposition division found that European Patent No. 1 120 097 as amended met the requirements of the European Patent Convention (EPC).
- II. The appellant (opponent) filed an appeal against this decision requesting that the decision of the opposition division be set aside and the patent be revoked.
- III. The respondent (patent proprietor) replied and requested to maintain the patent based on the main request which was found allowable by the opposition division and also filed auxiliary requests I to X.
- IV. The appellant as well as the respondent provided further observations in particular with regard to the experimental data on file.
- V. In a communication annexed to the summons to oral proceedings, the Board indicated its preliminary view that the requirements of Article 123(2) EPC and Article 83 EPC did not appear to be met.
- VI. In response to the communication of the Board, the respondent filed a new main request as well as first to seventh auxiliary requests.
- VII. Oral proceedings were held before the Board on 11 October 2016. During the oral proceedings, the respondent withdrew all previous requests and filed a new sole request (main request at 11:20).

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

The respondent requested that the decision under appeal be set aside and that the patent be maintained on the basis of the new main request as filed at 11:20 hours during the oral proceedings.

VIII. Claim 1 reads as follows:

"An absorbent article comprising: a main body including a liquid-pervious top sheet (10), a back sheet (11) and an absorbent core (12) sandwiched between the top sheet and the back sheet; a layer (50) containing a skin-protective ingredient; and a support layer (51) for covering the ingredient-containing layer, the support layer being provided on the surface of the main body to be in contact with the skin of a wearer; wherein the two layers are located on the surface of the top sheet, characterised in that; the solubility in water of the support layer is promoted at 25°C or higher, and/or the moisture absorbability or the solubility in water of the support layer is promoted at a relative humidity of at least 30%, and the layer containing a skin-protective ingredient is formed of a compound capable of forming an oily film on the skin of a wearer; wherein the support layer is formed of polyethylene oxide having a molecular weight of from 700 to 1,000, which has a melting point of from 35 to 40 °C; wherein the layer containing a skin-protective ingredient can be fluidized at 35°C or higher; and wherein the layer containing a skin-protective ingredient is formed of Vaseline."

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

The new request should have been filed earlier because all objections had been raised before. The features included in claim 1 were not disclosed in combination (Article 123(2) EPC), but were a selection from two lists for which no basis was present, the selected molecular weight together with melting temperature of polyethylene oxide and the choice of vaseline. The limitations defined in the new claim meant that the arguments which had been put forward with respect to novelty and inventive step so far were no longer directly applicable, particularly since there was no document in the proceedings which disclosed specifically the selected ranges. Hence, at least an additional search was necessary which would require a postponement of the proceedings.

The request should not be admitted.

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

The request was not filed earlier to avoid the need to consider a large amount of requests. A request including limitations for the compound of the support layer had already been presented in reply to the grounds of appeal as the eighth auxiliary request. Accordingly, the appellant could then have searched for a document with regard to the selected range.

The amendments merely limited the compounds to be considered for the support layer as well as for the ingredient-containing layer significantly. The combination of features was clearly disclosed since the

description referred to them both as being "most preferred". Although no combination of these most preferred features was explicitly mentioned, the skilled person would have chosen to do so.

Thus, the requirements of Articles 84 and 123(2) EPC were met and no additional search or postponement were necessary. Hence, the Board should admit the request.

Reasons for the Decision

1. Admittance of the request
 - 1.1 The Board as well as the appellant were presented with the sole new request for the first time at the end of the oral proceedings, after detailed discussion of earlier requests.
 - 1.2 Since the request was filed after the time limit for filing the response to the appeal grounds of the appellant as its complete case (see Art. 12(1) and (2) of the Rules of Procedure of the Boards of Appeal (RPBA)) it therefore constitutes an amendment to the respondent's case. As such according to Article 13(1) RPBA, 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. In order to be admitted at such a late stage of proceedings, such a request should normally be *prima facie* allowable at least in the sense that it overcomes the objections raised and does not give rise to new objections.

- 1.3 In addition, an amendment sought to be made after oral proceedings have been arranged shall not be admitted if it raises issues which the Board and the other party cannot reasonably be expected to deal with without adjournment of the oral proceedings (Article 13(3) RPBA).
- 1.4 Claim 1 relates to subject-matter which at least *prima facie* extends beyond the content of the application as originally filed (Article 123(2) EPC).
- 1.5 Claim 1 has been amended *inter alia* by limiting the support layer to being formed of polyethylene oxide having a molecular weight in the range of from 700 to 1,000 and having a melting point in the range of from 35 to 40°C and also by limiting the feature of the layer containing a skin-protective ingredient to being formed of vaseline.
- 1.6 Concerning the support layer, the description as filed generally refers to three groups of compounds: polyethylene oxides, polypropylene glycols and polyvinyl alcohols. In originally filed claim 2, the group of polyethylene oxides having a molecular weight of from 100 to 500,000 is included. No reference to a more specific group of polyethylene oxides is made in the claims. The amendment concerning the support layer being formed of a limited group of polyethylene oxides is based on the disclosure at page 15, lines 7 to 9 (corresponding to paragraph 30 of the A-publication) wherein this range is defined as being "more preferred", without any indication of why this range is more preferred, let alone with any relationship to further features of the article.

- 1.7 Concerning the ingredient-containing layer and its compounds, a variety of vegetable based oils and fats as well as animal based oils and fats are disclosed in the description as filed in addition to compounds selected from hydrocarbons. In the originally filed claims, vaseline merely appears as one of a list of compounds; it is mentioned specifically as one compound within a series of other hydrocarbons in claim 5 as filed. The amendment concerning this layer is based on the disclosure at page 11, line 6 as filed (corresponding to paragraph 23 of the A-publication) wherein vaseline is defined as a "more preferred" oily film-forming compound with regard to its characteristics concerning safety and low cost.
- 1.8 As set out in the paragraphs above, the features are based on the description as filed which refers to them both, independently, as being "more preferred". Accordingly, the issue is whether a disclosure existed for a skilled person indicating that polyethylene oxides should be selected as a support layer in specific combination with vaseline as the skin-protective ingredient in the ingredient-containing layer.
- 1.9 No example is given at all in the application and no specific disclosure in the description of this combination is present either. Accordingly, the limitation amounts to the selection of two compounds out of two lists (i.e. three possibilities for the support layer and ten possibilities for the ingredient-containing layer) without however any disclosure of such a selection. The respondent argued that all that was being done by the amendment was limiting the larger range to a smaller most preferred range and simply choosing one compound from a whole list of compounds

all of which could have been combined together. The Board does not accept this. On the contrary, the two layers act in intimate contact one on the other and it is self-evident that the properties of one affect the properties of the other.

- 1.10 In view of at least no clear and unambiguous disclosure of this combination of features being present in the application as filed, the amendments are at least not *prima facie* allowable and the requirement of Article 123(2) EPC is not met.
- 1.11 Additionally, the amendments concern specific subject-matter which had been neither searched nor examined previously. The appellant also argued, and this was not disputed by the respondent, that none of the documents in the proceedings disclosed the specific polyethylene oxide molecular weight range, let alone in combination with vaseline.
- 1.12 Accordingly, these amendments do not just represent a minor change in the wording of claim 1 but rather major limitations of the claim which would necessarily change the underlying arguments put forward by the appellant with respect to novelty and inventive step. Accordingly, the Board accepts that the limitation of the claim would warrant at least a new search being performed as well as new arguments by the appellant. In order for the appellant to perform an additional search, an adjournment of the oral proceedings would have been required.
- 1.13 Article 13(3) RPBA requires that amendments sought to be 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

with without adjournment of the oral proceedings, which is precisely the case here.

1.14 The respondent's argument that a search could have been performed by the appellant before the oral proceedings with regard to a document disclosing the more limited range is not accepted. Although it is true that one request (eighth auxiliary request) was presented with the reply to the statement of grounds of appeal, which limited the range of the molecular weight of the polyethylene oxide to a different range of 500 to 3000, there was no reason to suppose that a claim containing a still further limitation of this range would have been filed. Additionally, the request already filed did not refer to Vaseline as the skin-protective ingredient. Even in the requests filed with the letter of 8 September 2016, no claim had been further limited to the range in the present claim. Accordingly, it could not reasonably have been expected that the now selected combination of features would have formed the basis of a claim to be considered.

1.15 Accordingly, the amendments in claim 1 were at least *prima facie* not based on a clear and unambiguous disclosure in the originally filed application (Article 123(2) EPC) and they raised issues which could not be dealt with without adjournment of the proceedings. Hence, the Board did not admit the request into the proceedings - neither when exercising its discretion under Article 13(1) RPBA nor in accordance with Article 13(3) RPBA.

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