

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 20 September 2016**

Case Number: T 0067/13 - 3.2.06

Application Number: 04751910.3

Publication Number: 1622556

IPC: A61F13/20

Language of the proceedings: EN

Title of invention:

A PROCESS FOR PRODUCING STABILIZED TAMPONS

Patent Proprietor:

THE PROCTER & GAMBLE COMPANY

Opponent:

Johnson & Johnson GmbH

Headword:

Relevant legal provisions:

RPBA Art. 13(1)
EPC 1973 Art. 84
EPC Art. 123(2)

Keyword:

Late-filed request - justification for late filing (yes) prima
facie allowable (yes)

Remittal to the department of first instance - (yes)

Decisions cited:

Catchword:



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 0067/13 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 20 September 2016

Appellant: Johnson & Johnson GmbH
(Opponent) Johnson & Johnson Platz 2
41470 Neuss (DE)

Representative: Metten, Karl-Heinz
Boehmert & Boehmert
Anwaltspartnerschaft mbB
Patentanwälte Rechtsanwälte
Pettenkoferstrasse 20-22
80336 München (DE)

Respondent: THE PROCTER & GAMBLE COMPANY
(Patent Proprietor) One Procter & Gamble Plaza
Cincinnati, OH 45202 (US)

Representative: O'Callaghan, Robert James
Elkington and Fife LLP
Prospect House
8 Pembroke Road
Sevenoaks, Kent TN13 1XR (GB)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 30 October 2012
rejecting the opposition filed against European
patent No. 1622556 pursuant to Article 101(2)
EPC.**

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 decision of the opposition division rejecting the opposition to European patent No. 1 622 556. It requested that the decision be set aside and the patent be revoked.
- II. In its letter of response, the respondent (patent proprietor) requested that the appeal be dismissed, in the alternative that it be maintained according to an auxiliary request.
- III. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion, in which it indicated *inter alia* that Article 100(c) EPC appeared to prejudice maintenance of the patent according to the main request.
- IV. With letter of 5 August 2016 the respondent filed new auxiliary requests 1, 2 and 4, the previously pending auxiliary request being re-numbered auxiliary request 3.
- V. Oral proceedings were held before the Board on 20 September 2016, during which the respondent withdrew all its pending requests and submitted a new main request.

At the end of the oral proceedings the requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and the patent be revoked, or that the case be remitted to the department of first instance for further prosecution.

The respondent (patent proprietor) requested that the patent be maintained in amended form according to the new main request filed during the oral proceedings of 20 September 2016.

VI. Claim 1 (the sole claim) of the main request reads as follows:

"A process for producing a stabilized compressed tampon, comprising the steps of:
a. providing a compressed tampon pledget;
characterized in that steps (sic) further comprise
b. forcing a gas through said compressed tampon pledget to form a stabilized tampon,
wherein said compressed tampon pledget is maintained within a permeable mold,
the process further comprising the step of heating said gas and the step of humidifying said gas,
the process further comprising:
providing a gas supply opposed to a gas outlet, and a mold housing oriented there between that contains the tampon pledget within the permeable mold;
providing a moisture supply means, heating means, and a temperature and humidity control means,
wherein the incoming gas enters at the gas supply and the rate of the gas flow can be varied by a flow control means,
and wherein the heated and humidified gas flows into the mold housing and flows out the gas outlet."

VII. The appellant's arguments may be summarised as follows:
No time should have been allowed for the respondent to draft a new request, because it had already filed a number of auxiliary requests in preparation for oral proceedings and allowing time at this stage of the proceedings for drafting a further request was not fair. The request should not be admitted under Article

13 of the Rules of Procedure of the Boards of Appeal (RPBA). It was filed at the latest possible stage in proceedings. It could and should have been filed at the latest in response to the Board's preliminary opinion. The appellant's arguments had been as specific as possible, without giving hints away as to what further features the respondent should include in the claim to overcome the objection. In particular the argument in the appellant's submissions that there was no disclosure of feature b of claim 1 achieving the stabilisation "as such", made it clear that an objection to lacking features was being made. With many features now having been taken from the description, the claim was too complex to deal with during these oral proceedings.

The subject-matter of claim 1 failed to meet the requirement of Article 123(2) EPC. Page 11, line 1 and each of the examples in the description mentioned 'the machine' in connection with the flow of the gas or the item in which the mold housing was located; it was thus inextricably linked with claimed features and so could not be omitted. Similarly, page 10, lines 29 to 30 disclosed all embodiments of the invention as resulting in a tampon with about 4 to 15% water by weight which was omitted from claim 1. There was also a link missing between the statement in feature b of claim 1 regarding the stabilization of the tampon and the subsequently listed process steps allegedly pertaining to the stabilization, this latter objection also leading to the claim lacking clarity. The requirements of Article 84 EPC were also not met with respect to the feature regarding the gas flowing into the mold housing since feature b indicated that the gas flowed through the compressed tampon pledget; the relationship between the mold and the housing was thus unclear, as was the

relationship between a gas passing through the pledget and the gas which passed through the mold, as these could be different. A lack of clarity also existed regarding the claimed temperature and humidity control means, as it was not stated whether these were a single, combined control means or separate, individual means. A further objection arose due to the feature that 'the rate of the gas flow can be varied by a flow control means'. The gas flow thus could be varied by a flow control means, but was not necessarily so varied with the possibility left open for other, unclaimed, means to carry out the flow control and even that no flow control means were present at all (which was then also a problem under Article 123(2) EPC). It was also unclear where and when the temperature and humidity control occurred in the claim.

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

As regards the late filed main request, this reflected the arguments raised for the first time during the oral proceedings and could not have been presented earlier. The new request was therefore a direct response to the new, unexpected course of the proceedings. The request was also not complex and to simplify discussion all dependent claims had been deleted; the request should therefore be admitted.

The subject-matter of claim 1 met the requirement of Article 123(2) EPC. The process steps appended to claim 1 as granted were clearly linked to the stabilization step included in feature b; the subject-matter was now limited to the Fig. 9 embodiment and all elements disclosed in that figure were now included in the claim. The targeted moisture content of the tampon after stabilization was not relevant to the claimed

stabilization process itself, not least since it was simply a target, and thus a preferred feature, rather than an absolute requirement. It was not necessary to include an explicit reference to 'the machine' in claim 1 since it was implicit that the physical features included in claim 1 would be part of a machine.

Claim 1 was also clear. The process steps appended to claim 1 as granted clearly each individually referred to certain aspects of the stabilization claimed in feature b. It was unimportant whether the heating and humidifying occurred separately or together since this factor had no influence on the clarity of the process claim. The relationship between the mold and the mold housing was clear within the claim and was also supported through the definition of what constituted the mold in para. [0012] of the patent. The expression 'can be varied' was a statement of the capability of the flow control means; the flow control means were to be seen as definitely included in the scope of claim 1.

Reasons for the Decision

Main request

- 1.1 Prior to the filing of this request during oral proceedings, considerable discussion had ensued regarding the ground for opposition under Article 100(c) EPC, particularly with respect to the subject-matter of claim 1 of the previous main request on file. Whilst the appellant had raised the objection of added subject-matter in its grounds of appeal, this was formulated very briefly, essentially just indicating that no basis existed for step b of claim 1 as granted being solely responsible for stabilizing the tampon. The preliminary opinion of the Board further indicated

that the presence of moisture and heat appeared to play a role in the stabilization. However, only during the oral proceedings did the discussion on this point identify the extent of the objection which was being made regarding an intermediate generalisation which was present in the previous main request on file and thus the full extent of the objection as regards which specific features were inextricably linked with the stabilization of the tampon. It is thus accepted, as argued by the respondent, that the true nature and extent of the objection only became apparent during the present oral proceedings and could thus not have been appropriately responded to earlier. The granting of time to prepare a new request aimed at overcoming the objection now apparent was thus regarded as justified by the Board.

Admittance of the request (Article 13 RPBA)

- 1.2 Article 12(2) RPBA specifies that the statement of grounds of appeal and reply must contain the party's complete case. After filing the grounds of appeal or reply, any amendment to a party's case may be admitted and considered at the Board's discretion, which is set out in Article 13(1) RPBA, such discretion being exercised in view of *inter alia* the complexity of the new subject-matter, the current state of proceedings and the need for procedural economy. As is established case law of the Boards of Appeal, such procedural economy implies that amended requests should at least be *prima facie* allowable in order to be admitted.

- 1.3 The respondent filed the main request during oral proceedings. The request thus represented a change to the respondent's complete case as defined in Article 12(2) RPBA and its admittance is to be considered at

the Board's discretion under Article 13 RPBA.

1.4 Whilst the main request was indeed filed during the oral proceedings and comprised a significant number of features taken from the description, the appellant's argument that this request could have been filed much earlier in the appeal procedure is not accepted because it was only in the course of the oral proceedings that it became clear in what way the objection to the subject-matter of claim 1 of the patent as granted lacking basis was to be understood. Indeed, as indicated under point 1.1 above, the grounds of appeal with respect to added subject-matter are very brief, such that the full extent of the objection concerning which specific features were inextricably linked with the stabilization of the tampon can be seen as only becoming fully apparent to the respondent during the oral proceedings. It is further noted that the opposition division had found the subject-matter of claim 1 as granted not to extend beyond the content of the application as filed and, in its decision, had not to deal with the objections now being raised by the appellant relating to the stabilization only being disclosed *inter alia* in the presence of moisture and heat.

1.4.1 The appellant's contention that an objection relating to an intermediate generalisation was clearly raised in its grounds of appeal through the indication that feature b of claim 1 did not achieve stabilization 'as such' is not persuasive. No particular passages of the description are referred to in the grounds of appeal in support of the appellant's objection, such that it is not immediately apparent what was meant by the objection and thus that it was primarily an objection to an inadmissible intermediate generalisation due to

particular features having been omitted from the claim. The argument that an objection to an intermediate generalisation was raised in the grounds of appeal thus finds no support therein.

- 1.4.2 As regards the appellant's argument that it would be unable to deal with novelty and inventive step issues in such an amended claim without postponement, this was not persuasive with regard to the admittance of the request. As identified above with respect to the objections of added subject-matter, an over-riding consideration in support of admittance is the inability for the respondent to have fully responded to these objections at an earlier time, due to these having been incompletely presented. The arguments regarding novelty and inventive step thus hold less sway as regards admittance of the new request, but would be taken into account with respect to any request for the case to be remitted to the department of first instance for further prosecution.
- 1.4.3 It is further noted that the extent of discussion prior to the filing of the new main request during oral proceedings had the consequence that both parties were fully versed at least with the issues regarding Articles 84 and 123(2) EPC and could thus reasonably be expected to identify any further objections relating to the amendments made in the newly filed request. Prior to presenting its objections to this request, the appellant also indicated that it had been allowed sufficient time to analyse the request for possible objections under Articles 84 and 123(2) EPC.
- 1.4.4 It is furthermore noted that the respondent had limited the complexity of the newly filed request by deleting all claims dependent upon claim 1. As a consequence,

specifically regarding admittance of the request under Articles 84 and 123(2) EPC, the appellant had only independent claim 1 to consider, the major objections of which had already been extensively discussed in the foregoing discussions of the oral proceedings with respect to the previously pending main request.

1.4.5 From the above it follows that the new request is not so complex that the appellant would be unable to deal with any issues raised therein, at least with respect to Articles 84 and 123(2) EPC, without adjournment of the oral proceedings.

1.5 *Article 123(2) EPC*

1.5.1 The appellant's argument that 'the machine', indicated on page 11, line 1 and in each of the examples, is inextricably linked with the claimed process is not accepted. Claim 1 is directed to a process for producing a stabilized compressed tampon. The Board holds that physical features directed to a device for carrying out a process are only necessarily to be included in a claim to a process if such physical features are disclosed as integral to the definition of the process. As regards the feature 'the machine' in the present case, this is solely disclosed as a general overriding entity within which all the physical components affecting the tampon stabilization are located and thus is implicitly present by way of the inclusion of these physical components in the claim. It is further noted that the reference to 'a modified tampon compressor machine' on page 9 relates to a prior art machine not disclosed as necessarily being used for carrying out the process of the present invention. Furthermore, it is not necessary to include an explicit reference to 'the machine' in claim 1 since it is clear

that the structural elements of importance are already included in the claim and it is implicit that these structural features included in claim 1 must anyway be part of a machine in its broadest sense. The omission of 'the machine' from claim 1 therefore does not contravene Article 123(2) EPC.

1.5.2 The omission from claim 1 of the specific moisture content of the tampon after stabilization does not contravene Article 123(2) EPC. It is noted that the paragraph on page 10, lines 29 to 32 specifically concerns a targeted water content in the tampon after the stabilization process. Even if this can be seen to have an influence on the process conditions affecting stabilization, the cited passage indicates that it is a 'targeted' moisture content i.e. that it is a preferred feature relating to the final product. Thus, this is what the skilled person will strive for but, simply being a target, failing to achieve this will not be regarded as detrimental *per se* to the claimed stabilization process. Despite being indicated as applicable to 'all embodiments', the optional nature of the targeted moisture content has the consequence that it is not inextricably disclosed with the further features of the stabilization process taken-up into claim 1.

1.5.3 The appellant's argument that the list of process steps appended to claim 1 lacked a link to the stabilization step of feature b and thus extended beyond the application as filed is not persuasive. Each of the process steps appended to claim 1 provides further detail regarding the elements of feature b of claim 1. Since step b defines that forcing the gas through the pledget forms a stabilised tampon, and the further steps in the claim are concerned with the treating of

that gas in a certain way as well as the manner in which it passes into the pledget, namely by the heated and humidified gas entering the mold housing which contains the mold which itself contains the pledget, these appended process steps are directly linked to the stabilization process. Furthermore, the subject-matter of claim 1 is now limited to the embodiment of Fig. 9 and each of the appended process steps is depicted in the flow diagram of Fig. 9 and/or is detailed in the description of the embodiment relating to this figure from page 9, line 3 to page 12, line 3. There is thus a direct and unambiguous disclosure in the application as filed for the claimed subject-matter based on the combination of claim 1 as filed and the appended process steps relating to stabilization of the tampon.

1.5.4 In summary, therefore, the Board finds the subject-matter of claim 1 to *prima facie* meet the requirement of Article 123(2) EPC.

1.6 *Article 84 EPC 1973*

1.6.1 The appellant's argument that the list of process steps appended to claim 1 lacked a link to the stabilization step of feature b, and thus also led to the claim being unclear, is not accepted. The Board finds that each of the process steps appended to claim 1 relates directly to feature b concerning the forcing of a gas through the compressed tampon pledget to form a stabilized tampon. Even though some of these appended steps, which further specify the stabilization process, are not always placed directly before or after the first recitation of the feature which they are detailing, it is held that the claim can nonetheless, assisted by the common terminology used throughout for common features of the claim, be read by the skilled person such that

its content, meaning and inter-relationship of the features are clearly understood.

1.6.2 The appellant's argument regarding the relationship between the mold containing the pledget and the mold housing being unclear is not accepted. A mold is generally understood to comprise a mold cavity surrounded by material constituting the boundaries or walls of the mold cavity and thus constituting a mold body. This is also entirely in line with the mold itself as described in the application; Figs. 1 to 7 and para. [0012] of the patent clearly indicate this as comprising not just the cavity within which the pledget is restrained during stabilization but also a 'body' into which the cavity is formed. The entirety of the cavity and the body, also subdivided in the split cavity embodiments into first and second split cavity mold members (38, 46) is clearly what can be understood as the 'mold' in claim 1. The 'mold housing', as evident from its name, is the physical element which implicitly at least partially surrounds the mold and restrains it in a particular location and, according to claim 1, is located between the gas inlet and outlet. The relationship between the mold and the mold housing is thus clearly understandable for the skilled reader of the claim.

1.6.3 The appellant's contention that the gas passing through the pledget and the gas passing through the mold could be different is not accepted. Feature b of claim 1 mentions 'a' gas which in the further features of the claim mention the heating and humidifying of 'said' gas and later 'the' heated and humidified gas. There is thus a clear link between the gas when first recited with the indefinite article and subsequent recitations of the gas using either the adjective 'said' or the

definite article 'the'. The interpretation that the gas passing through the pledget and that passing through the mold need not be the same is thus not supported by the claim wording.

- 1.6.4 The appellant's contention that the nature of the claimed temperature and humidity control means was unclear as these could be single or combined means is also not accepted. No lack of clarity can be recognised irrespective of whether the control means are individual or combined; of sole importance is the function that these means are able to perform and this is fully independent of their physical constitution as individual means or combined means.
- 1.6.5 The argument that claim 1 was to be read as the flow control means not being the only means able to vary the rate of gas flow is not persuasive. Even though the expression 'can be varied' is used to describe the action of the flow control means on the gas flow, the Board sees this expression as unambiguously meaning that the gas flow can be varied as required by circumstances; the flow control means are therefore necessarily included in the claim scope and are responsible for varying the rate. The interpretation suggested by the appellant through which the gas flow can be varied by a flow control means or alternatively can be varied by an alternative unclaimed means, is not how the skilled person, based on the language alone, would read this feature of the claim. The linguistically unambiguous meaning is that the flow rate can be, but need not be, varied by the (necessarily present) flow control means.
- 1.6.6 As regards the suggestion that it was unclear where and when the temperature and humidity control occurred in

the claim, this argument is also not accepted. The final feature of claim 1 indicates that the gas flowing into the mold housing is already heated and humidified, such that this heating and humidifying must occur before the gas is forced through the compressed tampon pledget. The chronological order in which the claimed process steps are carried out is thus clear.

1.6.7 In summary, therefore, the Board finds claim 1 at least *prima facie* to meet the clarity requirement of Article 84 EPC 1973.

1.7 With claim 1 of the main request not being too complex to prohibit it being dealt with during oral proceedings and it *prima facie* meeting the requirements of both Articles 84 and 123(2) EPC, the Board decided to exercise its discretion so as to admit this request into the proceedings (Article 13(1) RPBA).

2. In respect of the substantive discussion of objections under Articles 84 and 123(2) EPC, the appellant stated that it had no further arguments beyond those which had already been presented for the foregoing *prima facie* discussion. The Board thus found that the requirements of both Article 84 EPC 1973 and that of Article 123(2) EPC were met by the main request.

3. *Remittal according to Article 111(1) EPC 1973*

3.1 The Board notes that the subject-matter of claim 1 differs significantly from each of the requests on file prior to the oral proceedings. As such the appellant has therefore not had the opportunity to prepare its arguments against this subject-matter under Articles 54, 56 and 83 EPC 1973. This situation is also reflected in the appellant's request to remit the case

back to the department of first instance for further prosecution.

3.2 According to Article 111(1) EPC 1973, when deciding on an appeal, the Board may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

3.3 In the present case the appellant is faced with subject-matter differing greatly from that of any of the requests hitherto on file. An opportunity to formulate its objections, possibly also including a further search for relevant prior art, therefore is regarded as equitable by the Board, particularly in the light of the fact that the respondent had not filed this request earlier and the Board having found that the filing at such a late stage was justified in the circumstances. Therefore, despite the respondent having argued that the case could have been dealt with immediately, the Board, for the reasons given above, avails itself of its power under Article 111(1) EPC 1973 to refer the case back to the department of first instance for further prosecution.

3.4 For the avoidance of doubt, the Board has only decided that the sole claim of the main request meets the clarity requirement of Article 84 EPC 1973 and its subject-matter does not contravene Article 123(2) EPC. The examination with respect to the further requirements of the EPC is entrusted to the department of first instance.

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:



M. H. A. Patin

M. Harrison

Decision electronically authenticated