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**Datasheet for the decision
of 16 November 2018**

Case Number: T 2000/14 - 3.2.06

Application Number: 04788417.6

Publication Number: 1669046

IPC: A61F13/15, A61F13/539

Language of the proceedings: EN

Title of invention:

ABSORBENT ARTICLE

Patent Proprietor:

DAIO PAPER CORPORATION

Opponent:

Kimberly-Clark Worldwide, Inc.

Headword:

Relevant legal provisions:

RPBA Art. 13(1)

EPC Art. 123(2)

Keyword:

Amendments - undisclosed disclaimer - allowable (no)
Late-filed request - submitted during oral proceedings -
request clearly allowable (no)

Decisions cited:

G 0001/16, G 0001/03, T 0660/14

Catchword:



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Case Number: T 2000/14 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 16 November 2018

Appellant: Kimberly-Clark Worldwide, Inc.
(Opponent) 2300 Winchester Road
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Respondent: DAIO PAPER CORPORATION
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
30 July 2014 concerning maintenance of the
European Patent No. 1669046 in amended form.

Composition of the Board:

Chairman M. Harrison
Members: P. Cipriano
A. Jimenez

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. 1 669 046 in amended form met the requirements of the EPC.
- II. The appellant requested with its grounds of appeal that the interlocutory decision be set aside and the patent be revoked.
- III. The respondent (proprietor) requested in its reply filed on the 19 May 2015 that the appeal be dismissed, subsidiarily that the patent be maintained in an amended form according to one of auxiliary requests 1 to 5.
- IV. The Board issued a summons to oral proceedings including a communication containing its provisional opinion, in which it indicated *inter alia* that the claimed priority did not appear to be valid for claim 1 of the main request and that the subject-matter of claim 1 appeared not to be novel over D1a.
- V. With letter of 15 October 2018 the respondent filed further auxiliary requests 6 and 7.
- VI. Oral proceedings were held before the Board on 16 November 2018, during which the respondent withdrew all its previous requests and filed a single amended main request.

The appellant requested that the decision under appeal be set aside and the European patent No. 1 669 046 be revoked.

The respondent requested that the patent be maintained on the basis of its request filed during oral proceedings on 16 November 2018.

VII. Claim 1 of the main request reads as follows:

"1. An absorbent article (1A;1B) in which an absorbent body (4) intervenes between a liquid permeable front sheet (3) and a back sheet (2), and a middle-height portion (6) is provided by thickening a front surface of an approximately center area of the absorbent body (4) with respect to a standard portion absorbent body (4A),

wherein leakage preventing grooves (8,8) which extend to a longitudinal direction of the absorbent article (1A;1B) are provided on both sides which sandwich a body fluid discharge portion area (K) in the area of the middle-height portion (6), respectively,

wherein the leakage preventing grooves (8,8) are deeper than a thickness (h1) of the middle-height portion (6) and reach the standard portion absorbent body (4A) and do not continue to the outside of the area of the middle-height portion, and

wherein the middle-height portion (6) is formed between front and rear folding line positions (P1,P2) for folding the absorbent article (1A;1B) in three at the time of individual packaging."

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

Admittance of the main request

The amendment was an undisclosed disclaimer excluding grooves that extended to the outside of the middle-

height portion (hereinafter also referred to as MHP). Further, the Figures disclosed much more specific groove shapes with other features that were not part of the claim, and it was not even clear if all the Figures of the application as filed disclosed grooves that did not extend to the outside of the MHP - in Figure 1, the groove extended to the edge such that leakage could occur.

The request was thus *prima facie* not allowable.

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

Admittance of the main request

The amendment was not a disclaimer in the strict sense and merely contained features of the grooves that the skilled person would directly and unambiguously derive from Figures 1, 5 and 7.

Thus, the claim *prima facie* met the requirement of Article 123(2) EPC.

Reasons for the Decision

1. Admittance of main request

1.1 The respondent filed an amended main request during the oral proceedings, wherein the amended claim 1 comprised the additional feature

"the leakage preventing grooves do not continue to the outside of the area of the middle-height portion."

- 1.2 The main request was filed after the time limit for filing the response to the appeal grounds of the appellant (Article 12(1) and (2) RPBA) and therefore constitutes an amendment to the respondent's complete case.

According to Article 13(1) RPBA, any amendment to a party's case 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.

In order to be in line with the requirement of procedural economy, amendments should be *prima facie* allowable in the sense that they at least overcome the objections raised against previous requests without giving rise to any new ones.

- 1.3 Contrary to the argument of the respondent, *prima facie* the additional feature is a disclaimer and does not represent simply features of the grooves taken from Figures 1, 5 and 7. The amendment constitutes a negative feature excluding from the generally defined subject-matter of claim 1 all embodiments comprising grooves that continue to the outside of the area of the middle-height portion (see definition in G 1/16, Reasons, point 13, 2nd paragraph referring to G 1/03, Reasons, point 2.6.1).

It is further noted that *prima facie* the disclaimer is an undisclosed disclaimer since neither the disclaimer itself nor the subject-matter excluded by it have been disclosed in the application as filed (see G 1/16, Reasons 14).

1.4 To be allowable, the introduction of an undisclosed disclaimer may not provide a technical contribution to the subject-matter disclosed in the application as filed. In particular it may not become relevant for the assessment of inventive step (G 1/16 Reasons, point 49.1).

In the present case, the leakage preventing grooves have been disclosed in the application in a way that prevents not only front-rear leakage but also sideways leakage - see paragraphs [0008] to [0010] and [0012] of the published application. The patent application discusses the influence of the groove shape on the surface of the absorbent article in comparison to the prior art to achieve this effect and presents in Figures 1, 5 and 7 embodiments with different groove shapes in addition to the prior art groove(s) of Figures 8 and 9. Thus, the shape of the grooves makes a technical contribution to the subject-matter disclosed in the application as filed and disclaiming the shapes continuing to the outside of the area of the middle-height portion logically does as well.

This finding is furthermore confirmed by considering whether merely a quantitative change to the original technical teaching has occurred or indeed whether a qualitative change has resulted from the introduction of the undisclosed disclaimers (see G1/16, Reasons point 46.4 and e.g. T 660/14, Reasons 5.1). By disclaiming the shapes continuing to the outside of the area of the middle-height portion, the considerations regarding leakage of body fluid identified in the application as filed have been modified, resulting in a qualitative change to the originally disclosed technical teaching in the sense that the proprietor's

position with regard to inventive step would be changed.

1.5 It is then immaterial if the disclaimer fulfils one of the criteria set out in point 2.1 of the order of decision G 1/03 (e.g if it restores novelty by delimiting a claim against state of the art under Article 54(3) and (4) EPC)). Thus, the question whether the subject-matter of claim 1 is entitled to priority or not may be left undecided.

1.6 As a consequence therefore, with the requirement for an undisclosed disclaimer not to provide a technical contribution to the subject-matter disclosed in the application as filed not being met, the undisclosed disclaimer in claim 1 does not, at least *prima facie*, meet the requirement of Article 123(2) EPC.

Therefore, the subject-matter of claim 1 is not *prima facie* allowable, which would be necessary for fulfilling the need for procedural economy and consequently admitting the request into the proceedings. Accordingly, the Board exercised its discretion under Article 13(1) RPBA not to admit this request.

In the absence of any admissible request submitted or agreed by the respondent, the appeal has to be dismissed.

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