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Datasheet for the decision of 26 July 2019

Case Number: T 0085/16 - 3.2.06

Application Number: 08157108.5

Publication Number: 1961404

IPC: A61F13/496, A61F13/514, A61F13/15

Language of the proceedings: EN

Title of invention:
Disposable under-shorts and production method therefor

Patent Proprietor:
Zuiko Corporation

Opponents:
THE PROCTER & GAMBLE COMPANY
Kimberly-Clark Worldwide, Incorporated
Essity Hygiene and Health Aktiebolag

Headword:

Relevant legal provisions:
EPC Art. 100(c), 76(1), 123(2)

Keyword:
Omission of features - allowable (no)

Decisions cited:
G 0002/98, G 0002/10, T 0331/87, T 2311/10

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 0085/16 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 26 July 2019

Appellant: (Patent Proprietor)	Zuiko Corporation 15-21, Minamibefu-cho Settsu-shi, Osaka 566-0045 (JP)
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Respondent: (Opponent 3)	Essity Hygiene and Health Aktiebolag 405 03 Göteborg (SE)

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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 6 November 2015 revoking European patent No. 1961404 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman M. Harrison
Members: M. Dorfstätter
J. Hoppe

Summary of Facts and Submissions

I. An appeal was filed by the appellant (patent proprietor) against the decision of the opposition division revoking European Patent No. 1 961 404, in which it found *inter alia* that the subject-matter according to claim 1 of each of the main request, and of the first to 13th auxiliary requests extended beyond the original disclosure of the parent application as filed (Articles 100(c) and 76(1) EPC for the main request; Articles 123(2) and 76(1) EPC for the auxiliary requests).

II. The appellant requested that the impugned decision be set aside and the patent be maintained as granted or, in the alternative, on the basis of the claims of auxiliary requests 1 to 15 (requests 14 and 15 being filed for the first time with the grounds of appeal). It further requested oral proceedings should none of its requests be allowable but withdrew this request during the course of the appeal proceedings.

III. The respondents (opponents O1, O2 and O3) each requested that the appeal be dismissed and auxiliarily requested oral proceedings. Additionally, respondents O1 and O3 requested remittal of the case if the Board were to decide that the requirements of Articles 76(1) and 123(2) EPC were fulfilled and the ground of opposition under Article 100(c) EPC was not prejudicial to maintenance of the patent. Furthermore, they requested not to admit auxiliary requests 14 and 15 into the proceedings.

IV. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion, in which it indicated that none of the

requests was considered allowable in view of Articles 100(c) and 76(1) EPC. Additionally, the Board indicated that it was inclined not to admit auxiliary requests 14 and 15 into the proceedings.

V. With letter of 28 May 2019 the appellant withdrew its request for oral proceedings, stating that it would not attend the oral proceedings.

VI. The oral proceedings were duly cancelled.

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

"Disposable pants, comprising
a fit gather laminate (2) in which an elastic member (1) is provided between a pair of upper and lower sheets in a widthwise direction thereof, with the elastic member (1) being secured on areas of the sheets except for a widthwise center area thereof and being cut off along the widthwise center area of the sheets;
wherein an absorbent (4) is provided on an upper surface side of the fit gather laminate (2) in the widthwise center area thereof."

Claim 2 of the main request reads as follows:

"A method of manufacturing the disposable pants of claim 1, comprising:
transferring continuous materials of a pair of sheets forming a fit gather laminate (2) and a continuous material of an elastic member (1) provided therebetween in a longitudinal direction thereof while intermittently securing the continuous material of the elastic member (1) on the sheets;
cutting off the elastic member (1) along with the sheets (6, 7) along a non-secured area thereof;

wherein the method comprising providing the absorbent (4) on an upper surface side of the fit gather laminate (2) at a position corresponding to the non-secured area of the elastic member (1)."

Claim 1 of auxiliary request 1 differs from claim 1 of the main request by the insertion of the word "solely", thereby defining that "an elastic member (1) is provided between a pair of upper and lower sheets solely in a widthwise direction thereof".

Claim 1 of auxiliary request 2 differs from claim 1 of the main request by referring to "a plurality of elastic members" instead of "an elastic member", and by additionally defining that "the elastic members are arranged parallel to each other" (underlining added by the Board to highlight the amendments made).

The following auxiliary requests only comprise a single method claim based on claim 2 of the main request.

The claim of auxiliary request 3 differs from claim 2 of the main request in that the reference to claim 1 is deleted, thereby defining "A method of manufacturing disposable pants" instead of "A method of manufacturing the disposable pants of claim 1".

The claim of auxiliary request 4 corresponds to the claim of auxiliary request 3, with the additional amendment of defining "elastic members" instead of "an elastic member".

The claim of auxiliary request 5 corresponds to the claim of auxiliary request 4, additionally defining: "wherein the method comprising cutting off the elastic members (1) by using a roller (21) which includes a

plurality of cutting blades arranged at a predetermined interval so as to avoid unnecessarily cutting off areas as much as possible while reliably cutting off the elastic members (1) between the sheets (6, 7)".

The claim of auxiliary request 6 is based on the claim of auxiliary request 3, additionally defining that the disposable pants comprise:
"a fit gather laminate (2) in which an elastic member (1) is provided between a pair of upper and lower sheets in a widthwise direction thereof, with the elastic member (1) being secured on areas of the sheets except for a widthwise center area thereof and being cut off along the widthwise center area of the sheets" and
"wherein an absorbent (4) is provided on an upper surface side of the fit gather laminate (2) in the widthwise center area thereof".

The claim of auxiliary request 7 is based on the claim of auxiliary request 6, but defining "elastic members" instead of "an elastic member".

The claim of auxiliary request 8 is based on the claim of auxiliary request 7, additionally defining that:
"wherein the method comprising cutting off the elastic members (1) by using a roller (21) which includes a plurality of cutting blades arranged at a predetermined interval so as to avoid unnecessarily cutting off areas as much as possible while reliably cutting off the elastic members (1) between the sheets (6, 7)".

The claim of auxiliary request 9 is based on the claim of auxiliary request 6, additionally defining that the pair of upper and lower sheets are "a pair of non-woven fabric sheets".

The claim of auxiliary request 10 is based on the claim of auxiliary request 9, but defining "elastic members" instead of "an elastic member".

The claim of auxiliary request 11 is based on the claim of auxiliary request 10, additionally defining that: "wherein the method comprising cutting off the elastic members (1) by using a roller (21) which includes a plurality of cutting blades arranged at a predetermined interval so as to avoid unnecessarily cutting off areas as much as possible while reliably cutting off the elastic members (1) between the sheets (6, 7)".

The claim of auxiliary request 12 is based on the claim of auxiliary request 10, only amended by the insertion of the word "solely", thereby defining that "an elastic member (1) is provided between a pair of upper and lower non-woven fabric sheets solely in a widthwise direction thereof".

The claim of auxiliary request 13 is based on the claim of auxiliary request 10, additionally defining that "the elastic members (1) are arranged parallel to each other".

The claim of auxiliary request 14 is based on the claim of auxiliary request 9, additionally defining that "a reinforcement sheet (3) secured in the widthwise center area of the fit gather laminate (2)" and that the method comprises "securing the reinforcement sheet (3) at a position corresponding to the non-secured area of the elastic member (1)".

The claim of auxiliary request 15 is based on the claim of auxiliary request 14, additionally defining that the

reinforcement sheet is "secured on a lower surface side of the fit gather laminate (2)..." and that the method comprises "securing the reinforcement sheet (3) on a lower surface side of the fit gather laminate (2)...".

VIII. The appellant's arguments relevant to the decision may be summarised as follows:

Omitting the features "non-woven fabric sheets", "reinforcement-sheet" and "back sheet" did not constitute an unallowable generalisation. For evaluating whether the omission of a feature resulted in subject-matter extending beyond the original disclosure, it was common practice at the EPO to apply the three-point-test put forward in T331/87. Applying these criteria, the omitted features had not been presented as being essential and were not, as such, indispensable for the function of the invention in the light of the technical problem they served to solve. Their removal required no real modification of other features to compensate for the change. The omission of the three features hence passed this test.

The same arguments applied to each of the auxiliary requests 1 to 15. Additionally, some of the requests included one or two of the omitted features in the respective claim.

Auxiliary requests 14 and 15 were admissible. They were only filed as a precautionary measure and no new aspects were introduced.

IX. The arguments of respondent O1 relevant to the decision may be summarised as follows:

The omission of any of the reinforcement sheet, the back sheet or the deletion of "non-woven fabric", contravened Article 76(1) EPC. The parent application did not directly and unambiguously disclose any instance of disposable pants not having the reinforcement sheet. Because the claims did not meet the standard set by G2/98, they had to be rejected irrespective of whether or not they passed the three-step-test.

None of the auxiliary requests 1 to 13 fully rectified the deficiencies of the main request.

Auxiliary requests 14 and 15 could and should have been submitted at an earlier stage in the procedure. Furthermore, these requests were *prima facie* not allowable as they still contravened Article 76(1) EPC.

X. The arguments of respondent O2 relevant to the decision may be summarised as follows:

The test for assessing whether the requirements of Article 76 EPC were met was the same as that set out in G2/98. The subject-matter must be directly and unambiguously derivable from the earlier application as filed. There was no suggestion anywhere in the earlier application that any of the three features could be omitted.

The same applied also to all auxiliary requests, none of which completely addressed the objections made under Article 76 EPC.

XI. The arguments of respondent O3 relevant to the decision may be summarised as follows:

The absence of the three omitted features constituted an unallowable generalisation of the content of the parent application.

Auxiliary requests 14 and 15 were filed late. The proprietor could have filed these requests already with its response to the opposition, or at least with the last submission before the oral proceedings.

Each of auxiliary requests 1 to 15 lacked one or more of the omitted features. Therefore, for the same reasons, they did not fulfill the requirements of Article 76(1) EPC.

Reasons for the Decision

1. Main request - Article 100(c) EPC

1.1 The ground for opposition under Article 100(c) EPC prejudices maintenance of the patent as granted.

As already indicated in the Board's communication (see point 1.3), the subject-matter of claims 1 and 2 as granted extends beyond the content of the earlier application as filed. It is not directly and unambiguously derivable by the skilled person from the earlier application as filed.

1.2 The European patent application on which the contested patent is based was filed as a divisional application. This later application (the "divisional") differs from the earlier application (the "parent", application number 00922946.9 - EP 1 188 427 A1) *inter alia* in that its independent apparatus claim 1 does not contain the following three features (the "omitted features"):

- the pair of upper and lower sheets are made of a non-woven fabric,
- a reinforcement sheet is secured on a lower surface side of the fit gather laminate in the widthwise center area thereof, and
- a back sheet is provided on a lower surface side of the reinforcement sheet.

The independent method claim 2 also does not contain method steps relating to the three omitted features.

1.3 Omission of features - the relevant standard and test

1.3.1 As already stated in the communication of the Board (see points 1.1 and 1.2), when assessing whether the subject-matter of granted claims 1 and 2 of the patent extends beyond the content of the earlier application as filed under Article 76(1) EPC the same principles apply as when examining whether the requirement of Article 123(2) EPC is met. The basic principle therefor can be found in the case law of the Enlarged Board of Appeal and was summarised in G2/10 (see Reasons 4.3).

1.3.2 The appellant argued that the three-point-test developed in T331/87 was applicable in the present case. It further referred to T2311/10, in which decision it was pointed out that the risk existed of applying the three-point-test in the wrong way by formulating an objective technical problem with regard to some state of the art instead of deriving it directly from the application. In the appellant's view, such risk did not exist in the present case and the test should be applied.

1.3.3 However, the basic principle underlying Articles 76(1) and 123(2) EPC is independent of particular tests that have sometimes been used in other decisions, even if

this might, in certain cases, have become common practice of the EPO. While such tests might give some guidance in certain situations, they do not substitute the application of said basic principle. The question to be answered is hence what a skilled person can derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed. This is known as the gold standard (see G2/10, Reasons 4.3).

1.3.4 Applied to the present case, it thus has to be established whether the disposable pants and the method of manufacturing them, as defined in claims 1 and 2, i.e. without the limitations to a non-woven fabric, a reinforcement sheet and a back sheet (the omitted features in item 1.2 above), can be derived directly and unambiguously from the original documents of the earlier application (i.e. the parent).

1.4 The omission of the feature "non-woven fabric"

1.4.1 As already mentioned in the communication of the Board under point 2, there is no suggestion in the earlier application that the sheets of the laminate could be anything else than upper and lower non-woven fabric sheets.

Already the first sentence of the earlier application refers to a pair of non-woven fabric sheets. Paragraph [0007] defines the object of the invention and again, reference is made to non-woven fabric sheets. The single embodiment described in paragraphs [0013] to [0039] also shows the non-woven fabric sheets.

1.4.2 The appellant argued that the non-woven fabric was not "essential" for solving the technical problems. The respondent O1 stated that the non-woven fabric sheets were disclosed in the parent application as being essential and that they were indispensable for the function of the invention.

1.4.3 However, whether something is essential or not is not the same as whether subject-matter is directly and unambiguously derivable by a skilled person. For example, a reader might well conclude, after having deliberated on the essentiality of the non-woven fabric for any particular purpose or reason, that another material could also have been used for the laminate's sheets, but this does not mean that it has been directly and unambiguously disclosed. There is no disclosure in the earlier application - be it explicit or implicit - of the general sheets with which the feature "non-woven fibre sheet" was replaced. These general sheets cannot be derived directly and unambiguously from the original documents. Having ascertained this, it is of no relevance whether the sheets of the non-woven fibre type have been presented as being essential for the invention or whether they were indispensable for its function.

1.5 The omission of the feature "reinforcement sheet"

1.5.1 With regard to the omission of the reinforcement sheet, similar considerations apply. As already stated under point 1.3.2 of the Board's communication, there is no passage in the earlier application indicating that a reinforcement sheet could be omitted, let alone an embodiment without such a reinforcement sheet.

1.5.2 The appellant again argued that the reinforcement sheet was not presented as being essential. The description merely referred to bonus effects associated with the provision of the reinforcement sheet. Paragraph [0032] mentioned that the reinforcement sheet rendered it possible to manufacture at a high speed without requiring complicated operations. From paragraph [0031], the skilled person immediately understood, however, that it was the omission of the elastic members in the widthwise direction that allowed the high speed production of disposable pants with a good appearance and a stable wear feeling without complicating the structure of the manufacturing apparatus. This meant that the provision of the reinforcement sheet was not essential and the described good appearance was already achieved by other features.

1.5.3 However, in this case the skilled person might well understand, both from structural and functional considerations, that reinforcement is present because all of the layers have been cut through. It thus appears that the reinforcement sheet has indeed been provided to structurally and functionally compensate for the weakening of the laminate caused by cutting the elastic strands and thereby also leaving incisions in the sheets of the laminate. The skilled person might regard the better appearance due to the provision of the reinforcement sheet to be a "bonus effect". However, the skilled person also recognises that it provides structural compensation for the weakened structure. Hence, even if the argument of the appellant were followed, the skilled person would still regard the provision of the reinforcement sheet as being a structurally integral part of the disposable pant. Whether the better appearance then comes as a bonus effect has no relevance for this finding. Therefore,

the skilled person is not presented with any information to omit the reinforcement sheet.

1.6 The omission of the feature "back sheet"

1.6.1 A back sheet is referred to throughout the original earlier application. The description of the background art, the disclosure of the invention, the figures and the original claims all mention it. As already stated in the Board's communication under point 1.3.3, the single embodiment also explicitly includes a back-sheet. There is hence no explicit disclosure of disposable pants not having a back-sheet.

1.6.2 The appellant argued that the person skilled in the art recognised implicitly that omitting the back sheet further simplified the structure of the manufacturing apparatus.

1.6.3 The Board finds, however, that such recognition is not directly derivable from the disclosure of the earlier application. In the earlier application, no information of this kind is apparent. Any recognition that the omission of the back sheet simplifies the structure of the manufacturing apparatus is hence merely based on possible considerations of the skilled person, for which there is no basis in the application as filed. It might originate from the mind of the skilled person but is not directly on unambiguously derivable from the disclosure in the application documents.

For similar reasons as with regard to the omission of the reinforcement sheet, when reading the description, the skilled person is even deterred from omitting the back sheet. In paragraph [0016], the back sheet is described to be "provided so as to cover the entire

lower surface of the fit gather laminate 2 on the lower surface side of the reinforcement sheet 3". With the disposable pants necessarily comprising a reinforcement sheet (see the reasoning above under point 1.5), the reader understands that the back sheet is also present. Paragraph [0016] further suggests that the reinforcement sheet should not be exposed but covered by a back sheet. No other means to cover the reinforcement sheet than a back sheet can be deduced from the original application documents.

Therefore, there is no direct and unambiguous disclosure of a disposable pant nor a method of manufacturing it, without a back sheet being present.

1.7 No substantive response from the appellant was received in response to the Board's communication. There is hence no reason to deviate from the opinion expressed in the communication of the Board, which is hereby confirmed.

1.8 As the claims of the main request lack all three "omitted features", their subject-matter extends beyond the content of the earlier application as filed. Article 100(c) EPC hence prejudices maintenance of the patent as granted.

2. Auxiliary requests - Article 76(1) EPC

2.1 None of the auxiliary requests includes all three "omitted features". As laid out under points (1.4), (1.5) and (1.6) above, none of the features can be omitted without contravening Article 76(1) EPC. Furthermore, none of the features added in the auxiliary requests can be regarded as a substitution for one or more of the omitted features. Nor has this

been argued to be the case. Insofar as the same feature(s) is/are omitted, the subject-matter defined in the claims of the auxiliary requests extends beyond the original disclosure of the earlier application for the same reasons as set out for the main request. All pending auxiliary requests hence fail to meet the requirements of Article 76(1) EPC.

2.2 Irrespective of the question as to whether auxiliary requests 14 and 15 should be admitted into the proceedings, their respective independent claim still does not include a back sheet. Already for this reason alone, they cannot remedy all the deficiencies of the higher ranking requests (see the reasons given above under point 1.6). Their subject-matter thus also extends beyond the content of the earlier application as filed such that the conditions of Article 76(1) EPC are not met.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

M. H. A. Patin M. Harrison

Decision electronically authenticated