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**Datasheet for the decision
of 1 September 2020**

Case Number: T 1170/16 - 3.2.06

Application Number: 05016289.0

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Language of the proceedings: EN

Title of invention:

Process for producing sandwich structures with particulate material pattern

Patent Proprietor:

The Procter & Gamble Company

Opponent:

Essity Hygiene and Health Aktiebolag

Headword:

Relevant legal provisions:

EPC Art. 84
RPBA 2020 Art. 13(1)

Keyword:

Claims - clarity (no)

Late-filed auxiliary requests - admitted (no)

Decisions cited:

Catchword:

See Reasons 1.4 - Lack of clarity of the expression 'useful for'



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Case Number: T 1170/16 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 1 September 2020

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
17 March 2016 concerning maintenance of the
European Patent No. 1621167 in amended form.**

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 interlocutory decision of the opposition division in which it found that European patent No. 1 621 167 in an amended form met the requirements of the EPC.
- II. 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 or, in the alternative, that the patent be maintained according to one of auxiliary requests 1 or 2.
- IV. With letter of 6 September 2019, the appellant argued that claim 1 of auxiliary request 1 contravened the prohibition of *reformatio in peius* and that claim 1 of auxiliary request 2 met with a clarity objection (which had been raised against the same expression in claim 1 of the main request).
- V. With letter of 3 October 2019, the respondent filed a further auxiliary request (auxiliary request 3).
- VI. With letter of 5 February 2020 the appellant *inter alia* reiterated the prohibition of *reformatio in peius* objections to claim 1 of auxiliary request 1.
- VII. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion, in which it indicated *inter alia* that the clarity of claim 1 of the main request would require discussion at oral proceedings.

VIII. With letter of 16 July 2020, the respondent provided further arguments in support of the clarity of claim 1 of the main request.

IX. Oral proceedings were held before the Board on 1 September 2020, during which the respondent withdrew the auxiliary requests 1 to 3 on file and filed new auxiliary requests 1 and 2.

X. The final requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and the patent be revoked. The respondent requested that the appeal be dismissed (main request), auxiliarily that the patent be maintained in amended form on the basis of one of new auxiliary requests 1 and 2 filed during the oral proceedings of 1 September 2020.

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

"A method for continuously producing a pattern of particulate material in a sandwich structure (300), wherein the sandwich structure is a liquid absorbent structure useful for absorbent articles, and wherein the particulate material is a super absorbent material, the method comprising the steps of providing

- a particulate material (310);
- a transfer device (440) for receiving said particulate material (300) in a receiving region (442) and transferring it to an discharging region (448),
- said transfer device (440) comprising a first pattern forming means (452),
- at least one flat web material as carrier (320) and/or cover (330) material
- an endless carrier support means (470) for said

carrier material (320) having a support pattern corresponding to the pattern of said first pattern forming means of said transfer device (440);

- a carrier material holding means (472) for temporarily attaching said carrier material (320) to the surface of said carrier support means (470),
- a sandwich fixation means (495) for combining the sandwich structure (300),

executing the process steps of

- transferring said particulate material (310) to said receiving region (442) of said transfer device (440), whereby said first pattern forming means defines a particulate cluster pattern;
- moving said pattern of particulate material to the discharging region (448) of said transfer device (440);
- guiding said carrier material (320) over said carrier support means (470) at a carrier speed corresponding to the carrier support speed,
- deforming said carrier material (320) by said carrier material holding means (472), such that an indentation (328) is formed in the unsupported regions of said carrier material (320), thereby forming a pattern corresponding to said particulate cluster pattern;
- expelling said particulate material (310) from said transfer device towards said carrier material (320),
- depositing said expelled particulate material (310) on said deformed carrier material (320);
- applying said cover material (330) to said carrier material (320) and said patterned particulate material (319), thereby forming a sandwich structure (300),
- providing fixation means (495) for bonding the outer sandwich layers to each other, at least in parts of the bonding area (360)."

Claim 1 of new auxiliary request 1 reads as follows:

"A method for continuously producing a pattern of particulate material in a sandwich structure (300), wherein the sandwich structure is a liquid absorbent structure useful for disposable absorbent articles in the form of diapers, training pants, adult incontinence articles and feminine hygiene articles, and wherein the particulate material is a super absorbent material, the method comprising the steps of providing

- a particulate material (310) in bulk form;
 - a transfer device (440) for receiving said particulate material (300) in a receiving region (442) and transferring it to an discharging region (448),
 - said transfer device (440) comprising a first pattern forming means (452),
 - at least one flat web material as carrier (320) and/or cover (330) material
 - an endless carrier support means (470) for said carrier material (320) having a support pattern corresponding to the pattern of said first pattern forming means of said transfer device (440);
 - a carrier material holding means (472) for temporarily attaching said carrier material (320) to the surface of said carrier support means (470),
 - a sandwich fixation means (495) for combining the sandwich structure (300),
- executing the process steps of
- transferring said particulate material (310) to said receiving region (442) of said transfer device (440), whereby said first pattern forming means defines a particulate cluster pattern;
 - moving said pattern of particulate material to the discharging region (448) of said transfer device (440);
 - guiding said carrier material (320) over said carrier support means (470) at a carrier speed corresponding to the carrier support speed, said carrier material being an essentially endless, fluid permeable, non-woven web

material,

- deforming said carrier material (320) by said carrier material holding means (472), such that an indentation (328) is formed in the unsupported regions of said carrier material (320), thereby forming a pattern corresponding to said particulate cluster pattern;
- expelling said particulate material (310) from said transfer device towards said carrier material 320),
- depositing said expelled particulate material (310) on said deformed carrier material (320);
- applying said cover material (330) to said carrier material (320) and said patterned particulate material (319), thereby forming a sandwich structure (300),
- providing fixation means (495) for bonding the outer sandwich layers to each other, at least in parts of the bonding area (360)."

New auxiliary request 2 reads as new auxiliary request 1 except for the first four lines which read as follows:

"A method for continuously producing a pattern of particulate material in a sandwich structure (300), wherein the sandwich structure is a liquid absorbent structure for disposable absorbent articles in the form of diapers, training pants, adult incontinence articles and feminine hygiene articles".

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

Claim 1 lacked clarity. The expression 'useful for' went beyond a mere 'suitability for', including a benefit associated with its suitability. The features adopted into claim 1 had been taken out of the context in which they were originally disclosed, in which

context the expression 'useful for' notably made some sense, since it was being compared to other absorbent articles. Having omitted this context in the claim wording, the wording of the claim as it stood was unclear. A skilled person had no way to judge whether something falling under the other terms of the claim was 'useful for' absorbent articles or simply suitable for.

New auxiliary requests 1 and 2 should not be admitted as these were filed at a very late stage of the appeal procedure and both could and should have been filed sooner since the objections against the auxiliary requests and the problems with *reformatio in peius* had already been raised in several submissions. Claim 1 of auxiliary request 1 was anyway still unclear due to the continued presence of the expression 'useful for'. Both auxiliary request 1 and 2 included 'providing' a particulate material in bulk form whereas paragraph [0023] as filed 'supplied' this in bulk form as part of the process; these expressions at least *prima facie* did not unambiguously have the same meaning, thus leading to an objection under Article 123(2) EPC.

XIII. The respondent's arguments relevant to the present decision may be summarised as follows:

Claim 1 of the main request was clear. The expression 'useful for' was either synonymous with the expression 'suitable for' or implied the provision of some unspecified benefit which a liquid absorbent structure clearly had for absorbent articles. The skilled person would thus have no difficulty in interpreting the claim to establish what was covered and what was not. All the wording of original paragraph [0024] had been included in the claim when making the amendment to avoid any

problem under Article 123(2) EPC; albeit the wording of the description should not be held decisive for clarity of the claim, the context in which it had been disclosed had not been lost since that paragraph referred to a sandwich structure which was already in claim 1 and it was this which made it useful for absorbent articles.

New auxiliary requests 1 and 2 should be admitted. The auxiliary requests included all the features from paragraph [0023] of the description which was the precise context in which the features of paragraph [0024] were being described and thus claim 1 was now clear. These could not have been filed sooner as only in the course of oral proceedings had the true nature and importance of the clarity objection become apparent; the Board's communication was also ambiguous in this regard. The amendments made in claim 1 of each request were also not complex and could be dealt with without adjournment of the proceedings.

Reasons for the Decision

1. *Main request*

1.1 *Clarity*

Claim 1 fails to meet the clarity requirement of Article 84 EPC.

1.2

During opposition proceedings, claim 1 as granted was amended to include *inter alia* the feature that 'the sandwich structure is a liquid absorbent structure useful for absorbent articles'. The expression 'useful

for absorbent articles' introduces a lack of clarity into claim 1 since, as also argued by the opponent during opposition proceedings, it is unclear in what way the liquid absorbent structure is 'useful for' absorbent articles.

1.3 According to established case law of the Boards of Appeal, a claim must be clear in its own right when read by the person skilled in the art, without any reference to the content of the description (see e.g. Case Law of the Boards of Appeal, Clarity of claims, II.A.3.1). In the present case, this requirement is not met as the claim fails to provide any elucidation of how the liquid absorbent structure is 'useful for' absorbent articles.

1.4 The expression 'useful for' includes an element of value with respect to the features it links i.e. a beneficial suitability of one feature to the other. In claim 1, therefore, the liquid absorbent structure being 'useful for' absorbent articles implies that the liquid absorbent structure must offer some benefit to the absorbent articles. Yet it is this benefit which is not defined in the claim and thus leaves the reader in the dark as to how the liquid absorbent structure is 'useful for' absorbent articles. The respondent's argument in this regard that 'useful for' is synonymous with the expression 'for' which meant 'suitable for', must thus fail since the latter merely indicates a suitability for a particular purpose, rather than some judgement of benefit for the purpose which is embodied in the 'useful for' expression.

1.5 The Board is also not persuaded by the appellant's argument that the wording 'useful for' is not any different in terms of preciseness than the commonly

used claim expression 'for' and that it should therefore be held as clear, even if it might be somewhat imprecise. The Board finds that the term 'for' in a claim commonly implies merely a suitability for a certain purpose or application and thus is normally considered clear (albeit the context of its use in a claim may be relevant to any clarity decision) since it has the purpose of excluding products/elements/steps which are unsuitable for that purpose, whereas 'useful for' means not only that something is 'suitable for' but that it has a further effect going beyond mere suitability.

- 1.6 As regards the respondent's argument that the context in which 'useful for' was disclosed in paragraph [0024] had not been lost in claim 1 due to the sandwich structure, which offered the benefit to the absorbent articles, already being in the claim, this is not accepted. It is of course not in dispute that a liquid absorbent sandwich structure will absorb liquid, yet the qualifying expression 'useful for absorbent articles' must add something additional to this since otherwise its inclusion in claim 1 would be superfluous. It is the question of what limitation is added in the present case which is unclear. The respondent's further argument that merely adding superfluous wording did not result in a lack of clarity is also not found persuasive. It is precisely the additional limitation defined by this expression which is unclear, since claim 1 fails to define in what way the liquid absorbent structure is useful for absorbent articles. Despite the respondent maintaining that the skilled person would have no difficulty in interpreting the scope of the claim, it is the inability of the skilled person to understand exactly what limitation the additional feature 'useful for absorbent articles'

places on the claimed subject-matter which results in the lack of clarity of the claim as a whole, as also argued by the appellant.

1.7 In summary, therefore, claim 1 is unclear such that it fails to meet the clarity requirement of Article 84 EPC. The main request is thus not allowable.

2. *New auxiliary requests 1 and 2*

Admittance

2.1 These two requests were filed during oral proceedings before the Board after the conclusion regarding the main request was announced. The admittance of these requests is thus at the discretion of the Board according to the requirements of Article 13(1) RPBA 2020. In the present case, of particular importance in this regard is the very late stage of the proceedings at which the requests were filed and the suitability of the amendments to *prima facie* overcome the clarity objection and not introduce any new objections.

2.2 The respondent's contention that it had been unable to file these requests sooner, since the Board's preliminary opinion had been ambiguous, in the sense that it was not recognised as really being an issue of any importance, and the true nature of the clarity objection as such had not been evident until oral proceedings, is not persuasive. Firstly, the clarity objection concerning the expression 'useful for absorbent articles' was already made during proceedings before the opposition division and has also been on file in the appeal proceedings since the filing of the grounds of appeal. The respondent's reaction on appeal to the objection had been to file auxiliary requests 1

to 3, of which auxiliary requests 1 and 3 had however met with subsequent objections from the appellant (with letter of 9 September 2019 and again with letter of 5 February 2020) under the prohibition of *reformatio in peius*, and auxiliary request 2 had not addressed the clarity objection, with the 'useful for' terminology remaining unamended. It was at this time that the respondent should have filed auxiliary requests attempting to overcome the outstanding clarity and *reformatio in peius* objections, but this did not occur. Postponing the filing of any further auxiliary requests until the last possible moment runs the very real risk of the requirement of procedural economy adversely affecting their admittance. In as far as the Board's communication is concerned, this states *inter alia* under item 1 (in respect of the appellant having questioned the 'clarity of claim 1' in relation to 'useful for'), that it 'may well require discussion whether this expression simply, in the context used, indicates the applicability of the absorbent structure for use in an absorbent article (i.e. in the sense of 'suitable for') or whether it implies something more limited'. The paragraph finishes by stating 'Should the expression however be determined to have no understandable meaning in the context used, a lack of clarity may indeed be the result (contrary to Article 84 EPC).' Thus the alleged ambiguity in the communication is not found to be present.

- 2.3 In regard to the arguments made during the oral proceedings before the Board when discussing the clarity objection, these did not result in any new clarity objection being made. The discussion during oral proceedings of the context in which the introduced wording had been made in the original description, with respect to paragraphs [0022] to [0024], did not alter

the objection as such, but was merely used by the appellant to develop the argument as to why the wording might have been clear as used in a particular context in the description, but was not clear when used in the claim. The Board had also stated that it followed this explanation. Thus, the fact that the wording that had been introduced into claim 1 was identical to the entire paragraph [0024], did not alter the fact that a clarity problem was present in the claim as such. Indeed, the objection regarding the clarity of the claim was not altered. Thus, the respondent did not convince the Board that the reason for the late filing of the amendment was caused by the discussions during oral proceedings and should thus be allowed at a late stage of proceedings. Indeed, when giving its conclusion on claim 1 of the main request, the Chairman had specifically stated that the discussion of paragraphs [0022] to [0024] of the description was not the reason leading to claim 1 being found by the Board to lack clarity, but that it perhaps could help elucidate for the respondent why something taken out of context from the description may result in that expression, when considered in the context of the claim alone, lacking clarity.

- 2.4 As regards new auxiliary request 1 maintaining the wording 'useful for' objected to as lacking clarity, albeit introducing further wording from paragraph [0023] and only new auxiliary request 2 amending this, particularly in the context of the procedure up until the time of filing these requests, this constellation of requests, albeit only two, represents a 'salami tactic' in attempting to overcome the clarity objection. The Board finds this way of proceeding to have a clearly negative impact on procedural

efficiency.

- 2.5 Further, as regards substantive issues with respect to auxiliary request 1, claim 1 still includes the expression 'useful for', albeit now in respect of 'disposable absorbent articles'. Claim 1 of auxiliary request 1 thus still suffers from a *prima facie* lack of clarity (Article 84 EPC) since it remains unclear, from the wording of claim 1 alone, in what way the liquid absorbent structure is useful for the now added specific disposable absorbent articles.
- 2.6 The further objection of the appellant that the respondent should anyway have overcome the objection to the prohibition of *reformatio in peius* by filing a claim, in accordance with the exceptions given in G1/99, which included more limiting features directed to the core of a disposable absorbent article, which it argued was that which made it 'useful for' disposable absorbent products, did not need to be decided by the Board in view of the aspects considered under points 2.1 to 2.5 in combination.
- 2.7 In view of the above aspects considered in combination, the Board exercised its discretion not to admit new auxiliary requests 1 and 2 into the proceedings (Article 13(1) RPBA 2020).
3. Asked whether it wished to file any further auxiliary requests, the respondent confirmed that it did not.

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:



D. Grundner

M. Harrison

Decision electronically authenticated