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**Datasheet for the decision  
of 21 February 2020**

**Case Number:** T 1171/16 - 3.2.06

**Application Number:** 05255736.0

**Publication Number:** 1637107

**IPC:** A61F13/53

**Language of the proceedings:** EN

**Title of invention:**

Drapeable sanitary absorbent napkin

**Patent Proprietor:**

Johnson & Johnson Consumer Inc.

**Opponent:**

Essity Hygiene and Health Aktiebolag

**Headword:**

**Relevant legal provisions:**

EPC Art. 83

**Keyword:**

Sufficiency of disclosure - main request (no) - auxiliary requests (no) - undue burden (yes)

**Decisions cited:**

T 0063/06

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 1171/16 - 3.2.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.06**  
**of 21 February 2020**

**Appellant:** Essity Hygiene and Health Aktiebolag  
(Opponent) 405 03 Göteborg (SE)

**Representative:** Hammond, Andrew David  
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**Respondent:** Johnson & Johnson Consumer Inc.  
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**Representative:** Kirsch, Susan Edith  
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**Decision under appeal:** **Interlocutory decision of the Opposition**  
**Division of the European Patent Office posted on**  
**11 March 2016 concerning maintenance of the**  
**European Patent No. 1637107 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. 1 637 107 in an amended form met the requirements of the EPC.

The appellant requested with its grounds of appeal that the interlocutory decision be set aside and the patent be revoked. As an auxiliary measure, oral proceedings were requested.

II. The respondent (proprietor) requested in its reply that the appeal be dismissed, or as an auxiliary measure that the patent be maintained in an amended form according to one of auxiliary requests 1 to 3. An auxiliary request for oral proceedings was also made.

III. The following document, referred to by the appellant in its grounds of appeal, is relevant to the present decision:

D7 declaration of Fábio Eduardo França Rangel

IV. The Board issued a summons to oral proceedings followed by a communication containing its provisional opinion, in which it indicated *inter alia* that the invention according to claim 1 of the main request was not sufficiently clearly and completely disclosed in a manner such that the skilled person could perform the invention over the whole range claimed and that none of the auxiliary requests seemed to address this objection.

V. With letter dated 10 February 2020 the respondent stated that it would not attend the oral proceedings

and withdrew its request for oral proceedings. The respondent however maintained its request for the appeal to be dismissed and as an auxiliary measure that the patent be maintained in an amended form according to one of auxiliary requests 1 to 3.

- VI. With letter dated 12 February 2020 the appellant withdrew its request for oral proceedings. It however maintained its request to set aside the decision under appeal and revoke the patent in its entirety.
- VII. The oral proceedings were duly cancelled.
- VIII. Claim 1 of the main request which is the same as that of auxiliary requests 1 to 3 is annexed at the end of this decision.
- IX. The arguments of the appellant may be summarised as follows:

*Article 83 EPC*

The skilled person would not know how to carry out the invention across the whole range claimed. The patent disclosed only one working embodiment (Inventive Sample 1), which was at the upper limit allowed by claim 1. From the whole disclosure, in particular paragraphs [0043]-[0055], [0064]-[0066], [0084] and [0086] it was not possible for the skilled person to "move to the right" (in the graph shown in paragraph [0093]) to carry out other embodiments of the invention without undue burden, since the disclosure did not teach them how the claimed parameters, i.e. the ratio BW/MCB (Basis Weight/Modified Circular Bend Stiffness) and the parameters Rewet (Rewet Potential) or FPT (Fluid Penetration Time), were interrelated and thus how they

could be obtained as claimed. For example, the thickness could not be increased since it was close to its upper range.

Since the patent did not give any information on how the features of the invention could be put into practice, only a weak presumption existed that the invention was sufficiently disclosed and the respondent bore the burden of establishing that common general knowledge enabled the skilled person to carry out the invention, as seen in decision T 63/06.

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

*Article 83 EPC*

Paragraphs [0043]-[0055], [0064]-[0066], [0084] and [0086] disclosed several possibilities of adapting an absorbing system that would allow the skilled person to modify the ratio BW/MCB and the parameters Rewet or FPT without undue burden.

Although there was only a single workable embodiment (Invention Sample 1) the skilled person would modify it by adapting these possibilities on the basis of trial and error, which would lead necessarily and directly to success. They understood that articles with a thickness lower than 2.5mm until the practical limit could be obtained.

Further, the amended claim 1 now defined a significantly narrower range ( $BW/MCB \leq 6.8$ ) than the one of granted claim 1 which had been contested initially by the appellant and in which the skilled person could

carry out the invention even though there was only a single workable embodiment.

As D7 attested, the skilled person would know how to "move to the right" (on a graph) of Inventive Sample 1 at the time of filing, by modifying the wood pulp, polyester fibres and SAP composition to increase absorbency and drapability.

Decision T 63/06 was not applicable since the patent did give information (Inventive Sample 1) on how the features of the invention could be put into practice.

### **Reasons for the Decision**

1. Article 83 EPC
  - 1.1 In its preliminary opinion (see items 2.1 to 2.6 of the Board's communication) the Board stated that the invention according to claim 1 of the main request seemed not to be sufficiently clearly and completely disclosed in a manner such that the skilled person can perform the invention over the whole range claimed.
  - 1.2 Since no further arguments were received in reply to its preliminary opinion, the Board sees no reason to alter its provisional opinion, which is thus confirmed herewith.
  - 1.3 The disclosure of the patent contains a single workable embodiment (Inventive Sample 1) for putting the invention into practice and, as pointed out by the respondent, paragraph [0052] discloses that the

flexibility of the material may be improved by chemically treating or mechanically working (tenderizing) the material. However, the Board finds that this alone is not sufficient to guide the skilled person to reliably obtain further embodiments falling within the whole range claimed.

- 1.4 The respondent argued that paragraphs [0043]-[0055], [0064]-[0066], [0084] and [0086] disclosed several possibilities of adapting an absorbent system that would allow the skilled person to modify the ratio BW/ MCB and the parameters Rewet or FPT without undue burden. However, the Board does not concur.

Paragraphs [0043]-[0055], [0064]-[0066], [0084] and [0086] disclose several possibilities of adapting an absorbent system that would undeniably affect the claimed properties (such as increasing the percentage of pulp mercerized as described in paragraphs [0052] and [0084] or changing the basis weight or the thickness). However, the patent as a whole provides no guidance allowing a skilled person to understand how these possibilities of adaptation would then affect all the parameters of the inequations ( $AI > 3.3 - 1.2 \ln(BW/MCB)$  and  $BW/MCB \geq 6.8$ ) defined in the claim and used to calculate the Absorbency Index  $((6.27 - R)/6.12) + ((499 - FPT)/495)$ , i.e. the parameters BW, MCB, Rewet or FPT.

For example, the mercerization of the pulp improves the flexibility of the pulp and consequently the modified circular bend stiffness (MCB) will decrease but the skilled person does not know, and is moreover given no guidance by the patent, how to derive whether or to what extent the mercerization would affect the parameters Rewet or fluid penetration time (FPT), even though it is evident that there is an interdependence



between these. The skilled person also does not know and is given no guidance by the patent how to derive in what way the thickness variation or the percentage of SAP (for example) will affect the parameters Rewet and FPT which are also dependent on the other changes.

1.5 Contrary to the argument of the respondent, should the skilled person attempt to modify Inventive Sample 1 by using these possibilities on the basis of trial and error, these attempts would not lead necessarily and directly to success through the evaluation of initial failures. Indeed, the guidance the skilled person would need in order to adapt one parameter and yet still fall within the claim by adapting others is entirely lacking from paragraphs [0043]-[0055], [0064]-[0066], [0084] and [0086].

1.6 The argument of the respondent that the range claimed was now significantly narrower such that the skilled person could carry out the invention although there was only one workable embodiment, is not found persuasive by the Board either. The Board finds that the size of the range is immaterial. Having a single workable embodiment so close to the limit defined by the inequation  $AI > 3.3 - 1.2 \ln(BW/MCB)$  and without any guidance on how to adapt the parameters and still fall within the range defined in the claim (as discussed above), the Board finds that even small changes to the parameters would understandably lead to the Absorbency Index becoming equal to or lower than  $3.3 - 1.2 \ln(BW/MCB)$ . The skilled person would therefore not know how to obtain any other value falling within the range even though this has been narrowed from that originally claimed.

1.7 The respondent argued further that the declaration D7 by an employee of the respondent made in 2016 attested to the knowledge of the skilled person in 2004. The Board, however, does not find the declaration to be a reliable source for establishing this. First, the declaration does not contain any particular information about the declarant's qualifications, occupation, knowledge nor indeed any other particular reason that would convince the Board that the declarant can reliably attest to the knowledge of a skilled person in 2004.

Even if this were the case *arguendo*, the Board does not understand how the mere fact of being able to choose and vary the possible materials as described in D7 could be understood as predictably affecting all the claimed parameters and thus would itself make up for the lack of guidance (i.e. a lack of completeness) in the patent as to how the various interrelated parameters need to be controlled when making any such changes to allow the skilled person to carry out the invention over the whole scope of claim 1.

1.8 In regard to the respondent's citation of T 63/06 and its argument that this decision would only be applicable when the patent did not provide any information, it is noted that this decision states (see Reasons 3.3.1 to 3.3.4) that only a weak presumption of validity would be present when (as explained above) "the patent specification does not contain detailed information of how to put the invention into practice". A single embodiment and a list of possible materials for various parts of the article gives a skilled person little guidance. The cited decision however, contrary to the passage cited from the Case Law Book and the respondent's argument in this regard, does not conclude

that, for the burden of proof to be shifted, it is necessary for the patent not to give any information whatsoever on how a feature of the invention can be put into practice.

In the present case, even any such "weak", presumption that might exist has, in the Board's view, already been rebutted by the appellant's arguments regarding the lack of information as to how the parameters BW, MCB, Rewet and FTP should be modified and how these would affect each other in respect of arriving at combinations of materials falling within the whole range claimed. As a consequence, the Board finds that the respondent indeed had the burden of proof for its contrary assertion that the disclosure in the patent and/or trial and error attempts would indeed be sufficient to enable the skilled person to obtain embodiments falling within the whole range claimed.

- 1.9 For the reasons above, the invention of claim 1 of the main request fails to meet the requirements of Article 83 EPC. The main request is therefore not allowable.
- 1.10 Claim 1 of auxiliary requests 1 to 3 has the same wording as claim 1 of the main request and thus does not meet the requirements of Article 83 EPC for the same reasons as claim 1 of the main request. Correspondingly, auxiliary requests 1 to 3 are also not allowable.

## 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

Claim 1 of the main request and of auxiliary requests 1 to 3

1. An absorbent article comprising:

a cover layer;

5 a barrier layer;

an absorbent system arranged between said cover layer and said barrier layer; and

wherein at least a portion satisfies the following equations:

$$AI > 3.3 - 1.2 \ln(BW/MCB), \text{ and } BW/MCB \leq 6.8;$$

wherein MCB = Modified Circular Bend Stiffness;

10 BW = Basis Weight of the Article; and

AI = Absorbency Index,

wherein Absorbency Index (AI) =  $\left(\frac{6.27-R}{6.12}\right) + \left(\frac{499-FPT}{495}\right)$ ;

wherein R = Rewet Value; and

FPT = Fluid Penetration Time; and

15 wherein the Modified Circular Bend Stiffness (MCB), the Basis Weight (BW),  
the Rewet Value (R), and the Fluid Penetration Time (FPT) are measured using  
the methods described in the description, and

wherein said absorbent system is a material containing a mixture of cellulosic fibers and  
superabsorbent material containing from 90% to 40% cellulosic fibers and 10% to 40%  
20 superabsorbent polymer (SAP) and that is embossed to have at least a first region and a  
second region, wherein said first region has a density greater than said second region,  
wherein the absorbent article has a thickness of less than 2.5 mm, wherein the thickness  
is measured using the method described in the description.