

BESCHWERDEKAMMERN
DES EUROPÄISCHEN
PATENTAMTS

BOARDS OF APPEAL OF
THE EUROPEAN PATENT
OFFICE

CHAMBRES DE RECOURS
DE L'OFFICE EUROPEEN
DES BREVETS

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen

**I N T E R L O C U T O R Y
D E C I S I O N
of 20 June 1996**

Case Number: T 1054/92 - 3.2.2

Application Number: 84301578.5

Publication Number: 0122042

IPC: A61 F13/00

Language of the proceedings: EN

Title of invention:

High density absorbent structures, method of their manufacture
and absorbent products containing them

Patentee:

The Procter & Gamble Company

Opponent:

(OI) Personal Products Company
(OII) Mölnlycke AB

Headword:

-

Relevant legal provisions:

EPC Art. 54(2), 87(1), 112(1)(a)

Keyword:

"Entitlement to priority - first and second priority document,
no, third priority document, yes"

"Prior use - no confidentiality"

"Referral to Enlarged Board of Appeal - no"

Decisions cited:

G 0003/93, T 0081/87, T 0073/88, T 0065/92, T 0969/90,
T 0221/91,

Catchword:

-



Case Number: T 1054/92 - 3.2.2

I N T E R L O C U T O R Y D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 20 June 1996

Appellant: The Procter & Gamble Company
(Proprietor of the patent) 301 East Sixth Street
Cincinnati
Ohio 45201 (US)

Representative: Lawrence, Peter Robin Broughton
Gill Jennings & Every
Broadgate House
7 Eldon Street
London EC2M 7LH (GB)

Respondent(s): Personal Products Company
(Opponent OI) Van Liew Avenue
Milltown
New Jersey 08850 (US)

Representative: Fisher, Adrian John
Carpmaels & Ransford
43 Bloomsbury Square
London WC1A 2RA (GB)

(Opponent OII) Mölnlycke AB
S-405 03 Göteborg (SE)

Representative: Brauns, Hans-Adolf, Dr. rer. nat.
Hoffmann, Eitle & Partner
Patentanwälte
Postfach 81 04 20
81904 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 5 November 1992
revoking European patent No. 0 122 042 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: H. Seidenschwarz
Members: P. Dropmann
J.-C. De Preter

Summary of Facts and Submissions

I. A notice of appeal was filed against the decision of the Opposition Division, issued in writing on 5 November 1992, revoking European patent No. 0 122 042 claiming the priority dates of 10 March 1983 from US 473 846, 24 June 1983 from US 507 824 and 6 September 1983 from US 529 900.

The Opposition Division held that the prior uses

U1: Procter & Gamble use before 10 March 1983 and

U2: Procter & Gamble use between 10 March 1983 and 6 September 1983,

both alleged by opponent III on the basis of

Annex K: Excerpts from the testimony in the Charleston suit,

Annex L: Preparation Report of 8 April 1983,

Annex M: Preparation Report of 9 March 1993,

Annex N: Preparation Report of 26 July 1983 and

Annex O: Preparation Report of 26 July 1983,

had not been made available to the public and thus did not constitute state of the art. Opponent III had withdrawn its opposition with a letter dated 14 May 1992.

However, the Opposition Division held that the subject-matter of claim 1 of the main and auxiliary requests then on file did not involve an inventive step in the light of documents

D8: GB-A-2 018 599 and

D16: Technical Bulletin "Sanwet IM-300", Sanyo Chemical Industries, October 1979.

II. During the appeal proceedings, respondent I (opponent I) referred to the prior uses U1 and U2 and argued that these uses belonged to the state of the art and that the claims were not entitled to the earliest claimed priority date.

Following a communication issued by the Board dated 8 September 1995, in which the appellant (proprietor of the patent) was requested to prove that the prior uses U1 and U2 were conducted under confidential conditions, the appellant, with a letter of 26 January 1996, filed a sworn affidavit by S. W. Miller dated 23 January 1996.

III. Oral proceedings before the Board were held on 20 June 1996. Respondent II (opponent II) did not attend as previously announced by letter of 8 March 1996.

At these proceedings, the appellant submitted a set of amended claims 1 to 16 according to a main request and three sets of amended claims 1 to 8 according to first, second and third auxiliary requests.

IV. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 to 16 according to the main request or on the basis of claims 1 to 8 according to the first, second or third auxiliary request. The appellant

further requested that, if the Board took the view that the patent in suit was not entitled to its first priority date, the following question be referred to the Enlarged Board of Appeal:

"Does the subsequent quantification or characterisation of a feature disclosed in a priority document as being essential to the described invention change the nature of that invention, with the result that a priority claim based on that document is invalid?"

- V. Respondents I and II (opponents I and II) requested that the appeal be dismissed.
- VI. Claim 1 according to the **main request** reads as follows:

"An absorbent structure which is a mixture of hydrophilic fibers and water-insoluble hydrogel in the form of discrete particles of cross-linked polymeric material in a fiber: hydrogel weight ratio of from 30:70 to 98:2, characterised in that the mixture has been air laid and the structure is a flexible substantially unbonded structure with a moisture content of less than 10% by weight of the dry absorbent structure and a density of from 0.15 to 1 g/cm³."

The respective claims 1 of the first, second and third auxiliary requests are directed to a process for making an absorbent structure.

- VII. The arguments of the appellant directed to the questions of priority and prior use dealt with in this decision can be summarised as follows:

Although the first (earliest) priority document US 473 846 (D21) did not specifically state that the absorbent structure according to the invention

had a moisture content of less than 10% by weight of the dry absorbent structure, the priority document did make it clear that the structure was made by air laying a dry mixture of hydrophilic fibres and hydrogel particles and that it was essential that dry hydrogel particles were used. A fibrous material containing hydrogel particles that had not been deliberately wetted, i.e., a dry product in accordance with the invention, normally had a moisture content of less than 10% and thus the disclosure of dryness inherently disclosed the quantitative limit of 10% (see page 7 of the appellant's letter of 23 May 1991 filed during the opposition proceedings). In addition, there was a disclosure of the moisture limit of 10% by cross reference in the first priority document D21, page 10, lines 23 to 28, to the Schoggen patent US-A-4 252 761 (document D4), column 4, lines 13 to 15. Furthermore, the quantification of the moisture limit did not change the invention in a way that the requirement "the same invention" of Article 87(1) EPC was not met. Reference was made to decisions T 73/88 (OJ EPO 1992, 557), T 65/92 (unpublished) and T 81/87 (OJ EPO 1990, 250) and to the Opinion of the Enlarged Board of Appeal G 3/93 (OJ EPO 1995, 18).

As regards the question of prior uses U1 and U2, the U1 tests (i.e. tests before the first priority date of 10 March 1983) were clearly confidential as proved by the Miller affidavit. As to the U2 testing (i.e., testing between the first and third priority dates of 10 March 1983 and 6 September 1983), the appellant admitted not being certain that the tests were confidential. If respondent I wished to rely upon the U2 tests, it was up to the respondent to prove without doubt that there was clearly no bar of confidentiality. In the absence of such proof, the Board should find on the balance of probabilities that the U2 tests were also confidential (see the letter of 16 January 1996).

If however, the Board decided that the U2 tests were not confidential, the question of enablement of the disclosure would arise. In the appellant's view it was not possible from an examination and analysis of the tested diaper to derive that it had been made by (i) air laying, (ii) while dry and (iii) subsequent compressing. There were several ways of achieving a uniform distribution of fibres and hydrogel particles, e.g. by a scattering technique.

The process features (i), (ii) and (iii) were thus not made available to the public by the prior use and therefore did not belong to the state of the art, in accordance with Article 54(2) EPC. Reference was made to decisions T 793/93 and T 677/91 (both unpublished) and to the internal Kimberly-Clark document "Absorbency work session" dated 25 September 1984 (D37) which document supported the contention that somebody looking at the U2 product would not know how to produce it.

VIII. In contesting the appellant's arguments, respondent I submitted that the claims were not entitled to the first priority date. The subject-matter of the claims, in particular the moisture content of less than 10%, was not clearly identifiable (as required by decision T 81/87) in the first priority document D21. The cross reference in document D21 to the Schoggen patent document D4 did not provide a clear basis for the moisture limit of 10%.

The burden of proof that the U2 tests were conducted under confidential conditions lay on the appellant. There was no proof in the Miller affidavit that the U2 tests were confidential. As to the question of enablement, the appellant itself accepted in its letter

dated 23 May 1991, page 5, third paragraph, that the scattering process was distinguishable over the air laying process, since the scattering technique resulted in a non-uniform distribution of the hydrogel particles through the web.

- IX. After having heard the parties present at the oral proceedings only on the matter of the main request, the Board decided, after deliberation, that the invention was not entitled to the first and second priority dates and that the U2 tests were not carried out under confidential conditions and clarified upon intervention of the appellant that the decision on the priorities concerned only the subject-matter of the main request. No final decision could be reached at the end of the oral proceedings as it appeared to the Board that evidence was needed as to the questions of enabling disclosure of prior use U2 and inventive step over said prior use, so that the proceedings had to be continued in writing.

Reasons for the Decision

1. The appeal is admissible.
2. The amendments in the claims of the main request do not offend against the provisions of Articles 84 and 123(2) and (3) EPC.
3. *Priority*
 - 3.1 Claim 1 according to the main request contains the feature that the absorbent structure has a moisture content of less than 10% by weight of the dry absorbent structure. This feature is, as admitted by the

appellant in its letter of 23 May 1991, page 7, not specifically stated in the first priority document US 473 846 (D21), nor is it specifically disclosed in the second priority document US 507 824.

3.2 According to Article 87(1) EPC, a European patent application is only entitled to priority in respect of **the same invention** as that disclosed in the previous application. This means, in accordance with decision T 81/87, points 6 and 12, that the subject-matter of the claims of the European application must be clearly identifiable in the documents of the previous application as a whole and that, if any essential element of the invention for which a European patent is sought is missing, there is no right to priority.

3.3 The feature concerning the moisture content of below 10% is such an essential element. This is made clear by the statement of page 11, lines 17 to 20 of the original application that "in order to ensure that the structure remains substantially unbonded the moisture content of the absorbent structure must be less than about 10% by weight of the dry absorbent structure". Furthermore, the relevant feature appeared in claim 1 as originally filed and was relied upon by the appellant in the examination proceedings when seeking to distinguish the subject-matter of this claim from cited prior art. Thus, the appellant stated in its letter of 1 December 1987 "that a moisture content of 10% or less is essential to the realisation of unbonded structures having the desired degree of flexibility".

3.4 It is true that the first (D21) and second priority documents make it clear that the absorbent structure is made by air laying a dry mixture of hydrophilic fibres and hydrogel particles and that it is essential that dry hydrogel particles are used (see document D21,

page 9). However, it is not true that, as stated at page 7 of the appellant's letter dated 23 May 1991, there was no disclosure whatsoever in document D21 of applying any humidity to the structures of the invention. Rather, page 10 of document D21 and the second priority document discloses that "dry" does not mean "absolutely water-free", that it may be desirable to use humidified air for air transport of the fibres and hydrogel particles to avoid dusting, and that under such process conditions, the hydrogel particles and fibres will take up even more moisture. Only prolonged exposure to air which has a high relative humidity should be avoided (see page 6, second paragraph of document D21).

3.5 A quantitative limit of the moisture content of less than 10% cannot be derived from the disclosures in the first and second priority documents. The Board thus cannot accept the appellant's argument that a product in accordance with the invention would normally have a moisture content of not more than about 10% and that the disclosure of dryness did in fact inherently disclose the quantitative limit. This upper limit was only introduced by the third priority document.

3.6 Moreover, the moisture limit of 10% was not disclosed by cross reference in the first priority document D21 (page 10, lines 23 to 28) to the Schoggen patent document D4. First, the limit of 10% mentioned in column 4, lines 13 to 15 of document D4 relates to the Buell patent US-A-3 825 194 and not to the Schoggen patent which latter patent reveals a moisture level of up to about 15% to 18% (see column 4, lines 19 to 24). Secondly, the moisture levels indicated in document D4, column 4, lines 13 to 24 concern the moisture of the dry lap sheets used as starting material in the disintegrator, whereas the moisture content specified in claim 1 is that of the absorbent structure.

- 3.7 As set out in points 3.3 to 3.5 above, the moisture content mentioned in claim 1 is an essential feature which is not specifically disclosed in the first and second priority documents and changes the character of the invention. The absence of this feature from the disclosure of these priority documents causes loss of priority, in line with decisions T 81/87 (see point 3.2 above) and T 73/88. The situation in case T 65/92 is different since in that case the Board, on the basis of the disclosure in the earlier application, came to the conclusion that the earlier and the European applications related to the same invention despite a change in the upper limit of the molecular weight.
- 3.8 The question which the appellant seeks to have referred to the Enlarged Board of Appeal is seen by the appellant as necessary to "reconcile" the decisions T 73/88 and G 3/93, see its letter dated 16 January 1996. It is implicit in the line of argument of the appellant that in its view a negative finding with respect to the entitlement to priority from the first priority document would go against what is said in the decision T 73/88 and be based on a false appreciation of what is said in decision G 3/93.

This is not the case. As indicated above, the finding that there is no entitlement to the first priority date is in fact fully compatible with the decision T 73/88. There it was held that a particular feature of granted claim 1, namely the requirement that a snackfood contains at least 5% of oil or fat, which could not be found in the relevant priority document, was not related to the character and nature of the invention disclosed so that the absence of this feature did not cause loss of priority. For the reasons given above the present Board is convinced that the requirement that

the claimed structure contain less than 10% by weight of moisture is essentially related to the character and nature of that structure and it cannot be seen how this feature can be equated to the type of feature mentioned above and considered in the decision T 73/88.

Furthermore, as the respondent I has pointed out in its letter dated 13 February 1996, it is a misconception that there is any need to "reconcile" the decisions G 3/93 and T 73/88.

The latter addressed the question whether a technical feature in the claim of a European patent needs to be disclosed in the priority document if priority is to be maintained. G 3/93 addressed an entirely separate question, namely whether a document published in the priority interval can be cited as prior art. In order to answer this question, the Enlarged Board in decision G 3/93 **assumed** a hypothetical situation in which the claim in the European Patent application is not entitled to priority because it is not for the same invention as that disclosed in the priority document. G 3/93 did not discuss what is meant by "the same invention", and there can therefore be no conflict with T 73/88.

It is clear from the above that a referral to the Enlarged Board of Appeal of the question formulated by the appellant is not necessary in order to ensure uniform application of the law.

The request of the appellant in this respect is therefore refused (Article 112(1)(a) EPC).

3.9 The subject-matter of claim 1 according to the main request is thus not entitled to the first and second priorities. Only the third priority date can be accorded.

4. *Prior use*

4.1 The prior uses U1 (before 10 March 1983) and U2 (between 10 March and 6 September 1983) alleged by the former opponent III and taken up by respondent I during the appeal proceedings concern consumer tests carried out on behalf of the appellant prior to going to a test market in Wichita in October 1984 (see annex K, pages 96 and 189). Annexes K, L, M, N and O were submitted as proof that such consumer tests took place and that third parties had the possibility, before the relevant priority date of the patent in suit, to have access to the absorbent structure used and its construction (see pages 13 to 16 of the opponent's III letter dated 2 August 1990). Since the appellant had claimed the existence of a secrecy agreement for these tests, the burden of proof was on the appellant to prove the existence of an obligation to maintain secrecy (see decisions T 221/91 and T 969/90, both unpublished but reported at page 69 of "Case Law of the Boards of Appeal of the European Patent Office", published by the European Patent Office in 1996).

4.2 The appellant's inquiries into the confidentiality of the alleged prior uses led to the sworn affidavit (including two exhibits) by S. W. Miller filed with the letter of 26 January 1996.

4.3 The Board accepts, on the basis of the statements in this affidavit and, in particular, in the sheets labelled 1670369 and 1670371 referring to security precautions, that the U1 tests before 10 March 1983 were confidential. They thus do not represent prior public use and hence do not form part of the state of the art.

4.4 However, the U2 tests between 10 March and 6 September 1983 on diapers, which were "all made exactly in accordance with the specific disclosure in the priority document" D21 (see page 8 of the appellant's letter dated 23 May 1991), cannot be considered as having been conducted under some bond of confidentiality. Indeed, it is stated in the affidavit, paragraphs 7 and 16 to 18 emphasis added):

"7. These confidential HPT tests are often conducted in a relatively small geographical area, often the Cincinnati area. Although they give useful data, before we can go to a public test marketing we often need a greater geographical or statistical basis. For this, we may have to run several additional HPT's in various regions involving **several hundred or thousand participants** over several weeks or months. In normal circumstances, for instance when patent action is still required or when the product is thought to be of particular commercial sensitivity, we **try** to maintain confidentiality, consistent with the difficulties of actually achieving full confidentiality when dealing with so many persons. In rare instances, a positive decision will have been made that confidentiality is no longer required."

- "16. I have also had investigations made similar to those summarised in paragraph 9 in respect of tests conducted between 10 March and 6 September, 1983.
17. I am informed that these tests include many tests of the type which I discuss in paragraphs 7 and 8 above, but that the formal documentation relating to many of the tests has not been located and that it has proved impossible to establish whether or not it even exists. I am told that the person responsible for HPT testing in 1983 recollects that there **may have been a security caution** associated with each test.
18. I therefore conclude that, following the policy outlined in paragraphs 7 and 8.

There was HPT testing between March and September 1983;

It was confined to geographical areas that minimised the risk of samples or information reaching competitors.

It is **possible that participants were told to maintain confidentiality.**"

It is clear from these statements that the tests according to annexes L, M, N and O (annex L is also mentioned in annex K, page 278) carried out by several hundreds of members of the public at several places in the USA. (Dayton, Tucson, Louisville, Minneapolis, Oklahoma, Omaha and Chicago) during several weeks (11 April to 6 June 1983, 14 to 28 March 1983 and 18 July to 1 August 1983) were of the type mentioned in the above quoted paragraphs of the Miller affidavit,

i.e. tests for which there may have been a security caution and whose participants possibly were told to maintain confidentiality, whose confidentiality, however, could not be proved. The Board is convinced in the light of common experience that it is very unlikely that tests carried out on such a scale were kept confidential, in particular since, as confirmed by the appellant, the used diapers, at least some of them, were not returned to Procter & Gamble. It is understandable in view of the high number of U2 tests, participants and testing areas why no documents concerning security precautions of these tests have been located (although documents like annex L dealing with the U2 tests and those dealing with the U1 tests were mentioned in annex K, the excerpts from the testimony in the Charleston suit), whereas such documents could be found for the U1 test. It is this contrast that shows that it is very probable that no obligation of confidence existed. Possibly, Procter & Gamble felt that there was no need for security precautions after having filed US application No. 473 846 (document D21) on 10 March 1983.

The Board having to decide on the basis of the available evidence what happened on the balance of probabilities, has found that the U2 tests were not confidential. The prior use U2 is thus to be considered as public.

- 4.5 The question to be addressed in accordance with Article 54(2) EPC is which features can be considered as being made available to the public by the prior public use U2, i.e., what information can be derived from the tested diaper.

In order to allow the parties to submit further arguments and evidence on this question the proceedings are continued in writing

Order

For these reasons it is decided that:

1. The subject-matter of claim 1 according to the main request is not entitled to the first and second priority dates.
2. The prior use designated U2 was not confidential.
3. The proceedings are continued in writing.

The Registrar:



S. Fabiani

The Chairman:



H. Seidenschwarz

