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D E C I S I O N
of 18 March 1998

Case Number: T 0219/94 - 3.2.2

Application Number: 85402516.0

Publication Number: 0185593

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:
Disposable garment having high-absorbency area

Patentee:
Kimberly-Clark Corporation

Opponent:
Paul Hartmann Aktiengesellschaft

Headword:
-

Relevant legal provisions:
EPC Art. 54, 111(1)

Keyword:
"Novelty (yes)"
"Remittal (yes) - right to two instances"

Decisions cited:
T 0056/87, T 0077/87, T 0450/89, G 0009/91, G 0010/91,
T 0412/92, T 0465/92, T 0511/92, T 0129/93, T 0793/93

Catchword:
-



Case Number: T 0219/94 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 18 March 1998

Appellant:
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 5 January 1994
revoking European patent No. 0 185 593 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: M. Noël
Members: M. Bidet
C. Holtz

Summary of Facts and Submissions

I. European patent No. 0 185 593 was granted on 27 March 1991 on the basis of European patent application No. 85 402 516.0, claiming the priority date of 19 December 1984.

II. The patent was opposed by Opponents 01 and 02 on the grounds that the subject-matter of claim 1 lacked novelty with respect to document D1: US-A-4 381 782 or at least did not involve an inventive step on the basis of this document alone or in combination with further documents.

Although Opponent 02 had withdrawn its opposition, both the proprietor of the patent and Opponent 01 kept on considering document D1.

The opposition division held that the subject-matter of claims 1 according to the main and auxiliary requests lacked novelty with regard to document D1 and, therefore, revoked the patent.

III. Claim 1 according to the main request reads as follows:

"A disposable absorbent garment comprising an impervious backing (12), a permeable body side lining (14) and an absorbent between said impervious backing and said body side lining, the front half (3) of the garment being divided by fold lines into a front center panel (43) and two side ears (42, 44), the back half (5) being divided into a back center panel (50) and two side ears (45, 47), and said front half (3) of said garment entirely containing an area of high absorbency (40), characterised in that between about 55% and about

75% of the total amount of absorbency of said garment is in the front half (3) of said garment, said area of high absorbency (40) comprising a suberabsorbent material."

Claim 1 according to the auxiliary request differs principally from Claim 1 according to the main request in that the range value of 55% to 75% in the front half is substituted by the single value of 65%.

IV. An appeal against this decision was filed by the appellant (proprietor of the patent) on 14 March 1994, the fee for appeal having been paid the same day. A statement of grounds of appeal was received on 11 May 1994.

V. Oral proceedings before the board were held on 18 March 1998.

(i) The appellant requested that the decision under appeal be set aside, that novelty be recognised for the claims of either the main or the auxiliary requests as annexed to the decision under appeal, and the case be remitted to the first instance for consideration of inventive step.

The respondent (opponent 01) requested that the appeal be dismissed and that, in case novelty was recognised, that the question of inventive step be discussed and decided by the Board.

(ii) In support of its requests the appellant submitted the following arguments:

- The passages in document D1 on which the decision was based , namely: column 7, lines 32 to 36 and lines 49 to 55, were evidently erroneous and were in direct contradiction with the teaching of document D1, seen as a whole.

According to this document, a mixture of hydrogel and filler to be used in an absorbent material provided better wicking and absorbency properties than pure hydrogel, as was demonstrated by absorbency test results mentioned in Table 1 and obtained for different **compositions** of pure hydrogel (see Example 1) and for different **mixtures** of hydrogels and fillers (see the other Examples). In the preferred embodiment disclosed in document D1 (see column 7, lines 21 to 36), the possibly pure hydrogel material incorporated in the front edge of the batt or absorbent layer was not actually part of the invention proposed in document D1, since the use of pure hydrogel was in direct contradiction with the object of this document which was principally based on the use of a mixture of hydrogel with filler for making a disposable diaper (see column 2, lines 10 to 17, 52 and 53).

In a specific example (see column 7, lines 49 to 55) "the hydrogel admixture of Example 1" was said to be used, although "Example 1" referred exclusively to pure hydrogel. This statement associating two opposed concepts was a second error in document D1. The texts including the errors would have been recognised as such by the reader, excluding them from the disclosure of

document D1 according to the case law of the boards of appeal, see decisions T 56/87, OJ EPC, 1990, 188; T 77/87, OJ EPO 1990, 280; T 412/91 of 27 February 1996 and T 793/93 of 27 September 1995.

There was neither any implicit disclosure in document D1 of the claimed range of 55% to 75%, so that the subject-matter of Claim 1 was novel in this respect. As a matter of fact, the mathematical analysis made by the respondent on the basis of the specific example described in column 7, lines 49 to 55 essentially relied on a number of assumptions with the result that the calculated values could not have been deduced directly and unambiguously from the disclosure of document D1.

(iii) The respondent O1 argued as follows:

As to the hydrogel material referred to in column 7, lines 26 to 28, the teaching of document D1 was correct in that it related to the use of hydrogel with filler. But the use of pure hydrogel was not excluded. If the skilled person were to find an apparent contradiction in column 7, lines 49 to 55 of document D1, he would necessarily have examined more precisely the content of the statement and would have tried the use of pure hydrogel which - as for the mixture - is also a superabsorbent. Therefore, the passages in column 7 of document D1 referred to by the appellant were not erroneous and not contrary to the rest of this document.

The calculation made by the opposition division was correct. If the board were to recognise novelty of Claim 1 according to either the main request or the auxiliary request, the question of inventive step should be discussed immediately and decided by the board.

Reasons for the Decision

1. The appeal is admissible
2. *Novelty*
 - 2.1 According to the consistent case law of the boards of appeal, a prior art document anticipates the novelty of any claimed subject-matter derivable directly and unambiguously from that document, including any features implicit to a person skilled in the art (see decision T 0511/92 of 27 May 1993, or T 0465/92, OJ EPO 1996, 32).
 - 2.2 Applying this principle when deciding upon novelty of the subject-matter of Claim 1, examination of document D1 gives the following results:
 - 2.2.1 Document D1 (see column 7, lines 21 to 31, Figures 2 to 4) discloses a disposable absorbent garment comprising an absorbent layer 10 located between an impervious backing 24 and a permeable body side lining 26. The front half of the garment is divided by fold lines 14 into a front center panel and two side ears 12. The back half is also divided into a back center panel and two side ears.

Document D1 relies on the fact that absorbency of a mixture of hydrogel with filler is higher than absorbency of pure hydrogel (see columns 5 and 6, Table 1, Examples 1 to 6; column 7, lines 16 to 20, and Claim 1). Therefore, the solution proposed in document D1 logically involves the use of a mixture of hydrogel with filler.

According to the application described in column 2, lines 32 to 40 and column 7, lines 21 to 28, hydrogel material is incorporated into an absorbent layer of the diaper. This means that hydrogel material is logically a mixture of hydrogel with filler. However, the teaching of document D1 is not limited to the improvement described therein - namely a mixture - but includes as well all other information available from this document. Thus, the reader of document D1 is aware that other pure hydrogel compositions such as those recited in example 1 may be used. However, if materials such as mixtures of hydrogel with filler are used, they will give a better overall absorbent performance (see column 2, lines 37 to 43). From this, it is unambiguously disclosed that, instead of a mixture, pure hydrogel can be incorporated into the absorbent pad.

Seen pragmatically, the wording "hydrogel material" (column 7, line 26) can relate to either a mixture of hydrogel with filler or a pure hydrogel. As a result, the wording "**hydrogel admixture of example 1**" appears to be antinomic. However, the reader of document D1 will logically be led to use a mixture of hydrogel with filler since the purpose of document D1 is essentially to further improve absorbency while avoiding gel-blocking. Again, this does not mean that the use of pure hydrogel is excluded from document D1.

Therefore, the hydrogel incorporated or added to an absorbent pad according to both applications can either be a pure hydrogel or a mixture of hydrogel with filler, and consequently there is no part of the description to be considered as excluded from the content of the disclosure of document D1 due to any error.

2.2.2 According to the prior art report in document D1 (see column 1, lines 31 and 32), hydrogels are well known as superabsorbent materials. Therefore, the incorporation or the addition of superabsorbent hydrogel material in the garment application as specified in column 7 of document D1, i.e. in the front half of the absorbent layer "by placement at 18 near the front edge 20", results in providing an area exhibiting a higher absorbency, in the same way as for the claimed absorbent garment. Consequently, the last characterising feature of Claims 1 was known from document D1.

2.2.3 Lack of novelty relied on a calculation made by the opposition division. However, there is no mention in document D1 of any range of values of absorbency with respect to either half of the garment. The assumptions made for this calculation, such as the absorbency value of the fluff, are going beyond what could be directly and unambiguously taken from the disclosure of document D1 since the type of fluff is not even mentioned. The calculation made by the first instance was, therefore, questionable, and could not be validly used to dispute the novelty of claim 1. It should be noted, however, that the above conclusion does not prejudice the further assessment of inventive step.

According to the constant case law, a finding of lack of novelty can only be based on a clear and unmistakable disclosure of the claimed subject-matter in the prior art document (see decision T 450/89 of 15 October 1991, reasons no 3.11) so that the claimed subject-matter can be derived directly and unambiguously from that document (see e.g. T 511/92 of 22 May 1993, reasons no 2.2). This is not the case here, so that for the reasons explained above, the absorbency range given in Claim 1 according to the main request is to be regarded as novel over the teaching of document D1.

3. *Remittal to the first instance*

The opposition division issued a decision only on lack of novelty and did not deal with the issue of inventive step. According to decisions G 9/91 and G 10/91, OJ EPO 1993, 408 and 420 the basic function of an appeal is to consider whether the decision which has been issued by the first instance is correct on its merits.

If a substantive issue has not yet been examined, examination of this issue by the board would amount to a continuation of the examination of the opposition which is not the task of the board (see decision T 129/93 of 2 July 1997, point 7 of the reasons) and would deprive the parties' rights to have this issue examined by two instances.


In these circumstances and in the exercise of its discretion under Article 111(1)EPC, the board remits the case to the opposition division for prosecution the issue of inventive step.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside
2. Novelty is recognised for the claims of the main request.
3. The case is remitted to the first instance for prosecution of the issue of inventive step.

The Registrar:



S. Fabiani

The Chairman:



M. Noël

