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D E C I S I O N
of 14 August 1998

Case Number: T 0770/94 - 3.2.2

Application Number: 86905334.8

Publication Number: 0236402

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:
Contoured Film

Patentee:
Smith & Nephew plc

Opponent:
The Procter & Gamble Company

Headword:
-

Relevant legal provisions:
EPC Art. 56, 123(2)

Keyword:
"Not extended subject-matter"
"Inventive step (confirmed)"

Decisions cited:
T 0583/93

Catchword:
-



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Boards of Appeal

Chambres de recours

Case Number: T 0770/94 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 14 August 1998

Appellant: The Procter & Gamble Company
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Ohio 45202 (US)

Representative: Hirsch, Uwe Thomas
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Respondent: Smith & Nephew plc
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Representative: Gilholm, Stephen Philip
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 22 July 1994
rejecting the opposition filed against European
patent No. 0 236 402 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: W. D. Weiß
Members: M. G. Noel
C. Holtz

Summary of Facts and Submissions

- I. European patent No. 0 236 402 was granted on the basis of European patent application No. 86 905 334.8. Independent claim 1 reads as follows:

"A water permeable contoured polymeric film which comprises a film containing apertures and which has a pattern of raised areas therein wherein the ratio of apertures to raised areas is greater than unity characterised in that the film is formed from elastomeric polymer and the apertures are in raised areas and in the land areas between the raised areas."

- II. An opposition was filed by the appellant on the grounds of Article 100(a) EPC (lack of novelty and inventive step) and of Article 100(b) EPC (lack of disclosure). After the expiration of the time limit for opposition, the appellant objected, as an additional ground for opposition on the basis of Article 100(c) EPC, that the subject-matter of the patent extended beyond the content of the application as filed.

The objection on the basis of Article 100(b) EPC was withdrawn at an oral proceedings before the Opposition Division.

The assertion of lack of novelty and inventive step was originally based on four documents. Later in the opposition proceedings and after the expiration of the time limit for opposition two additional documents were cited.

The Opposition Division decided to reject the opposition finding that the subject-matter of the patent did not extend beyond the disclosure of the application as filed and that the claimed subject-matter was novel and implied an inventive step having

regard to the four documents cited in the grounds for opposition. The two belatedly cited documents were not taken into consideration because they were seen to be less relevant.

III. The appellant (opponent) filed an appeal against this decision on the grounds that the subject-matter of claim 1 as granted offended against Article 123(2)/100(c) EPC and lacked an inventive step in the meaning of Article 56 EPC in connection with Article 52(1) EPC having regard to documents

(D4) US-A-3 292 619 (cited in the description of the patent in suit and in the grounds for opposition, page 1, second paragraph),

(D5) US-A-4 166 464, and

(D6) US-A-4 395 215,

the latter two documents being those cited belatedly.

IV. The appellant requested that the contested decision be set aside and that the European patent be revoked.

The respondent (proprietor of the patent) requested that the appeal be dismissed and that the European patent be maintained as granted. As an auxiliary request, that oral proceedings be arranged.

V. The appellant argued as follows:

- The Opposition Division was wrong in refusing to consider the late-filed documents (D5) and (D6) and the belated ground for opposition raised under

Article 100(c) EPC (Article 123(2)), although the belated submissions were made within the normal development of the opposition proceedings and in response to the arguments set forth by the patent proprietor.

- The amendments brought to the description and to the claims during examination were such as to extend the subject-matter of the European patent beyond the content of the application as filed, in contravention of Article 123(2) EPC. In particular, the feature added to claim 1, according to which "the apertures are in raised areas and in the land areas between the raised areas", was not considered as an essential feature in the original application.

- Document (D4) disclosed a water permeable contoured polymeric film of the type recited in the pre-characterising portion of claim 1 and, implicitly, the use of elastomeric polymer material and the provision of apertures in the land areas between the raised areas.
Documents (D5) and (D6) also disclosed the use of elastomeric or plastic films provided with apertures. Therefore, the subject-matter of independent claims 1, 12 and 15 was obvious vis-à-vis document (D4) in combination with the general knowledge of a person skilled in the art or with the teaching of either document (D5) or (D6).

Reasons for the Decision

1. The appeal is admissible.
2. *Procedural matters*

Formally, the Opposition Division refused to consider documents (D5) and (D6) and the new ground for opposition under Article 123(2) EPC for the reason that they were filed late. But the first instance in fact commented on the merits of these issues in the decision under appeal and finally decided to disregard them principally because they were irrelevant. Since, in addition, both parties continued to argue on these issues at the appeal stage, they must be regarded as being in the proceedings. Accordingly, the Board sees no reason for not considering said issues in the present proceedings. The late-filed documents and ground for opposition are, therefore, admitted.

3. *Formal aspects (Article 123(2) EPC)*

Although in the application as filed the paragraph on page 8, lines 2 to 19 has no basis in the priority document GB-A-8 521 254, the last characterising feature of claim 1 in suit according to which "the apertures are in the raised areas and in the land areas between the raised areas" is in fact fairly supported by the application as filed (cf. page 8, lines 2 to 6). Since a priority document has no relevance for the appreciation of Article 123(2) EPC, it must be concluded that said feature satisfies the requirements of Article 123(2) EPC.

In the expression "some of the apertures **may** fall in the land areas" (cf. application, page 8, lines 5 to 6), the term "may" was omitted in the patent specification (cf. patent, page 3, line 23). By so

depriving the said expression of its optional character, the modification is such as to restrict the scope of the claim to one of several possible options. Such a restriction to features previously described as optional is permissible provided that the application as originally filed contains an adequate basis for such limitation and that said limitation was caused by the normal development of the examining procedure (cf. T 583/93, OJ EPO 1996, 496, point 4.5).

Claim 1 is silent about the number of apertures irrespective of the areas which are considered. The interpretation of the appellant seeing the same number of apertures in the raised areas as well as in the land areas is, therefore, not founded, and has also no basis in the description. At the very best, the term "some" in the above mentioned expression could provide a relative indication about the number of apertures in both the raised and the land areas. However, an additional and more specific limitation of claim 1 is neither necessary nor appropriate so long the contested feature has not been seriously challenged by the state of the art.

4. *Closest prior art and novelty*

4.1 Document (D4) represents the state of the art coming closest to the invention. It discloses all the features contained in the pre-characterising portion of claim 1, in particular a thermoplastic film 1 comprising concave depressions 4 separated by continuous raised portions 5. With respect to the embodiment described in the present patent, the terminology used in document (D4) is inverted, so that the depressions 4 correspond to the raised areas in the patent whereas the raised portions 5 correspond to the land areas in the patent. Each depression is formed by sloping wall portions ending in a bottom portion at the base of the

depression. The bottom portion of the contoured film is perforated with one central opening 6 whereas the sloping portions of the walls are perforated with a plurality of openings 7 smaller in size than the bottom opening 6 (cf. column 2, lines 14 to 19).

- 4.2 In the present appeal, the central question at issue arises from the following passage in document (D4) (cf. column 1, lines 65 to 69):

"Moreover, in accordance with this invention a predominantly major portion, if not all, of the open area of the film is located in the film portions lining the walls of the depressions".

In the Board's view, the expression "open area" in said passage refers logically to the expression "total open area" mentioned in the sentence preceding immediately the contested passage, that is the totality of openings 6 and 7. Only the openings 7 are situated in the sloping wall portions of the film (cf. column 2, lines 69 to 71). Consequently, the "major portion" referred to in the passage under dispute relates unambiguously solely to the openings 7. The subsequent expression "if not all" means that, optionally, the total "open area" as previously defined may be formed exclusively by the openings 7. In such a case, a central opening 6 does not even exist. Document (4) does not disclose nor suggest forming openings in the separating zones 5 ("land areas" in the patent) between the depressions, so that the last characterising feature of claim 1 is neither disclosed nor derivable from this document.

- 4.3 The feature according to which the film is formed from elastomeric polymer is not mentioned in document (D4). In this document, suitable films are rather considered to be thermoplastic films such as low density

polyethylene films. Moreover, suitable properties such as those recited in the present patent (soft, recoverable and strong enough) are not particularly sought in document (D4). Therefore, *stricto sensu*, the first characterising feature of claim 1 is also not disclosed.

5. *Inventive step*

5.1 The subject-matter of claim 1 is thus distinguished from the disclosure of document (D4) by the features in its characterising portion, in particular by providing apertures in both the raised areas and in the land areas between the raised areas, which allows preventing re-emergence of absorbent fluid commonly termed "wet-back" (cf. patent, page 2, lines 11 to 13 and 34 to 36).

5.2 As outlined above, the skilled person was not able to find in document (D4) any incentive to form openings also in the raised portions 5 bordering the depressions.

5.3 Document (D5) was submitted by the appellant as evidence that using an elastomeric, perforated film was known *per se*, which can actually be derived from this document (cf. column 3, lines 10 to 15 and column 7, lines 56 to 61). However, the film described therein is not contoured to form a pattern of successive raised areas and land areas. Besides, forming such a pattern is not even an object in this document. Therefore, there cannot be any openings in non-existing land areas.

5.4 Document (D6) neither discloses using a film made of elastomeric polymer material nor forming openings in the uppermost surfaces (striations or grooves 12,212; cf. Figures 2 and 8) of a structure 10,210 for forming

a perforated laminate film. According to the level of vacuum which is applied, the plastic film is selectively apertured in the depression (debossed) areas but never in the uppermost land areas, between the debossed areas (cf. columns 9 and 15).

- 5.5 Since none of the cited documents discloses nor suggests forming apertures also in the land areas between the raised areas, the combination of the features contained in claim 1 is not rendered obvious by the cited state of the art and thus involves an inventive step within the meaning of Article 56 EPC.
- 5.6 The same conclusions apply to the independent claims 12 and 15 which incorporate the same distinguishing feature as mentioned above, regarding the land areas.
6. The grounds for opposition mentioned in Article 100 EPC do, therefore, not prejudice the maintenance of the European patent.

Order

For these reasons it is decided that:

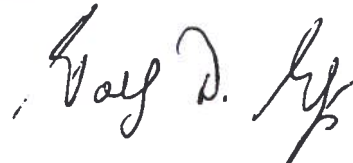
The appeal is dismissed.

The Registrar:



N. Maslin

The Chairman:



W. D. Weiß