

Internal distribution code:

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

D E C I S I O N
of 24 March 2000

Case Number: T 0368/98 - 3.2.2

Application Number: 91111307.4

Publication Number: 0467184

IPC: A61F 13/56

Language of the proceedings: EN

Title of invention:

Form retentive absorbent pads

Patentee:

McNEIL-PPC, INC.

Opponent:

SCA MÖLNLYCKE AB

Headword:

Form retentive absorbent pads/McNEIL-PPC

Relevant legal provisions:

EPC Art. 123(3), 112, 111(1)

Keyword:

"Admissibility of appeal (yes)"
"Admissibility of amended claim (yes)"
"Reformatio in peius"
"Referral to the Enlarged Board of Appeal (no)"
"Remittal to first instance"

Decisions cited:

G 0009/91, G 0009/92, G 0004/93, T 0220/83, T 0089/85,
T 0123/85, T 0296/87, T 0459/88, T 0611/90, T 0186/93,
T 0528/93, T 0828/93, T 0840/93, T 0900/94

Catchword:

-



Case Number: T 0368/98 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 24 March 2000

Appellant: McNEIL-PPC, INC.
(Proprietor of the patent) Van Liew Avenue
Milltown
New Jersey 08850 (US)

Representative: Groening, Hans Wilhelm, Dipl.-Ing.
BOEHMERT & BOEHMERT
Franz-Joseph-Strasse 38
D-80801 München (DE)

Respondent: SCA MÖLNLYCKE AB
(Opponent) 405 03 Goteborg (SE)

Representative: Hammond, Andrew David
Göteborgs Patentbyrå Dahls AB
Sjöporten 4
417 64 Göteborg (SE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 3 February 1998
revoking European patent No. 0 467 184 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: W. D. Weiß
Members: C. Holtz
D. Valle

Summary of Facts and Submissions

I. Decision under appeal

The patent was revoked on the grounds of insufficient disclosure and lack of inventive step, the latter with regard to document D6.

The opposition division based its finding of *insufficient disclosure* on the interpretation of the invention as requiring that the bendable means of the absorbent pad would, after having been bent by the user, maintain its shape during use. According to the opposition division, this feature could not be achieved by the skilled person, since the materials listed in the patent would not be able to maintain its shape. There was also no indication in the patent about the specific parameters necessary for the materials to fulfil this feature.

II. Claim history

Claim 1 as originally filed read as follows:

"1. An absorbent feminine absorbent product comprising:

an elongate pad (100) having a body facing side and an undergarment facing side, and defining longitudinal edges, said pad (100) comprising fluid absorbent material; and

bendable means attached to said pad (100) which can be bent by user for changing the shape of the pad (100) when so bent, at least along the longitudinal axis (y)

of the pad (100)."

Claim 1 as granted was reformulated into the two-part form through the insertion of "characterized in that" after the words "bendable means attached to said pad (100)", and had the following characterising portion: "said bendable means can be bent by user for changing and substantially maintaining the shape of the pad (100) when so bent, at least along the longitudinal axis (y) of the pad".

In comparison to claim 1 as filed the only added feature was the ability of the means of "substantially maintaining" the shape of the pad when so bent.

Claim 1 in the version considered in the *decision under appeal* contained the further features as compared to the claim as granted (excluding reference numbers):

"wherein the said bendable means comprises a strap of bendable material extending transversely across a central portion of said pad, wherein the shape of said strap is double concave in the direction (x) transverse of the pad, said bendable means further comprises a plurality of winglets extending beyond the transverse edges of said pad, said winglets being bendable around the edges of an undergarment to hold said product in place in the undergarment during use, wherein said winglets are shaped such that they are generally convex in relation to the pad."

These features were originally contained in claims 2 (a strap of bendable material extending transversely across a central portion of the pad), 3 (a plurality of winglets extending beyond the transverse edges of the

pad and being bendable around the edges of an undergarment to hold the product in place in the undergarment during use), 4 (the winglets shaped such that they are generally convex in relation to the pad) and 5 (the shape of the strap is double concave in the direction transverse of the pad).

On appeal, the following requests are on file:

Claim 1 according to the *main request*:

"An absorbent feminine hygiene product comprising:

an elongate pad (100) having a body facing side and an undergarment facing side, and defining longitudinal edges, said pad (100) comprising fluid absorbent material; and bendable means attached to said pad (100) characterized in that said bendable means comprises a material selected from the group consisting of malleable metal foils, waxes, impregnated nonwovens, laminated foils, and foils sandwiched between polymer films and that said bendable means can be bent by a user for changing and maintaining the shape of the pad (100) when so bent, at least along the longitudinal axis (y) of the pad (100)."

Claim 1 of the *first auxiliary request* differs from claim 1 of the main request in that the words "readily manipulatable into a desired conformation tended to be retained and" have been inserted after the word "material" in the characterising portion of the claim.

Claim 1 of the *second auxiliary request* differs from claim 1 of the main request in that the word "nonresilient" has been inserted before the word

"material" in the characterising portion of the claim.

Claim 1 of the *third auxiliary request* includes the features of claim 2 to 5 according to the main request, and reads as follows:

"1. An absorbent feminine hygiene product comprising:

an elongate pad (100) having a body facing side and an undergarment facing side, and defining longitudinal edges, said pad (100) comprising fluid absorbent material; and bendable means attached to said pad (100), wherein said bendable means comprises a material selected from the group consisting of malleable metal foils, waxes, impregnated nonwovens, laminated foils, and foils sandwiched between polymer films, said bendable means can be bent by a user for changing and maintaining the shape of the pad (100) when so bent, at least along the longitudinal axis (y) of the pad (100), wherein said bendable means comprises a strap (132; 232) of bendable material extending transversely (x) across a central portion of said pad (100), wherein the shape of said strap (132) is double concave in the direction (x) transverse of the pad (100), said bendable means further comprises a plurality of winglets (128, 130; 228, 230) extending beyond the transverse edges of said pad (100), said winglets being bendable around the edges of an undergarment (10) to hold said product in place in the undergarment (10) during use, wherein said winglets (128, 130; 228, 230) are shaped such that they are generally convex in relation to the pad (100)."

III. Documents

In the patent in suit D1, EP-A-0 337 438, and D5, EP-A-0 331 018, are cited in relation to the problem to be solved according to the inventor.

Before the opposition division, the following further documents were cited:

D2: EP-A-0 335 252,

D3: EP-A-0 335 253,

D4: US-A-4 773 905, and

D6: US-A-4 865 597, the latter filed only in the oral proceedings before the opposition division.

IV. Requests on appeal

In the oral proceedings held on 24 March 2000 the following requests were noted:

The appellant requested that:

the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 to 14 submitted on 15 June 1998 with the grounds of appeal, with the proviso that the word "substantially" in claim 1 be deleted, alternatively in accordance with the first, second or third auxiliary request as submitted in the oral proceedings on 24 March 2000.

The respondent maintained its requests according to the letter of 16 February 2000, namely

(a) that the board of appeal refuse to consider the

new claims because they are of considerably broader scope than the claims on which the decision under appeal was based,

- (b) unless the BA decides in favour of the respondent on the issue of admissibility of the new claims, that the following question be referred to the EBA:

If, during opposition proceedings, the only request of a patent proprietor is the maintenance of his patent in amended form and the patent is revoked by the Opposition Division due to the failure of the patent in that amended form to meet the requirements of the European Patent Convention, is the Board of Appeal obliged during a subsequent appeal by the patent proprietor to consider a request containing claims of broader scope than those upon which the decision to revoke the patent was based?

- (c) if the board admits the new claims, that the case be remitted to the first instance,
- (d) that costs be awarded to the respondent, if further oral proceedings become necessary, and
- (e) in the event that none of the previous requests can be met, that the appeal be dismissed.

In the course of the oral proceedings the admissibility of the appeal as such was also discussed, having been raised in a letter of 17 August 1998 from the respondent.

V. Submissions by the parties

The arguments of the parties may be summarised as follows:

(a) Admissibility issues

The respondent:

The purpose of an appeal is to have a review of the decision under appeal in order to give the losing party the possibility of challenging the decision of the opposition division on its merits. Referring to decision G 9/91 in this respect, the board in decision T 840/93 considered that it should confine itself to its appellate role and decide only on requests which had already been considered by the opposition division. Therefore the appellant cannot avoid addressing the issues dealt with by the first instance by filing new claims.

If the new claim 1 according to the main request is admitted, the respondent would be in a potentially worse position than if the opposition division had decided to maintain the patent in an amended form. *Reformatio in peius* is not allowed under G 9/92 and G 4/93. The appellant's new claim 1 is an abuse of the proceedings, since it could have filed alternate requests before the opposition division. The case law has established that a party has to file a multitude of requests, but the appellant had only one request before the opposition division. The present appeal is not the appellant's last chance to save the patent, claims

can always be made narrower. The present claim 1 of the main request is broader than the one decided by the opposition division, since it now corresponds to the granted claim 1 with an added list of materials. Under these circumstances the appellant cannot be entitled to go back to the granted claim.

The Appellant:

The grounds of appeal were quite detailed and consisted of 18 pages of which 10 pages were devoted to the concept of "maintain". The appellant chose the closest prior art and combined it with all other documents. The decision under appeal showed that there had been a misunderstanding of the concept of "maintain". The dual function of the bendable means of being manipulated into a desired shape by a user, and then further change when exposed to later forces was not understood. The new claim introduced the materials to make clear what the invention was about. Document D6 was discussed in relation to inventive step in the grounds of appeal. Only in the oral proceedings before the opposition division did the respondent cite D6 for the first time and brought samples to illustrate the prior art. The decision under appeal was in fact the first opportunity given to the appellant to analyse the situation.

Claim 1 of the main request does not represent any abuse of proceedings. The discussion on insufficient disclosure and lack of inventive step in relation to document D6 only arose in the oral

proceedings before the opposition division, as a result of this document having been cited by the respondent shortly before those proceedings. All the patentee did was to react to the reasoning of the opposition division in the decision under appeal. These reasons were conveyed to the appellant for the first time through that decision. The case law of the boards of appeal confirms that there is no abandonment of parts of the subject-matter of a patent. The interest of the general public in legal certainty only requires that a patentee does not go beyond the *granted* claim. There is a restriction in comparison to the granted claim in the new claim, since polymers are excluded from the materials mentioned in the patent. The main request should therefore be admitted. - The claim is not broadened, but different. It was essential to point out that the appellant was not interested in resilient materials, only in waxy materials without any spring force. The respondent is not in a worse situation, but in a different one. This was caused by the respondent itself, through the reference to D6 and the samples that were demonstrated in the oral proceedings, which apparently led the opposition division to misunderstand the invention.

- (b) Referral of a question to the Enlarged Board of Appeal or remittal to the first instance

The respondent:

There is a legal uncertainty regarding the *reformatio in peius* issue. The case law is

insufficient. There is nothing in the EPC allowing a patentee to go back to the granted claims but also nothing to prevent him from doing so. This warrants a referral to the Enlarged Board of Appeal of the question whether a patentee who in the first instance only had one request for maintenance of the patent in amended form is entitled to have a request considered that contains claims broader than those upon which the decision to revoke the patent was based. - When substantial amendments are admitted, the boards as a rule remit the case in order to give the parties the opportunity to argue their case in two instances, see eg. decision T 611/90, OJ EPO 1993, 50. In the present case, an entirely new situation has arisen warranting a remittal, in order to give the respondent an opportunity to file an appeal later, if necessary.

The appellant:

Oppositions are cases between the patentee and the general public. There is no absolute need to remit a case only because the claims have been amended in substance. Decision T 186/93 of 22 May 1995 established that a case is remitted only when substantial amendments require further examination. The present new claim 1 does not require any further search. However, the appellant has nothing against remittal, if the board finds it necessary.

(c) Insufficiency of disclosure

The respondent:

The materials now claimed were not in the application as filed. In a letter dated 8 June 1994 containing amended claims, the appellant contended that various shapes could be imparted to the pad by bending the strap prior to use, that the pad then maintained the preformed structure after the pre-bending stresses were released and that when pre-bent, this shape would be retained during use. Also according to the granted patent, column 2, line 15 and lines 25 to 29, as well as column 6, lines 48 to 50, the shape must be retained. The appellant maintained this argument before the opposition division, as noted in the decision under appeal. With the materials now claimed this object of the invention is impossible to achieve. The quoted passages refer to manipulation by the hands of the wearer and to the effect that the pad then retains its shape. There is no indication of how much maintenance of shape is needed. The patent is also silent on the amounts needed of the suitable materials to achieve the desired maintenance. The change in meaning introduced by the recent arguments of the appellant is absurd since "maintain" now means "changing all the time".

The appellant:

The word "maintain" as used in the patent in suit describes the ability of the invention to maintain desired conformations until new forces are acted upon it. It also describes the ability of the form retentive pad to maintain close proximity with the contoured surfaces of the body. It is precisely the ability of the pad to be manipulated by the

user in use that allows it "to assume a wide variety of body hugging conformations" and be capable of "maintaining close proximity with contoured, fluid bearing surfaces". It is obvious to the person skilled in the art that the wearer cannot pre-bend the pad to fit precisely these surfaces, but that this will be achieved during use by the forces exerted on the pad with varying movements. The pad has to fulfil the conditions of being both manipulatable and retaining its shape. It is clear from the passage bridging page 8 and 9 in the application as originally filed that the suitable material must be able to conform to outside forces and to tend to retain the shape formed. There was a misunderstanding on the part of the opposition division of the words "maintain" and "retain" to mean that the pad stays in the same conformation throughout use. What is meant is that the pad does not spring back to its original shape when the pressure is released. The new shape remains intact only so long as it is not affected by new forces. Therefore, only non-resilient materials are suitable. From the materials and the conditions to be met according to the patent the skilled person would understand that the pad would have to conform to forces exerted during use. A stiff, hard napkin would not achieve this and would not be comfortable to wear, which is another condition to be fulfilled. There is an express indication in the patent description that the pad will conform to further pressures, for example in column 1, lines 50 to 51, "to assume and maintain a variety of shapes", and column 6, lines 49 to 50, "which tends to retain that shape" and "Malleable materials". It would not be an undue

burden for the skilled person to arrive at suitable amounts in order to arrive at the invention, once the conditions to be met are understood.

- (d) On request by the respondent, the appellant declared that the features in claim 1 "bendable means attached to said pad ... maintaining the shape of the pad when so bent" is to be interpreted in the meaning of column 6, lines 44 to 50 of the patent specification, ie. both prior to use and during use.

Reasons for the Decision

1. Admissibility of the appeal

While it is correct to say that an appeal in order to be admissible should as a rule contain the reasons why the decision under appeal should be set aside (see eg. decisions T 220/83, OJ EPO 1986, 249 and T 250/89, OJ EPO 1992, 355), the board cannot agree with the respondent that the present appeal should be rejected as inadmissible for this reason. The explanation given by the appellant why the grounds of appeal did not deal with the reasons of the decisions under appeal is acceptable, namely that the reference to D6, made by the respondent only in the oral proceedings before the opposition division, made it impossible for the appellant to know what the reasons for revoking the patent would be until the written decision had been issued. The appellant tried to overcome these reasons by amending the claim. As a result, the reasons of the opposition division for finding a lack of inventive

step became irrelevant. A change of facts makes the cited case law inapplicable, for example when amended claims have been filed (see T 459/88, OJ EPO 1990, 425). An appeal is sufficiently reasoned, if the other parties and the board can understand the extent of the appeal and what arguments and evidence in support of it are brought forward, or in other words, what the issues are that shall have to be examined in the appeal. This condition is met in the present case.

All other conditions for a valid appeal having been fulfilled, the board finds the appeal admissible.

2. *Admissibility of new claim 1 according to the main request*

2.1 The respondent argues that claim 1 of the main request should be declared inadmissible, since it is broader than the corresponding claim as examined and refused by the opposition division. Since this argument would apply equally to the first and second auxiliary requests as well, the board will examine this issue with all three versions of claim 1 in mind.

2.2 The arguments of the respondent suggest that a patentee who has amended his claim before the OD but who did not insist on his original claim as a main request has abandoned all subject-matter covered by that claim which was excluded by the amended claim. Otherwise the respondent could never be worse off when a patent has been revoked, since the patentee on appeal always would be free to choose within the confines of Article 123(3) EPC from the patent as granted what he wishes to have protected. It is however established case law that a restricted claim does not mean that any subject-matter

is abandoned by the patentee, see eg. T 123/85, OJ 1989, 336. This decision is also confirmed by decision T 900/94, of 23 October 1996. It is to be noted that the reason why the board in the latter case did not admit the new claim was the fact that it was raised only in the oral proceedings, 33 months after the appeal had been lodged, without any reasons given for the delay.

2.3 Even if the amended claim were to be seen as broader than the claim refused by the opposition division, the board finds the amendment admissible under the case law, which allows broadening on appeal, unless it would constitute abuse of proceedings (see eg. decisions T 89/85 of 7 December 1987 and T 296/87, OJ EPO 1990, 195). Because of the surprise reference to a new document in the oral proceedings before the opposition division, the reaction of the appellant cannot be seen as an abuse. The new claim was moreover filed immediately on appeal in an attempt at overcoming the objections of the opposition division as expressed in the decision under appeal.

2.4 The board is aware of other case law which takes a stricter line, eg. decision T 528/93 of 23 October 1996, which however addressed a slightly different issue, namely that a claim not the subject of the decision under appeal could not be admitted, although it had been on file earlier during the prosecution history of the application. However, decision T 828/93 of 7 May 1996 allowed broader claims on appeal when the patent had been revoked. Decision T 840/93, OJ EPO 1996, 335, while taking a strict line and not admitting claims going beyond what the first instance had examined, still indicated that the situation would have

been different, if the amendment had been the last chance for the patentee to save something from his patent. The case law seems to make a distinction between the situation where the patent has been revoked entirely and the one where it has been maintained in amended form. In the latter situation, the patentee cannot revert back to a broader claim, unless he has pursued it before the first instance. Neither decision G 9/92, OJ EPO 1994, 875, nor G 4/93, OJ EPO 1995, 875, applies, since they deal exclusively with the rights of a *non-appealing party*.

- 2.5 In summary, the board finds sufficient support in the case law of the boards of appeal to admit claim 1 according to the main request as well as according to the first and second auxiliary requests, in particular in view of the procedural situation during the oral proceedings before the opposition division, which was caused by the respondent.
- 2.6 The argument of the respondent that a patentee has to file a multitude of requests in order to maintain his rights to revert to broader versions on appeal does not serve the purpose of procedural economy. If a patentee realises that a claim is not patentable, nobody is served by him insisting that it be examined. Under normal circumstances, however, the patentee would have sufficient time to consider filing new claims. Procedural economy is served by applying strictly the procedural rules for the introduction of new evidence, so that the proceedings are not unduly extended. If new documentation is allowed to be introduced late, in the interest of due process and party equality, the other party must be given the opportunity to have the oral proceedings adjourned in order to study the new

document properly, which of course would not serve the object of procedural economy. The argument of the respondent that they were prepared to withdraw D6, had it caused any procedural problems, is not convincing, since Rule 60(1) EPC makes it possible to continue the proceedings, even if the respondent had withdrawn its opposition, and the opposition division was entitled anyway under Article 114(1) EPC to consider the document.

3. *Referral of a question to the Enlarged Board of Appeal*

The question whether the new claim 1 is a broadening of the scope of the claim as refused by the opposition division is an issue that does not raise any important point of law. The case law on the procedural rights of an appellant/ patentee seems on the whole conclusive. In one respect, however, the case law cited above may raise a legal issue, namely whether the distinction made in the case law between revoked patents and patents maintained in amended form is justified. It would be procedurally more logical, if the rights of an appellant/patentee would be defined in the same way for all cases, regardless of the outcome of the first instance proceedings. In fact, it may be argued that the rights of the appellant/patentee should only depend on its procedural position before the first instance whose decision is appealed, as suggested by the respondent. However, this issue does not need addressing in the present case, for the reason that the particular procedural situation in the present case was caused by the respondent's belated reference to D6 and samples from the prior art, which were presented by the respondent only in the oral proceedings before the opposition division.

The board accordingly sees no need to refer a question to the Enlarged Board of Appeal.

4. *Insufficiency of disclosure*

There are several objects stated in the patent as granted, column 1, lines 34 to 37, column 1, lines 45 to 55, and column 2, lines 6 to 18, namely that it is important that the pad is able to achieve various shapes, that it can maintain close proximity with the fluid-bearing surfaces of the body, and that it is comfortable to wear. When read as a whole, the passages cited by both parties indicate that although a pre-bent shape may tend to be retained it does not necessarily do so throughout the entire use of the pad (e.g. "which tends to retain that conformation", column 6, lines 49 to 50). Taken together with the above objects to be achieved according to the patent, these passages support the contention of the appellant that the skilled person would understand that suitable malleable non-resilient materials as exemplified in the application as filed, bottom of page 6 and top of page 7, as well as in the patent, should be such as to conform to the body contours under the influences of external forces during use.

The importance of the pad being able to maintain close proximity with fluid-bearing surfaces would teach the skilled person to adjust the amount of malleable material until this object was achieved. The board concludes that it would not present an undue burden for the skilled person to determine the amount needed of any of these materials to achieve said object, since this would only require some trial and error experimentation. The board is convinced that the

skilled person would understand that the pad had to meet all of these conditions and that therefore resilient materials would not be suitable.

The invention is therefore sufficiently disclosed.

5. *Remittal to the first instance*

With regard to claim 1 of the main request, the respondent has requested that the case be remitted to the first instance, objecting inter alia that the claimed invention is not new over document D2, in particular in view of the embodiment represented by Figure 25 in that document, and that the deletion of the word "substantially" is a broadening of the invention as claimed in the application as originally filed (Article 123(3) EPC). In view of these and other issues, eg. inventive step, that may arise from the amendments, the board finds it necessary to exercise its powers under Article 111(1) EPC to remit the case to the first instance for further prosecution.

6. *Costs*

Since the case is to be remitted to the first instance, the respondent's request for apportionment of costs cannot yet be decided.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

V. Commare

W. D. Weiß