
Candidate's Answer (C)

LEGAL POINTS / MEMO TO CLIENT

AUTHORISATIONS

Although a general authorisation has been filed, under J 11/93 this does not automatically apply to all proceedings before the EPO on behalf of the party – reference must be made to the general authorisation when concerning any specific proceedings.

Accordingly, I may be authorised for this specific proceedings. According to the Decision of the President dated 19 July 1991, professional representatives need not ordinarily file an authorisation when beginning proceedings.

Thus, no particular step need to be taken with regard to authorisation.

ADDED MATTER

The amendment of claim 1 as filed to include the features of a dependent claim does not normally contravene Art. 123(2) EPC. However, the deletion of the flat surface of the engaged head does violate this article, since this feature is presented as essential. Further argument is given in the Statement of Grounds.

PRIORITY

The differences between the priority document and the application as filed will affect the priority date of the relevant subject matter. Further argument is given in the Statement of Grounds.

TRANSFER OF OPPOSITIONS

In G 4/88, the Enlarged Board held that opposition may be transferred to a new party insofar as the relevant business assets are transferred to the new party.

T 659/92 indicated that a transfer only of certain industrial property rights was not sufficient to transfer the opposition.

Thus, provided the partial transfer of the business to Pooter and Grovel includes that part relevant to the opposition, this will be permissible.

RELEVANCE OF A2

As stated in the statement of grounds, this document is a PCT publication having a priority date earlier than the effective priority date of claims 1-3 only of the patent. It will therefore be citable as prior art under Art. 52(3) EPC only if the European Regional phase was validly entered, and only for the commonly designated states (Art. 158 EPC). However, since no information regarding entry into the regional phase has been given, I have not included any arguments relating to this document in the statement of grounds. If and when we do discover whether the EP phase was entered, I shall then try to introduce the document into the proceedings. This should be possible under T 1002/92 since A2 prima facie prejudices the maintenance of claims 1 and 2 of the patent.

For example, A2 describes a fastener suitable for engagement with a fastener of the same type (page 2, line 1), with a plurality of heads on stems on a base (head 40,

stalk 30, web 10 of A2), integrally moulded from thermoplastic (page 2, line 4 indicates PolyPPPC or PolyBLE used; A4 page 2 line 9 indicates that these are thermoplastic), with a pressure sensitive adhesive (page 2, line 9) on the upper surface of the heads (page 2, line 12 + 13) and on the base (page 2 lines 12-13 "the entire top surface of the fastener"), and the second surface of the base being covered with the adhesive (page 2, lines 19+20).

As regards claim 2, page 2 lines 15-17 of A2 disclose viscosity of 10000-20000 MPa.s of the adhesive; this overlaps with the claimed range of 6000-16000 Mpa.s, which thus lacks novelty (T 26/85, T 666/89).

Thus, A2 would prima facie prejudice the maintenance of the patent on the grounds that claims 1+2 lack novelty under Art. 54(3) EPC, provided that the Regional Phase has been validly entered, and only for commonly designated states.

In view of the clearance of the document, I believe it would be possible to introduce it into the opposition proceedings subsequently, provided this is done as soon as possible.

STATEMENT OF GROUNDS

Documents Referred To

A1 – EP 0845965B1 (English version)
A2 – WO 98/01166 (English version)
A3 – EP 0803748A1 (English version)
A4 – US 4,100,547 (English version)
A5 – Advertisement (English version)
A6 – DE 19418824A1 (French version)

Priority entitlement

Patent A1 claims a priority date of 26-07-1996, and has a filing date of 25-07-1997. However, inspection of the priority document reveals that only paragraphs 7, 11 and 17-19 of the description, claims 4-6, and page 3 of A1 were present in the priority document. The remaining parts of the patent are not "clearly and unambiguously deniable" from the priority document, as required by G 2/98.

Thus, it is considered that claims 1-3 of the patent are only entitled to the later priority date of 25-07-1997, while claims 4-6 are entitled to the earlier date of 26-07-1996.

Claim 1

Added matter – Art 123(2) EPC

Claim 1 as granted offends against Art. 123(2) EPC. Claim 1 as originally filed included only the features of the preamble, with the features of the characterising portion being incorporated during prosecution. However, these features were originally included in claim 2 as filed, together with the additional feature that the upper surface of the engaging head is flat. Removal of this feature violates Art. 123(2) EPC.

It is clearly stated on page 3, lines 8-9 of A1 that in order to retain the adhesive on the heads during application, “it is essential that the engaging heads have a flat upper surface”. According to the Guidelines C-VI, 5-8a, removal of a feature from a claim may not violate Art. 123(2) provided that the skilled person would directly and unambiguously recognize that (1) the feature was not explained as essential for achieving the desired distribution of adhesive, it is clear that this condition is not met, and that claim 1 as granted is contrary to Art. 123(2) EPC.

Novelty – A6

A6 has a publication date of 8-11-1994, which is prior to the effective priority date of claim 1, 25-7-1997. A6 is therefore citable under Art. 54(2) EPC against claim 1.

A6 discloses “a fastener suitable for engagement with a fastener of the same type” (A6: figure 2; page 2 lines 10-12: “un ruban auto-accrochant...une liaison améliorée entre deux éléments de fermeture identiques”). The fastener “comprises a plurality of engaging heads on stems projecting from a surface of a base” (A6: page 2, line 3 – the elements are “en forme de champignon”; it is clear from A1 page 1 lines 13-15 that a “mushroom type fastener” has “stems projecting from a base and an engaging head at the end of each stem”).

The base, stems and heads of A6 are “integrally moulded from a thermoplastic material”: A6, page 3, lines 1+2 states “les éléments de fermeture en forme de champignon sont coulés intégralement en une bande sans fin à partir d’une matière synthétique thermoplastique.”

A “pressure sensitive adhesive” (“adhésif sensible à pression”, A6, page 2, line 2) is applied “on an upper surface of the engaging heads” – A6, page 2, lines 29+30 indicate that if the adhesive is not sufficiently thin when applied, it will not flow totally from the heads (Si...l’adhésif n’est pas assez fluide, il ne pourra pas s’écouler totalement des têtes.) – some adhesive will thus remain on the heads.

Furthermore, the passage at lines 25 of page 2 A6 also indicates that “said adhesive is also applied to the base between the stems” (“se répand uniformément entre les éléments de fermeture.”)

In addition, A6 also indicates that such a construction is possible with the apparatus of figure 1: page 2, lines 17-19 indicate that “la viscosité... doit être...suffisamment élevée pour que seulement une quantité minimale d’adhésif goute des têtes sur l’élément porteur” that is, some adhesive may nonetheless drip from the heads of the supporting base.

Finally, “a second surface of the base” of A6 “is provided with said adhesive” – see A6, page 3, lines 4+5: “l’adhésif peut être déposé également sur le dessous de l’élément porteur”.

A6 therefore discloses a structure having all the features of claim 1 of A1. Claim 1 thus lacks novelty over A6 for all designated states.

Further, should the patent proprietor attempt to remedy the deficiency under Art. 123(2) EPC by reintroducing the limitation that the upper surface of the heads is flat, it is observed that A6, page 1, line 16 states that the heads “de préférence est plate”. This feature thus also lacks novelty over A6.

Claim 2

Added matter – Art. 123(2) EPC

Claim 2 depends on claim 1, and hence includes all the limitations of that claim. As discussed above with reference to claim 1, the absence of the limitation that the upper surface of the head is flat violates Art. 123(2) EPC. Claim 2 as granted therefore offends against Art. 123(2) EPC.

Inventive Step – A6

Claim 2 includes all the limitations of claim 1 with the additional feature that the “pressure sensitive adhesive has a viscosity of between 6000 and 16000 MPa.s when measured at the application temperature”. The purpose of this limitation is described on page 3, lines 6-8 of A1 as “to ensure that part of the adhesive stays on the flat heads and part of the adhesive flows off the heads and fills the space between the stems.”

A6 describes on page 2, lines 27-31 that “on peut ainsi obtenir par un choix approprié de la viscosité que l’adhésif reste collé sur les têtes ou se répande entre les éléments de fermeture.” A6 further describes how a particular choice of viscosity may allow adhesive not to flow entirely from the heads, while still spreading between the closure elements.

Taking A6 as the closest prior art, then, the problem addressed by claim 2 is the identification of particular viscosity values which will allow adhesive to remain on both the heads of the mushrooms and to flow into the base between the stems.

The solution given by claim 2 is obvious to the skilled person.

A6 in fact indicates that “an appropriate choice” viscosity will permit such a condition; hence, ordinary trial and error would be sufficient to arrive at the claimed values. As indicated in the Guidelines C-IV, 3.1 (II), inventive step is not to be recognized in the choice of particular parameters from a limited range of parameters. Further, no unexpected advantage is found from the selection of these viscosities, only the effect which A6 would have led the skilled person to expect.

Thus, claim 2 lacks inventive step under Art. 56 EPC over A6.

Claim 3

Added matter – Art. 123(2) EPC

Claim 3 depends on claim 2, which in turn depends on claim 1. Claim 3 therefore lacks the essential feature that the top of the heads is flat, which as discussed above with reference to claim 1, renders claim 3 as granted in violation of Art. 123(2) EPC.

Inventive step: A6 + A4

A4 has a publication date of 15-9-1988, before the effective priority date of claim 3 of 25-7-1997. A4 is thus prior art under Art. 54(2) and Art. 56 EPC.

Claim 3 depends on claim 2, and hence contains all the limitation of that claim, in addition to the feature that the “engaging head is of the mushroom type having a cylindrical stem and an undercut having an angle α of between 25° and 50°”. The benefit of this undercut is stated in A1, page 3, lines 13 & 14 as it “improves mechanical engagement between fasteners”.

Taking A6 as the closest prior art, this has all the features of claim 3 with the exception of the undercut and the particular viscosity of the adhesive. (See discussion above with respect to A6 and claim 1). The fact that the heads of A6 are of the mushroom type is described on page 2, line 3 of A6.

The selection of the particular viscosity of the adhesive is considered to be obvious, as described above with reference to claim 2. The problem solved by the features of claim 3 vis-à-vis the closest prior art is thus to improve mechanical engagement between fasteners of the mushroom type (A1, page 3, lines 13 + 14).

Document A4 describes on page 2, lines 18-22 the provision of mushroom type fastener having an undercut of between 20-60°, for the purpose of adjusting the mechanical strength of the connection between fasteners. A4 thus solves the same problem as the undercut of claim 3 in the same manner as that claim. The difference in ranges of inherent angles (20-60° in A4, 25-50° in A1) is not demonstrated in A1 to have any unexpected advantages, simply the improvement of mechanical connection. This restricted range cannot therefore be considered inventive.

The skilled person concerned with improving the mechanical connections between fasteners would have found in A4 the same solution as claimed in claim 3. It would be natural for the skilled person starting with the teachings of A6 to incorporate the teachings of A4 since both documents lie in the same technical field of mushroom fastener, and the skilled person would have made this construction in the expectation of solving the problem and achieving a technical advantage.

Thus, claim 3 is obvious over A6 + A4.

Claim 4

Claim 4 is entitled to the claimed priority date of 26-07-1996.

Novelty: A3 : Art. 54(3) EPC

A3 has a priority date of 26-4-1996, before the priority date of claim 4, and a publication date of 24-10-1997. A3 is thus relevant for novelty of claim 4 under Art. 54(3) EPC, for those commonly designated states. In this case, all states designated in A1 are also designated in A3.

A3 describes a “closure tab for a sanitary article” (page 2, line 13: “close tab for a diaper”). A1 states on page 1, lines 2 + 3 that diapers are sanitary articles. In addition, the phrasing “for a sanitary article” is non-limiting, and simply means “suitable for” (Guidelines C-III, 4.8).

The tests of A3 in “provided with a fastening region”, that is, any part of the tab carrying hooks, “and a non-fastening region” (page 2, line 15 A3: “a central part of the tab is free of hooks”).

The fastening region of the tabs is provided with a direct fastening means comprising “mechanical fastening elements for engaging with further mechanical fastening elements on a surface to which the tab is to be attached” (A3, page 2, line 20: “the hooks engage the loops on the waist part of the diaper”), and “b) an adhesive on the fastening elements for attaching to a surface of the sanitary article” - A3 page 2 lines 21-22 “the adhesive on the upper side of the hooks adheres to the outer surface of the diaper”.

Thus A3 describes a closure tab having all the features of claim 4, which therefore lacks novelty under Art. 54(3) for all designated states.

Inventive step: A6 + A5

A5 and A6 were both published before the priority date of claim 4, and are thus citable as prior art under Art. 54(2) and Art. 56 EPC.

Taking A6 as the closest prior art, this describes a closure tab (=“ruban auto-accrochant”) including a fastening device “tels que ceux qui sont utilisés par exemple pour des articles hygiéniques à usage unique”. The device is thus suitable for use with sanitary articles. The device of A6 has a fastening region (“éléments de fermetures (10)”) comprising mechanical fastening elements for engaging with further mechanical fastening elements (the mention of A6 provides “un ruban auto-accrochant”, page 2 lines 5-6). There is also provided an adhesive on the fastening element for (=“suitable for” Guidelines C-III, 4.8) attaching to a surface of the sanitary article. The example of fig. 1 of A6 “peut adhérer aussi à la surface d’un article hygiénique” (page 2, lines 7-8).

Claim 4 differs from A6 in that a non-fastening region is provided on the tab. The advantage of a non-fastening region is given in A1, page 3, lines 24+25 as making it easier to grip the tab. The problem to be solved with respect to A6 is thus the provision of a means to ease grasping of the tab. A5 indicates that a solution to the problem is to

produce “the end of the tab free from any fastening means”, which “is easy to grasp” (A5, line 8). Thus, the same problem is solved by the same solution with the same advantages. The skilled person would naturally combine A6 and A5 when producing a tab for sanitary articles, since both documents relate to the same field. The combination is thus known.

Thus, claim 4 is not inventive over A6 in view of A5.

Claim 5

Inventive step: A6 + A5

Claim 5 depends on claim 4, and thus contains all limitations of that claim, in addition to the feature that the non-fastening region is an outer region of the tab.

Taking A6 as the closest prior art, this discloses all features of claim 5 with the exception of a non-fastening region of the tab (see discussion of A6 above with respect to claim 4), which is an outer region of the tab.

The problem to be solved with respect to A6 is therefore as with claim 4 to allow easy handling of the tab. A5 discloses the provision of a non-fastening region of the tabs on an outer region thereof (A5, line 6: “the end of the tab is free from any fastening means”).

Thus, A5 solves the same problem as claim 5 in the same way. As discussed above with reference to claim 4, the skilled person seeking to produce diaper tabs which are easier to handle would naturally seek to combine A6 with A5, since they are both in the same field, that of diaper fastener tabs.

Claim 5 thus lacks inventive step under Art. 56 EPC over A6 and A5.

Claim 6

Claim 6 depends from either claim 4 or claim 5.

Claim 6 dependent on claim 4

Novely – Art. 54(3) EPC

A3 is citable as prior art against claim 6 under Art. 54(3) EPC only. As discussed above, A3 includes all the features of claim 4. Claim 6 further specifies that the tab is elastic. A3 states on page 2 line 13 that “the tab is elastic”.

Claim 6 when dependent on claim 4 thus lacks novelty under Art. 54(3) EPC over A3, for all designated states.

Inventive Step – A6 + A5

A6 has the closest prior art and discloses all features of claim 6 when dependent on claim 4, with the exception of a non-fastening region and an elastic tab. As discussed above with reference to claim 4, the skilled person would naturally combine A6 with A5 to obtain a solution to the problem of creating an easy area of the tab to grasp, so obtaining a non-fastening region of the tab.

The remaining problem addressed by claim 6 is the provision of a comfortable and close fit on the wearer of the diaper (A1, page 3, lines 28-29). A5, which the skilled person would already be considering to solve the problem of claim 4, describes an elastic tab (line 10). This would be seen by the skilled person to allow a more comfortable fit on the wearer, hence solving the problem addressed by claim 6. For the reasons given above with respect to claim 4, the skilled person would naturally consider A6 and A5.

Thus claim 6 when dependent on claim 4 is obvious over A6 and A5.

Claim 6 when dependent on claim 5

Inventive step: A6 + A5

Claim 6 when dependent on claim 5 includes all features of claims 4 and 5, as well as on the elastic tab. Taking A6 as the closest prior art, the differences from claim 6 are: the provision of a non-fastening region on the tab; the provision of this region in the edge of the tab; and the provision of an electric tab. The problems to be addressed starting from A6 are thus to guarantee easy handling of the tab, and to allow comfortable fit of the diaper.

As discussed above with reference to claims 4 & 5, the first of these problems is solved in the same manner by A5, which the skilled person would naturally combine with A6 to obtain the solution. The second problem is, as discussed above with reference to inventive step of claim 6 when dependent on claim 4, also solved by A5, which again the skilled person would naturally combine with A6 to solve this problem.

Thus claim 6 when dependent on claim 5 lacks inventive step over A6 + A5.

Other Issues

Document A2 has a priority date of 8-4-1997, and a publication date of 15-10-1998, and is a PCT publication designating Europe. The priority date of A2 precedes the priority date of claims 1-3 of A1 (25-7-1997), and will thus be citable as prior art under Art. 54(3) EPC for novelty only, against claim 1-3 only, for the commonly designated states provided that the European regional phase is validly entered (Art. 158(1) & (2) EPC).

The Opponent wishes to bring this document to the Opposition Division's attention, and would wish to introduce the document into the proceedings in the event that the European regional phase was validly entered. It is considered that the document prejudices novelty of claim 1 and claim 2 of A1, for the commonly designated states. Arguments to this effect will be submitted in the event that A2 becomes citable prior art under Art. 56(3) EPC.



Notice of Opposition to a European Patent

To the
European Patent Office

Tabulation Marks

		for EPO use only	
I. Patent opposed	Opp. No.	OPPO (1)	
	Patent No.	EP 0 845 965 B1	
	Application No.	97 245 876.1	
	Date of mention of the grant in the European Patent Bulletin (Art. 97(4), 99(1) EPC)	27/06/2001	
Title of the invention:		SURFACE FASTENER FOR SANITARY PRODUCTS	
II.	first named in the patent specification Proprietor of the Patent	BURRETAPE A/S	
III. Opponent	Opponent's or representative's reference (max. 15 spaces)	OREF	
	Name	FASTENALL	
	Address	1002 SUN DRIVE COLORADO SPRINGS COLORADO 80906 (USA)	
	State of residence or of principle place of business	US	
	Telephone/Telex/Fax		
	Multiple opponents	☐ further opponents see additional sheet	
IV. Authorisation	1. Representative (Name only one representative to whom notification is to be made)	OPPO (2)	
	Name	JUDSON, WHITCOMB	
	Address of place of business	18 HIGH STREET STRATFORD-UPON-AVON WARWICKSHIRE CV3 7XJ (GB)	
	Telephone/Telex/Fax		
	Additional representative(s)	☐ (on additional sheet/see authorisation) OPPO (5)	
	2. Employee(s) of the opponent authorised for these opposition proceedings under act. 133(3) EPC	Name(s):	
	Authorisation(s)	☒ not considered necessary	
	To 1./2.	☐ has/have been registered under No.	
		☐ is/are enclosed	

V. Opposition is filed against

— the patent as a whole



— claim(s) No(s).

VI. Grounds for opposition:**Opposition is based on the following grounds:**

(a) the subject-matter of the European patent opposed is not patentable (Art. 100(a) EPC)
because:

— it is not new (Art. 52(1); 54 EPC)



— it does not involve an inventive step (Art.52(1); 56 EPC)

— patentability is excluded
on other grounds, i.e.

Art.



(b) the patent opposed does not disclose the invention in a manner sufficiently clear and complete
for it to be carried out by a person skilled in the art (Art. 100(b) EPC; see Art. 83 EPC).



(c) the subject-matter of the patent opposed extends beyond the content of the application/
of the earlier application as filed (Art. 100(c) EPC, see Art. 123(2) EPC).

**VII. Facts and arguments**

(Rule 55(c) EPC)

presented in support of the opposition are submitted herewith on a separate sheet (annex 1)

**IX. Other requests:**

*ORAL PROCEEDINGS ARE HEREBY REQUESTED, ACCORDING WITH
ART 116 EPC.*

IX. Evidence presented		for EPO use only
Enclosed = ☐		
will be filed at a later date = ☐		
B. Publications:		Publication date
1		
Particular relevance (page, column, line, fig.):		
2		
Particular relevance (page, column, line, fig.):		
3		
Particular relevance (page, column, line, fig.):		
4		
Particular relevance (page, column, line, fig.):		
5		
Particular relevance (page, column, line, fig.):		
6		
Particular relevance (page, column, line, fig.):		
7		
Particular relevance (page, column, line, fig.):		
Continued on additional sheet ☐		
C. Other evidence		
Continued on additional sheet ☐		

for EPO use only

X. Payment of the opposition fee is made

☒ as indicated in the enclosed voucher for payment of fees and costs (EPO Form 1010)

☒ PLEASE DEBIT OUR DEPOSIT ACCOUNT

XI. List of documents:

Enclosure No.:

No. of copies

- | | | |
|----|---|---|
| 0 | ☒ Form for notice of opposition | <input type="text" value="2"/> (min. 2) |
| 1 | ☒ facts and arguments (see VII.) | <input type="text" value="2"/> (min. 2) |
| 2 | Copies of documents presented as evidence (see IX.) | |
| 2a | ☒ — Publications | <input type="text" value="2"/> (min. 2 of each) |
| 2b | ☐ — Other documents | <input type="text"/> (min. 2 of each) |
| 3 | ☐ Signed authorisation(s) (see IV.) | <input type="text"/> |
| 4 | ☒ Voucher of payment of fees and costs (see X.) | <input type="text" value="1"/> |
| 5 | ☐ Cheque | <input type="text"/> |
| 6 | ☐ Additional sheet(s) | <input type="text"/> (min. 2 of each) |
| 7 | ☐ Other (please specify here): | <input type="text"/> |

XII. Signature of opponent or representative

Place

Date 22/03/2002

JUDSON, WHITCOMB

EUROPEAN PATENT ATTORNEY

Please print name under signature. In the case of legal persons, the position which the person signing holds within the company should also be printed.