



BL O/279/04

17<sup>th</sup> September 2004

## PATENTS ACT 1977

APPLICANT                      Kimberley-Clark Worldwide, Inc.

ISSUE                              Whether patent N° GB 2290456 B was  
   granted for the same invention as  
   EP 0688550 B2

HEARING OFFICER              S J Probert

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## DECISION

### Introduction

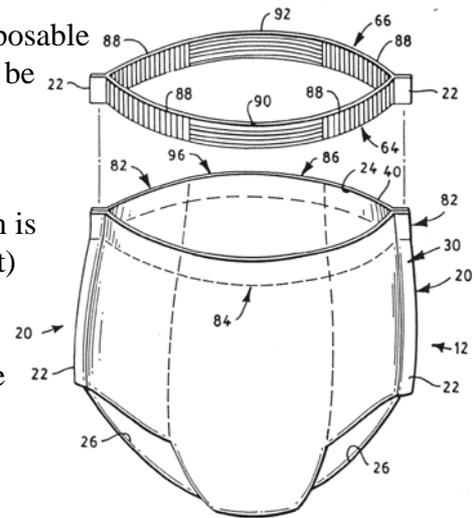
- 1      UK Patent N° GB 2290456 B was granted on 18 March 1998. It is on the register in the name of Kimberley-Clark. The same proprietor, Kimberley-Clark, is also registered as the proprietor of EP 0688550 B2 (the 'European patent'). This European patent was originally granted in April 1999, but was subject to opposition proceedings before the European Patent Office (EPO), and was not ultimately granted until 7 August 2002.
- 2      During substantive examination of the UK application, the examiner reported that the application appeared to be similar to EP 0688550, and warned the applicant that if patents granted on both of these applications related to the same invention, the Comptroller would revoke the UK patent in due course.
- 3      In December 2002, after the opposition proceedings concerning the European patent had concluded, the examiner considered that the two patents had been granted for the same invention and he initiated proceedings under section 73(2) to revoke the UK Patent. Several rounds of correspondence followed, during which the patentee amended the specification of the UK patent, and made observations. Nevertheless, the examiner remained of the opinion that the two patents had been granted for the same invention, and the patentee requested that a hearing be appointed to resolve the issue. The matter therefore came before me at a hearing on 8<sup>th</sup> July 2004, at which the patentee was represented by Mr Robert Jackson and Ms Sally Mason of Frank B. Dehn & Co.

### The Invention

- 4      The title of the invention as shown on the UK patent is "Disposable absorbent garment and a continuous, selectively elasticized band joined thereto". In common parlance, it is a disposable nappy or, to be more specific, a disposable training pant such as would conveniently be used with young children during the potty-training stage. Such training

pants combine the absorptive ‘safeguard’ of a disposable nappy with the advantage that young children can be encouraged to pull the pants up and down by themselves.

5 The particular contribution made by this invention is best demonstrated with reference to figure 2 (right) taken from the patent specification. The figure shows the main body of a disposable garment, with a waistband (66) above it. (NB. Although the figure shows the two parts separated, they would normally be joined together as part of the manufacturing process.)



6 The main body of the garment would usually include several elastic regions, but according to the specification, although the elastic regions of the garment may provide some “gasketing”, they are not entirely effective in containing the waste that might be expected if a child fails to make it to the potty in time.

7 The purpose of the waistband is to improve the fit, and therefore the “gasketing” of the garment. One of the innovative features of the invention that contributes to the improved gasketing is that the waistband is made up of several portions (eg. 88, 90, 92) with different elastic properties. The elasticity of each portion will typically be determined by the elasticity of the corresponding portion of the body of the garment. More specifically, the elasticity of the ‘side’ portions of the waistband (88) is selected to match the elasticity of the corresponding side portions (eg. 40) of the garment body, to which it will be attached during the manufacturing process. However, the elasticity of the central portions of the waistband, at the front and the back (90 & 92), is selected to provide the desired elasticity to the corresponding, *non-elastic* portions<sup>1</sup> of the garment body (84 & 86 respectively). In the remainder of this decision I shall refer to this aspect of the invention as feature ‘A’.

8 There is one other feature of the invention that is particularly relevant to the issue that I have to decide. It concerns the method used to attach the waistband to the body of the garment during the manufacturing process. The waistband can be made from an elastic material, the elasticity of which can be temporarily inhibited. In the example described in the patent specification, the elasticity of the waistband material is temporarily inhibited by compressing it. Later in the manufacturing process, after the waistband has been joined to the garment body, the elastic material of the waistband is “activated” to restore its elasticity. Activation (to restore the elasticity) of the waistband may be achieved by a suitable heat treatment. The term “recoverable” is used in the patent specification to refer to this property of the elastic material — ie. the fact that its elasticity may be temporarily inhibited and subsequently activated.

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<sup>1</sup>This is a very important aspect of the invention — ie. whereas the whole of the waistband is elastic to some extent, only the sides of the garment body are elastic; the front and back panels (84 & 86) of the garment body are non-elastic.

- 9 The benefit of using a ‘recoverable’ material for the central front and back portions (**90** & **92**) of the waistband is realised in the process of joining it to the corresponding *non-elastic* portions of the garment body. For example, before the waistband is joined to the garment body, the central front portion (**90**) is stretched by about 67% so that its length is the same as that of the *non-elastic* front portion of the garment body. This portion of the waistband is then compressed to temporarily inhibit its elasticity. The waistband is then intermittently joined to the garment body using ultrasonic, heat or adhesive point bonding. After the two parts have been joined together, the ‘recoverable’ portions at the front and back of the garment are heat treated to activate the elastic material. As it regains its elasticity, the front portion (**90**) of the waistband will gather the *non-elastic* front segment (**84**) of the garment body; similarly the back portion (**92**) will gather the *non-elastic* back segment (**86**) of the garment body. For convenience, I shall refer to this method of using a recoverable material in the construction of a disposable garment as feature ‘B’.
- 10 Mr Jackson submitted that features ‘A’ and ‘B’ are distinct inventions in their own right.

### **Comparing the UK and European patents**

- 11 As often happens, the claims of the UK patent application and the European application were amended during the examination process. Although the wording of the respective sets of claims differed, in substance both applications emerged with some claims that covered feature ‘A’, and some claims that covered features ‘A’ and ‘B’. (In addition, the European patent appears to have been granted with a claim that includes neither feature ‘A’ nor feature ‘B’, but I regard this an anomaly that need not concern me.)
- 12 As a result of the opposition proceedings involving the European patent, the claims were amended such that all the claims of the European patent now cover features ‘A’ **and** ‘B’. This led the examiner to question whether a claim just to feature ‘A’ would be valid. He raised this issue under the heading “public interest” during the correspondence. The patentee responded by saying that:
- “... nowhere in the Decision of the EPO issued in relation to the opposition does it suggest that the combination of features found in the claims of the UK patent lack novelty or inventive step. The proceedings concerned a different invention from that claimed here.”
- 13 I didn’t find this response particularly helpful, so I raised the subject again at the hearing. Unfortunately Mr Jackson was unable to tell me why the claims relating only to feature ‘A’ did not survive the opposition process, but he did add that the opposition division appear not to have regarded feature ‘A’ as lacking novelty on its own, since the patentee had not been required to move feature ‘A’ out of the so-called “characterising” portion of the claim<sup>2</sup>.

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<sup>2</sup>It appears to be standard practice in proceedings before the EPO for independent claims to be divided into two parts by the phrase “... **characterised in that...**”. The former part of the claim may set the scene, so to speak; the particular inventive contribution is defined in the latter, “characterising” portion of the claim.

- 14 In response to the initiation of these proceedings under section 73(2), the patentee has amended the claims of the UK patent in order to delete all references in the claims to feature ‘B’. Following these amendments, the UK patent now only contains claims covering feature ‘A’, and the European patent only contains claims covering the combination of features ‘A’ and ‘B’ (or ‘A+B’ for the sake of convenience). The text of the independent claims of both patents, as amended, can be found at Annex A of this decision. The question that I have to answer is whether these two patents (as amended) have been granted for the same invention.

### **The Law**

- 15 These proceedings have been initiated under section 73(2) which reads:

**73(2)** If it appears to the comptroller that a patent under this Act and a European patent (UK) have been granted for the same invention having the same priority date, and that the applications for the patents were filed by the same applicant or his successor in title, he shall give the proprietor of the patent under this Act an opportunity of making observations and of amending the specification of the patent, and if the proprietor fails to satisfy the comptroller that there are not two patents in respect of the same invention, or to amend the specification so as to prevent there being two patents in respect of the same invention, the comptroller shall revoke the patent.

- 16 Furthermore, it is well established that the tests for determining whether a UK patent and a European patent relate to the same invention, are the same as for deciding whether two UK applications are in conflict. This latter situation is the subject of section 18(5) of the Act. Although section 18(5) is not directly an issue in these proceedings, the provision (and its predecessor in the 1949 Act) is also relevant because of the case law that I need to consider. Section 18(5) reads as follows:

**18(5)** Where two or more applications for a patent for the same invention having the same priority date are filed by the same applicant or his successor in title, the comptroller may on that ground refuse to grant a patent in pursuance of more than one of the applications.

### **Relevant case law**

- 17 Three previously decided cases appear in the correspondence between Mr Jackson and the examiner — conveniently referred to as Marley<sup>3</sup>, Maag<sup>4</sup>, and Arrow<sup>5</sup>. Mr Jackson made further useful submissions on each of these cases during the hearing. I shall briefly summarise these authorities, and indicate how they relate to the facts in this case.

#### ***Arrow***

- 18 This case was decided under the 1949 Act. The second of the two applications involved had been divided out of the first application following an objection from the

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<sup>3</sup>Marley Roof Tile Co. Ltd.’s Patent [1994] RPC N° 6

<sup>4</sup>Maag Gear Wheel & Machine Co. Ltd.’s Patent [1985] RPC N° 24

<sup>5</sup>Arrow Electric Switches Ltd’s Applications 61 RPC 1

Office that the first application contained two distinct inventions (A and B). The tribunal decided that it is allowable for one of the applications to contain a claim to the combination of A and B. The tribunal considered the question of double jeopardy (ie. infringement of both patents arising out of a single act) and concluded that it would be unduly hard on inventors if protection for the combination A+B were denied because its unauthorised use could result in a suit under both patents.

- 19 Mr Jackson was quick to point out the relevance of this decision to the circumstances of the present case. I believe he accepted that the facts are not exactly the same, eg. the European patent which claims protection for the combination of A+B does not claim protection for feature B separately. Addressing this anomaly, Mr Jackson submitted that if the patentee was content to limit his protection (ie. by adding feature A to all the claims of the European patent), then there was no harm to the public — “... *it is a restriction on his [ie. the patentee’s] protection*”. The point was well made, but nevertheless, it also raised in my mind the question of whether feature B really is a distinct invention as Mr Jackson had asserted. This is something to which I shall return later.

### ***Maag***

- 20 This case, arising from an objection under section 73(2), concerned a pivoted pad journal bearing for a shaft. Each of the features contained in claim 1 of the UK patent was specified, albeit in slightly different terms, in claim 3 of the European patent. However, claim 1 of the European patent (to which claim 3 was appendant) included additional “pad geometry” features not to be found in the claims of the UK patent. The hearing officer observed that claim 1 of the UK patent was not limited to the pad geometry of claim 1 of the European patent but that that pad geometry was the only construction described and illustrated in the UK patent. Thus, he construed claim 1 of the UK patent as protecting a journal bearing including that pad geometry and accordingly found claim 1 (and its appendant claims 2 to 5 and omnibus claim 6) of the UK patent to be directed to the same invention as that claimed in claim 3 of the European patent.
- 21 The examiner considered *Maag* to be particularly relevant in the circumstances of the present case because the specification of the UK patent only describes one method of attaching the elastic portion of the wasteband to the non-elastic portions of the garment body — the method that I have referred to as feature B, involving the use of a recoverable elastic material.
- 22 Mr Jackson pointed out that although the Hearing Officer in *Maag* did not disagree with the reasoning in the *Arrow* case, he did not think it was pertinent because it (ie. the *Arrow* case) concerned an application which related to two inventions. Clearly in *Maag*, the Hearing Officer did not consider that there were two separate inventions. In the present case, as Mr Jackson reminded me, the patentee was maintaining that there were two separate inventions. Consequently, Mr Jackson felt that I should follow *Arrow* rather than *Maag*. However, it is not clear to me that there are two separate inventions in the proprietor’s patent. Even if I accept that there are two inventions, there is still one aspect of the *Maag* decision that is strikingly relevant to the present case — ie. the pad geometry claimed only in the European patent was the

only construction described and illustrated in the UK patent. The Hearing Officer in *Maag* clearly regarded this as very significant. He said<sup>6</sup>:

“Turning to claim 1 of the UK patent I observe that it is not limited to the pad geometry of claim 1 of the European patent, but that pad geometry is the only construction described and illustrated in the UK patent. Following the Arrow Electric Switches decision, I must construe claim 1 of the UK patent as protecting a journal bearing including that pad geometry. Accordingly I find claim 1, and consequently claims 2-5, of the UK patent to be directed to the same invention as that claimed in claim 3 of the European patent.”

- 23 When I pressed Mr Jackson on this point, he made two submissions. First, that the Hearing Officer in *Maag* appears to have regarded the pad geometry feature as being either a trivial difference, or a feature that is so obviously a part of the invention that it would be inferred by the language of the claim.
- 24 Secondly, he submitted that this was a *necessary*, but *not sufficient*, condition for the Hearing Officer to reach the conclusion that he reached. ‘*Necessary*’ in the sense that, had there been alternative embodiments (some of which included the pad geometry and some of which did not), the Hearing Officer would not have been able to infer that the pad geometry was an essential element of the invention. ‘*Not sufficient*’, because the absence of alternative embodiments in the specification could not be taken as proof that no such embodiments existed. In Mr Jackson’s opinion, the Hearing Officer reached his conclusion for other reasons, and was simply pointing out that there were no alternative embodiments in the specification that would prevent him from coming to that particular conclusion.

### *Marley*

- 25 In *Marley*, the Court of Appeal decided that the correct construction of section 73(2) was the literal one that the UK patent may be revoked if the claims of the UK and European patents cover the same invention. In *Marley*, claim 1 of the UK patent related to concrete articles made of a particular composition and having particular qualities and claim 8 of the European patent related to such concrete articles, but produced by a process claimed in claim 1. Although it was established that the articles claimed in claim 1 of the UK patent could be made by a process other than that covered by claim 1 of the European patent, nevertheless claim 1 of the UK patent was considered to cover the same invention as claim 8 of the European patent. In the *Marley* case, Balcombe LJ observed that the obvious purpose of section 73(2) was to avoid the possibility of a defendant who has successfully defeated a claim for infringement of one patent being threatened with proceedings for infringement of the other patent in relation to the same activities.
- 26 In his submissions to me on this authority, Mr Jackson emphasised that the Court of Appeal consistently referred to ‘linked’ inventions. If there were two inventions in *Marley*, then they were so linked as to form a single inventive concept. In its simplest form, one of the inventions was represented by a *product* claim, and the other was

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<sup>6</sup> [1985] RPC. Paragraph bridging pages 576 and 577.

represented by a *product-by-process* claim; but in essence, the two ‘inventions’ were broadly the same thing. Mr Jackson added that the Court of Appeal in *Marley* had not criticised the *Arrow* decision.

27 Regarding Balcombe LJ’s observation (above), Mr Jackson pointed out that the particular ‘mischief’ which section 73(2) was intended to prevent was not an issue in this case. For example, if someone made a disposable garment incorporating feature A, they would only be infringing the UK patent. If the product also included feature B, then it would infringe the European patent as well as the UK patent. But this would have been the result if the claims of the European patent only covered feature B. The important point that Mr Jackson wanted to make, was that a single activity (to borrow language from Balcombe LJ’s judgment in *Marley*) would only lead to infringement proceedings in relation to one of the two patents. The hypothetical defendant would have to have performed two activities (ie. A and B) before he could be threatened with proceedings for infringement of two patents. This, said Mr Jackson, was perfectly reasonable.

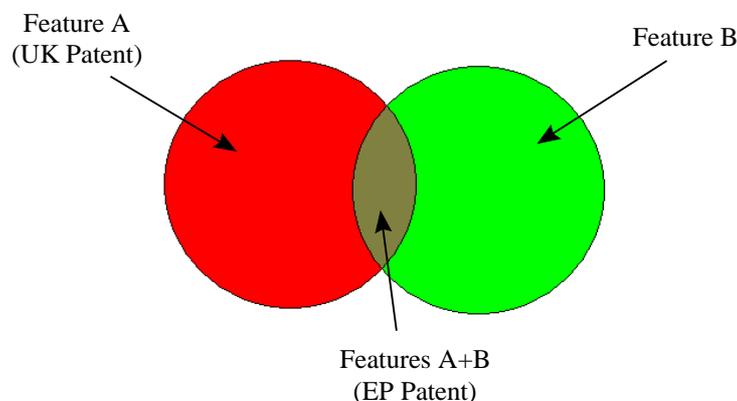
### Conclusions

28 Having set out the relevant law and the facts of this particular matter, I come now to the difficult bit — how to apply the relevant law to the facts in order to reach a conclusion.

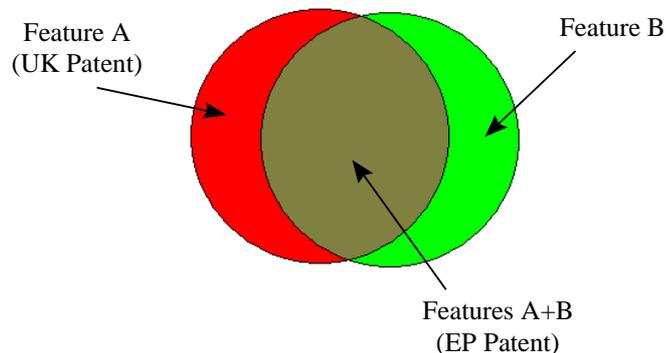
29 Mr Jackson accepted that there was a degree of overlap between the claims of the two patents, but as he reminded me, the Manual of Patent Practice clearly envisages that a degree of overlap must be allowable. He quoted part of paragraph 18.95 of the manual which says:

“The degree of overlap which is allowable must be decided on the facts of the case, ...”

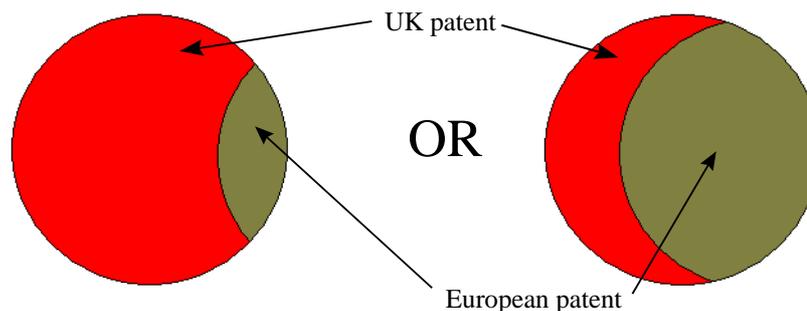
30 Thus the position seems to be that a slight overlap can be tolerated, but if the claims of the two patents overlap to a substantial degree, then the UK patent must be revoked under section 73(2). The diagrams below illustrate Mr Jackson’s argument; the scope of claims based on features A and B being represented by circles in a Venn diagram:



31 The diagram above represents the position when there is a small degree of overlap between the scope of claims based on features A and B. If the degree of overlap is greater, then the position might look more like that shown in the diagram below:



32 As I have noted above, the European patent does not include a claim covering feature B only. Consequently, one might say that in one direction, the claims of the two patents overlap completely, since the claims of the European patent fall entirely within the scope of the claims of the UK patent. In this respect, the two positions represented by the Venn diagrams above would be easier to recognise if the 'unclaimed' element corresponding to feature B is removed. For example:



33 In order to determine the extent of the overlap between the claims of the UK and European patents, it would be very useful to know for certain whether feature B is an invention in its own right. The answer to this question, one way or the other, would put the matter beyond doubt in my mind. That is to say, if feature B is **not** an invention, then these two patents **have** been granted for the same invention, and the Comptroller should revoke the UK patent — and *vice versa*.

34 Mr Jackson consistently maintained that feature B is a separate invention, but I am conscious of the fact that plurality of invention does not appear to have been raised either in this Office or before the EPO. While such an omission is not conclusive, it does mean that no statutory search has been conducted to determine the novelty and/or inventiveness of feature B.

35 In the course of these proceedings under section 73(2), the examiner did not accept that there were two inventions. He reported that the UK patent (as amended) relates to invention A and the European patent relates to a limited variation of invention A; the limitation relating to the use of a recoverable material (ie. feature B). This seems to me to be a very reasonable interpretation of the position as presented in the patent

specification, although I recognise that it is based to a large extent on what the examiner regarded as common general knowledge, and not on specific prior art.

- 36 However, there is one additional piece of relevant information that is available to me now, but which is not found in the patent specification. As stated above<sup>7</sup>, the European patent has been subject to opposition proceedings before the EPO and was only allowed to continue after the claims had been amended to include both feature A and feature B — effectively narrowing the scope of the European patent by comparison with the UK patent.
- 37 Before the opposition proceedings, the scope of the European patent was, for present purposes, the same as the scope of the UK patent. It seems to me that if there is no difference *in substance* between the claims of the UK patent and the European patent (after opposition), then it is unlikely that the difference would have been sufficient to avoid cancellation of the European patent during the opposition proceedings. In using the word ‘unlikely’, I recognise that there is an element of uncertainty involved in this reasoning; not least because I do not know anything about the opposition proceedings other than the wording of the European patent before and after opposition.
- 38 Nevertheless, the balance of probabilities lies in the patentee’s favour, and I am reluctant to order revocation of a patent from the register when there is doubt as to the justification for so doing. It is well established that in *ex parte* proceedings such as these, the applicant (or in this case the patentee) is entitled to the benefit of any doubt.

### **Summary**

- 39 Accordingly, I find that GB 2290456 (as amended) and EP 0688550 B2 have not been granted for the same invention and I make no order for revocation of the UK patent.

**S J PROBERT**

Deputy Director acting for the Comptroller

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<sup>7</sup>See paragraph 12

## Annex A

### **GB 2290456 B**

(with proposed amendments)

1. A disposable garment, comprising:
  - a pant body defining a waist opening and a pair of leg openings,
  - a partially elastic, continuous waistborder comprising a pair of elastic side segments and at least one non-elastic segment, and
  - a continuous, elastic waistband joined to said partially elastic continuous waistborder; said waistband having a pair of side portions which are respectively joined to said pair of elastic side segments of said waistborder and which have an elasticity that is substantially the same as the elasticity of said elastic side segments.
  
3. A disposable garment, comprising:
  - a pant body defining a waist opening and a pair of leg openings,
  - a partially elastic, continuous waistborder comprising a pair of elastic side segments and at least one non-elastic segment, and
  - a continuous, elastic waistband joined to said partially elastic continuous waistborder; said waistband comprising a pair of side portions, a front portion and a back portion, said pair of side portions being respectively joined to said pair of elastic side segments of said waistborder, one of said front portion and said back portion being elastically being joined to said non-elastic segment, said one portion and said non-elastic segment having an elasticity different from the elasticity of said elastic side segments.
  
9. A disposable absorbent garment, comprising:
  - a topsheet,
  - a backsheet comprising a waistborder having at least one elastic segment and a non-elastic segment,
  - an absorbent structure disposed on said backsheet, and
  - an elastic waistband joined to said waistborder, said waistband having at least one side portion which is joined to said at least one elastic segment of said waistborder and which has an elasticity substantially the same as the elasticity of said elastic segment.

### **EP 0688550 B2**

1. A disposable garment, comprising:
  - a pant body (12) defining a waist opening (24) and a pair of leg openings (26),
  - a partially elastic, continuous waistborder (30) comprising four oppositely disposed elastic side segments (82) and at least one non-elastic segment (84, 86), and
  - a continuous, elastic waistband (32) joined to said partially elastic, continuous waistborder (30), characterised in that said waistband comprising at least one recoverable portion that is capable of being temporarily inhibited, and at least one elastic portion having an elasticity substantially the same as an elasticity of said elastic segments, said continuous elastic waist-band being joined to said continuous waist border with said elastic portion joined to said elastic segment and said recoverable portion joined to said non-elastic segment.
  
4. A disposable garment comprising:
  - a pant body (12) comprising a continuous waistborder (30) defining a continuous waist opening (24),
  - said continuous waistborder (30) comprising at least one non-elastic segment (84,86) and at least one elastic segment (82), and
  - a continuous elastic waistband (32) characterised in that said waistband comprises at least one recoverable portion that is capable of being temporarily inhibited, and at least one elastic portion having an elasticity substantially the same as an elasticity of said elastic segment (82)
  - said continuous elastic waistband (32) being joined to said continuous waistborder (30) with said elastic portion joined to said elastic segment (82), and said recoverable portion joined to said non-elastic segment (84, 86),
  - said recoverable portion, upon being activated, gathering said non-elastic segment (84, 86).