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**Datasheet for the decision
of the Enlarged Board of Appeal
of 24 October 2016**

Case Number: R 0005/16

Appeal Number: T 0403/13 - 3.3.10

Application Number: 07700163.4

Publication Number: 1981554

IPC: A61L24/08

Language of the proceedings: EN

Title of invention:
LAYERED ADHESIVE CONSTRUCTION WITH ADHESIVE LAYERS HAVING
DIFFERENT HYDROCOLLOID COMPOSITION

Patent Proprietor:
Coloplast A/S

Opponent:
Hollister Incorporated

Headword:
Petition clearly unallowable

Relevant legal provisions:
EPC Art. 56, 83, 100(a), 100(b), 112a(2)(c), 112a(4), 113(1)
EPC R. 106, 107, 109(2)(a)
RPEBA Art. 13, 14(2)

Keyword:
Fundamental violation of the right to be heard (no)

Decisions cited:
R 0002/14, R 0016/13, R 0011/13, R 0021/11, R 0023/10,
R 0001/08, T 0763/04, T 0246/08

Catchwords:

A party to appeal proceedings should be aware of the methodology established in the case law of the boards of appeal for examining inventive step and should be prepared to submit its relevant arguments in this respect (Reasons, point 18).

A mere subjective surprise of a party in respect of an issue in the reasoning of the decision under review, which the party objectively could have known and on which the party was given an opportunity to comment, does not in itself amount to a violation of Article 113(1) EPC (Reasons, point 19).



Case Number: R 0005/16

D E C I S I O N
of the Enlarged Board of Appeal
of 24 October 2016

Petitioner: Hollister Incorporated
(Opponent) 2000 Hollister Drive
Libertyville, Illinois 60048-3781 (US)

Representative: Høiberg A/S
Adelgade 12
1304 Copenhagen K (DK)

Other party: Coloplast A/S
(Patent Proprietor) Høltedam 1
3050 Humlebæk (DK)

Decision under review: Decision of the Technical Board of Appeal
3.3.10 of the European Patent Office of
6 October 2015.

Composition of the Board:

Chairman: W. van der Eijk
Members: I. Beckedorf
A. Lindner

Summary of Facts and Submissions

- I. The opponent (hereinafter: the petitioner) filed a petition for review against decision T 403/13 of Technical Board of Appeal 3.3.10 (hereinafter: the board) dated 6 October 2015 (hereinafter: decision under review) by which the board had dismissed the petitioner's appeal against the decision of the opposition division dated 13 December 2012 rejecting the opposition against European patent EP 1 981 554 (hereinafter: the decision under appeal).
- II. The petition is directed against the written reasons of the board, which are said not to reflect the petitioner's arguments in respect of the (only) ground of opposition according to Articles 100(a) and 56 EPC.
- III. The relevant claim 1 of the patent as granted provides:
"A layered adhesive construction comprising a backing layer and a first and second layer of hydrocolloid adhesive, where the first and second layer of hydrocolloid adhesive have different composition and the hydrocolloids or mixture of hydrocolloids of the first and the second adhesive layer are different, and the second layer of hydrocolloid adhesive is at least partly interposed between the first layer of hydrocolloid adhesive and the backing layer, the first and second adhesive layers consisting of a continuous phase and a discontinuous phase wherein
a) *the discontinuous phase of the first adhesive layer comprises a hydrocolloid composition providing a higher moisture absorption capacity and higher initial rate of absorption to the adhesive layer than the hydrocolloids in the discontinuous phase of the second adhesive layer, and*
b) *the discontinuous phase of the second layer of adhesive comprises a hydrocolloid composition providing a higher cohesion following moisture absorption to the adhesive compared to the hydrocolloids in the discontinuous phase of the first adhesive layer,*

c) the composition of the continuous phase of the first and of the second adhesive layer are identical or essentially identical."

IV. In the decision under appeal the opposition division held that document D1 was the closest prior art, that the problem underlying the claimed invention was providing an alternative two layer adhesive with a rapid fluid transfer from one layer to the other, and that the solution, which was a construction in which both layers had identical or essentially identical continuous phases and different discontinuous phases, was not suggested by the available prior art (documents D1 to D3), with the consequence that the subject-matter claimed was inventive.

V. The petitioner appealed against aforementioned decision and submitted in the statement setting out the grounds of appeal that the subject-matter of claim 1 of the patent as granted did not involve inventive step starting from the teaching of any of documents D1 to D3 in combination with the teaching of either document D4 or D1. In the written proceedings, both parties to appeal proceedings focused on the discussion of documents D1 and D4; in respect of the latter the patent proprietor objected to admitting this document into the proceedings.

The matter was discussed with both parties during the oral proceedings before the board on 6 October 2015.

VI. Points VI and VII of the summary of facts and submissions in the decision under review contain what the board considered essential from the petitioner's and the patent proprietor's arguments.

Points 2 and 3 of the reasons are concerned with the admission into the proceedings of document D4 and the issue of remitting the case to the opposition division. The board then reasons why it chose document D1 as the closest prior art (point 4 of the reasons), followed by a discussion of the technical problem (point 5 of the reasons), the claimed solution (point 6 of the reasons), the success (point 7 of the reasons) and whether the claimed subject-matter was obvious to the person skilled in the art having regard to the teaching of document D1 either alone or in combination with any of documents D2 to D4 (point 8 of the reasons).

The crucial passages of the decision under review which causes the petitioner's concern are to be found in points 5 and 7 of the reasons:

"5. Technical problem underlying the invention

It has not been disputed that the technical problem underlying the claimed invention is that of providing a further layered adhesive construction comprising two different hydrocolloid adhesives, in which one adhesive has higher moisture absorption capacity and higher initial rate of absorption and the second adhesive has higher cohesion following moisture absorption."

"7. Success

It has not been disputed that this problem has been credibly solved by the features of claim 1 and, having regard to the clinical studies provided in examples 5-7 of the patent in suit, the board sees no reason to differ."

VII. With their petition the petitioner invokes the ground of petition according to Article 112a(2)(c) and 113(1) EPC.

1. The petition identifies three complaints of which two can be dealt with under one heading:

First, that the board erroneously considered uncontested the objective technical problem.

Second, that the board erroneously considered uncontested the credibility of the solution to said technical problem.

Third, that the board's definition of the technical problem was different from any proposed by the parties to the appeal proceedings and that the board's definition was not discussed at all.

2. Concerning the first complaint, the petitioner argues as follows: Despite of the petitioner's arguments in respect of the objective technical problem (point VI of the facts and submissions, acknowledged as correct by the petitioner), the board in the reasons for the decision under review (point 5 of the reasons) stated a different objective technical problem. By giving the wrong impression that there had been no dispute over the definition of the technical problem, the board failed to consider the petitioner's arguments and gave no reasons as to why the problem defined under point 5 of the reasons was the correct problem. The board's failure amounted to a violation of the petitioner's right to be heard.

3. Likewise, regarding the second complaint, the board's conclusion as to the indisputability of the aspect that this problem had been credibly solved by the features of claim 1 was not in line with the facts of the case. Rather, throughout the proceedings, it was one of the arguments presented by the petitioner that the alleged technical problem of the invention was not credibly solved by the features of claim 1 (cf. pages 3 and 4 of the statement setting out the statement of grounds of appeal). Point VI of facts and submissions reflected this submission correctly. Although the board deals with the petitioner's objection in points 8.5. and 8.6 of the reasons, this could not cure the board's incorrect conclusion in point 7 of the reasons, apart from the fact that the board had misinterpreted the petitioner's arguments as an objection under Article 100(b) EPC.

4. Concerning the third complaint the petitioner argues that the board formulated the objective technical problem on its own motion differently from what both the petitioner (page 8 of the statement setting out the grounds of appeal) and the patent proprietor (page 2 of the reply to that statement of grounds of appeal) had submitted.

The petitioner, referring to decisions of the Enlarged Board of Appeal in cases R 16/13 of 8 December 2014, R 21/11 of 15 June 2012 and R 23/10 of 15 July 2011, and to decisions of technical Boards of Appeal in cases T 763/04 of 22 June 2007 and T 246/08 of 14 August 2008 (none

of them published in the OJ EPO), considers the board's (re-)definition of the technical problem on its own motion and without informing the parties about this a violation of the parties' right to be heard. Moreover, the Board ignored arguments advanced by the petitioner and pretended there was agreement on two counts even though it was clear from the decision itself and the underlying written procedure that there was indeed a dispute.

5. Rule 106 EPC would be complied with, because the petitioner became aware of these alleged violations only after receiving the written decision from the Board and therefore had no opportunity to raise an objection during the appeal proceedings.
 6. On re-opening the appeal proceedings, the members of the board needed to be replaced.
- VIII. The Enlarged Board as composed under Rule 109(2)(a) EPC issued a communication pursuant to Articles 13 and 14(2) RPEBA informing the petitioner of its preliminary view that the petition for review appeared not to be allowable proceedings before the Enlarged Board.
- IX. Oral proceedings before the Enlarged Board with the petitioner as the only party were held on 24 October 2016 at which the petitioner essentially reiterated their earlier written submissions.

At the end of the oral proceedings the decision was announced.

X. The petitioner requested

that the decision under review be set aside and that the appeal proceedings are re-opened, that the members of the Board of Appeal who participated in taking the decision under review be replaced, and that the reimbursement fee for petition for review be ordered.

Reasons for the Decision

Admissibility

1. The petitioner is adversely affected by the decision under review.
2. The petition was filed in accordance with the formal requirements pursuant to Article 112a(4) EPC and Rule 107 EPC.
3. The deficiencies relied upon by the petitioner concern only alleged deficiencies in the written reasons given by the board for its decision under review. Thus, the petitioner could not have raised the required objections under Rule 106 EPC.
4. Consequently, the petition is admissible.

Allowability

5. The petitioner essentially invokes the ground of petition according to Articles 112a(2)(c) and 113(1) EPC.

6. The right to be heard according to Article 113(1) EPC is an important procedural right intended to ensure that no party is caught unaware by grounds and evidence in a decision turning down his request on which that party has not had the opportunity to comment (see R 2/14 of 22 April 2016, not published in the OJ EPO, Reasons, point 6, with further references). This requirement includes the party's right to have the relevant submissions and arguments considered and fully taken into account in the written decision in a manner that enables it to understand, on an objective basis, the reasons for the decision (see Case Law of the Boards of Appeal, 8th edition 2016, chap. IV.F.3.13.10; R 2/14, *supra*, Reasons, point 6, with further references).

7. Before investigating the petitioner's arguments, it is to be noted that the examination whether or not a European patent application or patent meets the requirements of Article 56 EPC is a matter of substantive law. In view of this, it has to be borne in mind that review proceedings based on Article 112a(2)(c) EPC are confined to procedural defects so fundamental as to be intolerable. It follows from the essential interest of legal certainty that appeal proceedings leading to a final decision shall be re-opened only if one of the grounds provided for in Article 112a EPC applies. It is by no means the objective of petition

for review proceedings to make the Enlarged Board a second judicial instance in reviewing the correct application of substantive law by the boards of appeal (consistent case law since R 1/08 of 15 July 2008, not published in the OJ EPO, referring to the *travaux préparatoires*; Case Law of the Boards of Appeal, *supra*, chap. IV.F.3.1).

The complaints

8. The petition identifies three complaints (see point VII.1 above) of which two could be dealt with under the same heading in the following manner:
 - 8.1 The two complaints regarding the issue of the objective technical problem (*i.e.* whether or not there had been a dispute between the parties to the appeal proceedings over this and whether or not the board re-defined the objective technical problem on its own motion without prior discussion with the parties to appeal) are both related to the board's reasoning in point 5 of the reasons of the decision under review. Since they would fail altogether should there be no discrepancy between the respective approaches taken by the parties to appeal and by the board, this issue will be dealt with first and jointly (see points 9 *et seq.*).
 - 8.2 The other issue in connection with the credibility of the solution of said problem by the claimed invention will be dealt with separately (see points 21 *et seq.*).

The determination of the objective technical problem (point 5 of the reasons of the decision under review)

9. The Petitioner refers in particular to decision R 16/13 (*supra*) and argues that the board disregarded the parties' dispute about the objective technical problem and introduced in the decision under review its own definition *ex officio* without prior discussion with the parties.
10. According to that decision (R 16/13, *supra*, headnote and Reasons point 6; see also R 2/14, *supra*, Reasons point 10.2.1), the Enlarged Board held that the right to be heard under Article 113(1) EPC is violated if a board of appeal relies for its decision *ex officio* on grounds that had not been put forward by the parties, without having given the losing party an opportunity to comment on these grounds and, if the patent proprietor is concerned, to submit appropriate new requests.
11. The case underlying decision R 16/13 (*supra*) concerned particular circumstances where the board of appeal chose a different document as closest prior art and developed a reasoning of its own starting from this starting point, *i.a.* stating that the comparative tests which sought to make clear that the claimed invention was inventive over the closest prior art were not relevant. The patent proprietor was not given the opportunity to comment on or to react to it because the problem was not mentioned at all and there was no reason for the patent proprietor to suspect that there was a problem in this respect.

12. In the case at hand the discussion before the board was all the time about inventive step of the subject-matter of claim 1 of the patent as granted. It is uncontested that the petitioner had been given every opportunity to convince the board of their point of view.

13. Document D1 was chosen as starting point for the examination of inventive step of the subject-matter of claim 1 of the patent as granted (points 4, 4.1 and 4.4 of the reasons of the decision under review); this selection has not been disapproved by the petitioner with the petition for review. The board noted that the adhesives of different composition of the layered construction of document D1 contain the same hydrocolloids but different continuous phases (point 4.4 of the reasons of the decision under review); again, this analysis has not been objected to by the petitioner with their petition.

14. The board then defined the critical issue of the objective technical problem that the board considered uncontested (point 5 of the reasons).

15. To examine whether there is a dispute between the parties to appeal over the issue of the technical problem to be solved as part of the so-called problem-solution-approach when examining inventive step, their respective approaches are quoted and analysed in the following and compared with the board's approach.

15.1 In the statement setting out the grounds of appeal, pages 7 and 8), the petitioner had submitted:

"The difference between the layered adhesive structures is the chemical composition of the layers. In one embodiment of D1 the advantageous properties are obtained by varying the continuous phase of each layer (i.e. by changing the molecular weight of polysiobutylene of the continuous phase or by increasing the content of an elastomer having a high molecular weight), whereas in the opposed patent the advantageous properties are obtained by varying the discontinuous phase of each layer (i.e. changing the content and composition of hydrocolloids while keeping the continuous phases identical).

Hence, the opposed patent solves the problems of providing a high initial tack and improved wear time by choosing one of the two alternative solutions mentioned in Document D1."

This submission of the petitioner is summarised in point VI on page 3 of the decision under review:

"If document D1 was considered the closest prior art, the technical problem underlying the claimed invention would be to provide a further layered adhesive construction..."

15.2 In their reply (page 2), the patent proprietor, defined the objective technical problem as follows:

"Claim 1 as granted differs from D1 in that claim 1 recites two adhesive layers where the hydrocolloid or

mixture of hydrocolloids are different in two layers and the continuous polymer phases are identical or essentially identical in the two layers...

Starting from D1, a problem to be solved is to provide an adhesive construction with high absorption, preserved high wet tack, high cohesion, and limited migration of components."

This submission of the patent proprietor is summarised in point VII on page 4 of the decision under review:

"Document D1 was the closest prior art, the technical problem underlying the claimed invention was to provide a further layered adhesive construction..."

16. Considering the parties' submissions, it appears that, regardless of differences in the actual wording, both the petitioner and the patent proprietor were in general agreement in respect of the distinguishing features of claim 1 of the patent as granted over the teaching of document D1. Moreover, it seems that the board accurately summarised the respective submissions in the facts and submissions section of the decision under review (the petitioner explicitly confirmed the correctness of the board's summary of their own submissions).

17. Comparing now the parties' approaches as summarised by the board with the board's reasoning in point 5 of the reasons of the decision under review (see point VI. above), the Enlarged Board cannot establish that the board committed a fundamental procedural error in reaching its conclusion by evaluation that between the petitioner and the patent proprietor there had been a

general agreement as to what the objective technical problem to be solved was.

18. With regard to the actual definition of the objective technical problem, the board evidently followed the methodology established in the case law of the boards of appeal (cf. Case Law, *supra*, chap. I.D.2. and 4; R 11/13 of 10 February 2014, not published in OJ EPO, Reasons, point 15) for examining inventive step by establishing the objective technical problem based upon the distinguishing features of the subject-matter of claim 1 of the patent as granted when compared with the teaching of the closest prior art (in the case at hand: document D1).

A party to appeal proceedings in general and its professional representative in particular should be aware of this methodology and be prepared to submit its relevant arguments in this respect.

The board's definition, although slightly different in its wording, is essentially in line with the parties' submissions as summarised in the facts and submissions section of the decision under review.

In fact, the board's definition appears to be close to what the petitioner had suggested in their written submissions and rather distinct from what the patent proprietor had proposed, as underlined by the petitioner during the oral proceedings before the Enlarged Board. However, a potential divergence to the patent proprietor's suggestion cannot and does not support the position of the petitioner in the present petition for review proceedings.

19. Against this objective coherence of the board's approach with the parties' submissions, the petitioner's contention that they were surprised by the board's definition amounts to a mere subjective surprise.

Since on an objective basis the petitioner could not have been surprised as the board applied the in the case law of the boards of appeal well-established methodology for defining the objective technical problem on the basis of the differences (*i.e.* distinguishing features) between the subject-matter of claim 1 and the teaching of document D1 as the closest prior art, on which the petitioner has had an opportunity to comment and indeed did comment, the petitioner's subjective surprise in itself does not imply that their right to be heard had been violated.

20. As a consequence, the petitioner has no case on the issue of the objective technical problem, neither in respect of the board's conclusion as to the general agreement between the parties to appeal regarding the objective technical problem to be solved when starting from the teaching of document D1 nor concerning the actual definition of said objective technical problem (point 5 of the reasons of the decision under review).

The issue of the credibility of the solution of the technical problem (point 7 of the reasons of the decision under review)

21. The petitioner objects to the board's reference to examples 5 to 7 of the patent in suit and its finding that there had been no dispute with regard to the

- objective technical problem being "credibly solved by the features of claim 1" of the patent as granted (point 7 of the reasons of the decision under review).
22. The Enlarged Board takes note of the petitioner's submission in their statement setting out the grounds of appeal, where it had argued (page 3) that
- "(t)he claimed improved technical effect could be the result of a large number of different properties of the opposed structure and the prior art structures. It could for instance just be the result of comparing a two layered structure with a single layered structure. The application contains no evidence that the beneficial technical effect is the result of the functional properties as specified in claim 1 of the opposed invention."
23. Although the petitioner's arguments come very close to an objection to insufficiency of disclosure pursuant to Articles 100(b) and 83 EPC, which had not been raised with the petitioner's opposition to the patent in suit, the decisive issue of the case at hand lies with the question whether the board had heard, understood and considered the petitioner's relevant arguments.
24. As admitted by the petitioner, the board did mention the petitioner's objections in the facts and submissions (point VI. on page 4 of the facts and submissions of the decision under review) and dealt with the relevant arguments under points 8.5 and 8.6 of the reasons on pages 13 and 14 of the decision under review.

25. The petitioner believes this could not cure the allegedly incorrect statement in point 7 of the reasons of the decision under review.

26. The Enlarged Board does not find this argument convincing.

The decisive issue of the case at hand lies with the question whether the board had heard, understood and considered the petitioner's relevant arguments.

It is clear from the decision under review that the board considered the arguments of the petitioner and dealt with them. It can be taken from points 8.5 and 8.6 of the reasons that the board understood the petitioner's argument that the technical problem was not credibly solved to refer to a different technical problem than the objective technical problem resulting from the distinguishing features of claim 1. As this problem was to provide an alternative to the existing layered adhesive construction according to document D1 and did not refer to any specific benefits, the approach of the board does not seem to be based on a fundamental misapprehension or ignorance of the points of views submitted by the petitioner.

27. Thus, the petitioner also has no case on the issue of the credibility of the solution of the technical problem (point 7 of the reasons of the decision under review).

28. Consequently, the Enlarged Board finds in respect of all complaints submitted by the petitioner with their petition for review that the petitioner failed to show

convincingly that a violation of their rights under Article 113(1) EPC had occurred by the board in the decision under review.

29. Because the petition for review is not allowable, the appeal proceedings are not to be re-opened and there is no need to deal with the petitioner's request for replacement of the members of the board.

Order

The Enlarged Board of Appeal as composed under Rule 109(2)(a) EPC unanimously decides:

The petition for review is rejected as clearly unallowable.

The Registrar:

The Chairman:

P. Martorana

W. van der Eijk