

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

D E C I S I O N
of 30 May 2003

Case Number: T 0392/01 - 3.2.5

Application Number: 95903878.7

Publication Number: 0735955

IPC: B44C 5/04

Language of the proceedings: EN

Title of invention:
Self-adhesive wallcoverings

Patentee:
COVA PRODUCTS LIMITED

Opponent:
The Imperial Home Decor Group (UK) Limited

Headword:
-

Relevant legal provisions:
EPC Art. 83

Keyword:
"Sufficiency of disclosure (no)"

Decisions cited:
-

Catchword:
-



Case Number: T 0392/01 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 30 May 2003

Appellant:
(Proprietor of the patent) COVA PRODUCTS LIMITED
Station Road
Cramlington,
Northumberland NE23 8AQ (GB)

Representative:
Jones, Helen Marjorie Meredith
GILL JENNINGS & EVERY
Broadgate House
7 Eldon Street
London EC2M 7LH (GB)

Respondent:
(Opponent) The Imperial Home Decor Group (UK) Limited
Belgrave Mills,
Belgrave Road,
Darwen
Lancashire BB3 2RR (GB)

Representative:
Wilkinson, Stephen John
Stevens, Hewlett & Perkins
1 St. Augustine's Place
Bristol BS1 4UD (GB)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 5 February 2001
revoking European patent No. 0 735 955 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: W. Moser
Members: P. E. Michel
H. M. Schram

Summary of Facts and Submissions

- I. The appellant (patentee) lodged an appeal against the decision of the Opposition Division revoking patent No. 0 735 955.

Opposition had been filed against the patent as a whole based on Article 100(a) and (b) EPC (lack of novelty and inventive step and insufficiency of disclosure).

The Opposition Division held that the patent in suit did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, cf. Article 83 EPC.

- II. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 to 8 as filed on 22 October 1999.

The respondent (opponent) requested that the appeal be dismissed.

- III. Claim 1 of the main request of the appellant reads as follows:

"A method of use of a continuous wall-covering web comprising in sequence a pressure sensitive adhesive layer formed from an aqueous acrylic emulsion, a substrate layer which comprises hydrophilic fibrous material and on one surface of which the adhesive layer is formed; a decorative surface layer of PVC formed by application of a plastisol onto the other surface of the substrate layer and a release surface, the web being wound into a roll by consecutive winding, the adhesive layer of one winding being received on the

release surface of the adjacent winding, in which method the web is unwound from the roll and the adhesive layer is adhered to a vinyl coated wall covering on a wall, whereby the web is effectively adhered to the wall covering on the wall, the web being characterised in that the initial adhesion (peel) strength of the web to steel is no greater than 7N/25mm and the adhesion (peel) to steel after 24 hours dwell time is higher than the initial adhesion and at least 5N/25mm and no greater than 12N/25mm, the internal delamination strength of the substrate is greater than the initial adhesion strength, the adhesive is plasticiser resistant such that the adhesive retains at least 70% of its adhesion strength after contact of the adhesive as a layer having a dry weight of 30 g/m² with a PVC coated wall covering having a dry coating weight of 90 g/m² and comprising plasticiser in an amount of at least 20% by weight, at 23±2°C for 3 weeks, at 55±2% RH."

IV. The appellant argued essentially as follows:

The person skilled in the art is able to determine a suitable adhesive satisfying the requirements of claim 1 without exercising inventive skill. The tests for whether or not a particular adhesive meets the requirements of claim 1 are sufficiently described in the specification. There is no difficulty in carrying out the tests to determine whether or not an adhesive meets the requirements of the claim. It is merely necessary to request an adhesive from a supplier, such as the supplier mentioned in the specification of the patent in suit. There is no evidence showing that the supplier would need to make an invention in order to devise a suitable adhesive.

Borden Chemical UK Limited, the supplier of the adhesive Cascotak ADP 21/494, had subsequently introduced a new product, WB 868, which had evolved from Cascotak ADP 21/494. Experimental data have been supplied which show that the commercially available acrylic based adhesive, Borden WB 868, meets the requirements of the claim.

The patent in suit thus meets the requirements of Article 83 EPC.

V. The respondent argued essentially as follows:

The adhesive Cascotak ADP 21/494, used in the single example of the patent in suit, became unavailable at some point after the filing of the application for the patent in suit. It is noted that WB 868 performs very differently from Cascotak ADP 21/494 and thus appears to be a different material. In any event, WB 868 was not available at the application date of the patent.

The only information in the patent specification is that the composition should be an aqueous acrylic emulsion. Vantac 301 is an example of such an adhesive, but, as was demonstrated by the appellant, does not provide the desired characteristics.

It is thus an undue burden on the person skilled in the art to find a suitable adhesive. The invention is therefore not sufficiently disclosed and the patent in suit does not meet the requirements of Article 83 EPC.

VI. On 5 March 2003, the appellant withdrew his auxiliary request for oral proceedings. On 17 March 2003, the respondent withdrew his request for oral proceedings.

The oral proceedings, which were due to take place on 8 April 2003, were accordingly cancelled.

Reasons for the Decision

Sufficiency of disclosure

1. In order to satisfy the requirements of Article 83 EPC, the invention forming the subject of the patent in suit must be disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

2. In the present case, claim 1 specifies the presence of a pressure sensitive adhesive layer formed from an aqueous acrylic emulsion, the adhesive being specified in terms of the desired initial adhesion strength, adhesion strength after 24 hours and plasticiser resistance. As set out in the decision under appeal, in the present case, the question of whether or not the invention is sufficiently disclosed turns on the question of whether or not the person skilled in the art would be able to choose a pressure sensitive adhesive formed from an aqueous acrylic emulsion satisfying the parameters specified in claim 1 without undue burden. It is accepted that the tests for whether or not a particular adhesive meets the requirements of claim 1 are sufficiently described in the specification.

3. The description of the patent in suit is largely concerned with elucidation of the desired properties of the adhesive and describing the tests for whether or not a particular adhesive meets the requirements of

claim 1. In addition, it contains the following directions with respect to the selection of a suitable adhesive:

- (i) "Suitable adhesives may be produced from synthetic and/or natural products, the natural rubbers being compounded with tackifying resin. The most highly preferred type of adhesive will be an acrylic based adhesive such as a polyacrylate-based aqueous emulsion adhesive. A particularly preferred adhesive is an acrylate-based emulsion adhesive sold under the name of Cascotak ADP 21/494." (column 7, lines 29 to 36)

- (ii) "... The selection of an appropriate adhesive to obtain the desired properties in the final product as disclosed above is a matter of choice by a person skilled in the art selecting amongst available polymers, application rates and additives." (column 8, lines 21 to 25)

In addition, the sole example (column 8, line 27 to column 9, line 47) uses Cascotak ADP 21/494.

- 4. The only adhesive specified in the patent in suit is Cascotak ADP 21/494 (see column 7, lines 33 and 36, and Example 1 at column 8, line 51). The formulation of this adhesive is not disclosed in the patent in suit. According to the facsimile from Borden Chemical UK Ltd dated 17 November 2000, this adhesive was, however, merely "a development product that evolved into WB 868". It is not seen as satisfying the obligation of the appellant to provide a disclosure sufficient to enable the person skilled in the art to carry out the invention merely to provide a trade name for a material

which is essential for carrying out the invention. As happened in the present case, the manufacturer of the material may cease manufacture of the material. It is also open to the manufacturer to change the composition and properties of the material bearing the trade name, so that the material could cease to possess the specified characteristics.

As regards the adhesive WB 868, in respect of which evidence has been provided that it satisfies the requirements of claim 1, it is not known precisely when this product was placed on the market. It is further noted that the adhesive properties of WB 868 are very different from those of Cascotak ADP 21/494. In any event, WB 868 was not available at the application date of the patent in suit.

5. The specification of the patent in suit thus does not give any assistance as regards the structure or molecular weight of the acrylic adhesive or as regards any additives which should be present in the adhesive.

In addition, an aqueous acrylic adhesive referred to as Vantac 301 is shown in a report filed by the proprietor on 22 October 1999 not to satisfy the parameters specified in claim 1. Thus, the position is that one acrylic adhesive is known to satisfy the parameters of claim 1 and one acrylic adhesive is known not to satisfy the parameters of claim 1.

The person skilled in the art is thus left with the task of selecting possible suitable candidates and carrying out a series of tests including a test for plasticiser resistance requiring three weeks. There is further no information given in the patent in suit

which would enable the person skilled in the art to evaluate failures in such a manner as to lead towards success in subsequent trials. Accordingly, adhesives satisfying the parameters of claim 1 can only be found by a process of trial and error.

6. The person skilled in the art attempting to put the invention into practice will thus be faced with a considerable amount of routine trials in attempting to find a suitable adhesive satisfying the performance criteria specified in claim 1. In this connection, the addressee of the patent in suit is regarded as being an adhesive expert faced with the task of selecting a suitable adhesive either alone or as a part of a team of experts. It is suggested on behalf of the appellant that it is merely necessary to specify the desired characteristics to a suitable supplier. However, it cannot be accepted that this is an appropriate approach to the question of sufficiency of disclosure, since this would mean passing on the burden of finding a suitable adhesive to a person other than the addressee.
7. For the above reasons, the process of trial and error which is necessary to establish a suitable adhesive, in the judgement of the Board, constitutes an undue burden. The Board is thus in agreement with the Opposition Division that the invention forming the subject of the patent in suit is not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

A. Townend

W. Moser