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**D E C I S I O N**  
**of 20 March 2006**

**Case Number:** T 0804/01 - 3.3.06

**Application Number:** 96112374.2

**Publication Number:** 0786554

**IPC:** D21H 25/18

**Language of the proceedings:** EN

**Title of invention:**  
Archival preservation coatings and adhesives

**Applicant:**  
Hollinger, William K., JR.

**Opponent:**  
-

**Headword:**  
Preservation method/HOLLINGER

**Relevant legal provisions:**  
EPC Art. 56, 122, 111

**Keyword:**  
"Notice of Appeal filed on time"  
"Inventive step (all requests) - no: obvious alternative to  
the prior art"

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 0804/01 - 3.3.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.06  
of 20 March 2006

**Appellant:** Hollinger, William K., JR.  
7015 Duncraig Court  
McLean  
Virginia 22101 (US)

**Representative:** Prato, Roberto  
Studio Torta S.r.l.  
Via Viotti, 9  
I-10121 Torino (IT)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 5 February 2001  
refusing European application No. 96112374.2  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** P. Krasa  
**Members:** P. Ammendola  
C. Rennie-Smith

## Summary of Facts and Submissions

- I. This appeal is from the decision of the Examining division dated 5 February 2001 refusing the European patent application No. 96 112 374.2 (European publication 0 786 554) on the ground that the subject-matter of the claims, according to the only request then pending, did not comply with the requirements of Article 82 EPC.
- II. Some of these claims were directed to methods (hereinafter "the coating-layer preserving methods") for preventing the physical degradation of an archival article by placing in its proximity a preservation article made of a substrate **coated** with a composition comprising an adsorbent ingredient and an alkaline buffer ingredient (hereinafter jointly referred to as "preserving ingredients"). Some other claims were directed to similar methods (hereinafter "the adhesive-layer preserving methods") wherein the preserving ingredients were instead added in an **adhesive** layer holding together the substrates forming the preservation article to be placed in the proximity of the archival article.
- III. In its decision the Examining Division found *inter alia* that the coating-layer preserving methods had been already disclosed in
- document (1) = EP-A-0 564 947
- and that, therefore, no novel inventive concept was common to the claimed coating-layer and adhesive-layer preserving methods.

IV. On 3 April 2001, the Applicant (hereinafter "Appellant") instructed his Representative to appeal this decision. On that same day the Representative paid the appeal fee and, according to his account, prepared a written notice of appeal which was thereafter placed in an envelope, together with documents referring to other cases of the same Representative, and sent on 5 April 2001 via DHL Courier to his associate office in Munich, with instructions to deliver it by hand to the EPO. On 24 April 2001 the Representative was informed by the EPO that no written notice of appeal had yet been received, while the appeal fee had been paid in due time.

Thereafter the Appellant filed the following facsimiles:

- on 26 April 2001, a copy of the notice of appeal dated 3 April 2001 said to have been already sent,
- on 13 June 2001, the grounds of appeal as well as the debit order for the payment of a fee for the re-establishment of rights under the provisions of Article 122 EPC (*restitutio in integrum*),
- on 15 June 2001, the written request for such *restitutio*, and
- on 6 May 2003, in reply to a communication of the Board of 19 March 2003 seeking supporting evidence for the assertion that the notice of appeal was filed in time, extracts from the European Patent Register showing that certain documents, said to be sent on 5 April 2001 in the same envelope as the notice of

appeal, had actually been received by the EPO on 6 April 2001.

- V. The Board issued *inter alia* a communication dated 23 November 2005 expressing its preliminary opinion on the substantial issues of the appeal and summoned the Appellant to oral proceedings to be held on 20 March 2006.
- VI. Finally, the Appellant filed under cover of a letter dated 23 January 2006 five sets of amended claims respectively labelled main request and auxiliary requests 1<sup>st</sup> to 4<sup>th</sup>, as well as amended pages of the description.
- VII. For the present decision it is necessary to consider only claim 1 of each of these final requests.

Claim 1 according to the main request and that of the 1<sup>st</sup> auxiliary request reads:

"1. *A method for preventing the physical degradation of an archival article comprising the steps of:*

*(a) applying to a substrate an adhesive composition comprising:*

*(i) an alkaline buffer; and*

*(ii) an adsorbent,*

*said alkaline buffer being capable of neutralizing acidic components from the environment of the archival article and said adsorbent being capable of removing chemical components from the environment of the archival article;*

*(b) adhering another substrate to the adhesive composition;*

*(c) drying the adhesive composition between the substrates; and*

*(d) preventing the physical degradation of the archival article by positioning the adhered substrates in proximity to the archival article."*

Claim 1 of the 2<sup>nd</sup> and 3<sup>rd</sup> auxiliary requests differs from claim 1 of the main request only in that the wording "*(i) an alkaline buffer; and (ii) an adsorbent*" has been replaced by "*(i) an adhesive; (ii) an alkaline buffer; and (iii) an adsorbent*".

Claim 1 of the 4<sup>th</sup> auxiliary request differs from claim 1 of the 3<sup>rd</sup> auxiliary request only in that the final wording "*archival article*" has been replaced by "*archival article; wherein said adsorbent is a molecular sieve and wherein said molecular sieve is a zeolite*".

VIII. Oral proceedings took place before the Board as scheduled.

IX. The Appellant argued substantially as follows.

He requested the Board to examine the patentability of his requests only in as far as the provisions of the EPC other than those of Article 56 EPC were concerned. A remittal to the first instance for the inventive step assessment would be justified by the fact that he had never discussed this issue before the Examining

Division. Moreover, it would give the Appellant sufficient time to carry out additional comparative experiments, if necessary. However, the Appellant finally conceded at the oral proceedings that such further experiments had not been made and were not in preparation.

The Appellant also maintained initially that the experimental results reported in the examples of the application would demonstrate that the claimed subject-matter had now been limited to the most advantageous of the preserving methods initially claimed in the application as filed. In particular, due to calcium carbonate migration from the neighbouring sheets of paper, at least the zeolite-based adhesive-layer preserving methods reported in example 3 would be according to the invention as defined in claim 1 of any of the present requests. The other examples in the application would refer to the less advantageous coating-layer preserving methods and, thus, would be representative of the most relevant prior art.

However, the Appellant eventually conceded at the hearing that no unambiguous conclusion could be derived from the experimental results reported in the application, because the description of these experiments was too incomplete.

The Appellant then stressed the substantially different physical and chemical properties - also in respect of the possible migration/permeation of ingredients from neighbouring layers - of an adhesive layer in comparison to those of the coating layers or paper layers disclosed explicitly in document (1) as possibly

containing the preserving ingredients. Hence, only with hindsight of the present invention would the skilled person have considered incorporating within an adhesive layer the preserving ingredients previously only added in completely different portions of the preservation article.

- X. The Appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request or any of the 1<sup>st</sup> to 4<sup>th</sup> auxiliary requests filed with the Appellant's letter of 23 January 2006 or that the case be remitted to the first instance for further prosecution.

### **Reasons for the Decision**

*Admissibility of the appeal and refund of the fee paid for the restitutio in integrum*

1. The deadline for filing a notice of appeal against the decision of the Examining Division and paying the corresponding fee was 17 April 2001. In view of the facts summarized above at point IV it is apparent to the Board that:
  - the copy (received by the EPO on 26 April 2001) of the notice of appeal carries the date of 3 April 2001 and includes a statement that the appeal fee has been paid on the same date,
  - the records of the EPO show that this statement is correct,



- evidence from the European Patent Register confirms that documents referring to other cases of the Representative of the Appellant were received by the EPO on 6 April 2001.

In view of these facts, the Board considers it wholly credible that the notice of appeal was actually sent by the Appellant together with those other documents in the same envelope which was delivered to the EPO on 6 April 2001 and, thus, that on the balance of probabilities the notice was received by the EPO within the time required by Article 108 EPC. Since the grounds of appeal were also filed at the EPO in the prescribed time (see above point IV), the Board finds that the present appeal was correctly filed.

2. Accordingly, the Appellant's request for re-establishment of rights under Article 122 EPC is unnecessary and the fee paid for this request is to be refunded (see the decisions of the Legal Board of Appeal J 1/80, OJ EPO 1980, 289 and J 7/93, unpublished in OJ EPO).

*Requirements of the EPC considered in the present decision*

3. At the oral proceedings the Appellant has alleged that the sets of amended claims according to his final requests resulted from an attempt to limit the claimed subject-matter to those preserving methods wherein both preserving ingredients are located in an adhesive-layer.
  - 3.1 The Board has severe doubts even as to the formal admissibility of the claims according the Appellant's present requests. Moreover, it seems also questionable

whether all the claimed subject-matter of all the requests only encompasses adhesive-layer preserving methods wherein both preserving ingredients are present in the adhesive layer.

3.2 However, at the hearing before the Board it became immediately evident that even the allegedly most advantageous of the adhesive-layer preserving methods encompassed in claim 1 of any of the Appellant's requests, ie those wherein a **zeolite** adsorbent and an alkaline buffer have both been added to the adhesive composition, might lack an inventive step over the prior art disclosed in document (1). Therefore, to reach the present decision, it has turned out to be sufficient to assess whether these zeolite-based adhesive-layer preserving methods complied with the requirements of Article 56 EPC or not.

3.3 The Appellant however requested the Board not to consider the issue of obviousness without allowing him the opportunity to argue that issue before the Examining Division and to carry out further comparative experiments that could possibly support the superior preserving results allegedly achieved by the methods now claimed.

The Board notes, however, that

- the Appellant had already been informed by the communication of 23 November 2005 that the obviousness of the claimed adhesive-layer preserving methods would be considered at the oral proceedings on 20 March 2006;

- no request for a postponement of the hearing had been filed in order for comparative experiments to be carried out;
- the Appellant has provided no evidence that comparative experiments have already been made or are even in preparation;
- it is not foreseen by the EPC that an Appellant should always have the possibility of discussing before the first instance any issue upon which the Board has to decide;
- Article 111(1) EPC gives the Board a complete discretion in such matters;
- the present application is of a considerable age, having been filed on 31 July 1996 with a priority date of 11 August 1995.

Taking all these circumstances into account, the Board decided to proceed with the issue of inventive step at the oral proceedings, as announced in its communication of 23 November 2005.

*Inventive step (Articles 52(1) and 56 EPC)*

4. The Board concurs with the Appellant that the prior art disclosed in document (1) represents a reasonable starting point for the assessment of inventive step. This is apparent when considering that both the present application and document (1) disclose methods for preserving archival articles which include providing in the proximity of these latter preservation articles

comprising an alkaline buffer and an adsorbent (compare page 2, lines 50 to 51, of the patent application as published with page 3, lines 9 to 11 of document (1)). In particular, and as the Appellant conceded, this citation discloses the coating-layer preserving methods initially claimed in the present application (see the paragraph bridging pages 3 and 4, page 3, lines 46 to 48, page 11, lines 13 to 15, claim 28 and figures 8 to 13 of document (1)). Finally, it is noted that document (1) also undisputedly discloses zeolite molecular sieves as preferred adsorbents (see document (1) from page 5, line 41 to page 6, line 2, the examples and claim 6).

- 4.1 The Board observes, however, that the present application contains not even an allegation of a technical advantage of the (presently claimed) adhesive-layer preserving methods in comparison to the (initially claimed) coating-layer ones. On the contrary, the present application as filed discloses both the coating-layer and adhesive-layer preserving methods initially claimed as fully equivalent. This was conceded by the Appellant too.
- 4.2 Nor is any advantage immediately apparent from the comparison between the results of the zeolite-based samples in example 3 (ie those allegedly representative of the preferred zeolite-based adhesive-layer preserving methods) with those of example 2 (allegedly representative of the coating-layer preserving methods no longer claimed and already disclosed in document (1)).

Even disregarding the severe doubts of the Board as to the Appellant's allegation that example 3 would, due to migration of the alkaline buffer from the neighbouring paper layers into the adhesive layers, be representative of the claimed adhesive-layer preserving methods, it remains the fact that the description of these examples is so incomplete that it does not even allow a qualitative evaluation of the local concentrations or of the total amounts of the preserving ingredients actually used therein.

Therefore, from the available information in the application it cannot be concluded that, as initially alleged by the Appellant, the still claimed zeolite-based adhesive-layer preserving methods disclosed in example 3 would provide better results than the no longer claimed coating-layer preserving methods also based on zeolite as disclosed in example 2 and which are also representative of the prior art (as is evident from the fact that the methods of example 2 of the present application are also comparable to most examples of document (1)). This was also finally conceded by the Appellant.

- 4.3 Hence the Board concludes that the only technical problem credibly solved by the zeolite-based adhesive-layer preserving methods claimed vis-à-vis the corresponding coating-layer preserving methods also preferably based on zeolite already disclosed in document (1) is that of providing further ways for preserving archival articles, ie an **alternative** to this prior art.

4.4 The Board notes

- that in the methods specifically disclosed in document (1) the preserving ingredients are located in layers of significantly different structure and properties, such as a coating layer formed by applying a solution on the surface of the preservation article, or that formed by sprinkling them on a surface previously coated with an adhesive, or interdispersed within the paper/cardboard layer(s) forming the preservation article (see page 3, lines 47 to 48 and 56 to 58, page 4, lines 12 to 13, claims 28, 33 and 39, as well as samples 1 to 20);
  
- that adhesive layers are disclosed as present in the preservation articles of document (1) both implicitly (as these are necessarily present portions in multi-layered preservation articles obtained by laminating paper sheets, see sample 20) and explicitly (when this citation suggests adhering a preservation article to a container surface, see page 11, lines 13 to 15, or using an adhesive to hold in place the preserving ingredients sprinkled on a surface of the preservation article),

and

- that in the case of multi-layered preservation articles this citation explicitly teaches that the preserving ingredients may be dispersed in any of the layers (see page 4, lines 10 to 11).

Hence, the skilled reader of document (1) would contemplate the possibility of solving the posed problem by placing these ingredients e.g. in the adhesive layers present in the multi-layered preservation articles. Thus, the skilled person would, without exercising any inventive activity, arrive at the zeolite-based adhesive-layer preserving methods encompassed in claim 1 of each of the Appellant's present requests.

- 4.5 The Appellant argued that the skilled person would in fact **not** consider locating the preserving ingredients in adhesive layers because the migration/permeation properties of these latter would be significantly different from those of a paper sheet or of a coating layer.

The Board notes, however, that this argument lacks any supporting evidence and is inconsistent with the disclosure in document (1) just mentioned, suggesting that the advantage produced by the preserving ingredients is unaffected by the presence of adhesive layers, even when they are in direct contact with each other.

Accordingly, the Board is not convinced by the Appellant's unsupported argument that the explicit teaching in document (1) to locate the preserving ingredients in any layer of e.g. the multi-layered preservation articles would not also extend to the adhesive layers thereof.

5. For all the above reasons, the Board concludes that the preferred claimed method according to claim 1 of each

of the Appellant's requests represents an obvious alternative to the preserving methods of the prior art disclosed in document (1).

Accordingly, the Board finds that the subject-matter of claim 1 of any of the main and 1<sup>st</sup> to 4<sup>th</sup> auxiliary requests is not based on an inventive step and, therefore, that none of these requests is allowable under the provisions of Article 56 EPC.

## **Order**

### **For these reasons it is decided that:**

1. The appeal is dismissed.
2. The fee paid in respect of the request for *restitutio in integrum* is to be reimbursed.

The Registrar:

The Chairman:

G. Rauh

P. Krasa