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D E C I S I O N
of 25 May 2004

Case Number: T 0045/02 - 3.2.5

Application Number: 91112831.2

Publication Number: 0469564

IPC: B29B 13/02

Language of the proceedings: EN

Title of invention:

Method of packaging an adhesive composition and corresponding packaged article

Patentee:

H.B. FULLER LICENSING & FINANCING, INC.

Opponent:

Henkel France S.A.
Henkel KGaA Patente (TTP)
Bostik Findley S.A.
SAVARE' INDUSTRIA CHIMICA S.r.l
National Starch and Chemical Investment Holding Corporation

Headword:

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Relevant legal provisions:

EPC Art. 83, 123(3)

Keyword:

"Sufficiency of disclosure (main request, no; auxiliary request, yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0045/02 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 25 May 2004

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 5 November 2001
revoking European patent No. 0469564 pursuant
to Article 102(1) EPC.**

Composition of the Board:

Chairman: W. Moser
Members: W. Widmeier
P. E. Michel

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division revoking European patent No. 0 469 564.

The Opposition Division held that the invention was not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

- II. Oral proceedings were held before the Board of Appeal on 25 May 2004. On 4 May 2004, respondent I (opponent 01) had informed the Board that he would not take part in the oral proceedings.

- III. The appellant requested that the decision under appeal be set aside and that the case be remitted to the Opposition Division for further prosecution on the basis of claims 1 to 21 as granted or, as an auxiliary request, on the basis of claims 1, 10 and 18 presented during oral proceedings as auxiliary request, and claims 2 to 9, 11 to 17, and 19 to 21 as granted.

Respondents II to V (opponents 02 to 05) requested that the appeal be dismissed. Respondent I did not file any requests.

- IV. Claim 1 according to the main request reads:

"1. A method of forming a substantially uniform separate portion of a packaged adhesive composition, substantially completely surrounded by a plastics packaging material, said packaging material being meltable together with the adhesive composition and

blendable into said molten adhesive composition, said adhesive being especially a thermoplastic or thermo-setting hot melt adhesive, said method characterized by the steps of

b) providing said substantially uniform separate portion of the adhesive composition;
c) sufficiently solidifying said portion for packaging;
and

d) substantially completely surrounding said sufficiently solidified portion with said plastics packaging material; wherein

- said packaging material has a melting or softening point below 120°C;
- said packaging material has a sharp melting point rather than a softening temperature range;
- said material is a component of the adhesive or a component physically and chemically compatible with the adhesive in the melt, so as to cause no physical phasing or separation of the adhesive, such that
- the kind and amount of said packaging material are chosen so as not to disadvantageously affect the properties of the adhesive composition when blended into same."

Independent claims 10 and 18 according to the main request are directed to a method of packaging an adhesive composition and to a packaged adhesive composition, respectively, and also comprise the features

- "- said packaging material has a melting or softening point below 120°C;
- said packaging material has a sharp melting point rather than a softening temperature range".

In independent claims 1, 10 and 18 according to the auxiliary request the alternative "or softening" has been deleted.

V. The appellant argued essentially as follows:

The patent in suit relates to packaging known meltable adhesives with known plastics film materials. This packaged adhesive is intended to be melted together with the packaging film in a hot-melt tool. If a block of adhesive is packaged with an inappropriate film material, the molten adhesive and the film will not form a homogeneous composition, and the nozzles of the hot-melt tool may clog. Thus, the feature of claim 1 of the patent in suit that the packaging material has a sharp melting or softening point is not an isolated feature. This feature has to be considered in the context of the other features of the claim and in the context of the aim of the patent in suit to provide a packaged adhesive which, when molten, forms a homogeneous composition. It is therefore clear for a person skilled in the art that the melting characteristic of the packaging material must match that of the adhesive. All adhesives shown in the examples of the patent in suit have a sharp melting point. A person skilled in the art will therefore select a film material which has at least the same sharpness of its melting point as the adhesive. Otherwise it will not be possible to achieve a homogeneous molten mass. DSC is a standard method for measuring the melting point, and a sharp melting point is a generally known feature in the art. Thus, a person skilled in the art will not have any difficulty in

carrying out the invention. He will also know when he is working in the protected range of claim 1. When, for a given adhesive, he selects a packaging material such that its melting point characteristic matches that of the adhesive, then he is working within the scope of claim 1.

The two alternatives for the packaging material in claim 1 according to the main request that the melting point or the softening point of the packaging material is below 120°C are to be considered as being synonymous. It is doubtful whether a film material exists which has a softening point different from its melting point.

The patent in suit according to the main request as well as according to the auxiliary request therefore meets the requirements of Article 83 EPC.

VI. Respondent I did not submit any arguments in the appeal procedure.

VII. Respondents II to V argued essentially as follows:

The expression "a sharp melting point rather than a softening temperature range" in claim 1 does not exclude the softening temperature range. It compares the sharp melting point and the softening temperature range and indicates a preference for the sharp melting point. Page 4, line 22 of the patent in suit supports this interpretation. This expression does not specify where between soft and sharp the characteristic of the melting point lies. Furthermore, the expression "sharp melting point" is ambiguous. Whether a melting point is sharp or not sharp depends on what is being compared.

It is not an absolute definition. The DSC method does not allow the shape of the melting curve to be measured, thus it does not allow a sharp or a non-sharp melting point to be determined. This method only allows the melting temperature to be determined. The DSC method also does not allow the softening point to be determined. The patent in suit does not specify how the softening point is to be measured. However, the softening point depends on the method by which it is measured. Different methods provide different results. Thus, since melting point and softening point are different things, a person skilled in the art cannot measure the softening point in accordance with claim 1 of the main request and he cannot determine the melting characteristic. Moreover, claim 9 specifies materials which do not even have a melting point.

As the sharpness of the melting point is a relative feature, one and the same melting characteristic may in one case be sharp and in another case be soft. It depends on what is being compared. Thus, a person skilled in the art cannot know when he is working within the scope of claim 1. Also homogeneity cannot be used as a criterion, because homogeneity can be determined only when the packaged adhesive is molten but not in a method as defined in claim 1, which relates to the packaging of the adhesive.

Thus, neither the subject-matter of claim 1 according to the main request nor the subject-matter of claim 1 according to the auxiliary request is disclosed in a manner sufficiently clear for it to be carried out by a person skilled in the art. The same applies to the

subject-matter of independent claims 10 and 18 according to the main and the auxiliary request.

The deletion of the term "or softening" constitutes, as any deletion of a feature of a claim, an extension of the scope of protection. Thus, claim 1 according to the auxiliary request infringes Article 123(3) EPC. The same applies to independent claims 10 and 18 according to the auxiliary request.

Reasons for the Decision

1. *Procedural matters*

In the oral proceedings the Board raised an objection against the alternative specified in claim 1 that the softening point is below 120°C for the first time. The auxiliary request, with the alternative "or softening" being deleted in its independent claims, had therefore, in keeping with the principle of procedural fairness, to be admitted. Since the auxiliary request differs from the main request only by the deletion of an alternative, the respondents were not confronted with a new or surprising situation.

2. *Main request*

- 2.1 The expression "a sharp melting point rather than a softening temperature range" is equivalent to an exclusion of the softening temperature range in favour of the sharp melting point. This expression does not constitute a comparison of a sharp melting point and a softening temperature range with a preference for the

sharp melting point. It is irrelevant whether the translations of this expression into the other official languages of the EPO reflect a different meaning. According to Article 70(1) EPC, the text in the language of the proceedings is the authentic text. Thus, the feature of claim 1 that the packaging material has a sharp melting point rather than a softening temperature range means that the packaging material has a sharp melting point. The reference to the softening temperature range is redundant. The sentence on page 4, lines 21 to 24, of the patent in suit, which states that a packaging material which has a softening temperature range (and therefore does not have a sharp melting point) is less advantageous, is in accordance with this feature of claim 1.

2.2 The problem on which the patent in suit is based is to provide a packaged adhesive which can be melted to form a homogeneous blend so that, for example, clogging of the nozzles of a hot-melt tool can be avoided (cf. page 2, line 56 to page 3, line 2). Thus, when the packaging material is melted together with the adhesive, it is clear for a person skilled in the art that the packaging material must have the same melting characteristic as, or a sharper melting characteristic than, the adhesive. Otherwise, it will not be possible to achieve a homogeneous blend and to avoid clogging. For this reason, claim 1 specifies that the packaging material has a sharp melting point. Although the expression "sharp melting point" does not have an absolute meaning in terms of a unique melting characteristic, in the context of the claim as a whole and the problem to be solved, it means for a person skilled in the art that the melting characteristic of

the packaging material must be at least as sharp as the melting characteristic of the adhesive. How these characteristics, i.e. the temperature and the sharpness of the melting point, are determined is irrelevant. A person skilled in the art knows suitable methods. For carrying out the method of claim 1, it is furthermore irrelevant whether a dependent claim or the description specifies adhesives which do not have a melting point. Claim 1 specifies that the packaging material does have a melting point. If there is inconsistency between two claims or between the claims and the description, then this is a conflict to be considered under Article 84 EPC which is not a ground of opposition (Article 100 EPC).

- 2.3 Claim 1 comprises two alternatives. One alternative is a packaging material which has a melting point below 120°C and the other alternative is a packaging material which has a softening point below 120°C. Melting point and softening point are not synonymous. A material may have a softening point which differs from the melting point such that the softening point is below 120°C, and the melting point is above 120°C. This also applies for materials as used for packaging materials for adhesives. Thus, considering the second alternative, i.e. a packaging material with a softening point below 120°C, a person skilled in the art will experience difficulties in carrying out the invention because a packaging material with a softening point below 120°C may be inappropriate even when its melting point is sharp. The patent in suit does not give sufficient guidance for finding the appropriate packaging material for the second alternative of claim 1.

2.4 The Board concludes therefore that the subject-matter according to claim 1 of the main request is not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Consequently, the patent in suit according to the main request does not meet the requirements of Article 83 EPC.

These findings also apply to the subject-matter of independent claims 10 and 18, which comprise the same two alternatives.

3. *Auxiliary request*

3.1 Claim 1 of the auxiliary request is restricted to the first alternative of claim 1 of the main request, i.e. to a packaging material which has a melting point below 120°C. Deletion of an alternative from a claim does not broaden the scope of protection of the claim. A claim comprising alternatives is equivalent to a plurality of independent claims, each specifying one of the alternatives. Deletion of one of the alternatives is therefore equivalent to the deletion of one of these independent claims. Thus, claims 1, 10 and 18 of the auxiliary request meet the requirements of Article 123(3) EPC.

3.2 The packaging material according to claim 1 of the auxiliary request is no longer characterised by the temperature of its softening point; rather, it is characterised by the temperature of its melting point. As the other feature objected to under Article 83 EPC by respondents II to V, viz. that the packaging material has a sharp melting point rather than a

softening temperature range, is also related to the melting point, a person skilled in the art obtains sufficient instructions from the patent in suit to carry out the method of claim 1 (see above under points 2.1 and 2.2).

- 3.3 The Board is therefore satisfied that the subject-matter according to claim 1 of the auxiliary request is disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art so that the patent in suit according to the auxiliary request meets the requirements of Article 83 EPC.

The same applies to the subject-matter of independent claims 10 and 18, which also comprise the features that the packaging material has a melting point below 120°C and that the packaging material has a sharp melting point.

- 3.4 It follows from the above that the auxiliary request has the effect of removing a ground of opposition as laid down in Article 100 EPC and that, therefore, the auxiliary request also meets the requirements of Rule 57a EPC.

4. The decision under appeal was based exclusively on the ground of opposition under Article 100(b) EPC. The other grounds of opposition under Article 100(a) and (c) EPC were not dealt with in the opposition procedure. In applying its discretionary power conferred to it under Article 111(1) EPC, the Board considers it appropriate to remit the case to the Opposition Division for further prosecution on the basis of the auxiliary request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the Opposition Division for further prosecution on the basis of the auxiliary request of the appellant.

The Registrar

The Chairman

M. Dainese

W. Moser