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**Datasheet for the decision
of 8 May 2007**

Case Number: T 0876/06 - 3.3.09

Application Number: 98933792.8

Publication Number: 1007597

IPC: C09J 153/02

Language of the proceedings: EN

Title of invention:

Biological fluid absorbing pressure sensitive adhesives

Patentee:

EVERY DENNISON CORPORATION

Opponent:

Coloplast A/S

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 111

Keyword:

"Limitation of range by defining a lower limit"
"Added subject-matter - no"
"Remittal for further prosecution"

Decisions cited:

G 0001/93, G 0001/03, G 0002/98, T 0201/83

Catchword:

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Case Number: T 0876/06 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 8 May 2007

Appellant: AVERY DENNISON CORPORATION
(Patent Proprietor) 150 North Orange Grove Boulevard
Pasadena, CA 91103 (US)

Representative: Bankes, Stephen Charles Digby
BARON & WARREN
19 South End
Kensington
London, W8 5BU (GB)

Respondent: Coloplast A/S
(Opponent) Holtedam 1
DK-3050 Humlebaek (DK)

Representative: Inspicos A/S
Bøge Allé 5
P.O. Box 45
DK-2970 Hørsholm (DK)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 3 April 2006
revoking European patent No. 1007597.

Composition of the Board:

Chairman: P. Kitzmantel
Members: J. Jardón Álvarez
W. Sekretaruk

Summary of Facts and Submissions

I. The grant of European patent No. 1 007 597 in respect of European patent application No. 98933792.8 in the name of AVERY DENNISON CORPORATION, which had been filed on 14 July 1998, was announced on 23 April 2003 (Bulletin 2003/17) on the basis of 17 Claims. Independent Claims 1 and 17 read as follows:

"1. A pressure-sensitive adhesive material comprising a mixture of:

(a) a continuous phase formed from a physically cross-linked solid rubber, a compatible liquid rubber and 0 to 15 wt.% of resinous materials, based on the total composition, wherein the weight ration of liquid rubber to solid rubber is at least 3:2; and

(b) 10 to 70% by weight, based on the total adhesive material, of a discontinuous phase comprising one or more hydrophilic polymers that are soluble and/or swellable in water.

17. An adhesive barrier or dressing for medical use, comprising a non-adhesive, waterproof film having coated thereon a layer of a pressure-sensitive adhesive material according to any preceding claim."

Claims 2 to 16 were dependent claims.

II. A Notice of Opposition was filed against this patent by Coloplast AS on 23 January 2004. The Opponent requested the revocation of the patent in its entirety on the

grounds of Article 100(a) EPC for lack of novelty and inventive step and Article 100(c) EPC for subject-matter which extended beyond the content of the application as originally filed.

- III. By its decision announced orally on 15 March 2006 and issued in writing on 3 April 2006, the Opposition Division revoked the patent on the grounds of added subject-matter (Article 123(2) EPC) and lack of clarity (Article 84 EPC) of all the requests pending before the Opposition Division.

The Opposition Division held that the feature "tacky adhesive" used in the amended claims was of subjective nature only and not clear and concise as required by Article 84 EPC.

The Opposition Division held further that the lower limit of the range for the ratio of liquid rubber to solid rubber (3:2) contravened Article 123(2) EPC because this value was picked out of a group of values for the ratio of liquid to solid rubber consisting of 1:1, 3:2, 2:1 and 4:1. The value, being an intermediate value, could not be used to form the lower limit of the claimed range. Moreover, the value could not be isolated from the other features in the examples such as the specific liquid rubber type (LVSI-101) and the specific polymer stabiliser (IRGANOX 1010) used. Under these circumstances, a generalization could not be allowed.

The Opposition Division also objected to the terms "tacky adhesive" and "imparting tackiness and adhesion"

as extending beyond the content of the application as originally filed.

- IV. On 6 June 2006 the Patent Proprietor (Appellant) lodged an appeal against the decision of the Opposition Division and paid the appeal fee on the same day.

In the Statement of Grounds of Appeal filed on 11 August 2006, the Appellant requested that the decision of the Opposition Division be set aside and the case be remitted to the Opposition Division for further prosecution on the basis of an amended set of claims. Amended Claim 1 read as follows:

"1. A pressure-sensitive adhesive material comprising a mixture of:

(a) a continuous phase formed from a physically cross-linked solid rubber and a compatible liquid rubber, wherein the weight ratio of liquid rubber to solid rubber is from 3:2 to 7:1 and

(b) 20 to 55 percent by weight, based on the total adhesive material, of a discontinuous phase comprising one or more hydrophilic polymers that are soluble and/or swellable in water, said adhesive material being free of resinous materials."

- V. The Respondent (Opponent) presented its counterstatement by letter dated 3 January 2007 and requested that the appeal be dismissed and the patent be revoked in its entirety.

- VI. On 7 February 2007 the Board dispatched a summons to attend oral proceedings on 8 May 2007. In the annexed communication pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal, the Board expressed its preliminary opinion on the case. The Board considered that the subject-matter of amended Claim 1 fulfilled the requirements of Article 123(2) EPC. The Board also expressed its intention to remit the case to the Opposition Division for further prosecution of the file.
- VII. By letter dated 1 March 2007, the Appellant filed a corrected version of Claim 3, including a line inadvertently omitted during typing.
- VIII. By letter dated 5 April 2007, the Respondent filed further arguments in support of its request.
- IX. The arguments presented by the Appellant in its written submissions and at the oral proceedings may be summarized as follows:
- The Appellant pointed out that of the four amendments objected to by the Opposition Division, only one was retained in the present claims, namely the one concerning the range of the weight ratio of liquid to solid rubber, whose upper limit of 7:1 was derived from page 10, lines 23 to 26 of the application as filed and whose lower limit of 3:2 was supported by several of its worked examples. It furthermore pointed out that only a few of the examples in the granted specification were excluded from the newly defined range.

- The Appellant further pointed out that the selected lower limit, when used in the examples, was independent from the other features of the examples and thus fulfilled the requirements imposed by the decision T 201/83 (OJ EPO 1984, 481).
- X. The arguments presented by the Respondent in its written submissions and at the oral proceedings may be summarized as follows:
- The Respondent, referring to G 1/93 (OJ EPO 1994, 541), G 1/03 (OJ EPO 2004, 413) and G 2/98 (OJ 2001, 413), pointed out that the relevant question in relation to amendments was whether the skilled person could derive the relevant subject-matter from the original disclosure directly and unambiguously, using common general knowledge. This test was not met by the lower limit of 3:2 for the liquid to solid rubber weight ratio range. That the generalization of this feature from the examples was not possible, was *inter alia* apparent from the fact that all the examples by which the amendment was alleged to be supported used the same liquid rubber and the same SIS (styrene-isoprene-styrene) type solid rubber.
 - The Respondent noted that in the present case the value 3:2, though being an "intermediate value" taken from a series of examples in the application as originally filed involving higher and lower weight ratios, was used to form the "lower end-point" of the range. In its opinion this situation was fundamentally different from the situation which was the subject of the decision in T 201/83

concerning EP - 0 019 945, where the lowest value of 690 ppm calcium disclosed in the relevant examples, which also met the requirement of the amended concentration range of magnesium (cf. Melt No. 8 on page 5), was chosen. T 201/83 could not therefore be used to justify the amendment under consideration here.

- Moreover the Respondent was of the opinion that the principles applied in T 201/83 have in the meantime been overruled by decisions G 1/93, G 1/03 and G 2/98.

XI. The Appellant (Patent Proprietor) requested that the decision under appeal be set aside and the case be remitted to the Opposition Division for further prosecution on the basis of the set of Claims 1 to 13 of the main request (Claims 1 to 4, 5 (in part), filed with letter dated 1 March 2007 and Claims 5 (in part) and 6 to 13 filed on 11 August 2006).

The Respondent (Opponent) requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. *Clarity (Article 84 EPC).*
 - 2.1 The amended claims now under consideration no longer include the expression "tacky adhesive" objected to by the Opposition Division. Consequently, the amendment

made overcomes the lack of clarity objections made by the Opposition Division in the appealed decision.

2.2 No objections under Article 84 EPC were raised by the Respondent to the present claims during the appeal proceedings and the Board sees no reason to take a different view. Hence, it is unnecessary to go into more detail in this respect.

3. *Amendments (Article 123 EPC).*

3.1 The only issue to be decided in the present appeal proceedings is whether the subject-matter of the amended claims fulfils the requirements of Article 123(2) EPC.

3.2 Claim 1 is essentially based on Claim 1 as originally filed wherein:

(i) the weight ratio of liquid rubber to solid rubber has been defined as from 3:2 to 7:1 in accordance with originally filed Claim 13 (for the upper end-point) and examples 1, 2, 4, 6 and 7 (for the lower end-point),

(ii) the range of contents for the discontinuous phase has been limited to 20 to 55% by weight of the total adhesive material in accordance with Claim 6 as originally filed, and

(iii) the presence of a resinous material has been excluded (support: page 7, lines 3 to 5 from the bottom of the description as originally filed),

3.3 Thus, amendments (ii) and (iii), as well as the upper limit (7:1) for the range of the amendment (i), find explicit support in the application as originally filed and fulfil the requirements of Article 123(2) EPC.

This finding has not been disputed by the Respondent.

3.4 The only amendment disputed is the lower limit for the weight ratio of liquid rubber to solid rubber (3:2), for which there is no explicit basis in the claims or in the description as originally filed. This value was introduced during the examination proceedings in order to overcome a novelty objection raised by the Examining Division.

The application as originally filed referred on page 10, lines 23 to 26 and in Claim 13 to a weight ratio of liquid rubber to solid rubber of from 0.5:1 to 7:1.

The only possible basis for the amendment is the use of a weight ratio of liquid rubber to solid rubber of 3:2 in examples 1, 2, 4, 6 and 7 of the application as originally filed.

3.5 According to EPO practice, as stated for instance in the Headnote of the decision T 201/83 (OJ EPO 1984, 481), an amendment of a concentration range in a claim for a mixture is allowable on the basis of a particular value described in a specific example, if the skilled person could have readily recognised this value as not so closely associated with the other features of the example as to determine the effect of the invention as a whole in a unique manner and to a significant degree.

3.6 Applying this principle, it has therefore to be decided in the present case whether or not the weight ratio of liquid rubber to solid rubber set out in examples 1, 2, 4, 6 and 7 is in this sense closely associated with the other features of these examples.

3.6.1 The patent in suit is directed to a pressure sensitive adhesive comprising a mixture of a continuous phase and a discontinuous phase. The application as originally filed (page 8, line 34 - page 12, line 14) describes the continuous phase as including a solid rubber and a liquid rubber and as also including, optionally, other materials such as low molecular weight polybutenes, to modify its properties for certain uses, and/or polymer stabilisers, to protect it from degradation during processing.

3.6.2 Concerning the weight ratio of liquid rubber to solid rubber it is stated that "the preferred weight ratio of solid rubber to liquid rubber is in the range from 1:0.5 to 1:7, and is varied in order to obtain the desired degree of adhesiveness and tackiness" (page 10, lines 24 to 27, emphasis by the Board).

From this passage in the specification as originally filed it can be inferred that the weight ratio of liquid rubber to solid rubber is in principle considered to be independent of the nature of the rubbers used but that what is important for the claimed invention is that the variation of their weight ratio allows the modulation of the properties of adhesiveness and tackiness.

While it is correct, as argued by the Respondent during the oral proceedings, that the worked examples show that other constituents of the continuous phase, including eg polyisobutylenes, have a considerable impact on these properties, this does not detract from the veracity of the above statement.

3.6.3 The possibility of varying the ratio of liquid/solid rubber is demonstrated by the wide range covered by the worked examples, which span weight ratios of liquid to solid rubber varying from 1:1 to 4:1. Thus, in examples 3 and 8 a ratio of 1:1 is used; in examples 1, 2, 4, 6 and 7 the ratio is 3:2; in examples 5, 16 and 17 the ratio is 2:1; and in examples 9 - 15 the value is 4:1. In all the examples the same liquid rubber (LVSI-101) is combined with different solid rubbers (Kraton KD-1161N, Kraton D-1117, Kraton D-1119, Kraton D-1112, Tacky G RP6919 and Exxon Vector 4111).

As for the use of the same liquid rubber (LVSI-101) in all the examples, is it noted that there is no indication in the application that the weight ratio of liquid to solid rubber would be dependent on the kind of liquid rubber used. Rather it is emphasised that, apart from their common characteristics as liquid rubbers implying *inter alia* an accordingly low molecular weight and glass transition temperature, their most important characteristic is their complete compatibility with the solid rubber (cf. page 10, 2nd paragraph of the application as filed, especially page 10, lines 12 to 14). This, together with what is set out above under point 3.6.2, indicates that the ratio of liquid to solid rubber is not dependent on the choice of a particular liquid rubber.

As to the solid rubber, it was argued by the Respondent that throughout those worked examples supporting the 3:2 weight ratio of liquid to solid rubber, the same SIS triblock rubber type was always used. While this is correct for the kind of repeating units (derived from styrene and isoprene) of the Kraton rubbers used it is not correct for their specific structure, which may even vary considerably: Kraton D-1117: 17% styrene, 33% diblock content; Kraton D-1119: 22% styrene, 66% diblock; Kraton D-1112: 15% styrene, 38% diblock (cf. page 16, Table 3, Formulas E2, E4, E5 (= examples 4, 6, 7) in conjunction with page 9, lines 12 to 17 and page 17, lines 1 to 8).

A further argument put forward by the Respondent and accepted by the Opposition Division was that the use of the same stabiliser IRGANOX 1010 in all examples militated against a generalisation of the liquid to solid rubber weight ratio 3:2. Again, this reasoning is not convincing in the light of the information in the specification. Rather it is evident from the use of the same amount of the same stabiliser in the examples reported in Table 3, which use three different weight ratios of liquid to solid rubber, that the liquid to solid rubber ratio is selected independently of the stabiliser and that these parameters are not linked.

- 3.6.4 In summary, the skilled person could have recognized in the application as originally filed that the weight ratio of liquid rubber to solid rubber was not so closely associated with the other features of the examples as to determine the effect of the invention as a whole in an unique manner and to a significant degree.

Thus, in the Board's judgment, in the present case it is permissible to use the particular value used in several examples to limit the range of the weight ratio of liquid rubber to solid rubber.

The limitation of the claim represents merely a quantitative reduction of a range to a value already envisaged within the document and not an arbitrary restriction providing a technical contribution to the subject-matter of the claimed invention in accordance with point 10 of the Reasons of T 201/83.

- 3.7 The Board also finds incorrect the argument of the Respondent that the amendment in T 201/83 was only considered allowable because it represented the lowest value disclosed with regard to the then claimed invention. While it is true that the value 690 ppm of calcium was the lowest value exemplified for the amended magnesium range 1 to 80 ppm, this fact played no role at all for the conclusion arrived at in T 201/83, according to which the amendment was only allowed on the basis that the calcium value chosen was functionally independent of the values of the other component magnesium in the examples (Reasons, point 6). The argument of the Respondent therefore goes against the essence of the reasoning in that decision for allowing the amendment and cannot therefore be accepted by the Board.

The Board also disagrees with the argument of the Respondent that decision T 201/83 has been overruled by later decisions of the Enlarged Board of Appeal. T 201/83 is not cited in any of the decisions mentioned by the Respondent and the Board cannot see any other

indication why this decision should be overruled by them. Moreover the finding in the present decision that the amendment is allowable is also in line with the decisions cited by the Respondent in the sense that the amendment at issue is considered directly and unambiguously derivable from the application as originally filed as explained above.

3.8 For these reasons the subject-matter of Claim 1 fulfils the requirements of Article 123(2) EPC.

3.9 The subject-matter of Claims 2 to 13 is also based on the application as originally filed (cf. Claims 2 - 5, 7-12, paragraph bridging pages 10 and 11 and Claim 15) and also fulfils the requirements of Article 123(2) EPC.

4. *Remittal (Article 111(1) EPC).*

4.1 The Board has decided that the subject-matter of the claims of the main request overcomes the objections under Article 84 EPC and Article 123(2) EPC forming the basis of the decision under appeal.

4.2 The Opposition Division has not yet taken a decision on the other patentability issues raised by the Opponent, namely, novelty and inventive step.

4.3 The Appellant has requested the remittal of the case to the Opposition Division for further consideration of these issues and the Respondent did not object to such remittal.

4.4 In these circumstances, the Board considers it appropriate to exercise its discretion under

Article 111(1) EPC to refer the case back to the Opposition Division for further prosecution.

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 set of Claims 1 to 13 of the main request (Claims 1 to 4, 5 (in part) filed with letter dated 1 March 2007 and Claims 5 (in part) and 6 to 13 filed on 11 August 2006).

The Registrar

The Chairman

G. Röhn

P. Kitzmantel