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**Datasheet for the decision
of 5 February 2015**

Case Number: T 1827/13 - 3.3.03
Application Number: 08425594.2
Publication Number: 2161303
IPC: C08L27/06, C09K3/10
Language of the proceedings: EN

Title of invention:

A plastisol composition, and a method and a plant for applying the composition to container-closing capsules for creating a seal, and capsules constructed using the composition, the method and the plant

Applicant:

In. Cam. Fabbrica Barattoli S.p.a.

Headword:

Relevant legal provisions:

EPC Art. 123(2), 84

Keyword:

Amendments - added subject-matter (no)
Claims - clarity (yes)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1827/13 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 5 February 2015

Appellant: In. Cam. Fabbrica Barattoli S.p.a.
(Applicant) 22/C-D, Via Brodolini
42040 Campegine (Reggio Emilia) (IT)

Representative: Corradini, Corrado
Ing. C. Corradini & C. S.r.l.
Via Dante Alighieri 4
42100 Reggio Emilia (IT)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 2 May 2013
refusing European patent application No.
08425594.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman B. ter Laan
Members: D. Marquis
C. Brandt

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Examining Division posted on 2 May 2013 refusing European patent application No. 08 425 594.2.
- II. The application as filed contained 19 claims, independent claims 1 and 12 of which read as follows:

"1. A composition of Plastisol material, destined for creating seals for closing capsules of food products, comprising following components:
resin to at least 35%; plasticiser to at least 30%; stabiliser to at least 0.3%; filler to at least 1%; slip to at least 1% and lubricant to at least 1%, characterised in that the plasticiser is a polyester, of 1,2-propandiole and/or 1,3- and/or 1,4-butandiole and/or polypropylene glycol with adipic acid, in which ends of the polymer chains below 1000 Da are constituted, to at least 50% thereof, by oxydrilic groups (-OH), excluding cyclic components, with a fraction of less than 20% of oligomers of the polyadipate having a molecular weight of below 1000 Da."

"12. A method for manufacturing the material of claim 1, comprising following operations:
- loading the liquid products (polyadipates and silicone oil) in a blade disperser, checking that the blade is immersed by at least 5-10 cm and mixing in a hermetic environment for about 15 minutes;
- loading the solid additives (stabiliser - titanium dioxide - amides) with the blade rotating for about five minutes;
- loading the PVC resin, with the blade in action up until the powder disappears;

- placing the disperser under vacuum conditions for at least 15-20 minutes while completing dispersion at a temperature of less than 55°C;
- filtering the material obtained through a more or less 1 mm. metal net filter;
- conserving the product obtained at a temperature of from 30°-40°C."

III. The contested decision was based on amended claims, claim 1 reading:

"1. A composition of Plastisol material, destined for creating seals for closing capsules of food products, comprising following components:
resin to at least 35%; plasticiser to at least 30%; stabiliser to at least 0.3%; filler to at least 1%; slip to at least 1% and lubricant to at least 1%, characterised in that the plasticiser is a polyadipate with a fraction of less than 20% of oligomers of polyadipate having a molecular weight of below 1000 Da, wherein at least 50% of the ends of the polyadipates below 1000 Da (excluding cyclic components) are oxydrilic groups, the percentages are expressed in weight comparison to a total of the composition."

The examining division found that amended claim 1 introduced subject matter that extended beyond the content of the application as filed. It was *inter alia* held that a generalisation had been made regarding the kind of polyadipate, for which there was no basis in the application as originally filed. Also, the restriction to "all the percentages expressed in weight comparison to a total of the composition" had no basis in the original application. Table 4 and the table on page 12 referred only to very specific examples of compositions suitable for pasteurisation/sterilisation,

wherein narrow ranges of specific components were given in weight percentages. There was no further disclosure implying that the percentages of the general composition expressed in original claim 1 could be interpreted as weight percentages. Thus, claim 1 did not fulfil the requirements of Article 123(2) EPC.

- IV. The applicant filed a notice of appeal on 1 July 2013, paying the required fee on the same day, and a statement setting out the grounds of the appeal on 20 August 2013. The amendments of a new claim 1 as part of a new main request were discussed in view of Article 123(2) EPC.
- V. Oral proceedings before the Board took place on 5 February 2015.
- VI. At the oral proceedings, after discussion of clarity issues regarding the claims as originally filed, the applicant filed a new set of 13 claims, claim 1 reading (additions in **bold**, deletion in ~~strikethrough~~ compared with the version as originally filed):

"1. A composition of Plastisol material, destined for creating seals for closing capsules of food products, ~~comprising~~ **consisting of** following components: **PVC** resin to at least 35%; plasticiser to at least 30%; stabiliser to at least 0.3%; filler to at least 1%; slip to at least 1% and lubricant to at least 1%, characterised in that the plasticiser is a polyester, of 1,2-propandiole and/or 1,3- and/or 1,4-butandiole and/or polypropylene glycol with adipic acid, in which ends of the polymer chains below 1000 Da are constituted, to at least 50% thereof, by ~~oxydrilie~~ **hydroxylic** groups (-OH), excluding cyclic components, with a fraction of less than 20% of oligomers of the

polyadipate having a molecular weight of below 1000 Da
**(all the percentages are expressed in weight comparison
to a total of the composition)
wherein the filler is titanium dioxide,
the slips are erucic amide and oleic amide,
the lubricant is silicone oil."**

In claims 4 and 5 the "erucic acid slips" was amended into "erucic amide slips".

VII. The arguments of the appellant as far as they are relevant to the present decision, can be summarised as follows:

Article 123(2) EPC

The basis for the amendments could be found in claims 1 and 7 to 9 of the originally filed application. The tables of the application supported the modification of "comprising" into "consisting of" and the whole application was only about PVC. The modification of oxydrilic in hydroxylic was an obvious correction. In the present technical field the use of weight percentages for indicating the amounts was usual; nothing else could have been meant, also in view of the tables of the original application. The basis for the amounts, referring to the total composition which was now formulated as "consisting of", could be found in the tables of the application as filed.

Article 84 EPC

By limiting the definition of the terms used to describe the composition, the claims were clear.

Due to the extensive modifications made in the application, the applicant was not in the position to discuss novelty and inventive step of the set of claims submitted during oral proceedings. A remittal to the examining division would be appropriate.

VIII. The appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution (novelty and inventive step) on the basis of the claims as filed during the oral proceedings.

IX. At the end of the oral proceedings, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

2. Modifications

2.1 Claim 1 finds a basis in claim 12 as originally filed which discloses compositions according to claim 1 in which the resin is PVC, the filler is titanium dioxide and the lubricant is silicone oil. The use of titanium dioxide as filler, silicone oil as lubricant and erucic amide and oleic amide as slip agents in the compositions of claim 1 also finds a basis in claims 7, 8 and 9 as originally filed; their combination can be derived from the tables of pages 11 and 12 of the application as filed.

2.2 The wording of claim 1 is now that of a closed composition by the amendment of "comprising" into

"consisting of". The percentage amounts of the components are now by weight, on the basis of the total composition. These amendments can be derived from the tables on original pages 11 and 12 in which the amounts of the components of representative compositions are expressed in percentage by weight and their total is indicated to be 100%.

2.3 The modification of "erucic acid slips" in claims 4 and 5 in "erucic amide slips" is the correction of an obvious error for which a literal basis can be found in the tables of pages 11 and 12, in conformity with original claims 8 and 12.

2.4 The replacement of "oxydrilic groups (-OH)" by "hydroxylic groups (-OH)" is based on the wording of original claim 1, indicating (-OH) groups. Also, on original page 5, last paragraph, the functionality of alcohols is discussed. Therefore oxydrilic is clearly meant to indicate (-OH) groups, normally known as hydroxylic groups.

2.5 The remaining claims have been renumbered accordingly.

2.6 Therefore, claims 1 to 13 comply with the requirements of Article 123(2) EPC.

3. Article 84 EPC

3.1 By the specific definition of the components in the second part of claim 1, the meaning of the generic definitions in the first part of claim 1 is clarified, in particular the difference between the generic terms "slip" and "lubricant". The limitation of the formulation of claim 1 to a closed composition ("consisting of") clarifies that the amounts of the

components are expressed in relation to the sum of the total of the components listed in claim 1. The reference to percentages by weight clarifies the amounts of the components.

3.2 Claims 1 to 13 satisfy the requirements of Article 84 EPC.

4. Remittal to the first instance

4.1 The examining division's decision was based only on Article 123(2) EPC. Novelty and inventive step still have to be examined and the board notes that a number of documents have been cited in the search report as X. Although there is no absolute right to have an issue decided upon by two instances, it is also not the function of the board to consider and decide upon issues which have not been examined at all by the department of first instance. The board thus decides to exercise its discretion under Article 111(1) EPC and remit the case to the first instance 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 first instance for further prosecution on the basis of the claims as filed during the oral proceedings on 5 February 2015.

The Registrar:

The Chairman:



B. ter Heijden

B. ter Laan

Decision electronically authenticated