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D E C I S I O N
of 23 July 1999

Case Number: T 0568/94 - 3.3.1

Application Number: 87112110.9

Publication Number: 0258753

IPC: C09J 133/00

Language of the proceedings: EN

Title of invention:

Pressure sensitive adhesive compositions

Patentee:

S. C. Johnson & Son, Inc.

Opponent:

BASF AKtiengesellschaft, Ludwigshafen

Headword:

Adhesive compositions/JOHNSON

Relevant legal provisions:

EPC Art. 54, 111(1), 123(2), (3)

Keyword:

"Novelty (yes, after amendment) - change from product claims to use claims - disclaimer"

Decisions cited:

G 0002/88, T 0433/86, T 0192/88

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0568/94 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 23 July 1999

Appellant: S. C. Johnson & Son, Inc.
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Representative: Baillie, Iain Cameron
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Respondent: BASF Aktiengesellschaft, Ludwigshafen
(Opponent) -Patentabteilung - C6-
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Representative: -

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 17 May 1994
revoking European patent No. 0 258 753 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: J. M. Jonk
Members: R. Freimuth
W. Moser

Summary of Facts and Submissions

- I. The Appellant (Proprietor of the Patent) lodged an appeal on 11 July 1994 against the decision of the Opposition Division posted on 17 May 1994 revoking the European patent No. 258 753.
- II. Notice of Opposition had been filed by the Respondent (Opponent) requesting revocation of the patent in its entirety for lack of novelty and inventive step (Article 100(a) EPC). The opposition was based on the documents
- (1) EP-A-212 358,
 - (2) US-A-4 151 143, and
 - (3) EP-A-173 300.
- III. The decision was based on a set of thirteen claims as amended during opposition proceedings directed to a pressure sensitive adhesive composition.

The Opposition Division held that the claims were allowable in view of Article 123(2) and (3) EPC since the amendment to claim 1 as granted represented merely a clarification and was clearly derivable from the description of the application as filed. However, the subject-matter of claim 1 was found not to be novel. Document (1), which constituted state of the art pursuant to Article 54(3) EPC, disclosed particularly in example 7 a pressure sensitive adhesive composition identical to the claimed invention, since that composition comprised the same components and was

manufactured essentially according to the same preparation process. Although documents (2) and (3) referred to film-forming coatings, the products described in those documents were identical to the claimed compositions; therefore documents (2) and (3) also anticipated the subject-matter claimed.

IV. In the Statement of Grounds of appeal submitted on 12 September 1994, the Appellant defended the maintenance of the patent in suit in amended form on the basis of a first set of thirteen use claims for the Contracting States AT, BE, CH, DE, FR, GB, IT, LI, LU, NL and SE, the sole independent claim 1 reading as follows:

"1. Use of a composition containing an emulsion polymer and, optionally, tackifiers, dyes, leveling agents, pigments or other pressure sensitive adhesive formulation ingredients as a pressure-sensitive adhesive, characterized by the emulsion polymer being prepared by combining, in an agitated reaction vessel, an alkali-soluble or an alkali-dispersible polymeric resin with water and an effective amount of an alkaline material for forming either a resin-containing alkaline solution or a resin containing alkaline dispersion, wherein at least 6 weight percent up to 30 weight percent of the polymeric resin is prepared from monomers selected from the group consisting of a polymerizable carboxylic acid, a polymerizable acid anhydride, and a polymerizable ester or a polymerizable partial ester of an inorganic acid, and wherein the polymer resin further includes a polymerizable vinyl monomer selected from the group consisting of acrylic acid esters and derivatives thereof, methacrylic acid

esters and derivatives thereof, styrene, alpha-methyl styrene, vinyl toluene, and combinations thereof, but does not include the acrylic or methacrylic esters of polyalkylene oxide;

subjecting the agitated reaction vessel contents to an inert atmosphere and maintaining the agitated reaction vessel contents at a predetermined reaction temperature;

adding to the agitated reaction vessel a portion of an emulsion-polymerizable monomer mixture and thereafter adding an effective amount of an initiator for initiating emulsion-polymerization of the emulsion-polymerizable monomer mixture in the presence of the polymeric resin, wherein at least 40 weight percent of the emulsion-polymerizable monomer mixture consists of at least one alkylacrylate monomer having an alkyl group with from 2 to 20 carbon atoms and the monomer mixture may contain one or more of styrene, alpha-methyl styrene, tetraethylene glycol diacrylate, hydroxyethyl methacrylate, methyl methacrylate, propyl methacrylate, hexyl methacrylate, vinyl acetate and combinations thereof:

then adding to the agitated reaction vessel, over a time period of at least 1/2 hour, the remainder of the emulsion-polymerizable monomer mixture; and

thereafter, maintaining the agitated reaction vessel contents at the predetermined reaction temperature for a time period of at least 1/2 hour, for producing a polymer emulsion that can be utilized as a pressure-sensitive adhesive."

A second set of thirteen use claims for the Contracting States ES and GR was identical to that for the other Contracting States apart from the absence of the

disclaimer "but does not include the acrylic or methacrylic esters of polyalkylene oxide" in claim 1.

- V. The **Appellant** submitted that the disclaimer in claim 1 for the designated Contracting States other than ES and GR, disclaiming the presence of acrylic or methacrylic esters of polyalkylene oxide in the alkali dispersible polymeric resin, delimited the subject-matter claimed from document (1), which constituted state of the art only under Article 54(3) EPC and only in respect of the designated Contracting States other than ES and GR. The compositions of comparative examples 7 and 9, objected to by the Respondent, did not anticipate the subject-matter claimed since they were not suitable as pressure sensitive adhesives due to the absence of tack and exceeded the upper limit of 30 weight percent of polymerizable carboxylic acid in the polymeric resin as defined in claim 1 of the present invention.

Document (2) related to polymer emulsions for use as film coatings for metal or glass surfaces and document (3) related to aqueous base coatings for paper substrates. The claimed use as pressure sensitive adhesives was different compared to that.

- VI. The **Respondent** submitted that document (1) destroyed the novelty of use claim 1. The compositions of that document were used as a pressure sensitive adhesive. The comparative examples 7 and 9 disclosed compositions which were prepared in the presence of polymeric resins not including (meth)acrylic esters of polyalkylene oxide; those compositions, however, were covered by claim 1 of the present invention.

VII. The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of a first set of thirteen claims submitted on 12 September 1994 with the grounds of appeal for the designated Contracting States other than ES and GR, and a second set of thirteen claims for the Contracting States ES and GR submitted on the same date. Auxiliarily the Appellant requested that oral proceedings be held.

The Respondent requested that a decision be taken according to the state of the file.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments (Article 123(2) and (3) EPC)*
 - 2.1 The Respondent raised no objection under Article 123(2) and (3) EPC to the claims as amended and the Board considers that these requirements are indeed satisfied.
 - 2.2 The first amendment to all the claims as granted is their change of category, i.e. the switch from product claims directed to the composition *per se* to use claims directed to the use of the composition as pressure sensitive adhesive. That amendment is supported by claim 1, page 1, lines 1 and 2, and page 8, line 30 to page 9, line 1 of the application as filed.

The second amendment to claim 1 as granted consists in

specifying at least one alkylacrylate to be mandatorily present in the emulsion-polymerizable monomer mixture, which finds support on page 5, lines 29 to 33 and page 6, lines 1 and 2 of the application as filed. Therefore this amendment complies with the requirements of Article 123(2) EPC as well.

The third amendment to claim 1 as granted, insofar as the designated Contracting States other than ES and GR are concerned, is that a disclaimer excludes the presence of acrylic or methacrylic esters of polyalkylene oxide in the alkali dispersible polymeric resin which reflects the subject-matter of document (1) on page 5, lines 1 and 2. The exclusion of this subject-matter which already forms part of the state of the art, does not contravene Article 123(2) EPC, even though the matter is not derivable from the application as filed (cf. decisions T 433/86, point 2 of the reasons, reported in EPOR 1988, 97 to 104, especially page 100; T 192/88, point 4.1 of the reasons; neither published in OJ EPO).

Therefore, all the amendments made to the claims as granted comply with the requirements of Article 123(2) EPC.

- 2.3 The amendment of the claims as granted simply by way of change of category from claims directed to the composition *per se* into claims directed to the use of that composition for a particular purpose, in the present case as a pressure sensitive adhesive, is not open to objection under Article 123(3) EPC (see decision G 2/88, OJ EPO 1990, 93, point 5 of the reasons and point (ii) of the order). The second and

third amendment of claim 1 as granted bring about a restriction of the scope of the claims, and thus of the protection conferred thereby, which is in keeping with the requirements of Article 123(3) EPC.

3. *Novelty*

The only substantial issue arising from this appeal is whether or not the subject-matter claimed is novel over the state of the art.

- 3.1 Document (1) has a priority date earlier than the priority date of the patent in suit, and the Respondent has not contested that the former is entitled to that earlier priority date. Since that document is a European patent application, its content is therefore to be considered as comprised in the state of the art pursuant to Article 54(3) EPC, subject to the requirements of Article 54(4) EPC.

Pursuant to Article 54(4) EPC, Article 54(3) EPC applies only in so far as the Contracting States designated in document (1) were also designated in the patent in suit. Document (1) designates the Contracting States AT, BE, CH, DE, FR, GB, IT, LI, LU, NL and SE, as does the patent in suit. Thus, document (1) is comprised in the state of the art under Article 54(3) EPC for the patent in suit only with respect to those Contracting States. The patent in suit also designates the Contracting States ES and GR, which have not been designated in document (1). Therefore, document (1) does not represent state of the art under Article 54(3) EPC for the patent in suit with respect to the Contracting States ES and GR.

3.2 Document (1) discloses a latex adhesive composition useful as pressure sensitive adhesive (page 1, lines 2 and 3), which is prepared by polymerizing a (meth)acrylate monomer in the presence of a polymeric colloid. That polymeric colloid, called polymeric resin in claim 1 of the patent in suit, mandatorily comprises acrylic or methacrylic esters of polyalkylene oxide according to page 5, lines 1 and 2 and claim 1 of document (1).

This leads the Board to observe that claim 1 for all the Contracting States designated in the patent in suit except ES and GR disclaims the presence of acrylic or methacrylic esters of polyalkylene oxide in the polymeric resin. Thus, that disclaimer in claim 1 delimits the claimed subject-matter from the teaching of document (1). The Respondent has not contested this finding.

The Respondent argued, however, that the comparative examples 7 and 9 of document (1) disclosed compositions which were prepared in the presence of polymeric resins not including (meth)acrylic esters of polyalkylene oxide; those compositions were not excised by the disclaimer and were thus still covered by claim 1.

However, the polymeric resin of comparative example 7 comprises 34 weight percent of acrylic acid according to page 15, line 8 of document (1), and the polymeric resin of comparative example 9, which is the commercial product "Joncryl 678", comprises 31 weight percent acrylic acid according to page 7, paragraph 2, line 3 of the data submitted with Appellant's letter dated 15 June 1993 in opposition proceedings. This was not

contested by the Respondent. The amount of acrylic acid in the polymeric resin of both comparative examples exceeds the upper limit of 30 weight percent indicated in claim 1 of the patent in suit, distinguishing thereby the claimed subject-matter from the disclosure of those comparative examples.

In addition, the compositions prepared in comparative examples 7 and 9 were not suitable for use as an adhesive, since no tack (page 15, line 16) and very low subjective tack (page 17, lines 10 and 11) were observed respectively. Therefore, neither comparative example discloses the use of those compositions as a pressure sensitive adhesive, a technical feature required in use claim 1 of the patent in suit. Thus, comparative examples 7 and 9 cannot destroy the novelty of the subject-matter claimed.

3.3 For the reasons given above, the Respondent's arguments are not convincing and, in the Board's judgement, document (1) neither anticipates the subject-matter of claim 1 in the form requested for all the Contracting States designated in the patent in suit except ES and GR nor in the form requested for the designated Contracting States ES and GR.

3.4 Document (2) is directed to coating compositions for use as film coatings for metal and glass surfaces (column 1, lines 6 to 9). That document reports that the use of those coating compositions results in hard and glossy film coatings (column 5, lines 34 and 35, column 6, lines 29 and 52, column 6, line 4, column 7, lines 50 and 51, column 8, lines 18 and 19, column 9, lines 62 to 64, column 10, lines 13 to 15 and 33 to 35,

column 11, lines 19 to 22, and column 12, lines 13 to 16, 40 and 41).

However, the use of those coating compositions as film coatings disclosed in document (2) is different to that indicated in use claim 1, i.e. use as a pressure sensitive adhesive. Nor does that document report that the coating compositions are tacky, the property the compositions must necessarily show in order to be suitable as pressure sensitive adhesive; rather, the resulting film coatings show the opposite properties of hardness and gloss.

Thus, document (2) does not disclose the technical feature of using the compositions as a pressure sensitive adhesive, which is required in use claim 1 of the patent in suit. Therefore, that document does not anticipate the subject-matter of claim 1 either.

- 3.5 Document (3), is directed to aqueous base coatings for use on a paper to be vacuum metallized (page 1, lines 1 and 2). Those coatings are characterized particularly by the desirable property of good to excellent block resistance (page 5, lines 20 to 23, page 17, lines 35 to 36, page 18, lines 11 to 12), which is supported by experimental data in Tables I and II.

However, that document neither discloses the use of those base coatings as pressure sensitive adhesive, nor reports the base coatings to be tacky, the property necessary for being suitable as pressure sensitive adhesive. Quite the reverse; the base coatings disclosed in document (3) show high block resistance, which is defined as resistance to adhesion between coated and uncoated surfaces under moderate pressure or under pressure and heat (page 2, lines 9 to 11, page 10, line 16 to page 11, line 6). Thus, high block resistance, i.e. not sticking together, is the opposite to tack, disqualifying therefore the base coatings of that document from being used as pressure sensitive adhesives.

Since the base coatings of document (3) are unsuited for use as pressure sensitive adhesive, that technical feature required in use claim 1 of the patent in suit lacks disclosure in that document with the consequence that it does not anticipate the subject-matter of that claim.

3.6 For these reasons, the Board concludes that the subject-matter of claim 1, and by the same token, that of dependent claims 2 to 13 are novel and meet the requirements of Articles 52(1) and 54 EPC.

4. *Remittal*

Having so decided, the Board has not taken a decision on the whole matter since the Opposition Division has ruled solely on the issue of novelty and has not yet concluded the examination of whether, taking into consideration the amendments made, the patent and the

invention to which it relates meet the other requirements of the European Patent Convention as required by Article 102(3) EPC. Under these circumstances the Board considers it appropriate to exercise the power conferred on it by Article 111(1) EPC to remit the case to the Opposition Division for further prosecution on the basis of the two sets of claims 1 to 13 as amended, in order to enable the first instance to decide on the outstanding issues.

5. In the light of the above findings, it is not necessary to consider the Appellant's auxiliary request for oral proceedings.

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 a first set of claims 1 to 13 submitted on 12 September 1994 for the designated Contracting States other than ES and GR, and a second set of claims 1 to 13 for the Contracting States ES and GR submitted on the same date.

The Registrar:

The Chairman:

E. Görgmaier

J. Jonk