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**Datasheet for the decision
of 15 September 2015**

Case Number: T 1001/14 - 3.3.09

Application Number: 04718821.4

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IPC: B32B7/04, C09J7/02, C09J11/08

Language of the proceedings: EN

Title of invention:
REUSABLE CLOSURES FOR PACKAGES AND METHODS OF MAKING AND USING
THE SAME

Applicant:
AVERY DENNISON CORPORATION

Headword:

Relevant legal provisions:
EPC Art. 56, 123(2)

Keyword:
Main request: added subject-matter (yes)
Auxiliary request 1: added subject-matter (yes)
Auxiliary requests 2 and 3: inventive step (no)

Decisions cited:
G 0001/93, T 0860/00, T 1041/07

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1001/14 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 15 September 2015

Appellant: AVERY DENNISON CORPORATION
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Representative: Müller-Boré & Partner
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Decision under appeal: **Decision of the Examining Division posted on
29 November 2013 refusing European patent
application No. 04718821.4 pursuant to
Article 97(2) EPC.**

Composition of the Board:

Chairman J. Jardón Álvarez
Members: N. Perakis
F. Blumer

Summary of Facts and Submissions

- I. This appeal lies from the decision of the examining division, taken on the basis of the file as it stands, refusing European patent application No. 04 718 821.4. This decision was taken on the basis of the reasoning set out in the communications of 20 October 2010 and 21 March 2013 and concerned the set of claims filed with letter of 20 April 2011.
- II. The examining division considered that the subject-matter of the claims extended beyond the content of the application as filed, that it lacked clarity and that the application did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Concerning novelty and inventive step, the examining division noted that a full assessment had to be postponed until an amended set of claims was provided by the applicant, and referred to the following documents:
- D5: WO 99/20709 A1; and
D6: US 5 290 842 A.
- III. The applicant (in the following: the appellant) filed an appeal on 22 January 2014 and paid the appeal fee on the same day. The statement setting out the grounds of appeal was filed on 9 April 2014, accompanied by two sets of claims corresponding to a main and an auxiliary request. The appellant requested that the decision of the examining division be set aside and that a patent be granted on the basis of the main or the auxiliary request. Regarding the issues of novelty and inventive step, the appellant made reference to the documents cited in Supplementary Partial European Search Report including *inter alia* D7:

D7: DE 38 05 223 A1.

- IV. With the summons to oral proceedings issued on 31 March 2015 the board gave its preliminary view on clarity and added subject-matter of the appellant's requests.
- V. By letter of 27 May 2015, the appellant submitted a new main and a new auxiliary request. The appellant also made reference to the documents cited in the patent application regarding the method of measuring the softening point of the tackifier component, namely:
- D13: US 3 577 398 A; and
D14: US 3 692 756 A.
- VI. By a communication faxed on 8 September 2015 the board commented on the inventive step of the requests in view of the disclosure of D6 and D7.
- VII. By letter of 10 September 2015 the appellant filed additional auxiliary requests, namely auxiliary requests 2 and 3.
- VIII. Oral proceedings took place before the board on 15 September 2015.
- IX. Claim 1 of each of the appellant's requests reads as follows:

Main request

"1. An adhesive article comprising (a) a moisture resistant substrate having a first and second surface, (b) a removable and resealable adhesive adhered to at least a first portion of the first surface of the

substrate and (c) a permanent adhesive adhered to a second portion of the first surface of the substrate; wherein the removable and resealable adhesive has a Moist Loop Test (Finat Test Method, FTM9) result of at least 0.25 N/25mm at a test plate temperature of 5°C, wherein the removable and resealable adhesive comprises a pressure-sensitive adhesive comprising:

- (a) a first elastomer selected from the group consisting of a styrene-butadiene block copolymer, a styrene-butadiene-styrene block copolymer and mixtures thereof, the first elastomer exhibiting a first glass transition temperature and a first value of tangent delta measured as a function of temperature;
- (b) a second elastomer selected from the group consisting of styrene-isoprene-styrene block copolymers, styrene-isoprene block copolymers, multiarmed styrene-isoprene block copolymers and mixtures thereof, said second elastomer exhibiting a second glass transition temperature greater than the first glass transition temperature and a second value of tangent delta measured as function of temperature, the second elastomer being immiscible in the first elastomer, said **first and second elastomers provided in proportions of 0.5:1 to 5:1** and in which a dynamic mechanical spectrum plot of tangent delta as a function of temperature exhibits a polybutadiene-attributable first glass transition temperature peak determinable separate from and lower than polyisoprene-attributable second glass transition temperature peak; and
- (c) a tackifying system comprising a tackifying component having **a softening point of 95°C measured according to ASTM E28-58T** and obtained by polymerization of a stream solely composed of aliphatic petroleum derivatives in the form of dienes and monoolefins containing 5 to 6 carbon atoms, said tackifying component being preferentially miscible with

the polyisoprene blocks of the second elastomer and present in an amount of from 50 percent to 70 percent by weight of the elastomers and tackifying system and sufficient to cause an increase in the second glass transition temperature and an increase in the temperature difference between the polybutadiene-attributable glass transition peak and the polyisoprene-attributable glass transition peak and an increase in the tangent delta value attributed to the polyisoprene-attributable peak".

(highlighted by the board)

Auxiliary request 1

Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that the first and second elastomers is provided in proportions of 1:1 to 1.5:1.

Auxiliary request 2

Claim 1 of auxiliary request 2 differs from claim 1 of auxiliary request 1 in that the method for measuring the softening pint of the tackifying system, namely measured according to ASTM E28-58T, has been deleted.

Auxiliary request 3

Claim 1 of auxiliary request 3 differs from claim 1 of auxiliary request 2 in that the permanent adhesive is structurally defined, namely to comprise "a pressure sensitive adhesive (PSA), said pressure sensitive adhesive including a rubber based adhesive, an acrylic adhesive, a vinyl ether adhesive, a silicone adhesive, or mixtures of two or more thereof."

- X. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims according to the main request, filed with letter dated 27 May 2015, alternatively on the basis of

the claims according to one of auxiliary requests 1 to 3, auxiliary request 1 filed with letter of 27 May 2015 and auxiliary requests 2 and 3 filed with letter of 10 September 2015.

XI. The arguments presented by the appellant in its written submissions and at the oral proceedings may be summarised as follows:

- Claim 1 of both the main request and auxiliary request 1 complied with the requirements of Article 123(2) EPC. Although the method for measuring the softening point of the tackifying system according ASTM E28-58T was not explicitly disclosed in the patent application, it was implicitly disclosed therein in view of the two citations cited in the patent application as incorporated by reference, namely D13 and D14, and in view of the exemplified tackifier additives disclosed on page 14, lines 13-17. This method was directly and unambiguously derivable from the application as filed in conformity with the case law (see T 0860/00 and T 1041/07). Furthermore, the insertion of this method into claim 1 did not give the patent proprietor any unwarranted advantage and did not damage the legal security of third parties as set out in G 0001/93.

- Regarding the subject-matter of claim 1 of auxiliary request 2, it involved an inventive step. D6 was considered to represent the closest prior art, and the subject-matter of claim 1 differed from the disclosure of D6 only in that the adhesive article comprised a permanent adhesive. The technical problem underlying the subject-matter of claim 1 in view of D6 was the

provision of an adhesive article which acted to attach or anchor the substrate to the container (page 4, lines 8-10; page 17, lines 29-30 of the application as filed). The solution was provided by the subject-matter of claim 1, which combined (i) a removable and resealable adhesive with (ii) a permanent adhesive adhered to the substrate, the permanent adhesive being different from the removable and resealable adhesive. The skilled person looking for a solution to the technical problem would not find in the prior art any hint towards the claimed subject-matter. On the one hand, D6 dealt with the problem of PSAs with excellent ability to achieve cutting of the adhesive additives in processing operations involving cutting through a face stock and adhesive to at least the release liner of the laminate. Furthermore, D6 did not disclose any permanent adhesive. On the other hand, D7 disclosed contact adhesive sheet-like structures residuelessly redetachable and readherable to a substrate, which did not deform or damage the substrate. Preferably the substrate had both removable and permanent adhesion sites. Thus the prior art did not disclose the use on a substrate of two different adhesives, one permanent and the other removable and resealable.

- The same reasoning applied to the subject-matter of claim 1 of auxiliary request 3, which defined the permanent adhesive in structural terms.

Reasons for the Decision

1. Main request

- 1.1 Claim 1 of the main request filed with letter of 27 May 2015 as a reaction to the communication of the board, was so amended that it comprised the feature "a tackifying component having a softening point of 95°C measured according to ASTM E28-58T".
- 1.2 The appellant acknowledged that this feature was not disclosed in the application as filed. The argument of the appellant was, however, that this feature was implicitly disclosed in the application as filed since it was disclosed in documents D13 and D14 cited in the application and incorporated therein by reference (see page 14, lines 8 and 9).
- 1.3 No doubt, D13 and D14 disclosed the above-mentioned feature (see D13: column 2, lines 60-63 and column 3, lines 56-58; D14: column 2, lines 4-8; sentence bridging columns 4/5 and column 6, lines 34-35). Nevertheless, the citation of D13 and D14 in the patent application only related to the manufacture of the tackifier additives of the patent application. Specific reference is made to page 14, lines 5 to 9, which states:

"Tackifier additives for the polyisoprene component are obtained by the polymerization of a stream of aliphatic petroleum derivatives in the form of dienes and mono-olefins containing 5 or 6 carbon atoms generally in accordance with the teachings of U.S. Pat. Nos. 3,577,398 to Pace and 3,692,756 to St. Cyr, both of which are incorporated herein by reference".

It is therefore concluded that, on the one hand, this disclosure refers to D13 and D14 only "generally" and, on the other hand, it concerns the manufacturing method of the tackifier additives. Thus, contrary to the assertions of the appellant, the incorporation by reference to D13 and D14 in the application is restrictive. It is not construed to concern every piece of information these documents may contain.

1.4 Additionally, contrary to the assertions of the appellant, there is no disclosure in the application as filed on the basis of which the contested feature would be considered as directly and unambiguously derivable. Decisions T 0860/00 and T 1041/07, to which the appellant made reference, are irrelevant, since they have nothing to do with the present legal situation. They relate to the implicit combination of features cited in the application as filed and to the implicit disclosure of generic terms (see T 0860/00, point 1 of the reasons, and T 1041/07, points 3.4.2 and 3.5 of the reasons).

1.5 Even G 0001/93 (see point 9 of the reasons) does not provide any legal support to the allegations of the appellant. This decision stipulates that no amendment should be allowed that would improve the position of an applicant by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application. In the present case, the addition of the contested feature certainly would improve the position of the appellant/applicant by allowing him to overcome a clarity objection by adding information not clearly and unambiguously disclosed in the application as filed, giving him an unwarranted

advantage and damaging the legal security of third parties.

- 1.6 In view of the above, claim 1 does not comply with the requirements of Article 123(2) EPC, and the main request is not allowable.

2. Auxiliary request 1

Claim 1 of auxiliary request 1, which also incorporates the feature of measuring the softening point of the tackifying system according to ASTM E28-58T, does not comply with the requirements of Article 123(2) EPC for the reasons given for the main request. Thus, this request also is not allowable.

3. Auxiliary request 2

- 3.1 Claim 1 of this request does not incorporate the contested feature of the hierarchically higher requests, and therefore the objection under Article 123(2) EPC set out above does not apply.

- 3.2 The board concurs with the appellant that the subject-matter of claim 1 is novel over the cited prior art.

- 3.3 Inventive step

- 3.3.1 Closest prior art

The board agrees with the appellant that D6, which relates to PSAs for adhesive articles, such as labels and tapes, and to their excellent adhesive properties at both ambient and reduced temperature, represents the closest prior-art document (see column 1, lines 11-13; column 2, lines 57-65). More concretely, D6 discloses

adhesive articles with a substrate and a removable and resealable adhesive, this adhesive comprising:

- a first elastomer,
- a second elastomer and
- a tackifying system

(see claims 2 and 12).

This adhesive is the removable resealable adhesive used in the application (see page 12, line 17). It is remarked that, even if D6 does not explicitly disclose that the removable resealable adhesive has a Moist Loop Test (Finat Test Method FTM9) result of at least 0.25 N/25mm at a test plate temperature of 5°C, this is an inherent property of the disclosed removable and resealable adhesive. The appellant did not contest this interpretation of the teaching of D6 during the oral proceedings before the board.

The subject-matter of claim 1 differs from D6 only in that the adhesive article also comprises a permanent adhesive.

3.3.2 Problem and solution

The appellant defined on page 11 of its statement of grounds of appeal the technical problem underlying the invention of claim 1 in view of the teaching of D6 as "to provide an adhesive article that provides resealing capabilities on packages stored at low temperatures, particularly for packages stored in refrigerators and freezers, wherein in addition the substrate of the adhesive article is anchored to the container". The board concurs with the appellant and acknowledges that this is the problem recited in the patent application (page 2, lines 5-7; page 4, lines 8-10).

There is no doubt that this problem has effectively been solved. The patent application discloses many permanent adhesives which attach or anchor the substrate to the container (page 19, line 8 to page 30, line 17).

3.3.3 Obviousness

The skilled person starting from D6 and aiming at a solution to this problem would find in D7 the motivation to provide an adhesive article with both a removable/resealable adhesive and a permanent adhesive.

D7 relates to adhesive articles used as reversible closures for bags and diapers, these articles comprising a substrate such as paper, foil, fleece, tissue or woven, having a portion which attaches strongly/permanently on the diaper or bag and another portion which is removable and resealable (column 4, lines 6-8; column 5, line 53 to column 6, line 8). The permanent and removable/resealable portions of the adhesive article are manufactured by using the same adhesive resin, whereby the difference in the attachment strength is monitored by the number of the attachment regions on the substrate (column 3, lines 25-34).

In this context, it is remarked that the permanent adhesive of claim 1 is defined in functional terms. From a chemical point of view, it is not necessarily different from the removable and resealable adhesive of this claim. Reference is made to the patent application (page 24, lines 11-15; page 27, lines 7-17; page 28, lines 28-30), which discloses that the most preferred permanent adhesives are PSAs including rubber based adhesives, the definition of which encompasses the PSAs

used as removable and releasable adhesives in the patent application.

In view of the disclosure of D7 the skilled person would obviously combine it with D6 and would arrive at the claimed subject-matter without the exercise of inventive step.

3.4 As claim 1 lacks an inventive step, auxiliary request 2 is not allowable.

4. Auxiliary request 3

4.1 Claim 1 of this request differs from claim 1 of auxiliary request 2 only in that the permanent adhesive is structurally defined, namely that it comprises a pressure sensitive adhesive (PSA), said pressure sensitive adhesive including a rubber based adhesive, an acrylic adhesive, a vinyl ether adhesive, a silicone adhesive, or mixtures of two or more thereof.

4.2 As already set out above regarding claim 1 of auxiliary request 2, this more specific definition of the permanent adhesive still comprises PSAs which are rubber based adhesives. According to the description, such PSAs encompass adhesive compositions which cannot be distinguished from the removable and resealable adhesive composition. In this case the subject-matter of claim 1 of auxiliary request 3 lacks an inventive step in view of the obvious combination of D6 with D7 as put forward above.

4.3 Consequently, auxiliary request 3 is not allowable either.

5. In view of the outcome regarding the issue of inventive step, it is not necessary to elaborate on the issues under Articles 123(2) and 84 EPC regarding claim 1 of auxiliary requests 2 and 3.
6. Since none of the requests is allowable, the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Cañueto Carbajo

J. Jardón Álvarez

Decision electronically authenticated