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**Datasheet for the decision  
of 10 January 2020**

**Case Number:** T 1965/17 - 3.3.03

**Application Number:** 13195047.9

**Publication Number:** 2878606

**IPC:** C08F220/28

**Language of the proceedings:** EN

**Title of invention:**

UV-curable composition and pressure sensitive adhesive having breathability derived therefrom, as well as method for manufacturing the same

**Patent Proprietor:**

ICAP-SIRA S.p.A.

**Opponent:**

Henkel AG & Co. KGaA

**Relevant legal provisions:**

EPC Art. 54, 56, 83, 99(1), 114(1)

**Keyword:**

Novelty - main request (yes)

Late submitted ground of opposition - admitted (no) - not  
prima facie highly relevant

Inventive step - (yes) - closest state of the art - none of  
teachings invoked suitable - main request

Late filed ground - not admitted - correct exercise of  
discretion - (yes)

**Decisions cited:**

G 0010/91, G 0007/93, T 0835/00, T 0640/91, T 1002/92



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Case Number: T 1965/17 - 3.3.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.03**  
**of 10 January 2020**

**Appellant:** Henkel AG & Co. KGaA  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 24 July 2017  
rejecting the opposition filed against European  
patent No. 2878606 pursuant to Article 101(2)  
EPC.**

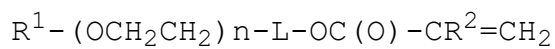
**Composition of the Board:**

**Chairman** D. Marquis  
**Members:** M. C. Gordon  
R. Cramer

## Summary of Facts and Submissions

- I. The appeal of the opponent lies from the decision of the opposition division posted on 24 July 2017 rejecting the opposition against European patent number 2 878 606.
- II. The patent was granted with a set of 13 claims whereby claim 1 read as follows:

"A polymerizable composition, comprising  
(a) a polymerizable monomer of formula (I),  
(b) a copolymerizable UV-initiator,  
(c) at least one copolymerizable (meth)acrylic monomer,  
Formula (I):



wherein  $R^1$  is hydrogen or a  $C_1$ - $C_6$  alkyl group,  $n$  is an integer from 2 to 100,  $L$  is a single bond or a divalent linking group, preferably a single bond or a  $C_1$ - $C_6$  alkylene group, and  $R^2$  is hydrogen or a  $CH_3$  group; and

optionally (d) at least one copolymerizable non-acrylate monomer;

wherein the amount of the polymerizable monomer of formula (I) is between 2.5 and 40 % by weight of the total of all polymerizable monomers (a), (b), (c) and (d)."

Claims 2-5 were directed to preferred embodiments of the composition of claim 1. Claim 6 was directed to the resulting random copolymer. Claims 7-12 were directed to compositions/composites comprising the polymer of claim 6, a method for preparation thereof and the use

thereof.

Claim 13 was directed to the use of the subject-matter of any of claims 1-5 (composition), claim 6 (random copolymer), claim 7 (solvent based adhesive composition), claims 8, 9 (cross-linked product) for forming adhesive tape or sheet, wound dressing or first aid dressing.

- III. A notice of opposition against the patent was filed in which revocation of the patent on the grounds of Article 100(a) EPC (lack of novelty, lack of inventive step) and Article 100(b) EPC was requested.

*Inter alia* the following documents were cited in support of the opposition:

D1: US-A-2005/0192370.

D11: US-A-5 849 325

- IV. The decision of the opposition division was based on the claims of the patent as granted.
- V. According to the decision the opposition ground of Article 100(c) EPC, raised by the opponent for the first time at the oral proceedings, was not admitted.

Novelty was acknowledged since a plurality of selections from D1 was required in order to arrive at the subject-matter claimed.

The composition of example 1 of D1 was held to represent the closest prior art. The examples of the patent provided evidence for a technical effect, which was considered not to be obvious.

An argument, raised by the opponent for the first time at the oral proceedings, that the closest prior art was not in fact the main teaching of D1 but the adhesive employed in the examples thereof was dismissed.

Accordingly the opposition was rejected.

VI. The appellant (opponent) filed an appeal.

In the statement of grounds of appeal objections in respect of novelty, inventive step and sufficiency of disclosure were pursued.

The ground pursuant to Article 100(c) EPC was further invoked.

Further documents, designated D2a, D11 and D12 were submitted. However it is not necessary for the purposes of this decision to comment further on these.

VII. The respondent (patent proprietor) replied.

VIII. The Board issued a summons to oral proceedings and a communication.

IX. With letter dated 10 December 2019 the respondent addressed matters raised by the Board and filed nine sets of claims as auxiliary requests, the details of which are not of relevance to this decision.

X. Oral proceedings were held before the Board on 10 January 2020.

XI. The arguments of the appellant can be summarised as follows:

- (a) Status of the objection under the ground of opposition pursuant to Article 100(c) EPC

The opposition division had wrongly exercised its discretion not to admit the objection.

In the light of the detailed considerations and analysis reported in the decision it should have been concluded that the ground was *prima facie* highly relevant to the extent that it prejudiced maintenance of the patent.

- (b) Sufficiency of disclosure

The definitions of components (a) and (c) overlapped which was a clarity issue but also resulted in a deficiency with respect to sufficiency of disclosure since the claimed scope was not commensurate with the contribution of the patent to the art. The patent did not enable the skilled person to practice the claimed invention over the whole scope of the claim.

- (c) Novelty

Contrary to the decision, it was not necessary to make multiple selections from the disclosure of D1 to arrive at a disclosure of the claimed subject-matter. All concrete compounds disclosed as preferred and used in the examples of D1 fell within the requirements of claim 1. The only difference between the examples of D1 and claim 1 was the amount of monomer (a). However D1 disclosed a range which overlapped with that claimed. Consequently the subject-matter claimed was disclosed in D1.

(d) Inventive step - closest prior art

D1 was the relevant document, which contained two separate teachings, each of which could serve as the closest prior art, i.e. the starting point for the analysis of inventive step.

The patent was directed to a polymerisable composition, not a UV curable pressure sensitive adhesive - contrary to the findings of the decision. Hence a broader understanding of the closest prior art could be employed.

The examples 1A-1F of D1 were relevant. The compositions thereof broadly satisfied the structural requirements of the claims. The fact that D1 was directed to the provision of hydrophilic gels for wound dressings and not to adhesives was immaterial. D1 taught in paragraph [0021] that such gels could also serve as adhesives, in particular pressure sensitive adhesives and properties of such adhesives were discussed in the following paragraph.

A second potential starting point was paragraph [0129] of D1 which related to an adhesive, although it was not stated that this was crosslinked or UV-crosslinkable. However the required monomers were disclosed here and it would be possible to employ a UV initiator monomer therewith.

XII. The arguments of the respondent can be summarised as follows:

- (a) Status of the objection under the ground of opposition pursuant to Article 100(c) EPC



The decision explicitly stated that the objection was not admitted to the procedure.

This was a discretionary decision of the opposition division, which was the result of an analysis concluding that the ground was not *prima facie* relevant and hence was not admitted to the procedure.

The Opposition Division had applied the correct criteria in reaching this decision. Thus the Board had no power to overturn this discretionary decision with the consequence that Article 100(c) EPC was not part of the appeal proceedings.

(b) Sufficiency of disclosure

The objections - insofar as they could be understood - appeared to relate to the breadth of the claims or to speculation that embodiments which were not exemplified would not permit the required result to be achieved.

These objections were unsupported by data or facts and consequently had no merit. In any case it appeared that the objections were in reality in respect of lack of support pursuant to Article 84 EPC, which was not applicable to the claims of the patent as granted.

(c) Novelty

D1 disclosed certain compounds which fell under the scope of the components specified in the claims, however the required proportions thereof were not

derivable from D1. Furthermore the patent in suit was directed to polymerisable compositions containing certain monomers and to the resulting random copolymer. D1 related to oligomers and the copolymers derived therefrom which were necessarily block copolymers, not random copolymers.

The example of D1 related to a composition wherein the content of monomer of formula (I) of the operative claim was at an amount of 62% and thus outside the claimed range. The approach of the appellant, relying on this example and then seeking to adjust the proportions of components to arrive at the subject-matter claimed was the result of a hindsight approach, not based on the teachings of D1.

(d) Inventive step - closest prior art

The patent was directed to the provision of UV curable pressure sensitive adhesives in particular for the medical field, e.g. wound dressings.

The invention of D1 was directed to the provision of a hydrophilic gel for wound dressings which was a different problem to that of the patent. The composition of D1 was not required to be adhesive. Indeed adhesiveness was undesirable for said products since the composition was intended to be in direct contact with a wound.

Despite certain similarities in the constitution of the composition, as discussed in respect of novelty, the skilled person seeking to provide adhesives would have had no reason to consult D1.

The argument of the appellant relying on modification of the compositions of D1 was based on a hindsight approach, which departed from and disregarded the explicit teaching.

Accordingly this aspect of D1 was not suitable to serve as closest prior art.

Regarding the discussion of the adhesive to be used in paragraph [0129], D1 provided only minimal information. It was not stated whether this adhesive was breathable or UV crosslinkable. The question was not what would have been understood by the skilled person as inherent but what was directly disclosed (following G 1/92, OJ EPO 1993, 277).

Consequently this aspect of the teaching of D1 was also not suitable to serve as closest prior art.

- XIII. The appellant requested that the decision under appeal be set aside and that the patent be revoked. It further requested the admittance of documents D2a, D11 and D12.
- XIV. The respondent requested that the appeal be dismissed, or alternatively that the decision under appeal be set aside and the patent be maintained in amended form on the basis of one of the sets of claims according to the first to ninth auxiliary requests, filed with the letter of 10 December 2019. It further requested that documents D2a, D11 and D12, and the inventive step objection based on paragraph 129 of document D1, not be admitted into the proceedings.

## Reasons for the Decision

1. Status of the objection pursuant to Article 100(c) EPC and the discretionary decision of the opposition division not to admit this to the procedure.
  - 1.1 The objection had not been raised during the nine month opposition period, but was invoked for the first time at the oral proceedings before the opposition division. The appellant conceded that this objection had been filed "late" i.e. beyond the time limit stipulated in Article 99(1) EPC.
  - 1.2 The Opposition division carried out a detailed analysis of the arguments advanced and concluded that the ground was not *prima facie* relevant so as to prejudice maintenance of the patent. Consequently it was not admitted to the procedure.
  - 1.3 Admittance of such objections is a matter for the discretion of the opposition division - Article 114(1) EPC as explained in G 10/91, section 16 of the reasons (OJ EPO 1993, 420). This can occur when, *prima facie* there are clear reasons to believe that such grounds are relevant (G 10/91 Headnote, 2; Opinion, 2). The meaning of "*prima facie*" is not elucidated in G 10/91. However in section 3.3 of the reasons of decision T 1002/92 (OJ EPO 1995, 605) it is stated that newly filed material submitted in opposition proceedings "should only exceptionally be admitted if, *prima facie* there are clear reasons to suspect....would prejudice the maintenance of the European Patent".
  - 1.4 According to the established case law, in particular decision G 7/93 (OJ EPO 1994, 775), point 2.6 of the reasons, Boards of Appeal should only overturn

discretionary decisions of the first instance if it is concluded that the first instance exercised its discretion according to the wrong principles, or without taking into account the right principles or in an unreasonable way. In particular it is not the function of a board to review all the facts and circumstances of the case as if it were the first instance department. See also T 640/91 (OJ EPO 1994, 918) section 6.3 of the reasons.

- 1.5 The meaning of "right" or "incorrect" principles is not defined in G 7/93 or T 640/91. However with reference to T 1002/92, *infra*, it can be inferred that this relates to the question of whether the new objection is *prima facie* highly relevant.
- 1.6 In the present case it is apparent that the Opposition Division carried out an analysis of the *prima facie* relevance of the objection with reference to the claims of the patent as granted and the claims and description of the application as originally filed, which are the basis for an assessment of compliance with the requirements of Article 123(2) EPC.
- 1.7 The Board is satisfied that the analysis carried out by the opposition division, reported in section 3 of the decision; demonstrates that the correct principles were applied. The appellant has not disputed this, but takes issue with the conclusion reached.
- 1.8 Furthermore the Board does not consider that the opposition division exercised its discretion in an "unreasonable" manner. On the contrary, it is apparent from the decision that careful consideration of the relevant aspects (amended claims, application as filed)

was carried out.

- 1.9 The consequence of the foregoing is that the Board sees no reason to overturn the discretionary decision of the opposition division not to admit the late filed ground of opposition pursuant to Article 100(c) EPC to the procedure.

Consequently Article 100(c) EPC does not form part of the present appeal proceedings.

2. Sufficiency of disclosure

Claim 1 of the main request concerns a polymerizable composition, comprising (a) a polymerizable monomer of formula (I), (b) a copolymerizable UV-initiator, (c) at least one copolymerizable (meth)acrylic monomer, optionally (d) at least one copolymerizable non-acrylate monomer; wherein the amount of the polymerizable monomer of formula (I) is between 2.5 and 40 % by weight of the total of all polymerizable monomers (a), (b), (c) and (d).

With respect to sufficiency of disclosure, the relevant question is whether the skilled person would have been able to prepare the polymerizable composition of claim 1 according to the main request.

In the statement of grounds of appeal, the appellant raised objections which it seems are acknowledged to relate to clarity (first 4 lines of section 4 of the statement of grounds of appeal) and not to sufficiency of disclosure.

In the following section of the statement of grounds of appeal it is postulated that the "limited" data **may**

(Board's emphasis) not be sufficient to enable the invention to be put into practice. However no detailed arguments or evidence were advanced to support this position and in particular it was not shown why a skilled person relying on the guidance provided in the patent in suit and the common general knowledge would not have been able to prepare the claimed compositions.

The appellant also argued that the modification in claim 1 of the main request (amendment of  $n=1-100$  in  $n=2-100$  in Formula (I)) allowed embodiments that were disclosed as not achieving the desired object, referring to pages 11 and 12 of the application as filed where it is mentioned that a too high amount of monomer (I) in the composition leads to a reduced adhesion strength of the cross-linked pressure sensitive adhesive. That argument however relates to the question of whether a technical effect was achieved over the whole scope of the claims or not and not to the preparation of the polymerizable compositions according to claim 1 of the main request. It is thus not relevant to the question of sufficiency of disclosure.

Thus the Board can identify no grounds to disagree with the observation of the respondent in the third and fourth paragraphs of section 4 of the rejoinder to the statement of grounds of appeal that the statements of the appellant are mere allegations.

Accordingly the Board can identify no reason to diverge from the findings of the decision in respect of sufficiency.

3. Novelty - D1

Within D1 there are to be found disclosures of oligomers derived from the monomers specified in operative claim 1:

- paragraphs [0008]-[0010] and paragraphs [0027]-[0028] in respect of a compound corresponding generally to component (a);
- paragraph [0035] for the photoinitiator bearing monomer;
- paragraph [0036] for an - optional - ethylenically unsaturated monomer having a pendant polymerisable group corresponding to component (d) and
- paragraph [0037] as an - optional - (meth)acrylic acid ester derived oligomer, corresponding broadly to component (c) of operative claim 1.

D1 however does not provide a disclosure of features of the claim in combination.

With respect to the composition of example 1, disclosed in paragraph [0137] of D1, it appears to be undisputed that the proportions of the components are outside the scope of the claims (ca 60 weight% of component (a)).

The question is whether this disclosure can be combined with further disclosures in the document relating to other amounts of the components.

In this respect it is noted that according to paragraphs [0044] and [0045] of D1 the compound used in the examples is simply one of the possibilities for component (a). The possible amounts thereof are set out in paragraphs [0033]-[0038] whereby for component (a), - bearing pendant hydrophilic poly(alkylene oxide) groups corresponding in general terms to formula (I) of



the operative claim - the amounts given are 20-99 parts by weight, preferably 50-90 parts by weight, neither of which ranges corresponds to the amount of 2.5-40% by weight as specified in the operative claim. Accordingly to arrive at a disclosure of this specific group of compounds in the necessary amount would require at least two selections from the disclosure of D1, regardless of the need to select for the presence of certain other components.

Furthermore D1 relates to the polymerisation of oligomers, not monomers as defined in operative claim 1.

This leads necessarily to the conclusion that a combination of monomers in the proportions as defined in operative claim 1 is not part of the disclosure of D1.

Accordingly novelty is to be acknowledged.

#### 4. Inventive step

4.1 The patent in suit is directed to UV curable compositions and pressure sensitive adhesives (paragraph [0001]). The focus of the patent is on breathable, hot melt adhesives for use in the medical field as set out in paragraphs [0009], [0012] and [0073]-[0075]. The adhesive is a hot melt adhesive and is applied to the substrate in molten form and subjected to cross-linking e.g. by irradiation (paragraphs [0009] and [0015], in particular page 2 lines 35-48).

#### 4.2 Closest state of the art

Two separate aspects of D1 were proposed by the appellant as representing the closest state of the art.

- 4.2.1 The first aspect of D1 invoked is the invention of D1 itself, a hydrophilic gel useful as wound dressing (paragraphs [0001], [0005], [0006], claim 1).

The purpose of this composition is to provide an absorbent material which is attached to an adhesive tape backing (paragraph [0002]). The material is applied to the wound to absorb exudate (paragraph [0002]).

It is thus apparent that the composition to which the invention of D1 is directed is not an adhesive but is intended to be held in place by an adhesive tape.

It is correct, as observed by the appellant (see section XI.(d), above) that D1 contains in paragraph [0021] a statement that the application of hydrophilic gels in medical practice is found, *inter alia*, in adhesives. However this statement appears to be in the nature of background information relating to the scope of applicability of hydrophilic polymer gels in general. There is no statement that the gels of D1 themselves are suitable for use as adhesives, nor any indication how these could be adapted to render them suitable as adhesives.

On the contrary, it is rather the case that adhesive properties would render the composition of D1 unsuitable for the intended use as a material to be in direct contact with a wound.

Accordingly the statement in respect of adhesives prepared from hydrophilic gels does not relate to the

invention of D1 and would not be regarded by the skilled person as part of, or even related to, the teaching of the document.

It is indeed the case, as noted with respect to novelty, that there are certain similarities between the compositions of D1 and those claimed. However these similarities become apparent only in the light of knowledge of the patent in suit. To reiterate, there is in D1 no indication that the compositions exemplified therein could serve as adhesives, no indication as to how the compositions should be modified or adapted to imbue them with adhesive properties. Consequently there is no reason for the skilled person to consider this teaching when seeking to provide adhesives for the intended area of application.

Accordingly the composition of the invention of D1 is not suitable to serve as the closest prior art.

4.3 A second approach was proposed, relying on the disclosure of paragraph [0129] of D1.

This relates to the adhesive employed to prepare an exemplary dressing employing the hydrophilic gel of D1. It is taught that the adhesive includes 15 wt% acrylic acid (corresponding to component (a) of operative claim 1), 15 wt% of methoxypolyethylene oxide 400 acrylate (corresponding to formula I of operative claim 1 with n having a value of approximately 7) and 30 wt% isooctyl acrylate a compound falling within the terms of component (c) of claim 1.

A copolymerizable UV-initiator is not disclosed. Nor does D1 provide any further information about this adhesive, beyond a reference to a further document

(cited by the appellant as D11 in the statement of grounds of appeal). Nor is it stated whether the adhesive is breathable. Indeed no properties of this adhesive are disclosed, nor is any other form of explanation given as to why this adhesive is "particularly preferred".

On the contrary, the "relevance" as such of this adhesive composition becomes apparent only in the light of the claimed subject-matter in as much as two of the required types of monomers are present. An essential feature, central to the problem underlying the claimed subject-matter, namely a copolymerizable UV-initiator is however absent.

Accordingly the Board cannot conclude that the skilled person when seeking to solve the problem of providing a breathable, UV crosslinkable polymer for the medical field would identify the adhesive generally described in paragraph [0129] of D1 as particularly relevant, in particular since there is no disclosure of it being UV curable.

- 4.4 According to the established case law, as summarised in "Case Law of the Boards of Appeal of the European Patent Office", Ninth Edition, 2019, sections I.D.3.1, the closest prior art is normally a document disclosing subject-matter conceived for the same purpose or addressing the same objective as the claimed invention and having the most relevant technical features in common. A further criterion for selection of the closest prior art is the similarity of the technical problem.

Neither of the teachings of D1 invoked by the appellant fulfil these requirements.

The invention of D1, namely the hydrophilic gel, is not conceived for the same purpose as the subject-matter of the operative claim, as explained above, and hence does not address the same or a similar technical problem.

The second aspect of D1 invoked namely the adhesive mentioned in paragraph [0129] can only in some respects be considered as relating to subject-matter conceived for the same purpose since it is not disclosed as being UV curable, and no statement exists within the relevant portion of D1 suggesting that this might be the case. Since a central aspect of the invention of the patent in suit relies on the UV curability it is also not possible to conclude that the adhesive referred to in D1 and that of the patent in suit are aimed at addressing the same technical problem.

Accordingly neither of the aspects of D1 invoked can, under correct application of the problem - solution approach, be considered as representing the closest state of the art.

There is accordingly no need for the Board to address or decide upon the matter of admittance of this new attack to the procedure.

- 4.5 In the absence of a technical teaching which is suitable to serve as the closest state of the art, there is no basis on which the Board can identify any grounds for overturning the findings of the opposition division in respect of inventive step - see also T 835/00 (7 November 2002), section 4.4.5.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed

The Registrar:

The Chairman:



B. ter Heijden

D. Marquis

Decision electronically authenticated