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**Datasheet for the decision
of 14 September 2023**

Case Number: T 1011/21 - 3.3.09

Application Number: 13176743.6

Publication Number: 2826831

IPC: C09J133/08, C09J131/04,
C09J125/08, B29L31/00,
B29C65/48, C08J5/12, C09J153/02

Language of the proceedings: EN

Title of invention:

Use of hot-melt adhesive for the collation of containers and bottles for beverages or food into shelf ready packs of various items

Patent Proprietor:

KHS GmbH

Opponent:

Henkel AG & Co. KGaA

Headword:

Hot-melt adhesive for the collation of containers and bottles/
KHS

Relevant legal provisions:

EPC Art. 83, 123(2)
RPBA 2020 Art. 13(2)

Keyword:

Amendments - allowable (yes)

Sufficiency of disclosure - (yes)

Amendment after summons - exceptional circumstances (no)

Decisions cited:

Catchword:



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Case Number: T 1011/21 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 14 September 2023

Appellant: Henkel AG & Co. KGaA
(Opponent) Henkelstrasse 67
40589 Düsseldorf (DE)

Representative: Henkel AG & Co. KGaA
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Respondent: KHS GmbH
(Patent Proprietor) Juchostraße 20
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Representative: Scholz, Volker
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 4 May 2021
rejecting the opposition filed against European
patent No. 2826831 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman A. Haderlein
Members: M. Ansorge
L. Basterreix

Summary of Facts and Submissions

- I. The opponent (appellant) lodged an appeal against the opposition division's decision rejecting the opposition.
- II. With its notice of opposition, the opponent had requested that the patent be revoked on the grounds for opposition under Article 100(a) EPC (lack of novelty and lack of inventive step) and Article 100(b) EPC.
- III. The opposition division decided that the subject-matter of claim 1 of the patent as granted met the requirement of sufficiency of disclosure, was novel and involved an inventive step.
- IV. In its grounds of appeal, the appellant argued that the claims of the patent as granted did not comply with the requirement of inventive step.
- V. In reply to the grounds of appeal, the proprietor (respondent) further pursued the patent as granted as a main request and auxiliary requests 1 to 3, which had been filed in the proceedings before the opposition division. The main request and auxiliary request 1 were withdrawn during the oral proceedings before the board. The only claim request relevant for this decision is auxiliary request 2.
- VI. Claim 1 of auxiliary request 2 (being the sole claim of this claim request) reads as follows (amendments made in comparison with claim 1 of the patent as granted are underlined):

"Use of a hot-melt adhesive mixture for adhering multiple containers for beverages or food to form a pack of various items in an automated application process, without the use of secondary / external packaging, wherein the hot-melt adhesive mixture comprises:

(a) a polymer component in the range of 7-48 parts by weight with regard to the total weight of the mixture comprising at least one styrenic block co-polymer;

(b) a tackifying component in the range of 15-52 parts by weight with regard to the total weight of the mixture comprising a thermoplastic adhesive resin, aliphatic hydrocarbon, cycloaliphatic hydrocarbon, aromatic hydrocarbon, modified hydrocarbon, hydrogenated versions thereof; terpenes, modified terpene, hydrogenated versions; rosins, rosin derivatives thereof, hydrogenated versions thereof or mixtures thereof; and

(c) a plasticizer component in the range of 5-25 parts by weight with regard to the total weight of the mixture comprising paraffinic oils, naphthenic oils, polybutene, dibasic esters, polyols or mixtures thereof; and

d) a stabilizer component in the range of 0.02 - 1.2 parts by weight with regard to the total weight of the mixture comprising steric hindered phenolic antioxidant and/or hindered amine light stabilizer,

wherein the hot-melt adhesive compound has a density of between 0.790 - 1.2 g/cm³, a melt flow index of 15 - 4000 g/min (@200°C), a Brookfield viscosity @ 160°C between 200 and 10,000 cPs, a Shore hardness in the

range of 15 and 70 A at 23°C according to ASTM D2240, and a softening point determined by ASTM E28 above 40°C and not greater than 158°C."

VII. The parties' relevant arguments, submitted in writing and during the oral proceedings, are reflected in the reasons for the decision below.

VIII. Requests

The appellant requested that the decision be set aside and that the patent be revoked.

The respondent requested that the patent be maintained on the basis of auxiliary request 2 or auxiliary request 3, both submitted with the reply to the grounds of appeal.

Reasons for the Decision

AUXILIARY REQUEST 2

1. Article 123(2) EPC

1.1 The subject-matter of claim 1 of auxiliary request 2 differs from claim 1 of the patent as granted in that the feature "wherein the hot-melt adhesive compound has a density of between 0.790 - 1.2 g/cm³, a melt flow index of 15 - 4000 g/min (@200°C), a Brookfield viscosity @ 160°C between 200 and 10,000 cPs, a Shore hardness in the range of 15 and 70 A at 23°C according to ASTM D2240, and a softening point determined by ASTM E28 above 40°C and not greater than 158°C" has been introduced into claim 1.

1.2 The appellant did not raise an objection under Article 123(2) EPC against claim 1 of auxiliary request 2. The board does not consider there to be an added-matter problem, either. In particular, the feature newly introduced into claim 1 is disclosed on page 3, third line from the bottom, to page 4, line 2, of the application as filed.

2. Admittance of experimental data

2.1 The appellant filed experimental data on 14 July 2023 and requested that this evidence be admitted into the proceedings. The respondent requested that these data not be admitted to the proceedings.

2.2 For the following reasons, these experimental data cannot be admitted into the proceedings.

2.2.1 Filing these experimental data represents an amendment to the appellant's case. The question of its admittance is subject to Article 13(2) RPBA and thus presupposes that there are exceptional circumstances for taking these data into account.

2.2.2 The appellant argued that the experiments were conducted in order to back up their position and to try to rebut the board's preliminary opinion outlined in the communication pursuant to Article 15(1) RPBA.

These arguments are not convincing, since backing up the appellant's position and responding to the board's preliminary opinion, which merely assesses the parties' arguments submitted in writing without adding anything from the board's side on its own motion, do not qualify as exceptional circumstances.

2.2.3 The appellant also mentioned that the experimental data were *prima facie* relevant to the patentability of the requests.

However, the question of whether or not late-filed experiments are *prima facie* relevant is not a relevant criterion which could justify the presence of exceptional circumstances either.

In view of the above, the experimental data are not taken into account in this case (Article 13(2) RPBA).

3. Article 83 EPC

3.1 For the first time in these appeal proceedings, the appellant argued in its letter of 14 July 2023 that the invention could not be carried out. This was the only specific objection raised by the appellant against the subject-matter claimed in auxiliary request 2 in the above letter, i.e. after the board had issued its communication under Article 15(1) RPBA. In particular, it argued that the properties required for the claimed use could not be achieved over the whole claimed range. In this context, the appellant referred to the experimental data filed by letter of 14 July 2023. In its view, in the absence of any examples in line with claim 1, the burden of proof that the invention can be carried out lay with the respondent.

3.2 At the oral proceedings, the respondent engaged in the appellant's insufficiency objection and provided counter-arguments to demonstrate why the invention could be carried out by a skilled person. Amongst other things, it pointed out that the appellant did not provide evidence supporting the mere allegation that

not all compositions falling within the scope of claim 1 would exhibit the desired properties necessary for the claimed use.

- 3.3 For the following reasons, the appellant's insufficiency objection is not considered convincing.
- 3.3.1 A successful objection of insufficient disclosure presupposes that there are serious doubts, substantiated by verifiable facts. In *inter partes* proceedings, the burden of proof generally lies with the opponent (i.e. the appellant in this case), who must establish, on the balance of probabilities, that a skilled person reading the patent, using common general knowledge, would be unable to carry out the invention (cf. the Case Law of the Boards of Appeal, II.C.9).
- 3.3.2 Since the board does not take into account the late-filed experimental data (see point 2 above), there are no verifiable facts on file which could raise serious doubts that the invention can be carried out. The mere absence of an example in the patent that tests the specific use defined in claim 1 cannot raise serious doubts that the invention can be carried out and does not lead to the burden of proof being shifted, either. Under these circumstances, the burden of proof remains with the appellant.
- 3.3.3 In the absence of any verifiable facts, such as experimental data, the appellant's insufficiency objection is based on unsubstantiated assertions which cannot raise serious doubts that the invention can be carried out.
- 3.3.4 Moreover, the appellant did not demonstrate that the opposition division's conclusion that the invention can

be carried out might have been erroneous (see point 2.1 of the decision).

Under these circumstances, the board concludes that the invention can be carried out by a skilled person (Article 83 EPC).

4. Admittance of the inventive-step attack against claim 1 of auxiliary request 2 (Article 13(2) RPBA)

For the first time in the appeal proceedings, at the oral proceedings before the board the appellant raised a specific objection for lack of inventive step concerning the use according to claim 1 of auxiliary request 2, this objection addressing the features included with respect to claim 1 of the patent as granted (see the underlined features in point VI above). Such a specific objection was not raised at any point in the written appeal proceedings. This was not contested by the appellant, who also refrained from submitting any exceptional circumstances justifying this late objection. The board is also unable to recognise any exceptional circumstances which could justify admitting this new and late objection into the proceedings, which was raised at the very last stage of the appeal proceedings. In this context, it is to be kept in mind that auxiliary request 2 was on file since the respondent's reply to the grounds of appeal (which is more than one and a half years ago) and that the same claim request was filed during the first-instance proceedings as a possible fallback position. Even in response to the board's communication, the appellant raised only a specific insufficiency objection against the subject-matter claimed in auxiliary request 2 as its only specific objection.

Under these circumstances, this inventive-step objection against auxiliary request 2 is not taken into account (Article 13(2) RPBA).

5. The appellant did not demonstrate that the subject-matter claimed in auxiliary request 2 fails to meet one of the requirements of the EPC, and so it is allowable.

6. With respect to the adaptation of the description, the respondent requested that paragraph [0019] of the patent specification be deleted and that the patent be maintained based on claim 1 of auxiliary request 2 and paragraphs [0001] to [0018] and [0020] to [0047] of the patent specification. Neither the appellant nor the board had any objections against the description being adapted in this way.

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 with the order to maintain the patent in amended form in the following version:
 - claim: the sole claim of auxiliary request 2 filed with the reply to the grounds of appeal and
 - description: paragraphs [0001] to [0018] and [0020] to [0047] of the patent specification.

The Registrar:

The Chairman:



M. Schalow

A. Haderlein

Decision electronically authenticated