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**Datasheet for the decision
of 4 February 2025**

Case Number: T 1422/23 - 3.3.02

Application Number: 16175230.8

Publication Number: 3260512

IPC: C09J123/20, B32B27/32

Language of the proceedings: EN

Title of invention:

EXTRUDABLE PRESSURE SENSITIVE ADHESIVE BASED ON POLYBUTENE-1
SUITABLE FOR RECLOSABLE PACKAGINGS

Patent Proprietor:

Henkel AG & Co. KGaA

Opponent:

Savarè I.C. S.r.l.

Relevant legal provisions:

EPC Art. 56

RPBA 2020 Art. 13(2)

Keyword:

Inventive step - selection of the closest prior art
Amendment after notification of Art. 15(1) RPBA communication
- no exceptional circumstances

Decisions cited:

G 0009/91, T 1733/21, T 1518/17, T 1742/12



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0

Case Number: T 1422/23 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 4 February 2025

Appellant: Savarè I.C. S.r.l.
(Opponent) Via Polidoro da Caravaggio, 3
20156 Milano (IT)

Representative: Vatti, Francesco Paolo
Fumero S.r.l.
Via Sant' Agnese, 12
I20123 Milano (IT)

Respondent: Henkel AG & Co. KGaA
(Patent Proprietor) Henkelstraße 67
40589 Düsseldorf (DE)

Representative: Viering, Jentschura & Partner mbB
Patent- und Rechtsanwälte
Hamborner Straße 53
40472 Düsseldorf (DE)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
30 May 2023 concerning maintenance of the
European Patent No. 3260512 in amended form.**

Composition of the Board:

Chairman M. O. Müller
Members: A. Lenzen
L. Bühler

Summary of Facts and Submissions

- I. The present decision concerns the appeal filed by the opponent (appellant) against the opposition division's decision (decision under appeal) that European patent No. 3 260 512 (patent) in amended form meets the requirements of the EPC.
- II. Reference is made in the present decision to the following documents filed with the opposition division:
- D1 US 6,114,261
D11 WO 2012/052429 A1
- III. With the reply to the statement of grounds of appeal, the patent proprietor (respondent) filed, *inter alia*, the set of claims of auxiliary request 1.
- IV. In preparation for the oral proceedings, which had been arranged at the parties' request, the board issued a communication under Article 15(1) RPBA.
- V. Oral proceedings before the board were held in person on 4 February 2025 in the presence of both parties. The board decided not to admit the respondent's submission that the nature of the copolymer in example 3 of D1 is a second distinguishing feature. At the end of the oral proceedings, the chair announced the order of the present decision.
- VI. The parties' requests at the end of the oral proceedings were as follows.

The respondent requested that the appeal be dismissed (main request), implying that the decision under appeal

would be confirmed and the patent maintained in the amended form held allowable by the opposition division. In the alternative, the respondent requested that the patent be maintained in amended form based on the set of claims of auxiliary request 1, filed with the reply to the statement of grounds of appeal.

The appellant requested that the decision under appeal be set aside and the patent not be maintained on the basis of the main request.

VII. Summaries of the parties' submissions relevant to the present decision and key aspects of the decision under appeal are set out in the reasons for the decision below.

Reasons for the Decision

Main request (patent in amended form as held allowable by the opposition division) - Inventive step (Article 56 EPC)

1. The patent (paragraphs [0001] and [0002]) states that pressure-sensitive adhesives (PSA) based on polybutene-1 (co)polymers suitable for use in reclosable packaging are known from D11. However, the properties of these adhesives still leave much to be desired. The invention as defined in claim 1 of the main request is offered as an improvement in this respect. Claim 1 reads as follows:

"A pressure sensitive adhesive composition comprising,
i) at least one butene-1 (co)polymer;
ii) at least one liquid tackifier;
iii) at least one solid tackifier;

iv) optionally at least one further (co)polymer, different from i);
v) optionally at least one additive, wherein the at least one butene-1 (co)polymer has a butene-1 content of 85 to 99 % by mol, based on the butene-1 (co)polymer and wherein the co-monomer is selected from alpha-olefins;
and wherein
the at least one liquid tackifier is selected from liquid hydrocarbon resins and hydrogenated hydrocarbon resins, liquid polystyrenes, liquid rosin esters, liquid polyterpenes, liquid resins from polymerized and hydrogenated C9 hydrocarbon streams; liquid resins from polymerized and hydrogenated dicyclopentadiene species; liquid resins from polymerized and hydrogenated pure monomer selected from styrene, vinyl toluene, or alpha-methyl styrene;
wherein the composition comprises:
35 to 74 wt.-%, of i);
5 to 50 wt.-% of ii);
10 to 50 wt.-% of iii);
0 to 30 wt.-% of iv); and
0 to 30 wt.-% of v);
based on the total weight of the pressure sensitive adhesive composition."

2. Closest prior art

2.1 There was disagreement between the parties on whether only D11 or also D1, more specifically example 3 of the latter, could be considered as the closest prior art.

2.2 D1 relates to hot-melt adhesives which are beneficial in construction and elastic-attachment applications in non-woven disposable absorbent articles such as diapers

(column 1, lines 14 to 18). The composition of example 3 performs well as an elastic-attachment adhesive (column 11, lines 13 to 30).

- 2.3 D1 is thus in the same technical field as the claimed invention, namely the field of adhesives.
- 2.4 The board acknowledges that, as was argued by the respondent, the purpose to be achieved by the claimed invention, namely to provide reclosable structures, i.e. structures that are glued together in a reversible and thus non-permanent way, is different from the purpose on which D1 focuses, namely the provision of structures that are permanently glued together. However, the two purposes are at least similar in that they both concern structures involving some sort of gluing.
- 2.5 Since D1 is thus in the same technical field as the claimed invention and is directed to a purpose that is at least similar, the board is convinced that example 3 of D1 constitutes a suitable closest prior art.
- 2.6 The board acknowledges that, as was set out by the respondent, in terms of purpose, D11 is closer to the claimed invention than D1. However, the board follows the rationale as set out in decision T 1742/12 (see, in particular, point 10.3 of the Reasons). In this case, the proprietor had argued that D6 was closer than D1, such that D1 could not be the closest prior art. This was not accepted by the board, which held that, if it can be shown that an invention is obvious having regard to a certain piece of prior art, this cannot be refuted merely by the introduction of another piece of prior art. According to the board, "*this would be an absurd*

situation in conflict with Article 56 EPC, and therefore untenable".

Also, the mere fact that the purpose in D1 is not the same as that underlying the claimed invention cannot disqualify D1 as a suitable closest prior art. As held in T 1518/17 (point 2.1 of the Reasons), even if a prior-art document for the same purpose is available, this does not preclude a document relating to a similar purpose from being considered either a better choice than the closest prior art or an at least equally plausible choice.

- 2.7 In fact, the respondent acknowledged that the composition of example 3 of D1 is a pressure-sensitive adhesive. As argued by the appellant and not disputed by the respondent, the fact that the composition of example 3 of D1 is a pressure-sensitive adhesive suggests to the skilled person that this composition is suitable for use in at least some reclosable structures. The fact that this is not explicitly mentioned in example 3 of D1 does not render this example and the document as a whole unsuitable as closest prior art. More specifically, as set out in T 1733/21 (point 3 of the Reasons), even though it may be true that a prior-art document directed to the same technical effect as the invention in question is, *a priori*, more promising, this does not constitute a condition *sine qua non* for selecting this document as the starting point for the assessment of inventive step. If it did, then any prior-art document which was silent about an effect aimed at by the invention in question could never form a suitable starting point. This would be contrary to the practice established before the EPO.

2.8 Example 3 of D1 thus constitutes a suitable closest prior art.

3. Distinguishing features

3.1 Example 3 of D1 (column 11, lines 13 to 30; column 3, lines 40 to 53) discloses the following adhesive (amounts in wt.%):

Eastotac H100 (18)
Escorez 2520 (5)
Polybutylene 8910 (19)
Polybutylene 0800 (19)
RT2715 (28)
Epolene N15 (10)
Irganox 1010 (1)

3.2 As set out in the decision under appeal (point 2.2.3, on pages 5 to 7) and agreed by both parties, this adhesive is pressure-sensitive. The parties also agreed on the following points:

- The component "Escorez 2520" is a liquid hydrocarbon tackifying resin. It corresponds to component ii) of the PSA of claim 1 and is present in an amount as provided for this component in claim 1.
- The component "Eastotac H100" is a solid tackifying resin. It corresponds to component iii) of the PSA of claim 1 and is present in an amount as provided for this component in claim 1.

3.3 The decision under appeal (page 7, first to fifth paragraphs) sets out that the component "Polybutylene 8910" is a copolymer comprising 89.6 mol% of butene-1 and 10.4 mol% of ethene, i.e. an alpha-

olefin according to the patent (page 3, line 3), and that, consequently, this component corresponds to component i) of the PSA of claim 1. This was not contested by either party until the oral proceedings.

At the oral proceedings, the respondent questioned for the first time on appeal the view that example 3 of D1 directly and unambiguously disclosed a butene-1 copolymer. It submitted that the component "Polybutylene 8910" could also be a butene-2 copolymer. At the request of the appellant, the board decided not to admit this submission (for the reasons, see below).

Hence, the component "Polybutylene 8910" corresponds to component i) of the PSA of claim 1.

3.4 Based on the previous points, it must be concluded that the PSA of claim 1 of the main request differs from that of D1, example 3, only in that the amount of component i) is higher (claim 1: 35 to 74 wt.%; D1: 19 wt.%).

4. Technical effect(s), objective technical problem

The respondent did not rely on any technical effect associated with the distinguishing feature set out above. Hence, the board agrees with the appellant that the objective technical problem is to provide an alternative PSA.

5. Obviousness

5.1 Arbitrarily varying the concentrations of components in a composition, including changing the concentration of one component in favour of, or to the detriment of,

other components, is routine for the skilled person. Such a measure does not involve an inventive step.

By replacing the component "Polybutylene 0800" of example 3 with the component "Polybutylene 8910", the skilled person would have increased the amount of the latter component to 38 wt.%, falling within the range provided in claim 1 for component i).

- 5.2 The respondent argued that example 3 was a ready-to-use formulation, in which the components had been carefully selected with respect to each other. The skilled person would be very reluctant to change the amounts of the components. They would certainly not have fully replaced a component contained in a high quantity, i.e. replaced all of the "Polybutylene 0800" with "Polybutylene 8910".

In so far as this argument implies that the skilled person would not have changed a formulation simply because it was a ready-to-use formulation, it equates novelty with inventive step. This would mean that a ready-to-use formulation is inventive as soon as it is novel. This obviously makes no sense.

However, this argument is also unconvincing in so far as it concerns the quantitative replacement of one component by another component in the present case, i.e. the complete replacement of "Polybutylene 0800" by "Polybutylene 8910". As already stated by the opposition division in its decision (page 7, sixth paragraph) and by the board in its communication under Article 15(1) RPBA (point 5.9.1), "Polybutylene 0800" is a butene-1 homopolymer. This was not questioned by the respondent at any point. Furthermore, D1 discloses - as also explained by the board in its communication

under Article 15(1) RPBA (point 5.9.1) and not disputed by the respondent at any point - that the adhesive of D1 in its most general embodiment contains 10 to 65% by weight of a polybutylene copolymer, homopolymer or blend thereof (column 3, lines 6 to 16). D1 thus essentially teaches the equivalence of butene-1 homo- and copolymers and thus also the possibility of replacing any amount of "Polybutylene 0800" with "Polybutylene 8910", or *vice versa*.

- 5.3 Thus, faced with the objective technical problem of providing an alternative PSA, the skilled person would have arrived at the subject-matter of claim 1 in an obvious manner. The subject-matter of claim 1 is not based on an inventive step and the main request is not allowable.

Change of the respondent's appeal case - Admittance
(Article 13(2) RPBA)

6. At the oral proceedings before the board, the respondent questioned whether example 3 of D1 directly and unambiguously disclosed a butene-1 copolymer. It submitted that the component in question ("Polybutylene 8910") could also be a butene-2 copolymer (see above). The respondent thus identified a second distinguishing feature in addition to the amount of component i). At the appellant's request, the board decided not to admit this submission into the appeal proceedings. The reasons are as follows.
7. In its decision, the opposition division had stated that the component "Polybutylene 8910" of example 3 of D1 corresponds to component i) of the PSA of claim 1 (see above). Although the appellant focused on this example as the closest prior art in its statement of

grounds of appeal, the respondent did not question the opposition division's finding in this respect in its subsequent reply. Rather, the respondent's whole case focused on D11 but not on example 3 of D1 being the closest prior art, and on the fact that it considered the opposition division's decision in this respect to be correct.

It must therefore be concluded that the respondent's submission at the oral proceedings before the board, namely that the subject-matter of claim 1 of the main request differed from example 3 of D1 not only in the quantity but also in the nature of component i), amounted to an amendment of its appeal case.

8. Under Article 13(2) RPBA, such an amendment made after notification of a communication under Article 15(1) RPBA is not to be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

The respondent, however, did not invoke any exceptional circumstances for its late submission. Contrary to the respondent's argument, and as also pointed out by the board at the oral proceedings, it is irrelevant in this context whether or not this submission had already been made before the opposition division and whether or not, on a subjective basis, the appellant was taken by surprise at the oral proceedings.

Therefore, the board decided not to admit the respondent's submission that the nature of the copolymer in example 3 of D1 was a second distinguishing feature.

Auxiliary request 1

9. Claim 1 reads as follows:

"An article comprising a pressure sensitive adhesive composition as an adhesive layer between two substrates, wherein the adhesive composition comprises,

- i) at least one butene-1 (co)polymer;*
- ii) at least one liquid tackifier;*
- iii) at least one solid tackifier;*
- iv) optionally at least one further (co)polymer, different from i);*
- v) optionally at least one additive, wherein the at least one butene-1 (co)polymer has a butene-1 content of 85 to 100 % by mol, based on the butene-1 (co)polymer; and wherein the at least one liquid tackifier is selected from liquid hydrocarbon resins and hydrogenated hydrocarbon resins, liquid polystyrenes, liquid rosin esters, liquid polyterpenes, liquid resins from polymerized and hydrogenated C9 hydrocarbon streams; liquid resins from polymerized and hydrogenated dicyclopentadiene species; liquid resins from polymerized and hydrogenated pure monomer selected from styrene, vinyl toluene, or alpha-methyl styrene;*

wherein the article is a reclosable packaging unit."

10. This claim differs from claim 1 of the main request, *inter alia*, in that the amounts of components (i) to (iii) have been removed and in that the claim is now directed to an article which is a reclosable packaging unit rather than to a composition.

11. In its communication under Article 15(1) RPBA, the board had set out that it might be discussed whether auxiliary request 1 is reconcilable with the prohibition of *reformatio in peius*. At the oral proceedings, the appellant expressly confirmed that the board could deal with this request and order the maintenance of the patent based on this request without taking into account the prohibition of *reformatio in peius*.
12. In such a situation, all that is left for a board to do is to examine the amendments for their compatibility with the requirements of the EPC (G 9/91, point 19 of the Reasons).
 - 12.1 The amendments inserted into auxiliary request 1 comply with the requirements of Article 84 EPC.
 - 12.2 Independent claims 1, 10 and 12 of auxiliary request 1 are a combination of claims 1/11/12, 10/1 and 14/1/10/12 as granted, respectively, along with the further limitation that the packaging unit must be reclosable. The claims of auxiliary request 1, therefore, do not extend the protection conferred by the patent as granted (Article 123(3) EPC).
 - 12.3 Claim 1 of auxiliary request 1 is a combination of claims 1, 2, 12 and 13 as filed and has the following further limitations:
 - (a) the list of specific compounds for the liquid tackifier ii)
 - (b) the requirement that the packaging unit be reclosable.

Amendment (a) is based on page 5, last paragraph, of the application as filed. Amendment (b) is based on the fact that the entire application as filed is clearly directed at reclosable packagings (see, e.g., page 1, first and second paragraphs, of the application as filed).

Claims 2 to 12 of auxiliary request 1 are based on claims 3 to 11 and on claims 14 and 15 as filed.

The claimed subject-matter of auxiliary request 1, therefore, does not extend beyond the content of the application as filed (Article 123(2) EPC).

13. Auxiliary request 1 is thus allowable.

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 with the following claims and a description to be possibly adapted thereto: Claims 1 to 12 of auxiliary request 1 filed with the reply to the statement of grounds of appeal.

The Registrar:

The Chairman:



U. Bultmann

M. O. Müller

Decision electronically authenticated