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D E C I S I O N
of 23 September 1997

Case Number: T 0068/95 - 3.3.1

Application Number: 87102047.5

Publication Number: 0273997

IPC: C09J 7/02

Language of the proceedings: EN

Title of invention:

Fluorescent adhesive tape for use as a highlighter

Patentee:

INCAS HOLDING Spa, et al

Opponent:

Pelikan GmbH

Headword:

Highlighting tape/INCAS HOLDING - SICAD

Relevant legal provisions:

EPC Art. 56, 83, 123(2), (3)

Keyword:

"Insufficiency of disclosure - not substantiated"

"Closest state of the art: as indicated in introductory part"

"Inventive step - claimed solution not suggested by cited state of the art"

Decisions cited:

T 0182/89, T 0881/92

Catchword:

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Case Number: T 0068/95 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 23 September 1997

Appellant:
(Opponent)

Pelikan GmbH
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Representative:

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Respondent:

(Proprietor of the patent)

INCAS HOLDING Spa
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and

SICAD Spa
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Representative:

Gervasi, Gemma, Dr.
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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 5 December 1994
rejecting the opposition filed against European
patent No. 0 273 997 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: A. J. Nuss

Members: P. P. Bracke

R. E. Teschemacher

Summary of Facts and Submissions

- I. This appeal is against the Opposition Division's decision to reject the opposition to European patent No. 0 273 997.
- II. The Opposition Division found that the claimed fluorescent tape was not obviously derivable from document (1), US-A-2 387 512, since this document said nothing whatever about the use of adhesive tapes for highlighting and the claimed tapes were structurally different from the ones described therein.
- III. During the oral proceedings, held on 23 September 1997, the Respondents filed a set of five claims, with the only independent claim reading:
- "1. A fluorescent tape for use as a highlighter to apply to a support with writing, characterized in that it consists of
- a- a transparent or semi-transparent support film having a thickness between 15 and 65 microns;
 - b- a layer of 3-4 g/m² of a dry, fluorescent, writable ink obtained by applying an ink having the following chemical composition: fluorescent pigment 33-37% b.w., acrylic resin 9-12% b.w., synthetic wax 0.3-1% b.w., phthalic acid esters 4-5% b.w., ethyl acetate 38-43% b.w., ethanol 9-11% b.w. and evaporating the solvent;

c- a layer of 12-15 g/m² of an adhesive of low adhesive power which allows removal from said support without altering the support itself or the writing, having the following chemical composition: natural rubber 65-75% b.w., hydrocarbon resins 25-35% b.w., polyisobutylene 0-10% b.w., polybutenes 0-10% b.w."

IV. The Appellant alleged that the contested patent did not meet the requirements of Article 100(b) EPC and that the claimed fluorescent tapes were not inventive vis-à-vis the teachings of documents (1) and (2), EP-A-0 109 177.

V. The Respondents argued that, since the problem underlying the invention was the elimination of the drawbacks caused by highlighting pens and neither such a problem nor the proposed solution was mentioned in document (1), the claimed tapes were inventive.

VI. The Appellant requested that the decision under appeal be set aside and that the European patent No. 0 273 997 be revoked.

The Respondents requested that the appeal be dismissed and that the patent be maintained on the basis of Claims 1 to 5 as submitted during the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

2. *Amendments*

Present Claim 1 is a combination of the features defined in Claims 1, 3 and 6 to 9 as originally filed (and as granted) and of the feature that the ink is writable, mentioned on page 3, lines 8 and 9, of the originally filed application (page 2, line 45, of the contested patent), which combination results in a limitation of the claimed scope in comparison with the scope as granted. Although the feature "and evaporating the solvent" was not explicitly described in the original application, it was not contested that this feature was unambiguously derivable from the original application by a skilled person.

Claims 2 to 5 correspond to the originally filed Claims 2, 4, 5 and 10 respectively.

Consequently, the requirements of Article 123(2) and (3) EPC are not contravened, which was not disputed by the Appellant.

3. *Article 100(b) EPC*

The Appellant essentially argued that the contested patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a skilled person, since it was not specified in the contested patent which pigments, acrylic resins and synthetic waxes could suitably be used in the ink composition and which compositions would be suitable for providing an adhesive of low adhesive power and since during the opposition procedure the Respondents

themselves had shown that the finding of a suitable tape according to the claimed invention was the result of complex research work. The Respondents submitted that showing the complexity of preparing a suitable tape did not mean that the patent in suit did not contain sufficient information.

According to the case law of the Boards of Appeal of the EPO, in order to establish insufficiency, the burden of proof is upon the Opponent (in the present case: the Appellant) to establish on the balance of probabilities that a skilled reader of the patent using his common general knowledge would be unable to carry out the invention (T 182/89, OJ EPO, 1991, 391, point 2 of the reasons for the decision). In the absence of any substantiation of the Appellant's allegation, the Board concludes that it has not been established that the invention is insufficiently disclosed.

4. *Novelty*

The Board is satisfied that the claimed subject-matter is novel with regard to the cited prior art. Since novelty has never been contested, there is no reason to give detailed information for this finding.

5. *Inventive step*

- 5.1 In the appealed decision the Opposition Division considered document (1) to represent the closest state of the art.

However, since the patent in suit is concerned with the

problem arising from the use of highlighting pens, marking the page permanently and indelibly (page 2, lines 12 to 14), and since document (1), which is concerned with luminescent adhesive tapes that may be stuck to eg doorways for identification in the dark (page 1, left hand column, lines 1 to 5), says nothing whatever about the problem arising from highlighting a text, the Board finds that a skilled person would not have had any incentive to consider document (1) as an appropriate starting point.

According to the case law of the Boards of Appeal of the EPO, the definition of the technical problem to be solved should normally start from the technical problem actually described in the patent in suit in relation to the closest state of the art indicated there. Only if it turns out that an incorrect state of the art was used or that the technical problem disclosed has in fact not been solved or has not been correctly defined for some reason(s), is it appropriate to consider another problem which objectively existed (see, for example, T 881/92 of 22 April 1996, point 4.1 of the reasons and the other decisions cited in EPO Board of Appeal Case Law in 1996, special edition of OJ EPO 1997, Part I.C.2.1).

Since, in the present case, none of the cited documents is concerned with the highlighting of text, the Board has no reason to assume that a state of the art exists which is more relevant to the claimed tapes than the known highlighting pens described in the introductory part of the description of the patent in suit, whose status as part of the prior art was not disputed.

- 5.2 In view of the above, the technical problem underlying the claimed invention was to provide an alternative to the known highlighting pens which, when applied to the parts of the writing that interests the reader, gives excellent highlighting, whereas when highlighting is no longer required it can be removed without damaging the support and the writing (page 2, lines 20 to 23, of the patent in suit).
- 5.3 According to the contested patent this problem is effectively solved by the claimed fluorescent adhesive tapes, which has never been disputed.
- 5.4 The question to be decided is whether it was obvious, in view of the cited state of the art, to solve the problem defined above by providing a fluorescent tape consisting of a transparent or semi-transparent film, a layer of fluorescent coloured ink and a layer of adhesive of low adhesive power, as defined in Claim 1.
- 5.5 Document (1) discloses luminescent adhesive tapes obtained by coating a transparent film with a pressure-sensitive adhesive composition having the luminescent pigment dispersed therein or having the luminescent pigment between two layers of the adhesive (page 1, left-hand column, lines 36 to 41, and Figures 1 and 2).

In the Appellant's opinion, the claimed tapes only differed from the ones described in document (1) by the fact that the fluorescent coloured ink is not incorporated in the adhesives but in a separate layer, which could not form the basis of an inventive step.

Moreover, he submitted that the tapes described in document (1) also had highlighting properties and that the claimed tapes were not structurally different from those described in document (1). More specifically, he argued that the tapes described in document (1) were also peelable tapes, obtained by applying on the surface of the film "pressure sensitive adhesive compositions" and by incorporating an ink as defined in the present Claim 1.

However, since such tapes are said to be suitable for identifying objects in the dark (eg during blackouts or other emergencies) and for that purpose only **phosphorescent** inks are of any practical use, the Board considers that the claimed **fluorescent** tapes were not suggested in document (1), especially in view of the fact that the requirements for the pressure-sensitive adhesive compositions for sticking a tape to doorways and similar surfaces are not comparable with those for applying tapes to a support with writing, in such a way that it can be removed without damaging the support or the writing.

- 5.6 Document (2) discloses pressure-sensitive adhesive tapes, which reliably adhere to most clean supports and which can be cleanly peeled from the support without delaminating the surface or leaving any adhesive residue (page 2, lines 31 to 34). The Appellant therefore concluded that the claimed tapes were obviously derivable from the combined teaching of documents (1) and (2).

However, on page 2, lines 54 to 56, it is said that the tapes are especially for masking tape and for the mounting of posters, bulletins and temporary labels. The conditions for the adhesive compositions for such applications are not comparable with those for applying tapes to supports with writing, eg books and magazines, which are envisaged in the patent in suit, such that the tape can be removed without damaging the substrate and the writing. The Board therefore finds that document (2) also contains no reference to the claimed tapes.

- 5.7 The Board therefore comes to the conclusion that the claimed subject-matter is not obviously derivable from the available prior art documents.

6. In view of the above, the grounds for opposition do not prejudice the maintenance of the patent with the set of claims submitted during the oral proceedings before the Board.

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 with the order to maintain the patent with Claims 1 to 5 as submitted during the oral proceeding and a description yet to be adapted.

The Registrar: The Chairman

P. Martorana A. Nuss