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Datasheet for the decision of 4 July 2006

Case Number: T 0566/03 - 3.3.09

Application Number: 96112038.3

Publication Number: 0756931

IPC: B32B 27/32

Language of the proceedings: EN

Title of invention:
Multilayer film

Patentee:
Kureha Corporation

Opponent:
Cryovac, Inc.

Headword:
-

Relevant legal provisions:
EPC Art. 84, 123(2),(3) EPC

Keyword:
"Main request: Compliance with Art. 123(2) (no)"
"Auxiliary request I: Compliance with Art. 84 (no)"
"Auxiliary request II: Compliance with Art. 123(2),(3) (yes)"

Decisions cited:
G 0001/93, G 0004/95, G 0001/03, T 0526/92

Catchword:
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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0566/03 **-** 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 4 July 2006

Appellant: (Patent Proprietor)
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Decision under appeal:
Decision of the Opposition Division of the European Patent Office orally announced 17 December 2002 and posted 18 March 2003 revoking European patent No. 0756931 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Kitzmantel
Members: W. Ehrenreich
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. Mention of the grant of European patent No. 0 756 931 in respect of European patent application No. 96 112 038.3 in the name of *Kureha Kagaku Kogyo Kabushiki Kaisha - now Kureha Corporation* - filed on 25 July 1996 was announced on 1 March 2000. The patent, entitled "Multilayer film", was granted with twenty one claims, Claim 1 reading as follows:

"1. A multilayer film, comprising at least three co-extruded layers including an outer first seal layer, an intermediate second seal layer disposed adjacent to the first seal layer, and an outermost third layer of a thermoplastic resin disposed opposite to the first seal layer with the second seal layer disposed between the first seal layer and the outermost third layer;

said first seal layer comprising more than 50 wt.% of a metallocene-catalyzed polyolefin;
said second seal layer having a thickness larger than that of the first seal layer and comprising a copolymer of at least one oxygen-containing monomer and ethylene;
provided that said copolymer of the second seal layer has a crystal melting point lower than that of the metallocene-catalyzed polyolefin of the first seal layer, and
that said multilayer film has a free shrink at 85°C of less than 80%."

Claims 2 to 11 are, either directly or indirectly, dependent on Claim 1. Claims 12 to 16 are directed to a container (Claims 12, 13) or a packaged product

comprising a container (Claims 14 to 16) comprising a multilayer film according to one of Claims 1 to 11 and Claims 17 to 21 pertain to the use of a multilayer film as defined in Claim 1 for providing a bonded film structure.

II. Notice of opposition based on the grounds of Articles 100 (a), (b) and (c) EPC was filed by

Cryovac Inc.

on 1 December 2000. The Opponent requested revocation of the patent in its entirety.

The documents relied upon were

D1 EP-A 0 707 957
D2 EP-A 0 597 502

III. Oral proceedings took place before the Opposition Division on 17 December 2002 during which the Patent Proprietor filed a set of Claims 1 to 20 as a basis for a new main request and four sets of claims as bases for auxiliary requests 1 to 4.
Claim 1 of the main request corresponded to Claim 1 as granted. Use Claim 17 was amended in that the word "co-extruded" was inserted between the words "three" and "layers" (line 2 of the claim). Claim 19 was deleted and Claims 20 and 21 were renumbered accordingly.

In the oral proceedings, the Opponent withdrew its objection raised in the notice of opposition that the Patent Proprietor was not entitled to priority. The

document D1 was therefore considered to constitute prior art according to Article 54(3) EPC only.

The Patent Proprietor introduced the following document:

D3 Annual Book of ASTM Standards (1989), pages 382-385.

IV. With its decision orally announced in the oral proceedings and issued in writing on 18 March 2003 the Opposition Division revoked the patent.

It was held in the decision that the feature in Claims 1 of all requests that the multilayer film *"has a free shrink at 85°C of less than 80%"* (hereinafter referred to as "the free shrink feature") had no basis in the application as filed. Furthermore, the term "free shrink" could not be regarded as a disclaimer over the disclosure of D1 because this term had to be interpreted in its normal sense as unidirectional shrink, whereas the term "free shrink" as used in D1 had the specific meaning "total free shrink", the latter being the sum of the free shrink in machine and in transverse directions. Introduction of the above feature into the claims therefore contravened Article 123(2) EPC.

Non-compliance with Article 123(2) was the only reason for revocation of the patent.

V. Notice of appeal was filed by the Patent Proprietor (hereinafter the Appellant) on 16 May 2003. The Statement of the Grounds of Appeal was submitted on 24 July 2003.

With the Statement of Grounds, the Appellant defended its main request submitted in the previous instance and filed new sets of claims as bases for auxiliary requests I to VI.

In a communication dated 10 May 2006 the Board *inter alia* indicated that the free shrink feature contravened the provisions of Article 123(2) EPC. The Appellant was informed that this feature could only be deleted without violating the requirements of Art. 123(3) EPC if it was replaced by originally disclosed shrinkability features limiting these properties of the film vis à vis the film according to Claim 1 as granted. In response to this communication, the Appellant replaced the previous auxiliary requests by new sets of claims according to auxiliary requests I, II and IIIa/b to VIIa/b submitted with the letter dated 1 June 2006.

Claim 1 of the new auxiliary request I differs from Claim 1 according to the main request in that

- the feature "at least three coextruded layers" was replaced by "only coextruded layers";
- the thickness of the first seal layer was indicated to be "3-20 µm";
- the thickness of the second seal layer was specified to be "1.5 to 2.5 times that of the first seal layer";
- the free shrink feature was supplemented with the term *"in both longitudinal and transverse directions"* and a further definition was introduced that the film *"has a heat-shrinkability in both longitudinal and transverse directions of 25-50% at 90-95°C or of 35-50% at 100°C".*

Claim 1 of the auxiliary request II differs from the corresponding claim of auxiliary request I by the deletion of the free shrink feature and reads as follows:

"1. A multilayer film, comprising only co-extruded layers including an outer first seal layer, an intermediate second seal layer disposed adjacent to the first seal layer, and an outermost third layer of a thermoplastic resin disposed opposite to the first seal layer with the second seal layer disposed between the first seal layer and the outermost third layer;

said first seal layer comprising more than 50 wt% of a metallocene-catalyzed polyolefin, and having a thickness of 3-20 µm;
said second seal layer having a thickness which is 1.5 to 2.5 times that of the first seal layer and comprising a copolymer of at least one oxygen-containing monomer and ethylene;
provided that said copolymer of the second seal layer has a crystal melting point lower than that of the metallocene-catalyzed polyolefin of the first seal layer and that said multilayer film has a heat-shrinkability in both longitudinal and transverse directions of 25-50% at 90-95°C or of 35-50% at 100°C."

Furthermore, documents D6 (a copy of page 698 of the "Plastic Processing Technical Handbook") and D7 (a copy of JIS K7127-1989) were submitted.

VI. The Respondent maintained its objections under Article 123(2) EPC raised in the first instance opposition proceedings and also provided arguments against the presence of novelty and an inventive step over D1 and D2. New documents D4 (EP-A 217 252) and D5 (US-A 5 035 955) were submitted.
The new auxiliary requests of the Appellant were argued to be late filed.

VII. Oral proceedings were arranged for 4 July 2006, for which the Appellant by letter of 1 June 2006 announced. accompanying persons and requested that they be allowed to speak, a request which the Respondent asked to be turned down.

VIII. The written and oral arguments of the Appellant are as follows:

(a) *Allowability of the free shrink feature according to the main request and auxiliary request I under the provisions of Article 123(2) EPC*

Original Claim 12 indicated that the claimed multilayer film had a "heat-shrinkability". This implied that the film was shrinkable from 0-100%, which range embraced all possible shrink values at any heat shrink temperature.
The free shrink feature merely excluded a small range of from 80 to 100% shrink at one single temperature of 85°C out of a very broad range embraced by the original disclosure, with the consequence that the shrinkability range remaining under the protection of the claims was still very broad. Therefore, the principles of a selection

invention developed by the jurisprudence of the boards of appeal, which inter alia required that the selected range be narrow, were respected.

It was furthermore evident from the disclosure at page 7, lines 55 to 58 of the A2 publication that the "heat shrinkability" disclosed in original Claim 12 was a synonym for "free shrink" used in Claim 1 of the patent and corresponded to the definition of "free shrink" as a "unidirectional shrink" either in the longitudinal or the transverse direction according to the ASTM Standard D3. In the above-mentioned passage the plural form "shrinkabilities" in both longitudinal and transverse directions" was used in context with shrink and its direction. This implied that the singular word "shrinkability" used in original Claim 12 had the meaning of a shrink in only one direction, which corresponded to the "free shrink" according to D3.

By contrast, the term "free shrink" used in Claim 1 of D1 had a different and specific meaning, namely the sum of the values for the free shrink in the longitudinal and in the transverse directions, for which the expression "total free shrink" was defined (D1, page 4, lines 46 to 50). Such a summation of the shrink values, however, was not part of the disclosure of the application as filed.
For these reasons, the free shrink feature according to the invention did not constitute a disclaimer vis à vis D1 in respect of which the provisions set out in G 1/03 had to be applied,

but represented an amendment within the framework of the original disclosure, which was allowable under Article 123(2) EPC.

(b) *Allowability of the feature "that it [i.e. the film] has a heat-shrinkability in both longitudinal and transverse directions of 25-50% at 90-95°C or of 35-50% at 100°C" according to the auxiliary requests I and II under the provisions of the Articles 123 (2) and (3) EPC.*

The above feature was disclosed in the application as filed, see the A2 publication, page 6, lines 40 to 45, and could be introduced into a product claim, protecting the product as such, without violating Article 123(2) EPC although it was linked in this passage with certain use purposes (hot sterilization for processed meat packaging and tray packaging, respectively).

The feature also constituted a limitation of the free shrink feature. The shrink range "25%/35%-50% excluded the range between 50% and 80% from the broader range "less than 80%" of the free shrink feature, given the fact that a reduction of the shrink temperature of from 90-95°C or 100°C to the temperature of 85°C according to the free shrink feature would result in a decrease rather than in an increase of the film shrinkability. It was therefore guaranteed that the shrink value of 80% was not exceeded.

The shrinkability/temperature relation supplementing the free-shrink feature in Claim 1

of auxiliary request I was therefore allowable under Article 123(2) EPC and, as a replacement feature in Claim 1 of auxiliary request II, did not extend the protection conferred and was therefore in line with Article 123(3) EPC.

IX. The counterarguments of the Respondent may be summarized as follows:

(a) *Concerning the arguments under (a) in section VIII*

There was no explicit disclosure to be found in the application as filed that the heat-shrink-ability of the film at 85°C was less than 80%, nor was the term "free shrink" originally disclosed.

By analogy with the circumstances underlying the decision T 526/92 - which is discussed in the Case Law of the Boards of Appeal, 4th Edition 2001, cf. last paragraph of page 202, - the free shrink feature according to the patent in suit made a technical contribution to the claimed invention because it not only introduced a technical parameter for which no information had been available in the original specification, but, moreover, selected a particular range which had not originally been disclosed.

For the following reasons, the free shrink feature constituted rather a disclaimer with respect to the disclosure in D1:

– the term "free shrink", the temperature of 85°C and the value 80% as a limiting value exactly corresponded to the indications in Claim 1 of D1;

– The remark in the cover page of the patent specification that *"the file contains technical information submitted after the application was filed and not included in this specification"* referred to the file history. From this history - in particular the passages in paragraph 2 at page 4 and paragraph 3 at page 10 of the letter dated 7 August 1998, submitted in the examination proceedings - the Applicant's intention was clearly evident, namely that the free shrink range of at least 80% at 85°C disclosed in D1 (D5 in the letter) should be disclaimed by the wording in Claim 1 "free shrink at 85°C of less than 80%".

Such a disclaimer, however, was not suitable to establish novelty over D1 because, according to the definition in D1 at page 4, lines 46 to 48, the term "free shrink" had the specific meaning of a "total free shrink", i.e. the sum of the free shrink in both longitudinal and transverse directions. However, it was not part of the technical teaching according to the patent in suit to characterise the shrink properties of the claimed film by way of a total free shrink.

The disclaimer was therefore not allowable.

(b) *Concerning the arguments under (b) in section VIII*

The disclaimer, however, which was already part of Claim 1 as granted, could not removed from the claims without violating Article 123(3) EPC.

By incorporating the free-shrink feature as a disclaimer into Claim 1 as granted, the intention was to exclude technical features disclosed in D1. Therefore, the technical meaning of such a disclaimer had to be interpreted in the sense of the teaching provided in this prior art document, i.e. as a total free shrink of less than 80%.

This upper limit of the total free shrink, however, could be exceeded by certain embodiments falling under the definition provided in the auxiliary requests I and II that "the film has a heat shrinkability in both longitudinal and transverse direction of 25-50% at 90-95°C or of 35-50% at 100°C".

X. The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request filed on 17 December 2002, or on the basis of any of the auxiliary requests I to VIIb, filed with the letter of 1 June 2006.

XI. The Respondent requested that the appeal be dismissed, that the auxiliary requests I to VIIb, filed with the letter of 1 June 2006, not be admitted into the oral proceedings, nor documents D6 and D7, as they were late filed. He further requested that the case be remitted to the Opposition Division for further prosecution in

the event that the Board came to the conclusion that any of the requests was considered formally allowable.

Reasons for the Decision

1. The appeal is admissible.

2. *Admissibility of the auxiliary requests into the appeal proceedings*

Auxiliary request I differs from auxiliary request I submitted with the Statement of the Grounds of Appeal only in that the first seal layer and the second seal layer are more precisely defined by indicating values for their respective thickness.

The free shrink feature was removed in the auxiliary request II, in order to overcome the Respondent's objections that this feature could not remain in the claim because of non-compliance with Article 123(2) EPC.

No new matters were introduced by these amendments such as would take the Respondent by surprise. Therefore, the auxiliary requests I and II are admitted into the proceedings.

The necessity to decide on the admissibility of the subsequent auxiliary requests does not arise because, as will be shown in the following, auxiliary request II was considered formally allowable.

3. *Allowance of the persons offered by the Appellant to speak*

The conditions for allowing persons accompanying the representative to speak in an oral hearing as set out in the decision G 4/95 (Headnote 2 (b), (i) to (iv)) were, in the Board's judgment, fulfilled with the Appellant's petition submitted with the letter dated 1 June 2006. The persons accompanying the Representative in the oral proceedings did not, however, take the opportunity to speak.

4. *Main Request - Admissibility of the free shrink feature in Claim 1*

4.1 In the light of the content of the application as filed

According to the case law of the Boards of Appeal (4th edition 2001, page 197 et seq.) an amendment is allowable under Article 123(2) EPC only if there is an unambiguous basis for it in the application as filed.

In exceptional cases, a feature which has not been disclosed in the application as filed but which had been added to the application during examination is not considered as subject-matter which extends beyond the content of the application as filed if it merely limits the protection conferred by the granted patent without providing a technical contribution to the subject-matter of the claimed invention (G 1/93, Headnote 2 Reasons 16).

In the application as filed, there is no disclosure to be found that the heat shrinkability of the multilayer

film in both the longitudinal and transverse directions is less than 80% at a temperature of 85°C. The normal requirement for the allowance of amendments under Article 123(2) EPC is therefore not fulfilled.

Concerning the afore-mentioned exception offered by G 1/93, it is *prima facie* obvious that the limitation of a technical feature, here shrinkability, impinges on its technical contribution to the subject-matter concerned and is therefore technically meaningful. The Appellant has failed to provide convincing arguments to disprove this inevitable logical consequence.

For these reasons, the free shrink feature according to the main request extends beyond the content of the application as filed.

4.2 As a disclaimer

In accordance with well-established practice, a disclaimer is an amendment to a claim excluding specific embodiments or areas from a broader concept. According to the decision G 1/03 a disclaimer may, *inter alia*, be allowable, if it restores novelty by delimiting a claim against state of the art under Article 54(3) EPC. It should not remove more than is necessary to restore novelty (Headnotes II.1 and II.2).

D1, state of the art according to Article 54(3) EPC, pertains to biaxially oriented multilayer films. One feature characterising the film in Claim 1 of D1 is a "free shrink, at 85°C, of at least 80%" (emphasis by the Board). The Appellant's intention to exclude this feature from the invention in the examining procedure

is immediately evident from the following passage at page 10, paragraph 3 of the letter dated 7 August 1998:

"... the film of D5 [which corresponds to D1 in the appeal proceedings] is characterized by having a heat shrinkability (free shrink) at 85°C of at least 80 percent... . As D5 is a prior application, such an exclusive proviso as adopted in the above-amended Claim 1 is believed acceptable under the EP practice ..."

and this exclusion was performed by formulating in Claim 1 of the patent the positive feature "free shrink at 85 °C of less than 80%" (emphasis by the Board).

In the Board's judgment, and in the absence of any information to the contrary in the patent specification itself, the term "free shrink" in this passage has to be interpreted in the way it is understood by the skilled person, i.e. as **unidirectional shrink** as set out in the ASTM Standards, reference D3. Even if it appears on the basis of the file history that the use of this term resulted from an incorrect interpretation of its intended meaning in D1, there is no room for a retroactive re-interpretation of this term in granted Claim 1 contrary to common general knowledge. This all the more as (i) D1 itself refers to the measurement of this feature according to ASTM Standard 2732 (page 4, lines 42 to 45) and (ii) as the reference on page 8, lines 18 to 21 of the patent specification to "shrinkabilities" in "both longitudinal and transverse directions" shows that importance is attributed to separate the shrink properties in these two directions.

The meaning of the term "free shrink" according to Claim 1 as granted is therefore to be interpreted as a unidirectional shrink.

However, according to the passage at page 4, lines 46 to 48 of D1 the term "free shrink" used in Claim 1 of D1 is defined differently:
"The multilayer film according to the present invention has a total free shrink of at least 80 percent. "Total free shrink" is determined by summing the percent free shrink in the machine direction with the percentage of free shrink in the transverse direction."

Given the meaning of the term "free shrink" in present Claim 1 as unidirectional shrink and the special meaning of the same term in D1 as "total free shrink" it is apparent that the free shrink feature in Claim 1 is at variance with D1's disclosure and cannot, therefore, be regarded as an admissible disclaimer thereover.

4.3 Conclusion

Because the free shrink feature in Claim 1 has no basis in the application as filed and does not represent a genuine disclaimer, the requirements of Article 123(2) are not met.

The main request is therefore not allowable.

5. *Auxiliary Request I - Allowability under the provisions of Article 84 EPC (Clarity)*

The amendment in Claim 1 of the auxiliary request I by introducing additional shrink properties of the film was made after the grant of the patent and has therefore to be considered under the provisions of Article 84 EPC.

In the Board's judgment, Claim 1 does not clearly express whether the film should either have a free shrink at 85°C in both longitudinal and transverse directions of less than 80% or a heat-shrinkability in both longitudinal and transverse directions of 25-50% at 90-95°C or of 35-50% at 100°C - which would mean that a choice can be made between the two features - or whether these latter shrinkability features limit the first one.

Claim 1 does therefore not meet the requirements of Article 84 EPC.

Consequently, the auxiliary request I is also not allowable.

6. *Auxiliary request II - Admissibility under the provisions of the Articles 123(2) and 123(3) EPC*

6.1 Article 123(2) EPC

In the oral proceedings, the Respondent argued that the features in Claim 1:

(a) that the multilayer film comprises only coextruded layers;
(b) that the thickness of the first seal layer is 3-20 µm;
(c) that the thickness of the second seal layer is 1.5 to 2.5 times that of the first seal layer and
(d) that the feature defining the heat-shrinkability of the film and replacing the free shrink feature

did not comply with Article 123(2) EPC.

The Board does not share the Respondent's position.

Feature (a) is derivable from page 6, lines 36/37 of the A2 publication, where it is stated that *"the multilayer film according to the present invention may generally be formed through co-extrusion"*, and the examples of the invention which all describe multilayer films, having up to eight layers, produced by coextrusion. Coextrusion is therefore unambiguously the preferred preparation method over "extrusion coating" or "lamination" disclosed in the same passage as alternatives.

Feature (b) is disclosed at page 5, lines 1 to 4 of the A2 publication, which comprises the statement: *"The thickness of the first seal layer may be suppressed below a half of the total multilayer film thickness and preferably at most 20 µm"*.

Concerning the upper limit of 20 µm, the Respondent argued that the disclosure in said passage limited, as a first requirement, the thickness of the first seal layer to a maximum of half of the total film thickness.

As a second requirement, the value "20 µm" represented the highest possible value but only under the condition that the total film thickness reached or exceeded double of this value.

In the Board's judgment this interpretation does not take proper account of the fact that there is no cogent technical reason for a dependence of the absolute value limit of 20 µm from the possible ("may be": see above quotation) relation between the thickness of the first seal layer and the total film thickness. In this instance, the Respondent's interpretation to the contrary is unfounded.

Clear and unambiguous disclosure of the feature (c) is found at page 4 line 58 to page 5 line 1 of the A2 publication.

The heat shrinkability values in feature (d) are disclosed at page 6, lines 42 to 45 of the A2-publication in the context of certain uses of the multilayer film (25-50% at 90-95°C for hot sterilisation for processed meat packaging; 35-50% at 100°C for tray packaging). This disclosure means that the shrink values make a film according to the invention particularly suitable for the indicated purposes but does not restrict the film thereto. Therefore, no violation of Article 123(2) EPC can be seen in an incorporation of these shrinkability/temperature relations into a product claim which protects the multilayer film as such.

From the above, the Board concludes that Claim 1 of the auxiliary request II meets the requirements of Article 123(2) EPC.

6.2 Article 123(3) EPC

Because the free shrink feature was already part of Claim 1 as granted and cannot remain in the Claim for the reasons given in point 4 above, it has to be considered whether Claim 1 of the auxiliary request II, omitting the free shrink feature and containing the replacement feature *"heat shrinkability in both longitudinal and transverse directions of 25-50% at 90-95°C or of 35-50% at 100°C"*, extends the scope of Claim 1 as granted or not.

This exercise has to start from the interpretation of the proviso in granted Claim 1 given above (Section 4.2), namely that the free shrink feature relates to unidirectional free shrink.

Accordingly, this feature requires that the claimed multilayer film has a free shrink at 85°C of less than 80%, measured independently either in the longitudinal or the transverse direction.

Any amendment of this feature allowing a free shrink of 80% or in excess thereof would therefore contravene the requirements of Article 123(3) EPC.

In assessing whether or not the amendment of the free shrink feature carried out according to Claim 1 of auxiliary request II extends the protection conferred by granted Claim 1, it has to be kept in mind that

uncontested, well-established general common knowledge teaches that in normal circumstances the shrink capacity of oriented polymer films increases with increasing temperature and decreases with decreasing temperature.

If, therefore, the amended shrink feature limits the heat shrinkability in both longitudinal and transverse directions to at most 50% at, respectively, 90-95°C and 100°C, it stands to reason that the respective shrinkabilities (corresponding to free shrink) when measured at the lower temperature of 85°C cannot attain or even surpass 80%.

Therefore, the feature "a heat-shrinkability in both longitudinal and transverse directions of 25-50% at 90-95°C or of 35-50% at 100°C" as defined in Claim 1 of auxiliary request II does not extend the protection conferred by granted Claim 1, in compliance with Article 123(3) EPC.

6.3 Conclusion

For the reasons given in points 6.1 and 6.2 and because the subsequent claims are either directly or indirectly dependent on Claim 1, the Board considers the auxiliary request II admissible within the meaning of the Articles 123(2) and 123(3) EPC.

7. *Remittal to the first instance*

Because the patent was revoked by the appealed decision for formal reasons only, based on the opposition ground under Article 100(c) EPC, the Board exercises its power

according to Article 111(1) EPC to remit the case to the first instance for the consideration of the issues of novelty, inventive step and, if necessary, sufficiency of disclosure.

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 for further prosecution on the basis of Claims 1 to 17 of auxiliary request II, submitted with letter of 1 June 2006.

The Registrar The Chairman

G. Röhn P. Kitzmantel