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D E C I S I O N
of 10 July 2006

Case Number: T 1001/04 - 3.3.09

Application Number: 96922330.4

Publication Number: 0871570

IPC: B32B 27/10

Language of the proceedings: EN

Title of invention:

Packaging laminates based on cardboard and paper

Applicant:

Tetra Laval Holdings & Finance SA

Opponent:

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Headword:

-

Relevant legal provisions:

EPC Art. 84

Keyword:

"Change of claim category - Clarity (yes)"
"Remittal to the previous instance"

Decisions cited:

-

Catchword:

-



Case Number: T 1001/04 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 10 July 2006

Appellant: Tetra Laval Holdings & Finance SA
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CH-1009 Pully (CH)

Representative: Smart, Peter John
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 17 March 2004
refusing European application No. 96922330.4
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. Kitzmantel
Members: W. Ehrenreich
W. Sekretaruk

Summary of Facts and Submissions

- I. European Patent Application No. 96 922 330.4 in the name of *Tetra Laval Holdings & Finance SA* entitled "*Packaging laminates based on cardboard and paper*" was filed on 25 June 1996 as International application PCT/SE96/00829.

The application was refused by a decision of the Examining Division issued in writing on 17 March 2004.

- II. The decision was based on a set of Claims 1 to 4 filed by the Applicant with the letter dated 21 January 2004. Claim 1 reads as follows:

"1. A folded moisture and heat resistant container intended for food products, microorganisms therein being killed or inactivated so that the filled product is not reinfected, which is manufactured of a material of laminate type in the form of a sheet or a web, said laminate comprising at least one base layer (1), an outer coating (2) and an inner coating (3), characterized in that the base layer (1) consists of paper or cardboard, the outer coating (2) consists of a polymer selected from the group including polypropylene, oriented polypropylene, metalized oriented polypropylene, high density polyethylene, metalized high density polyethylene, linear low density polyethylene, polyester, metalized polyester and amorphous polyester, and the inner coating (3) consists of a polymer selected from the group including polypropylene, high density polyethylene, linear low density polyethylene, polyester and amorphous polyester, the container with included food products being able to

withstand a heat treatment at a temperature of 85°C or more under the strong influence of moisture in the form of water as liquid or steam as well as with moist heat and a pressure above the atmospheric."

Claims 2 to 4 were, either directly or indirectly, dependent on Claim 1.

- III. The only reason for refusing the application was that the claims lacked clarity, contrary to the requirements of Article 84 EPC.

It was held in the decision that Claim 1 was formulated in terms of a result to be achieved. In the absence of suitable criteria, the skilled person would not be able to distinguish between packages which were able to withstand heat treatment and those which were not. Although the skilled person was familiar with sterilisation and autoclaving processes, the claims did not indicate which sterilisation method was used, which type of food was to be packaged or which microorganisms were to be neutralised. Indications as to the duration of the heat treatment under very moist conditions in the form of liquid water or steam were missing as well as information about moist heat and pressure above atmospheric pressure.

- IV. On 13 May 2004, a Notice of Appeal against the above decision was filed by the Applicant (hereinafter referred to as the Appellant) with simultaneous payment of the prescribed fee.

With the Statement of the Grounds of Appeal filed on 8 July 2004 the Appellant submitted, as basis of a new

main request, Claims 1 to 6 in which the claim category had been changed vis à vis the category of the claims on which the appealed decision was based. The wording of Claim 1 was as follows:

"1. A method for producing a folded moisture and heat resistant container manufactured of a laminate material in the form of a sheet or a web, said method comprising producing a container from a laminate comprising at least one base layer (1) which consists of a liquid absorbing material, an outer coating (2) which consists of a polymer selected from polypropylene, oriented polypropylene, metalized oriented polypropylene, high density polyethylene, metalized high density polyethylene, linear low density polyethylene, polyester, metalized polyester and amorphous polyester, and an inner coating (3) which consists of a polymer selected from polypropylene, high density polyethylene, linear low density polyethylene, polyester and amorphous polyester, by folding, and sealing said laminate to form a said container, filling and closing said container, and heat treating the filled and closed container in a humid atmosphere at a temperature of 85°C or more in a process of sterilisation by heat, without the dimensional stability of the container being thereby impaired."

The Appellant argued that the claims of the main request were free from the objections raised in the appealed decision and also put forward arguments for the presence of novelty and an inventive step over the documents cited in the examining procedure.

V. Oral proceedings were arranged for 3 May 2006. In a communication issued on 21 March 2006, the Board expressed its concern about some of the amendments in Claim 1 with respect to Article 123(2) EPC.

The Board further noted that the claims according to the main request met the requirements of Article 84 EPC and indicated that the case would be remitted to the Examining Division for further prosecution once claims had been filed which were formally allowable under the Articles 84 and 123(2) EPC.

VI. In response to the Board's communication the Appellant filed, with a letter dated 30 March 2006, auxiliary requests 1 to 4 and indicated that it was willing to adopt either the first or second auxiliary request as the main request if the Board still considered the current main request not to be acceptable.

VII. In a further communication dated 10 April 2006 and submitted in advance by fax on 7 April 2006, the Board maintained its opinion that Claim 1 of the main request was not allowable and informed the Appellant that Claims 1 to 6 of the auxiliary request 1 could be accepted under the provisions of the Articles 84 and 123(2). The Appellant was invited, in order to avoid the oral proceedings scheduled for 3 May 2006, to declare that the claims according to the auxiliary request 1 constituted the new main request and to amend Claim 3 of this request by replacing the wording "*selected from the group including*" by "*selected from*".

VIII. In its letter of response dated 7 April 2006 the Appellant stated that the previous first auxiliary

request was now its new main request and filed a complete set of Claims 1 to 6 of this request. All previous requests were cancelled. A correction of Claim 1 was discussed in a telephone conversation between the rapporteur and the representative of the Appellant on 11 April 2006, and a replacement page with the necessary correction in Claim 1 was submitted by fax on 12 April 2006.

The oral proceedings were cancelled.

IX. Claim 1 of the new main request reads as follows:

"1. A method for treating a filled, folded moisture and heat resistant container manufactured of a material of laminate type in the form of a sheet or a web, said laminate comprising at least one base layer (1), an outer coating (2) and an inner coating (3), wherein the base layer (1) consists of a liquid absorbing material, the outer coating (2) consists of a polymer selected from polypropylene, oriented polypropylene, metalized oriented polypropylene, high density polyethylene, metalized high density polyethylene, linear low density polyethylene, polyester, metalized polyester and amorphous polyester and the inner coating (3) consists of a polymer selected from polypropylene, high density polyethylene, linear low density polyethylene, polyester and amorphous polyester, said method comprising heat treatment of the container in a humid atmosphere at a temperature of 85 °C or more to produce sterilisation by heat, without the dimensional stability of the container being thereby impaired."

Claims 2 to 6 are, either directly or indirectly, dependent on Claim 1.

- X. Although no clear request was submitted by the Appellant to remit the case to the Examining Division for further prosecution on the basis of Claims 1 to 6 filed with the letters dated 7 April (Claims 2 to 6) and 12 April 2006 (corrected Claim 1), it follows from the whole correspondence that such a request was intended. This particularly results from the passage in the first paragraph of the Appellant's letter dated 27 June 2006 "*... we are awaiting a decision from the Board remitting the application back to the Examining Division for further examination on the basis of amended claims.*"

Reasons for the Decision

1. The appeal is admissible.
2. *Article 84 EPC*

The claims of the new main request overcome the objections under Article 84 EPC which constituted the reasons for the refusal of the application.

The process steps, as well as the laminate structure and the materials constituting the layer (1) and the coatings (2) and (3), are clearly defined in Claim 1.

3. *Article 123 (2) EPC*

In the Board's judgment, the subject-matter of the main request does not extend beyond the content of the application as filed: see the application as filed (represented by the WO-publication 97/02140), Claims 1 to 5 in conjunction with the whole of page 3.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution on the basis of
 - Claim 1 submitted with the letter (erroneously dated 7 April 2006) sent in response to the telephone conversation of 11 April 2006, confirmed in writing with the Board's communication of 13 April 2006;
 - Claims 2 to 6 submitted with the letter, dated 7 April 2006 and received by fax on the same day.

The Registrar

The Chairman

G. Röhn

P. Kitzmantel