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**Datasheet for the decision
of 4 March 2016**

Case Number: T 0971/11 - 3.2.05

Application Number: 02722834.5

Publication Number: 1391288

IPC: B29C61/02, B29C55/02, C08J5/18,
B29C47/10, B29B7/30, B29B7/58,
B29B11/00, B29B13/10, C08L67/02

Language of the proceedings: EN

Title of invention:

Heat-shrinkable polyester film roll and process for producing
the same

Patent Proprietor:

Toyobo Co., Ltd.

Opponent:

Klöckner Pentaplast GmbH

Headword:

Relevant legal provisions:

EPC 1973 Art. 54(2), 56, 114
RPBA Art. 12(4), 13(1), 13(3)

Keyword:

Late-filed evidence - re-submitted with the statement of grounds of appeal (admitted)
Public prior use (evidence insufficient)
Novelty (yes)
Inventive step (yes)

Decisions cited:

G 0007/93, T 0876/05, T 2102/08

Catchword:

Discretion of a board of appeal to admit a document which was not admitted in the first-instance proceedings (see points 1.3 and 1.4)



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Case Number: T 0971/11 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 4 March 2016

Appellant: Klöckner Pentaplast GmbH
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 25 February
2011 rejecting the opposition filed against
European patent No. 1391288 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman	M. Pooock
Members:	P. Lanz
	G. Weiss

Summary of Facts and Submissions

- I. The appeal by the opponent is against the decision of the opposition division rejecting the opposition against European patent EP-B-1 391 288.
- II. In the opposition proceedings, the grounds for opposition according to Article 100(a) (lack of novelty and lack of inventive step) and 100(b) EPC 1973 were raised.
- III. Oral proceedings were held before the board of appeal on 4 March 2016, during which the appellant stated that of the three alleged prior uses that relating to "Steiny" beer bottles (cf. documents B8 and B9) would not be pursued.
- IV. The appellant requests that the decision under appeal be set aside and that the European patent be revoked.

The respondent (patent proprietor) requests as main request that the appeal be dismissed or, on a subsidiary basis, that the case be remitted to the department of first instance or that the decision under appeal be set aside and that the patent be maintained on the basis of the claims filed with the letter of 26 February 2016 as auxiliary requests 1 and 2.

- V. Reference is made to following documents:

B1: Wayne K. Shih: "Shrinkage Modeling of Polyester Shrink Film", Polymer Engineering and Science, July 1994, Vol. 34, No. 14 (referred to as E13 during the opposition proceedings);

B2: Test results concerning the shrinkage properties of films made of "Eastar PETG 6763" according to the data of Figure 10 of document B1 (shrinkage time 30 sec.);

B3: Shrinkage properties of films made of "Eastar PETG 6763" measured according to the contested patent with a shrinkage time of 10 seconds;

B4: "Some Do's and Don'ts in Extrusion of Film From Eastar PETG Copolyester 6763", Eastman Chemical Company, May 1994;

B5: Chemical composition of polyesters of the type "Eastar PETG 6763" and "Embrace";

B6: Acceptance protocol for the stretching frame "1267 KAP / BSR2" of Brückner GmbH dated 10 July 1998;

B7: Measurement of air temperature in the stretching frame "1267 KAP / BSR2";

B8: Press releases on shrink sleeves made of "Eastar PETG 6763" for beer bottles of Asahi Breweries Ltd.;

B9: Picture credits "Steiny Bottle (Asahi Super Dry)", PhD thesis by Natascha Haehling von Lanzauer, 18 February 1999;

B10: Declaration by Dr Deiringer concerning the industrial production of polyester shrink films with a minimum length of 3000 metres;

B11: SAP system print-outs, invoice and data sheets of Klöckner Pentaplast concerning the sale and the technical properties of shrink films "E749/01" made of "Eastar PETG 6763" between 1998 and 2000;

B12: Expert article "Taking technology to flex extremes" on the occasion of the market launch of "Nesquik" drinks in the USA in bottles with shrink labels made of polyester of the type "Embrace" in April 1999, Packaging Digest, 1 March 2002;

B13: Shrinkage measurements on a 1000 m long film made of polyester of the type "Embrace", measured according to the contested patent with a shrinkage time of 10 seconds;

B14: US 4 634 840;

B15: Massey, Liesl K.: "Permeability Properties of Plastics and Elastomers - A Guide to Packaging and Barrier Materials", 2nd Edition, 2003, Plastics Design Library, page 188;

E7: Patent abstract and English translation of JP 4117432;

E11: WO 01/12697.

VI. The independent claims of the patent as granted read as follows:

"1. A film roll of a heat-shrinkable polyester film, the length of the film roll being 500m or more, and the heat-shrinkable polyester film meeting the following requirements (1) and (2):

(1) when an initiation end of winding of a film which is obtained from a steady region where physical properties of the film are stabilized in a longitudinal direction is designated as a first end; a termination end of winding thereof is designated as a second end; a first

cut-off point of samples of the film is provided at a position 2m or less inner from the second end; a final cut-off point of the samples is provided at a position 2m or less inner from the first end; a plurality of additional sample cut-off points are provided at an interval of about 100m from the first cut-off point; the samples being square samples in a size of 10cmx10cm cut off from each of the cut-off points; and all the samples have a heat shrinkage percentage of 20% or more in the maximum shrinkage direction after the respective samples are immersed in hot water at 85°C for 10 seconds, subsequently in water at 25°C for 10 seconds, and then withdrawn;

(2) a raw polymer used for production of the film comprises a major constitutional unit and one or more sub constitutional units different therefrom; the sub constitutional unit which is present in the greatest amount among all the sub constitutional units is designated as a primary sub constitutional unit; the content of the primary sub constitutional unit in each sample properly cut off from each of the cut-off points described in the requirement (1) is 7 mole% or more in 100 mole% of all the constitutional units; and when an average of the content of the primary sub constitutional unit is calculated, the contents thereof of all the samples fall within a range of ± 2 mole% relative to the average content, wherein the major constitutional unit is an ethylene terephthalate unit, and the primary sub constitutional unit is a unit consisting of neopentyl glycol and terephthalic acid, or a unit consisting of 1,4-cyclohexane dimethanol and terephthalic acid, or a unit consisting of 1,4-butanediol and terephthalic acid, or a unit consisting of ethyleneglycol and isophthalic acid; and wherein the heat shrinkable polyester film further meets the requirement that when the average of the heat shrinkage percentages in the maximum shrinkage

direction of the samples defined in requirement (1) is calculated, the heat shrinkage percentages of all the samples fall within a range of $\pm 3\%$ relative to the average."

"6. A process for producing the film roll of the heat-shrinkable polyester film defined in anyone of claims 1 to 5 wherein the extruding step is carried out by an extruder mounted with a funnel-shaped hopper as a raw chip supplier, the hopper having an inclination angle of 65° or more relative to the ground; wherein the hopper has an internal capacity of holding 15 to 120 mass % of polyester relative to a discharge amount of the extruder per hour; and further comprising the steps of melt-extruding raw polymer into film, cooling the film and drawing the film, and winding the film into a film roll wherein variations in the surface temperature of the film measured at any point in a preheating step, a drawing step, and a heat-treating step after the drawing step, are controlled, respectively, in a range of $\pm 1^\circ\text{C}$ relative to the average temperatures with respect to preheating, drawing, and heat-treating zones over an entire length of the film."

"10. Use of a film roll according to any of Claims 1 to 5 for the production of a heat-shrinkable label."

VII. The arguments presented by the appellant in writing and during the oral proceedings are essentially as follows:

Admission of documents B1 to B7 and B10 to B14

Document B1, which had by mistake not been admitted by the opposition division and which was now resubmitted together with the statement setting out the grounds of appeal, was clearly *prima facie* relevant. This had been

erroneously denied by the opposition division. In particular, the polyester material "Eastar PETG 6763" used for the shrinkage tests in document B1 had all the properties specified in the contested claim, as established in documents B2 and B3. Moreover, this film type had been the subject of multiple sales prior to the earliest priority date of the patent in the form of labels on "Nesquik" containers and as rolls of "E749/01" films by Klöckner Pentaplast, in view of which the subject-matter claimed was neither novel nor inventive. Thus, document B1, as well as the further supporting documents B2 to B7 and B10 to B13, prejudiced the maintenance of the contested patent. When deciding on the admissibility of the evidence B1 to B7 and B10 to B13, account should also be taken of the course of events in the first-instance proceedings, in view of which the submission of this evidence at the beginning of the appeal proceedings had to be considered an immediate and appropriate reaction to the appealed decision. It should therefore be admitted into the appeal proceedings.

Document B14 was *prima facie* particularly relevant for proving that a precise temperature control of +/- 0.5°C during the process steps of pre-heating, drawing and heat-setting belonged to the common general knowledge and was thus not inventive. The document was being filed in response to an assertion already made by the patent applicant, now respondent, during the examination proceedings in September 2007 that the accuracy of the temperature control was +/- 2.5°C. In view of that and because it could not be retrieved earlier, document B14 should be admitted into the appeal proceedings even though filed only after the arrangement of oral proceedings before the board of appeal. In fact, document B14 further supported and only filled a gap in

the appellant's submissions on file. Furthermore, a combination of document B14 with documents E7 or E11 rendered obvious the subject-matter claimed.

Novelty and inventive step

Glycol-modified polyester of the type "Eastar PETG 6763" in documents B1, B4 and B15 (referred to as "E749/01" in document B11) had both the chemical composition (cf. document B5) and the shrinkage properties (cf. documents B2 and B3) defined in claim 1. Documents B2 and B3 confirmed that the shrinkage behaviour of this material depended linearly on the stretching temperature with a gradient of 0.36%/°C. Already in 1998 stretchers having a temperature variation of less than +/- 0.2°C were state of the art so that a shrinkage variation below the claimed +/- 3% could be achieved (cf. documents B6 and B7). Moreover, the material had been made available to the public before the priority date, since it was not only discussed in document B1, but was also produced and sold by Klöckner Pentaplast GmbH & Co KG under the designation "E749/01", as proven by document B11. According to the declaration by Dr Deiringer (cf. document B10), the industrial production of shrink films for packaging required a roll length of at least 3000 metres. Particular reference was made to the fact that the currency appearing on the invoice of pages 8 and 9 of document B11 was "DEM", indicating that the sale took place before 2002, and also to the weight of the delivered film roll as about 6500kg, which implied a film length of about 3600 metres. Thus, all features of the contested claims were anticipated by the prior sale of "E749/01" films.

Additionally, the subject-matter claimed had been disclosed before the earliest priority date by the offer

for sale of "Nesquik" bottles with shrink sleeves made of a glycol-modified polyester of the type "Embrace" (cf. document B12, starting from page 3, last paragraph), the chemical composition and the shrinkage properties of which were as specified in present claim 1 (cf. documents B5 and B13).

For these reasons, the subject-matter claimed was neither novel nor inventive.

VIII. The respondent argues essentially as follows:

Admission of documents B1 to B7 and B10 to B14

As regards the procedural aspects, a decision rejecting document B1 as being late filed had already been rendered by the opposition division. Reference was made to page 6 of the decision under appeal, where the division emphasised that this document failed to disclose several features of granted claim 1. In order to allow document B1 to be taken into account, it was thus not sufficient to simply resubmit the document in the appeal phase. Rather, it would have been the appellant's task to demonstrate that the opposition division had misused the discretion provided by Article 114(2) EPC 1973 when disregarding this document. However, the appellant merely alleged in the grounds of appeal that document B1 described films having all the features of claim 1 of the opposed patent, without addressing the shortcomings identified in the contested decision.

Additionally, it was noted that document B1 was filed so late that the arguments based on it, which the appellant now sought to substantiate with the newly filed evidence B2 to B7 and B10 to B13, had never been discussed in the

first-instance proceedings. The facts allegedly proven by these documents were unrelated to the facts and evidence which had been relied on by the appellant in the original notice of opposition, or in the subsequent written opposition proceedings. The new material now submitted by the appellant together with the grounds of appeal did not supplement the material previously discussed in the first-instance proceedings or serve as a response to the findings in the decision under appeal. The appellant's grounds of appeal failed to challenge the decision on its merits. Rather, both the board and the respondent were confronted with a completely fresh opposition case which only formally remained within the framework of the grounds of opposition originally raised. Moreover, the newly filed documents had been available to the appellant for a long time and should have been filed together with the notice of opposition. Finally, they were *prima facie* not relevant enough to potentially change the outcome of the appeal proceedings. The evidence B1 to B7 and B10 to B13 should therefore be rejected by the board as being late filed.

Document B14 was filed on 3 February 2016, i.e. one month before the oral proceedings before the board of appeal. As explained by the appellant, its submission did not relate to developments in the present appeal proceedings but was regarded by it as a reaction to discussions during the examination proceedings in September 2007. Moreover, it neither filled gaps in an existing chain of arguments nor related to common general knowledge, which was normally reflected in textbooks and not in patent literature. In fact, document B14, which was readily available in patent databases, was combined with documents E7 or E11 in order to form a new inventive step attack. However, it was submitted so late that the respondent could not

comprehensively deal with it without adjournment of the oral proceedings. Late-filed document B14 should therefore not be admitted.

Novelty and inventive step

Regarding the substance of document B1, the respondent put forward that according to page 1124, right-hand column, the experiments were carried out, *inter alia*, with a copolymer "Kodar PETG 6763". The subsequent references to "PETG 6763" referred to this specific polymer. In document B1 there was no mention of "Eastar PETG 6763", so that the appellant's assertion that "PETG 6763" actually meant "Eastar PETG 6763" had no basis. Even on the assumption that the experiments in document B1 were indeed carried out with "Eastar PETG 6763", there was no proof that the properties and the chemical composition established in the test reports B3 and B5 for a contemporary "Eastar PETG 6763"-type polyester were identical to those which would have been shown by the polyester allegedly referred to in document B1, which dated from July 1994. In that respect, further doubts arose from the inconsistencies in the appellant's submissions regarding the chemical composition of "Eastar PETG 6763", in particular with respect to the content of 1,4-cyclohexane dimethanol (cf. appellant's letter dated 17 January 2011 and document B5).

Regarding the appellant's own, allegedly novelty-destroying prior sale of "E749/01" films, it was noted that document B11 did not, in fact, concern "Eastar PETG 6763" but a blend of 99.2% "Eastar PETG 6763" with 0.8% of another polyester, the composition of the blend being valid as of December 2005 (cf. page 1 of document B11), i.e. after the earliest priority date of the patent in suit. Moreover, pages 2 to 5 of document B11 apparently

referred to deliveries between January 1998 and December 2000. It was thus not clear whether all parts of document B11 related to the same polyester material. For the same reason the evidence on file was not suitable to establish the composition of the "E749/01" films allegedly sold in May 2000 (cf. invoice on pages 8 and 9 of B11). The fact that this invoice was dated 17 May 2000 but contained on its second page a reference to a legal provision of 28 November 2006 raised further doubts as to the value of document B11 as objective evidence. Additionally, neither the conditions under which the "E749/01" films had been prepared nor the homogenous composition and shrinkage characteristics defined in the contested claim were established. In view of that, the allegedly novelty-destroying prior sale of "E749/01" films was not proven beyond reasonable doubt, as required by the case law of the boards of appeal for a prior use by an opponent itself.

Finally, document B12 relating to the alleged disclosure of the subject-matter of claim 1 in the context of shrink sleeves made of "Embrace" polyester on "Nesquik" bottles was silent on the exact type of "Embrace" polyester used. According to document B5, at least two types of this material existed ("Embrace 21214" and "Embrace LV"). Document B13 showed shrinkage data for a film prepared from "Embrace LV". It remained unclear how this test film had been prepared, and whether the preparation conditions had any relationship to those used for the shrink labels discussed in document B12. In fact, it appeared highly likely that the film tested in document B13 had been prepared by the appellant in 2011 in full knowledge of the granted patent and the pending opposition proceedings. For this reason, the reliability of the respective data for these proceedings was contested. In addition, no explanation was provided on

why (only) "Embrace LV" had been tested, although even the appellant's own data showed that at least one further polyester was available under this name.

In summary, for neither of the prior uses had a complete and conclusive chain of evidence been made available which would support the allegation that the products in question inherently anticipated or at least rendered obvious the subject-matter of the present claims.

Reasons for the Decision

1. *Admission of documents B1 to B7 and B10 to B13 filed with the statement setting out the grounds of appeal*

1.1 Under Article 114(2) EPC 1973 it is at the opposition division's discretion not to admit late-filed documents. It is well established case law that these are to be examined as to their relevance by the department of first instance; late-filed facts and evidence and supporting arguments should then be exceptionally admitted into the proceedings if, *prima facie*, there are reasons to suspect that such late-filed documents prejudice the maintenance of the European patent in suit.

The discretionary power conferred by Article 114(2) EPC 1973 necessarily implies that the EPO department of first instance has a certain degree of freedom in exercising its power (cf. G 7/93, OJ EPO 1994, 775). A board of appeal should only overrule the way in which a department of first instance has exercised its discretion when deciding on a particular case if it concludes that it has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way. This rule also

applies with respect to opposition division decisions on the admission of late-filed submissions. It is generally not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the department of first instance, in order to decide whether or not it would have exercised such discretion in the same way (cf. cases cited in Case Law of the Boards of Appeal of the European Patent Office, 7th Edition, 2013, IV.C.1.3.3).

- 1.2 In the present case, the opponent/appellant filed the document now referred to as B1 two days before the oral proceedings before the opposition division as document E13. According to the impugned decision (cf. point 2 of the Reasons), the opposition division not only took into account that document B1 was filed shortly before the oral proceedings, but also examined its *prima facie* relevance. It came to the conclusion that the late-filed document failed to disclose or render obvious the subject-matter of claim 1 and could thus not prejudice the maintenance of the patent in suit. Hence, the opposition division based its discretionary decision not to admit document B1 into the proceedings on the principles established by the jurisprudence and did not act in an unreasonable way. Nor was this aspect challenged by the appellant. Under these circumstances, the board sees no reason to overrule the way in which the department of first instance exercised its discretion under Article 114(2) EPC 1973.

Together with its statement setting out the grounds of appeal, the appellant resubmitted document B1 in addition to new documents B2 to B7 and B10 to B13, the admission or not of which is governed by Article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA). Following this provision, the non-admission of a

document which was not admitted in the first instance proceedings into the appeal proceedings is at the discretion of the board. In fact, the wording of Article 12(4) RPBA puts documents that could have been submitted before the department of first instance but were not and documents that were submitted but were not admitted on an equal footing. According to the established case law, a filing made with the statement of grounds of appeal should not be considered inadmissible if it is an appropriate and immediate reaction to developments in the previous proceedings, such that the appellant who lost the opposition proceedings is thereby given the opportunity to fill the gaps in its arguments by presenting further evidence on appeal (cf. cases cited in Case Law of the Boards of Appeal of the European Patent Office, 7th Edition, 2013, IV.C.1.4.5 a)). Where an appellant challenges a finding in the impugned decision concerning the non-admission of a document by bringing forward further related submissions, the board must establish whether these submissions can be considered an appropriate and immediate reaction to developments in the first-instance proceedings and to this aspect of the appealed decision. This is not to say that, in doing so, the board of appeal is re-exercising the discretion of the department of first instance based on the case as it was presented then. Rather, the board may be now confronted with additional facts and different circumstances. The board has to exercise its discretion under Article 12(4) RPBA independently, giving due consideration to the appellant's additional submissions.

- 1.3 For these reasons, the present board does not fully share the view expressed, for example, in decision T 2102/08 of 26 July 2011 (point 4.3.1 of the Reasons, cf. in particular page 23), or in "The treatment of late

submissions in proceedings before the boards of appeal of the European Patent Office" by B. Günzel (OJ EPO, Special Edition 2/2007, 40, no. 7), that the provisions of Article 12(4) RPBA exclude the admission of a document into the appeal proceedings if it was held inadmissible by the opposition division by a correct discretionary decision. In the judgement of the present board, a document which would have been admitted into appeal proceedings if it had been filed for the first time at the outset of those proceedings should not, however, be held inadmissible for the sole reason that it was already filed before the department of first instance (and not admitted). To impose such a limitation on the discretion conferred by Article 12(4) RPBA could even have the undesirable effect of encouraging a party to hold back a document during the opposition proceedings, only to present it at the appeal stage (cf. also T 876/05 of 7 November 2007, Reasons 2).

- 1.4 Turning to the course of the first-instance proceedings of the present case, it is noted that in a communication dated 4 December 2009 the opposition division provisionally assessed the evidence then on file and came to the conclusion that the subject-matter of claim 1 appeared not novel in view of document E7. After a further exchange of arguments between the parties, the opposition division issued a summons to attend oral proceedings (cf. communication dated 7 May 2010). In the annex to the summons, the division's indications on the disputed substantive issues were essentially limited to the following statement:

"It is the purpose of the oral proceedings to assess [sic], if the opposition is admissible and [sic] if the patent in suit meets the requirements of Article 83 EPC, Article 54 (1) (2) EPC and Article 56 EPC."

It follows that, before the oral proceedings, there was no indication from the opposition division that it would depart from its previously communicated opinion. It appears from the file that it was only in the light of the discussions during the oral proceedings that the division changed its view and finally arrived at the decision to reject the opposition, essentially based on the finding that the feature relating to the heat shrinkage of all the samples falling within a range of $\pm 3\%$ relative to the average over a roll length of 500 metres was not disclosed or rendered obvious by the prior art filed before it (cf. appealed decision, point 5 of the Reasons).

Under these circumstances, it appeared not necessary for the opponent/appellant to file further evidence before the final date set by the opposition division according to Rule 116(1) EPC. Submitting the evidence B1 in combination with B2 to B7 and B10 to B13 at the beginning of the appeal proceedings and at the same time challenging, on that basis, the non-admission of document B1 because, in its view, B1 inherently disclosed the contested claim feature can be considered to be an immediate and appropriate reaction to developments in the last phase of the opposition proceedings and to the appealed decision, and more particularly to be an attempt by the opponent/appellant to fill gaps in its arguments which only became apparent during the oral proceedings before the opposition division. The fact that the opponent/appellant already filed document B1, on its own initiative, shortly before the oral proceedings so that this document could possibly be considered by the department of first instance, instead of holding it back in order to submit it only at the appeal stage, was neither detrimental to

procedural economy nor a disadvantage to the respondent (or the board) and is thus not to be held against the appellant under Article 12(4) RPBA. The board additionally observes that none of the documents B1 to B7 and B10 to B13 relates to the alleged prior use "SF-E649", which was raised in the notice of opposition but not pursued further by the appellant (cf. minutes of the oral proceedings of 19 January 2011, page 2, paragraph 5). In the light of the above, the board concludes that documents B1 to B7 and B10 to B13 are not to be held inadmissible under Article 12(4) RPBA. Consequently, they are admitted into the proceedings.

2. *Document B14 filed after the arrangement of oral proceedings before the board of appeal*

2.1 According to Article 13(1) RPBA, any amendments to a party's case after it has filed its grounds of appeal may be admitted and considered at the board's discretion. The discretion is to be exercised in view of, *inter alia*, the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

Article 13(3) RPBA additionally requires that amendments sought to be made after oral proceedings have been arranged are not to be admitted if they raise issues the board or the other party cannot reasonably be expected to deal with without adjournment of the oral proceedings.

2.2 In the present case, the appellant filed document B14 approximately one month before the date of the oral proceedings before the board of appeal, allegedly in order to respond to a statement of September 2007 put forward by the respondent during the examination of the

application underlying the patent in suit. According to the appellant, document B14 was to be admitted since it represented common general knowledge and filled gaps in its previous submissions.

- 2.3 In the judgement of the board, a reference to a statement made by the respondent during the examination proceedings does not, as such, justify the filing of a prior art document at the final stage of opposition appeal proceedings. If the appellant considered it decisive for its case to introduce document B14 in order to relativise an argument used in the procedure up to grant, it could and should have done so in the notice of opposition. Moreover, according to the established case law, common general knowledge is represented by basic handbooks and textbooks on the subject in question; it normally does not include patent literature and scientific articles (cf. decisions cited in Case Law of the Boards of Appeal of the European Patent Office, 7th Edition, 2013, I.C.1.6.1). In view of that, patent document B14 is not immediately recognisable as appropriate to prove common general knowledge. Finally, the board observes that, rather than relying on late-filed document B14 to fill gaps in its existing submissions, the appellant combines this prior art with documents E7 or E11 in order to present a new line of attack against the inventive merits of the contested claims at a very late stage of the appeal proceedings. The appellant's course of action is not compatible with the principles of procedural economy and procedural fairness. Moreover, the other party cannot be reasonably expected to deal comprehensively with the newly filed objections without adjournment of the oral proceedings or remittal of the case to the opposition division. For these reasons, document B14 (and the submissions based

thereon) are not admitted into the appeal proceedings under Article 13(1) and (3) RPBA.

3. *Novelty and inventive step*

- 3.1 In proceedings before the European Patent Office the party which raises an objection bears the burden of proving it. If an objection based on a public prior use is disputed, the standard of proof of the balance of probabilities is applicable when both the patent proprietor and the opponent had access to the evidence in support of the alleged public prior use. However, in cases where all the supporting evidence lies within the power and knowledge of the opponent, while the patentee has barely any or no access to it at all, the standard of proof established by the case law of the boards of appeal is more stringent (cf. decisions cited in Case Law of the Boards of Appeal of the European Patent Office, 7th Edition, 2013, III.G.4.3.2 and III.G.5.1.1).
- 3.2 Turning to the case at hand, the appellant submits that in May 2000 it delivered to a customer 6505kg of "E749/01" films, which consisted of 99.2% of "Estar PETG 6763" polyester. Document B11 was filed as evidence of this prior sale, in respect of which following inconsistencies remain: the composition on the first page of document B11 dates from November 1998 with a last change in December 2005, i.e. after the earliest priority date of the patent in suit. However, pages 2 to 5 of document B11 refer to deliveries between January 1998 and December 2000. The evidence is thus not suitable to establish whether all parts of document B11 relate to the same polyester material or what exactly the composition was at the priority date of the patent in suit. This also applies to the composition of the batch of films allegedly delivered in May 2000 (cf.

invoice on pages 8 and 9 of B11). The fact that the invoice is dated 17 May 2000 and refers to "DEM" as the currency but contains on its second page a reference to a legal provision of 28 November 2006 raises doubts as to its value as objective evidence. Additionally, the documents on file remain silent on the conditions under which the films sold had been prepared and fail to establish clearly whether the films delivered had the features of the homogenous composition and shrinkage characteristics defined in the contested claim. In view of this, the board judges that the allegedly novelty-destroying prior sale of "E749/01" films is not proven as required by the case law of the boards of appeal for a prior use by an opponent itself.

- 3.3 The second line of attack is based on an alleged public prior use of a glycol-modified polyester film of the "Embrace"-type in the form of shrink sleeves on "Nesquik" bottles as of April 1999 (cf. document B12, bottom of page 3 onwards), which allegedly met all the requirements defined in present claim 1. It is noted that document B12 does not mention the exact type of material which was used for the shrink sleeves. Following the appellant's own document B5, at least two different products of the "Embrace" type exist ("Embrace 21214", "Embrace LV"). The shrinkage test of document B13 was, however, only carried out for one of them ("Embrace LV"). Moreover, the general question arises whether a contemporary "Embrace"-type polyester is identical to an "Embrace" polyester of the year 1999. In the light of the above, the evidence on file is not sufficient to establish according to the standard of balance of probabilities what were the properties and chemical composition of the shrink sleeves which were allegedly disclosed by the sale of "Nesquik" bottles

having those sleeves before the earliest priority date of the contested patent.

3.4 Finally, the appellant alleges that the polyester material "Eastar PETG 6763" used for the shrinkage tests in document B1 had all the properties specified in the contested claim, as established in documents B2, B3 and B5. However, as already stated above for the "Embrace"-type polyester, the documents on file leave it open whether the properties and the chemical composition determined in test reports B2, B3 and B5 for a contemporary "Eastar PETG 6763"-type polyester are identical to those which would have been shown by the respective polyester allegedly referred to in document B1, which dates from July 1994.

3.5 In view of the above, the appellant's submissions based on two different alleged prior uses do not establish an inherent lack of novelty of the subject-matter claimed, in particular in view of the parameter of a shrinkage variation of less than +/- 3% on a roll having a length of at least 500 metres. The same is true if documents B1, B4 and B12 are considered as written disclosures in themselves.

Since none of the disclosures shown to have taken place before the earliest priority date contains any reference to the claimed parameter of a shrinkage variation of less than +/- 3% on a roll having a length of at least 500 metres, they do not render obvious the claimed subject-matter. The appellant's argument that already in 1998 stretchers having a temperature variation of less than +/- 0.2°C were state of the art, so that a shrinkage variation below the claimed value of +/- 3% could be achieved, is not sufficient to demonstrate that the skilled person would indeed have

arrived at a film roll having a length of at least 500 metres and a shrinkage variation of less than +/- 3% in an obvious manner.

- 3.6 In the judgement of the board, the evidence B1 to B7, B10 to B13 and B15 does not prove the objections raised by the appellant according to the standards required by the case law of the boards of appeal (*supra*). Therefore, it cannot put into question the novelty and inventive step of the subject-matter claimed in the patent in suit, Article 52(1) EPC in conjunction with Articles 54(1), (2) and 56 EPC 1973.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated