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**Datasheet for the decision
of 4 April 2019**

Case Number: T 0052/15 - 3.3.09

Application Number: 08788633.9

Publication Number: 2139678

IPC: B32B27/32, B65D71/00

Language of the proceedings: EN

Title of invention:
NAKED COLLATION PACKAGE

Patent Proprietor:
Innovia Films Limited

Opponents:
Terichem, a.s.
Irplast S.p.A.
Treofan Germany GmbH & Co. KG
Philip Morris Products S.A.

Headword:

Relevant legal provisions:
EPC Art. 83, 100(b), 123(2)
RPBA Art. 12(4), 13(1)

Keyword:

Admission of main and auxiliary requests 1, 2, 6 and 7 - no
Admission of auxiliary request 3 - yes
Added matter, auxiliary request 3 - yes

Decisions cited:

G 0009/91, R 0014/10, T 0155/88, T 0169/96, T 1105/96,
T 0386/04, T 0390/07, T 0361/08, T 0671/08, T 0922/08,
T 1525/10, T 2599/11, T 0140/12, T 0388/12, T 1697/12,
T 0143/14, T 0348/14

Catchword:

Filing of a series of main requests resulting in each new main request being considered as replacing the previously filed main request.

Procedural steps preventing the department of first instance from deciding on relevant issues.

(See points 1.1-2.11 of the reasoning)



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Case Number: T 0052/15 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 4 April 2019

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 29 October 2014
revoking European patent No. 2139678 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman W. Sieber
Members: A. Veronese
 C. Josefsson

Summary of Facts and Submissions

- I. The appeal was filed against the decision of the opposition division to revoke European patent No. EP 2 139 678 B1.
- II. With their notices of opposition, the four opponents had requested revocation of the patent in its entirety on the grounds under Article 100(a) EPC (lack of novelty and inventive step), Article 100(b) EPC and Article 100(c) EPC. In the course of the proceedings, opponent 4 withdrew its opposition.
- III. Oral proceedings took place before the opposition division. The minutes of the oral proceedings record the following sequence of events:
- The proprietor confirmed the request that the patent be maintained as granted.
 - After the opposition division's opinion was announced that this request did not comply with Article 123(2) EPC, the proprietor filed a new main request (Annex I of the minutes).
 - After the opposition division's opinion was announced that this new main request did not comply with Article 83 EPC, the proprietor filed again a new main request (Annex II of the minutes).
 - After the opposition division's opinion was announced that this new main request did not comply with Article 83 EPC, the proprietor filed yet again a new main request (Annex III of the minutes).
 - After the opposition division's opinion was announced that this last main request did not comply with Article 56 EPC, the decision was announced that the patent was revoked.

IV. Claim 1 of the last main request (Annex III), which forms the basis of the written appealed decision, reads as follows (underlining and strike-through added by the board to highlight the amendments relative to granted claim 1):

"1. A method for forming a naked collation package comprising:

a. providing an arrangement of packages individually wrapped in a filmic polyolefinic material;

b. providing a naked collation film for nakedly wrapping said individually wrapped packages, the naked collation film comprising a polyolefinic core layer C, a polyolefinic inner sealing layer A on the inner surface of the naked collation film and a polyolefinic outer sealing layer B on the outer surface of the naked collation film, the polyolefinic material of the inner sealing layer A being selected for sealing incompatibility with the filmic polyolefinic material of the individually wrapped packages under a specified sealing condition, sealing incompatibility being indicated by a seal strength of less than 40g/25mm at the sealing condition, and the polyolefinic material of the outer sealing layer B being selected for sealing compatibility with B and for sealing compatibility with A under the selected sealing condition, the seal strength of the or each sealing layer of the naked collation film to itself and/or to the other sealing layer of the naked collation film being at least about 50g/25mm higher than the seal strength of the said sealing layer to the filmic polyolefinic material of the individually wrapped packages at the sealing condition, wherein the external surface of the filmic polyolefinic material of the individually wrapped packages comprises at least one polyolefinic component derived from a monomeric olefin having a carbon chain length x , and the polyolefinic material of the inner sealing layer A comprises at least one polyolefinic component derived from a monomeric olefin having a carbon chain length y , y being different from x wherein both x and y are from 2 to 4, wherein the

polyolefinic material of the outer sealing layer B also comprises at least one polyolefinic component derived from a monomeric olefin having chain length y , wherein either:

the surface polyolefinic material of the individually wrapped packages comprises a polyethylenic component and the polyolefinic material of the inner sealing layer A comprises a polypropylenic component and/or a polybutylenic component, and the polyolefinic material of the outer sealing layer B also comprises a polypropylenic and/or a polybutylenic component; or

the surface polyolefinic material of the individually wrapped packages comprises a polypropylenic component and the polyolefinic material of the inner sealing layer A comprises a polyethylenic component and/or a polybutylenic component, and the polyolefinic material of the outer sealing layer B also comprises a polyethylenic component and/or a polybutylenic component

and wherein the sealing condition comprises a temperature above ~~80°~~ 100°C and ~~optionally~~ pressure and a dwell time for the sealing operation;

c. arranging the individually wrapped packages in an ordered configuration in contact with polyolefinic sealing layer A of the naked collation film;

d. wrapping the naked collation film around the ordered configuration of individually wrapped packages to form a film tube with overlapping edges;

e. forming a girth seal by heat sealing together the overlapping edges of the film tube, without sealing inner sealing layer A to the filmic polymeric material of the individually wrapped packages; and

f. forming envelope seals at each end of the package by folding in the film tube and heat sealing the folded ends, without sealing inner sealing layer A to the filmic polymeric material of the individually wrapped packages."

Claim 9 of this last main request defines a naked collation package comprising an arrangement of individual packages, a selection of filmic materials and of seal types, and conditions for forming those seals which correspond essentially to those defined in claim 1.

V. In its decision the opposition division decided as follows. The last main request filed during the oral proceedings (annexed to the decision as "Annex III") was admitted into the opposition proceedings. This request did not add subject-matter extending beyond the content of the application as filed. The claimed subject-matter was clear, met the requirement of sufficiency of disclosure, and was novel over D1 and D4 and over an alleged public prior use substantiated by D5-D9. However, that subject-matter did not involve an inventive step over D1, the closest prior-art, in combination with D2 and D11.

VI. This decision was appealed by the proprietor (appellant), who requested that:

- the decision be set aside, and
- the patent be maintained as granted (main request) or, alternatively, on the basis of one of auxiliary requests 1 to 4, filed with the statement setting out the grounds of appeal.

Claims 1 and 10 of the main request (which correspond to the claims as granted) differ from claims 1 and 9 of the request on which the decision was based essentially in that they do **not** contain the features defining the strength of the seals and specific combinations of materials comprised in layers A and B and in the film

of the individually wrapped packages, in that the temperature for forming the seal is 80°C instead of 100°C, and in that the application of pressure is not optional.

Auxiliary request 1, which corresponds to the request annexed to the minutes of the oral proceedings as Annex I, differs from the main request in that claim 8 was deleted and previous claims 9 and 10 renumbered and adapted accordingly.

Auxiliary request 2 differs from the request on which the decision was based essentially in that claims 1 and 9 do **not** contain the features defining the combination of materials used for preparing layers A and B and the film of the individually wrapped packages.

Auxiliary request 2 corresponds to the request annexed to the minutes as Annex II but for the following amendment: "*..being at least about 50g/25mm higher than the seal strength of said sealing layer to ~~the filmic polyolefinic material of the individually wrapped packages at the sealing condition..~~*"

Auxiliary requests 3 and 4 differ from the request on which the decision was based in particular in that a third embodiment has been added when defining possible combinations of materials present in layers A and B and in the film of the individually wrapped packages. The amendments concern claim 1 of auxiliary request 3 and claims 1 and 9 of auxiliary request 4. In addition, in these requests, the use of pressure when forming the seals is optional.

VII. In reply to the statement of grounds of appeal the opponents (respondents 1, 2 and 3) requested that the appeal be dismissed. They further requested that the

main request and auxiliary requests 1 to 4 not be admitted into the appeal proceedings. Opponent 3 also contested the admissibility of the appeal. Opponent 2 requested that an accompanying person be allowed to make oral submissions during the oral proceedings within the conditions set out in G 4/95.

- VIII. In a communication issued in preparation for the oral proceedings, the board expressed the preliminary opinion that the main request and auxiliary requests 1 and 2 were not to be admitted into the appeal proceedings and that auxiliary requests 2, 3 and 4 contained subject-matter extending beyond the content of the application as filed.
- IX. By letter dated 1 March 2019, the proprietor filed auxiliary request 5, corresponding to the request on which the decision was based.
- X. On 4 April 2019 oral proceedings took place before the board in the presence of the representatives of the proprietor and of respondents 2 and 3. During the hearing, the proprietor filed auxiliary requests 6 and 7 and withdrew auxiliary requests 4 and 5.

Auxiliary request 6 differs from the request on which the decision was based in that claim 1 was amended to include the embodiment introduced in auxiliary request 3 already mentioned above, replacing the feature "less than 40g/25mm" with "less than 100g/25mm", deleting the requirement that the difference in the seal strength is "of at least 50g/25mm" and specifying that the temperature for forming the seal is 80°C. Claim 9 and some dependent claims have also been deleted.

Auxiliary request 7 differs from auxiliary request 6 in that the feature "less than 100g/25mm" characterising the seal incompatibility has also been deleted and in that the temperature for forming the seal is 100°C.

- XI. During the oral proceedings before the board the respondents requested that none of the appellant's requests be admitted into the appeal proceedings. Respondent 3 withdrew its request that the appeal be rejected as inadmissible. The proprietor did not object to the request for oral submissions by the person accompanying opponent 2. The chairman stated that such submissions were allowed as far as they remained within the terms set out in G 4/95. At the end of the oral proceedings the chairman announced the decision.
- XII. The appellant's arguments which are relevant for the present decision were as follows.

When filing new requests during the oral proceedings before the opposition division, the then proprietor did not withdraw any of the previously filed requests. Each new request was identified as the "main request". However, each new request was meant to supersede the previous one for the purposes of discussion, but not to replace it. The minutes of the oral proceedings did not mention the withdrawal of any request. Furthermore, a negative decision with respect to each of the requests was announced by the chairman during the hearing; thus, none of these requests could be considered withdrawn. Even if they were considered withdrawn, according to established case law, requests that are withdrawn during opposition proceedings can be reintroduced in ensuing appeal proceedings. This case law had to be followed and the main request and auxiliary requests 1 and 2 had to be admitted into the appeal proceedings.

Auxiliary requests 3 and 4 differed from the request on which the appealed decision was based in that they included a further embodiment when defining the possible combination of materials used to prepare the claimed naked collation package. This amendment could only be made when filing the appeal because during the oral proceedings before the opposition division, the proprietor had not been given enough time to consider all variants of the claimed invention and to draft the claims accordingly. Thus, auxiliary requests 3 and 4 were to be admitted into the appeal proceedings. Auxiliary request 5 corresponded to the request on which the decision was based.

A basis for the amendments made to auxiliary requests 3, 4 and 5, and in particular for the selection of the parameters defining the strength of the seals and the operating temperature for forming the seals, was found in pages 11 and 13 of the application as filed.

Auxiliary requests 6 and 7 were filed during the oral proceedings before the board as a reaction to the announcement of the negative finding of the board that auxiliary requests 3, 4 and 5 added new subject-matter. The amendments made in these requests directly addressed the issue of added subject-matter, were not complex in nature, and did not create a fresh case.

XIII. The respondents' arguments which are relevant for the present decision were as follows.

During the oral proceedings before the opposition division, the then proprietor had filed a succession of different requests, identifying each of them as the "main request". The proprietor's course of action

inevitably resulted in the withdrawal of each previously filed request and its replacement with a new one. It was irrelevant that the minutes of the oral proceedings did not explicitly mention the withdrawal of any request.

The decision of the opposition division and the minutes of the oral proceedings confirmed that the opposition division had correctly regarded all previously filed requests as being withdrawn. The decision only dealt with the last request. The minutes mentioned, at most, preliminary opinions of the opposition division relating to the previously filed requests, but by no means any decision. After receiving the minutes of the oral proceedings, the proprietor had not challenged their content. Nor had it alleged that the decision failed to deal with pending requests when filing the appeal. This meant that the proprietor had acknowledged that the opposition division had acted correctly when dealing only with the last request.

Since the proprietor had prevented the opposition division from rendering a decision on requests that were filed but subsequently withdrawn, these same requests or substantially identical requests could not be admitted into the appeal proceedings. This applied to the main request as well as to auxiliary requests 1 and 2.

Auxiliary requests 3 and 4 added new embodiments which were not present in the request on which the decision of the opposition division was based. Since these requests could have been filed during the opposition proceedings, but had not been, they were not to be admitted into the appeal proceedings.

Auxiliary requests 3, 4 and 5 contained new subject-matter extending beyond the content of the application as filed.

Auxiliary requests 6 and 7, filed during the oral proceedings before the board, reintroduced issues that had not been settled in the appealed decision. The amendments made in these requests also created a fresh case at a very late stage of the appeal proceedings. Such a late filing was not a justified reaction to the previous finding of the board with regard to added subject-matter, in particular in view of the objections previously raised by the opponents and the preliminary opinion expressed by the board in its communication.

XIV. The final requests of the parties were the following.

- The appellant requested that the decision under appeal be set aside and the patent be maintained as granted (main request), or, alternatively, on the basis of one of auxiliary requests 1, 2 or 3 filed with the statement setting out the grounds of appeal, or on the basis of auxiliary requests 6 and 7 filed during the oral proceedings before the board.
- The respondents requested that the appeal be dismissed.

Reasons for the Decision

1. *Requests decided/not decided upon in the appealed decision*

1.1 As set out in detail in the facts and submissions and as apparent from the minutes of the oral proceedings

before the opposition division, the proprietor initially confirmed the request that the patent be maintained as granted. After a negative opinion was announced by the chairman with respect to this request, the proprietor filed a new request and identified it as the "main request". This occurred again two more times in succession. The new main requests were named Annex I, Annex II and Annex III in the minutes. After deliberation on the last main request filed, the chairman announced the opposition division's opinion that this request did not meet the requirements of inventive step and then announced the decision that the patent was revoked.

- 1.2 The appealed decision deals only with this last request, which was filed and identified as the "main request" by the then proprietor and is annexed to the decision as Annex III. As stated on page 5 of the decision, during the oral proceedings, the then proprietor requested that the patent be maintained on the basis of this request. No reference is made to any other request for maintenance of the patent on the basis of any auxiliary request. The reasons of the decision deal exclusively with said main request, Annex III. From the content of the decision, it does not transpire that the opposition division failed to deal with any pending request.

- 1.3 The minutes of the oral proceedings also do not record any fact or circumstance indicating that pending requests were neglected. It is true that the minutes of the oral proceedings before the opposition division do not explicitly mention the withdrawal of any of the requests filed before the last one. However, despite the absence of an explicit statement to this effect, the board considers that, in the situation described

above, the opposition division did not err when considering that each newly filed "main request" superseded and was clearly meant to replace the previously filed one/s, and, consequently, when deciding on the last request only.

- 1.4 It is not disputed that the withdrawal of a request is a serious procedural step which is usually announced explicitly by a party via a corresponding statement. Any such statement must be mentioned in the minutes (EPO Guidelines E-III, 10.3 and T 361/08, mentioned by the appellant). However, an explicit withdrawal is not required if a party's behaviour or procedural steps it takes during the proceedings make its intention unequivocal (see T 388/12, point 4.2, mentioned by the appellant). Requiring an explicit statement to be made for a withdrawal to take legal effect would render the proceedings a purely formalistic exercise in which the entire body of evidence and facts surrounding the specific case would not be taken into account.

- 1.5 The appellant argued that the expectation of the then proprietor was that a request would only be considered withdrawn if the relevant party expressly withdrew it, which was not the case in this instance. This ostensible expectation is not reflected, however, in any of the following procedural steps or assertions of the proprietor/appellant. Neither the correctness of the minutes was contested, nor were complaints raised when the appeal was filed that the decision was flawed because it did not deal with pending requests.

- 1.6 It is also noted that according to established EPO practice, parties filing more than one request must specify which request is the main request, which is/are

the auxiliary request(s), and, if there are several auxiliary requests, their ranking (see e.g. R 14/10 and legal advice from the EPO No 15/05 (rev. 2), OJ EPO 2005, 357). The appellant appears to be well acquainted with this practice, since in the statement of grounds of appeal a main request as well as four auxiliary requests were filed, the latter being identified as such and ranked. No such procedure was followed during the oral proceedings before the opposition division.

1.7 It could be argued that the opposition division should have asked the proprietor to confirm the withdrawal of the previously filed requests. The board endorses the view that, in order to avoid any misunderstanding, the opposition division should always clarify the status of previously filed requests before closing the debate. The EPO departments have the duty to ensure that any uncertainty with regard to procedural acts of the parties is clarified, and so they may be expected to draw attention to evident deficiencies. However, if a procedural act performed by a party is clear and there are no reasons to suggest that its intentions were not correctly understood, e.g. on account of subsequent actions and/or statements, that party cannot expect not to have to bear the consequences of that procedural act. This applies all the more so when the party is represented by a professional representative.

1.8 In the present instance, from the sequence of events which took place during the oral proceedings, it was correct to conclude that each new main request which was subsequently filed replaced the previously filed main request. Furthermore, on the basis of the facts recorded in the minutes, there was no reason to assume

that the proprietor intended to maintain those previously filed requests.

1.9 The appellant cited numerous decisions allegedly supporting the view that no request should have been considered as withdrawn by the opposition division. However, the facts and the circumstances surrounding those decisions differ substantially from those of the present instance. In those cases, the allegedly withdrawn request had been decided upon in the written decision (T 348/14), requests had been filed and explicitly identified as auxiliary requests (T 361/08, T 388/12, T 169/96 and T 1105/96), and/or the alleged procedural error had taken place during a different stage of the proceedings (e.g. at the grant stage: T 169/96 and T 1105/96). None of these decisions deals with a case like the present one where, during the oral proceedings, the proprietor filed new requests in succession identifying each of them as the "main request".

1.10 For these reasons, it is concluded that the written decision of the opposition division is based on the only request that was pending when the decision to revoke the patent was orally announced. This also means that, by choosing the course of action described above during the oral proceedings, the patent proprietor had prevented the opposition division from rendering a decision on all the requests discussed at those oral proceedings, except the last one.

Main request and auxiliary requests 1 and 2

2. Admission of the requests

2.1 The main request and auxiliary requests 1 and 2 were filed with the statement setting out the grounds of appeal and thus form part of the proceedings (Article 12(2) RPBA). Nonetheless, under Article 12(4) RPBA, a board of appeal has discretionary power to refuse to admit requests that could have been presented at or were not admitted into the first-instance proceedings. In the board's view, this applies all the more to requests that were filed during first-instance proceedings and subsequently withdrawn. The inevitable result of the withdrawal of the requests is that the department of first-instance is prevented from deciding on them. The reintroduction of previously withdrawn requests on appeal runs counter to the main purpose of *inter partes* appeal proceedings, namely to give the losing party the possibility of challenging the decision of the opposition division on its merits (see Case Law of the Boards of Appeal, 8th edition, IV.E.4.3.2d, the cited decisions and G 9/91).

2.2 Such a situation has been created in the present case, as far as the main request and auxiliary requests 1 and 2 are concerned:

- The main request corresponds to the set of claims as granted and the proprietor's initial request during the oral proceedings before the opposition division.
- Auxiliary request 1 corresponds to the first main request filed during those oral proceedings, which is annexed to the minutes as Annex I.

- Auxiliary request 2 corresponds essentially to the second main request filed during the oral proceedings (Annex II of the minutes). It differs from it only in the following amendment "*..being at least about 50g/25mm higher than the seal strength of said sealing layer to ~~the filmic polyolefinic material of the individually wrapped packages at the sealing condition..~~*". According to the appellant, this difference does not change the interpretation of the claims. Since in view of the outcome of the present decision this assumption is not detrimental to the respondents, it will not be challenged or further discussed in the following reasoning.

2.3 These requests differ substantially from the request which was decided upon in the appealed decision in that:

- claim 1 of each of the three requests does not entail the requirement that a component of layers A and B and of the film wrapping the individually wrapped packages is made of certain combinations of polyethylene/polypropylene and/or polybutylene materials,
- claim 1 of the main request and auxiliary request 1 does not set specific values for the strength of the seals; it further foresees the use of pressure as optional and requires the seal to be formed at 80°C instead of 100°C, and
- claim 8 was deleted in auxiliary requests 1 and 2.

- 2.4 As is apparent from pages 1 to 6 of the minutes of the oral proceedings before the opposition division, which lasted two days, a lengthy discussion took place on whether the aforementioned requests (the last one in slightly different form) complied with Articles 123(2), 83 and 84 EPC. During this discussion the parties addressed several issues relating to the definition of the strength of the seals present in the claimed collation package and to the choice of the materials and temperature used to prepare the films and the seals. Since a negative opinion was announced in respect of these requests, whereas the following request was considered positively, as far as these articles were concerned, it can be deduced that the addition of specific definitions relating to the strength of the seals, the addition of the materials used for preparing the films, and the deletion of an independent claim were conspicuous for overcoming pending objections. However, neither the minutes nor the written decision report the reasoning followed by the opposition division when it orally announced its negative conclusion with respect to these requests.
- 2.5 Accordingly, admitting these requests into the appeal proceedings would compel the board to decide as if it were the department of first instance on the aforementioned complex issues (e.g. for compliance with Article 83 EPC). This course of action would run counter to the primary purpose of appeal proceedings mentioned above in point 2.1.
- 2.6 Referring to some earlier decisions of the boards of appeal (T 155/88, T 386/04 and the Case Law of the Boards of Appeal, 8th edition, IV.E.4.3.1(f), the appellant argued that proprietors must be free in appeal proceedings to reinstate their patent as

granted, even if they had explicitly and unconditionally withdrawn all requests apart from the one finally defended in the opposition proceedings. These decisions are based on the idea that, when requesting maintenance of a patent in more limited form, the patentee is not irrevocably abandoning the subject-matter that lies outside such a request.

2.7 Even if, as a rule, a proprietor could not be prevented from reverting to the patent as granted, it would be illogical if this right could be exploited without restrictions. For example, a proprietor may not steer the appeal proceedings in a manner that undermines the main purpose for which these proceedings were foreseen, i.e. to give a judicial decision on what was decided at first instance. This would also result in the board being precluded from exercising its discretionary power under Article 12(4) RPBA in these cases.

2.8 Article 12(4) RPBA is not mentioned in T 155/88 or T 386/04 (it entered into force on 13 December 2007, after the dates of these decisions). However, T 155/88 explicitly states that amendments such as those described above are subject to the discretionary control of the board and should be admitted only when appropriate and necessary (see point 2.2). The appellant also referred to T 2599/11, in which the board admitted a request which had not been maintained in opposition proceedings and was broader in scope than the one on which the appealed decision was taken. Yet, in this case, the board argued that the issues which were critical for the appeal had already been dealt with by the opposition division in its decision, so that no fresh case was created by admitting that request.

2.9 It is also noted that although there have been decisions, such as the aforementioned ones, where the boards have allowed patent proprietors to reinstate broader requests which had been withdrawn or not maintained during the opposition proceedings, numerous decisions have also been issued in which the board's discretion has been applied in a strict manner and such requests not admitted into the appeal proceedings (see the Case Law of the Boards of Appeal, 8th edition, IV.E.4.3.2d and IV.E.4.5.1; T 390/07, T 361/08, T 671/08, T 922/08, T 1525/10, T 140/12, T 1697/12, T 143/14). This appears to be the current predominant approach applied by the boards.

2.10 The present board endorses the principle that the admission of any such request is under the board's discretion, taking into account, *inter alia*, whether the undecided issues are critical for the board's decision, the complexity of those undecided issues and possibly also the reasons for not maintaining that request before the department of first instance.

2.11 In the present case, considering that:

- the undecided technical issues are complex and also critical for a decision to be taken by the board (e.g. with regard to Articles 83 and 100(b) EPC),
- these issues could not be decided upon by the opposition division as a consequence of procedural steps chosen by the proprietor during the opposition proceedings, and
- there are no special reasons for admission into the appeal proceedings,

the main request and auxiliary requests 1 and 2 are not admitted into the appeal proceedings (Article 12(4) RPBA).

Auxiliary request 3

3. *Admission of the request*

3.1 Auxiliary request 3 was filed with the statement of grounds of appeal. It corresponds to the request on which the decision was based, with the following exception: in claim 1 an embodiment was added which defines a third possible combination of polyethylene/polypropylene and/or polybutylene materials included in layers A and B and in the film wrapping the individually wrapped packages (where this film contains a polybutylenic component). The application of pressure during seal formation is also said to be optional.

3.2 The appellant submitted that this request contained amendments which were necessary to correctly claim the invention. It also argued that during the oral proceedings before the opposition division the then proprietor was not given enough time to react to an unexpected negative findings of the division and to prepare a properly drafted request. The first paragraph of page 6 of the minutes of the oral proceedings confirms that the then proprietor had asked if the filing of the request could be postponed to the following day and that this request was refused. Taking into account this fact and that auxiliary request 3 includes all other features relating to the strength of the seals which characterise the request upon which the earlier decision is based, auxiliary request 3 is admitted into the appeal proceedings (Article 12(4) RPBA).

4. *Added subject-matter*

4.1 Claim 1 of auxiliary request 3 derives from claim 1 of the application as originally filed and is characterised, *inter alia*, by the following additional technical features:

(a) "*...the sealing incompatibility being indicated by a seal strength of less than 40g/25 mm at the sealing conditions...*",

(b) "*...seal strength of the or each sealing layer of the naked collation film to itself and/or to the other sealing layer of the naked collation film being at least about 50g/25mm higher than the seal strength of the said sealing layer to the individually wrapped packages at the sealing condition...*", and

(c) "*the sealing condition comprises a temperature above 100°C*".

4.2 Feature (a) is disclosed on page 11, third paragraph, of the application as filed, where the value 40g/25mm is listed as one of nine alternative values. Feature (b) is disclosed on page 11, second paragraph, where the value 50g/25mm is listed as one of three alternative values. Feature (c) is disclosed on page 13, second paragraph, which mentions the value of 100°C besides four other alternative values.

4.3 There is no pointer in the application as filed to choose and combine exactly the three aforementioned features. It is also noted that the values characterising the seal strength and the temperature

used for preparing the seals of the films described in the examples are so scattered that, even taking into account the experimental section of the application as filed no preferential pattern pointing to the aforementioned combination of values can be identified.

- 4.4 The appellant contended that the specified values relating to the seal strength were neither essential nor relevant to define the invention. These values were only introduced in the claims to provide some orientation and for the purpose of clarification. Furthermore, by selecting the value of at least about 50g/25mm for feature (b), the list of possible values relating to feature (a) was shortened. Thus, claim 1 did not contain added subject-matter.
- 4.5 The board does not agree. The introduction of the aforementioned precise values relating to features (a), (b) and (c) results inevitably in a more specific characterisation of the scope of the claims. Furthermore, even assuming that the selection of the value at least about 50g/25mm for feature (b) would inevitably result in a shrinking of the list relating to feature (a), this list would still contain six possible alternative values.
- 4.6 Accordingly, it is concluded that the aforementioned combination of features inserted into claim 1 is not directly and unambiguously disclosed in the application as filed and that, for this reason, this claim contains added subject-matter extending beyond the content of that application (Article 123(2) EPC). Thus, auxiliary request 3 is not allowable.

Auxiliary requests 6 and 7

5. *Admission of the requests*

- 5.1 Auxiliary requests 6 and 7 were filed by the appellant during the oral proceedings before the board. Therefore, their admittance is subject to the board's discretion under Article 13 RPBA. This 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.
- 5.2 Claim 1 of each of auxiliary requests 6 and 7 differs from claim 1 of the request decided upon by the opposition division (Annex III) in that a third possible combination of polyethylene/polypropylene and/or polybutylene materials included in layers A and B and in the film wrapping the individually wrapped packages was added.
- 5.3 Furthermore, in auxiliary request 6 the feature identified as feature (b) in point 4.1 above was deleted; the value of 40g/25mm characterising the feature identified as feature (a) in point 4.1 above was replaced by the value of 100g/25mm; the temperature of 100°C (feature (c)) was replaced by 80°C.
- 5.4 In auxiliary request 7 the two features identified above as features (a) and (b) were deleted, but the temperature for feature (c) remained 100°C.
- 5.5 Claim 1 of each of auxiliary requests 6 and 7 can be considered as a hybrid between claim 1 as decided upon by the opposition division and granted claim 1. The appellant justified the late filing of these auxiliary requests as a reaction to the board's conclusion

reached during the oral proceedings that auxiliary request 3 contains added subject-matter. The appellant further submitted that the amendments made in these requests directly addressed the objection of added subject-matter, were simple to understand and did not create a fresh case.

5.6 As already pointed out in point 2.4, the definition of the strength of the seals present in the claimed naked collation package together with the relevance of setting specific values to define that strength was one of the issues that was discussed at length during the oral proceedings before the opposition division, when the first three main requests were considered. It also appears that the addition of specific values for defining the strength of the seals was one of the amendments which later resulted in pending objections being considered as overcome (e.g. under Article 83 EPC). The absence of any reason as to why the opposition division gave a negative opinion on requests not comprising these features renders it difficult or even impossible for the board to distinguish between decided and undecided issues that are relevant for the new requests, and possibly obliges the board to decide on complex issues that were not decided on by the department of first instance in view of the then proprietor's repeated filing of main requests.

5.7 Furthermore, the reasons put forward by the appellant for the late filing are not convincing. The objection that the combination of features characterising auxiliary request 3 added subject-matter had already been raised by respondent 3 in its reply to the statement of grounds of appeal (see paragraphs 7, 8, 271, 273). A negative preliminary opinion on this issue

had also been expressed in the board's communication issued in preparation for the oral proceedings (see points 5.1 and 5.2). Whilst a detailed reasoning for the negative preliminary opinion on each pending request was not given in this communication, the conclusions reached by the board during the hearing could not be surprising. The appellant also could not have expected the board to provide an exhaustive reasoning on all open questions and all pending requests in its communication and should not have waited until the outcome of the different issues in the oral proceedings to decide its line of defence and tailor the claims accordingly.

5.8 Thus, taking into account the technical and procedural complexity associated with auxiliary requests 6 and 7, the advanced state of the proceedings, and procedural economy, these requests are not admitted into the appeal proceedings (Article 13(1) RPBA).

5.9 In summary, the appellant's only request on file is auxiliary request 3, claim 1 of which is found not to meet the requirements of the EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Cañueto Carbajo

W. Sieber

Decision electronically authenticated