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**Datasheet for the decision  
of 20 February 2020**

**Case Number:** T 0890/17 - 3.3.03

**Application Number:** 13155905.6

**Publication Number:** 2612638

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B32B25/04, B32B25/14,  
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C08L23/16, B32B25/10

**Language of the proceedings:** EN

**Title of invention:**  
Elastomeric materials

**Patent Proprietor:**  
Clipay Plastic Products Company, Inc.

**Opponent:**  
Mondi Gronau GmbH

**Relevant legal provisions:**  
EPC Art. 54(2), 56

**Keyword:**  
Novelty (yes) - multiple selections - objection based on  
hindsight knowledge of the patent in suit  
Inventive step (yes) objection not substantiated

**Decisions cited:**

G 0003/89, G 0011/91, G 0001/03, G 0002/10



**Beschwerdekammern**

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**Chambres de recours**

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Case Number: T 0890/17 - 3.3.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.03**  
**of 20 February 2020**

**Appellant:** Mondi Gronau GmbH  
(Opponent) Jöbkesweg 11  
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**Representative:** Lorenz, Bernd Ingo Thaddeus  
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**Decision under appeal:** **Decision of the Opposition Division of the European Patent Office posted on 7 February 2017 rejecting the opposition filed against European patent No. 2612638 pursuant to Article 101(2) EPC.**

**Composition of the Board:**

**Chairman** D. Semino  
**Members:** F. Rousseau  
W. Ungler

## Summary of Facts and Submissions

I. The appeal lies against the decision by the opposition division, posted on 7 February 2017, rejecting the opposition against European patent No. 2 612 638, whose claim 1 read as follows:

"1. A multilayer elastomeric film (22) with two or more layers comprising

(1) a first layer comprising,

(a) at least one olefin-based elastomeric polymer, and  
(b) at least one first draw down polymer present in a combined amount of from 5 wt% to 25 wt% of said layer, said at least one draw down polymer is selected from the group consisting of linear low density polyethylene, high density polyethylene, homopolymer polypropylene, and mixtures thereof,

(2) a second layer comprising

(a) at least one elastomeric polymer and  
(b) at least one second draw down polymer selected from the group consisting of linear low density polyethylene, high density polyethylene, homopolymer polypropylene, and mixtures thereof,

wherein said multilayer elastomeric film (22) has a basis weight of no more than 40 gsm, and said multilayer elastomeric film (22) has a permanent set, as measured per ASTM D882-97, of no more than 14% after recovery from being initially stretched to 100% of its original size."

The remaining claims consisted of dependent claims 2 to 14 defining multilayer elastomeric films in accordance with claim 1 and claims 15 and 16 defining a method for making said multilayer elastomeric film of claims 1 and 11, respectively.

II. The following documents were *inter alia* cited in support of the opposition:

D1: US 2005/0215964 A1

D2: WO 2007/141745 A2

D3: WO 2007/146148 A2

D4: US 6,982,231 B1

III. According to the reasons of the decision claim 1 unambiguously stated that the permanent set related to a parameter which was measured after the film had been initially stretched, an initial stretching being interpreted as the very first stretching of said film. Novelty was acknowledged over each of documents D1, D2 and D4, since none of them unambiguously disclosed a multilayer elastomeric film having a first layer and a second layer as defined in claim 1 of the opposed patent, a basis weight of no more than 40 gsm and a permanent set of no more than 14% after recovery from being initially stretched to 100% of its original size. Regarding inventive step, D2 represented the closest prior art. D2 did not give any motivation to provide a second layer comprising at least one elastomeric polymer and at least one second draw down polymer as defined in claim 1 and at the same time to achieve a lower permanent set. This was considered to be against the general teaching provided in D2. Accordingly, D2 did not render the claimed subject-matter obvious. The other documents cited also failed to provide such a teaching. An inventive step was therefore acknowledged.

IV. The opponent (appellant) lodged an appeal against the above decision. The following document was submitted by the appellant with its statement setting out the grounds of appeal dated 16 June 2017:

D7: Test report (submitted as Annex 2 with the statement of grounds for appeal).

V. The patent proprietor (respondent) submitted with the reply to the statement of grounds of appeal dated 26 October 2017 auxiliary requests I and II whose wording is not relevant for the present decision.

VI. A communication of the Board dated 11 December 2019 sent in preparation for oral proceedings was issued in which the Board gave its preliminary opinion that novelty was to be acknowledged, in particular over D3. The Board also noted that the objection of inventive step of the appellant did not go beyond identifying D3 as a document from which the skilled person would start, i.e. without providing any indication of (i) the disclosure within that document representing the starting point for the skilled person, (ii) the features distinguishing the claimed multilayer film from that identified starting point, (iii) the problem successfully solved vis-à-vis that starting point by the claimed subject-matter and (iv) why it would have been obvious for the skilled person in view of the closest prior art, possibly in combination with other prior art or with common general knowledge, to modify this starting point in the manner defined in the granted patent in order to provide a successful solution to the above problem. On that basis the Board indicated that in the absence of a proper reasoning regarding inventive step the subject-matter of granted

claim 1 had not been shown to lack an inventive step over D3.

- VII. Oral proceedings before the Board took place on 20 February 2020.
- VIII. The appellant's submissions, in so far as they are pertinent, may be derived from the reasons for the decision below. They are essentially as follows:
- (a) The subject-matter of claim 1 lacked novelty over the disclosure of each of D1, D2, D3 and D4.
  - (b) The subject-matter of claim 1 was not inventive over D3, should novelty over that document be acknowledged.
  - (c) The appellant should be allowed to submit during the oral proceeding an inventive step objection based on D3 as the closest prior art.
- IX. The respondent's submissions, in so far as they are pertinent, may be derived from the reasons for the decision below. They are essentially as follows:
- (a) Novelty over each of D1, D2, D3 and D4 should be acknowledged, since none of these documents provided a direct and unambiguous disclosure for the subject-matter of granted claim 1.
  - (b) The appellant had not set out in writing an arguments for lack of inventive step. An inventive step was therefore to be acknowledged.

(c) The appellant should not be allowed to submit during the oral proceeding an inventive step objection based on D3 as the closest prior art.

X. The appellant requested that the decision under appeal be set aside and the European patent be revoked.

XI. The respondent requested that the appeal be dismissed (main request), or in the alternative that the decision under appeal be set aside and the patent be maintained in amended form according to one of auxiliary requests I and II filed with letter dated 26 October 2017.

## **Reasons for the Decision**

### *Novelty*

1. Objections that the subject-matter of claim 1 of the granted patent lacks novelty have been raised over the disclosure of each of documents D3, D1, D2 and D4. These four objections have in common that they have been made having regard to multiple separate passages of each of the documents concerned.

1.1 The Enlarged Board reminded in decisions G 1/03 (OJ EPO 2004, 413, point 2.2.2 of the Reasons) and G 2/10 (OJ EPO 2012, 376, point 4.6 of the Reasons) that the concept of disclosure must be the same for the purposes of Articles 54, 87 and 123 EPC, which concept defined in opinion G 3/89 and decision G 11/91 of the Enlarged Board of Appeal (OJ EPO 1993, 117 and 125, respectively) was reaffirmed in decision G 2/10 (OJ EPO 2012, 376, point 4.3 of the Reasons).



1.2 In application of that concept, a prior art document is novelty destroying only if the skilled person would derive directly and unambiguously from the whole of that document, using common general knowledge, and seen objectively and relative to the date of said document, a subject-matter falling within the scope of what is claimed. In the present case, it must be therefore determined whether for at least one of the prior art documents D3, D1, D2 and D4 the enumeration of the various passages thereof made by the appellant is sufficient to demonstrate the existence of an anticipatory disclosure within the above meaning for the subject-matter of granted claim 1.

*Novelty over D3*

2. The various passages of D3 cited by the appellant in order to show that this document anticipates the multilayer elastomeric film defined in granted claim 1 are:

- page 5, lines 12-20 which gives a definition of the term plastoelastic, namely a material containing at least an elastomeric compound and at least a plastic component, which second general term undisputedly encompasses but does not constitute a disclosure of the the specific drawn down polymers listed in granted claim 1,
- page 16, lines 16 to 19 which solely describes that the basis weight of the polymeric film may be in the range of 10 gsm to 40 gsm, but which does not render mandatory the use of a basis weight in that range,
- dependent claim 2 which describes a basis weight of the polymeric film of less than about 30 gsm, although claim 1 to which it refers does not comprise any limitation with respect to the basis weight or any

requirement concerning the presence of an olefin-based elastomeric polymer or of a plastic component, let alone a draw down polymer of the type specified in granted claim 1,

- the passage from page 10, line 16 to page 11, line 7 which discloses a list of olefin-based elastomeric polymers, i.e. the same component as required for the first layer of granted claim 1, although according to the preceding passage on page 10, lines 8-15 of D3 the use of elastomeric polymers which are not olefin-based is also envisaged,

- page 11, lines 12-33 describing a list of plastic components to be used for the plastoelastic material defined in lines 8-12 of page 11, at least half of which are drawn down polymers within the definition of granted claim 1, including a specific linear low density polyethylene described in lines 19-20, meaning that this list also includes drawn down polymers not in accordance with claim 1 under scrutiny,

- page 9, lines 21-25 which describes the amount of plastic component, without further specifying the chemical nature of that plastic component, the amount described therein overlapping, but being not necessarily the same as the amount defined in granted claim 1 for the first layer,

- page 16, lines 20-31 describing the use of a multilayer film, which can include a skin layer, possibly made of a plastoelastic material as indicated on page 16, lines 30-31, although other materials can be used, this passage describing neither the basis weight of the polymeric film, nor the chemical nature of the materials making the plastoelastic material and their respective amounts,

- page 11, lines 8-27 from which the skilled person in the appellant's opinion would get instructions regarding the drawn down polymer to be used for the

plastoelastic material of the skin layer in accordance with claim 1 under dispute, although as already noted above other plastic components which are not drawn down polymers within the meaning of granted claim 1 can also be used according to page 11, lines 14 to 32, - and Example 5, sample 5E which describes a blend whose chemical composition corresponds to that of the first layer of granted claim 1, however in the context of a monolayer film.

The appellant also referred to experimental report D7 meant to show that a film prepared with sample 5E used in Example 5 of D3 would exhibit a permanent set of no more than 14%.

2.1 It can be seen from the above that the list of the various passages of D3 cited by the appellant and the presentation which is made thereof does not go beyond the mere observation that the features of granted claim 1, to the exception of the permanent set value of the multilayer elastomeric film, are at least separately and explicitly described in that document. These passages alone, however, do not show the existence of any disclosure, even implicit, that the features of D3 addressed by the appellant, corresponding to those recited in operative claim 1, should be used all together as defined in claim 1 by virtue of Rule 43(1) EPC specifying that the subject-matter of a claim is defined by the combination of the features recited therein.

2.2 In accordance with the case law of the Boards of Appeal the term "implicit disclosure" refers to a disclosure which any person skilled in the art would objectively consider as necessarily implied by the the explicit content, i.e. the direct and unambiguous consequence of

what is explicitly mentioned (Case Law of the Boards of Appeal of the EPO, 9th Edition, 2019, I.C.4.3). The appellant however did not refer to any pointer in that document, i.e. one or more passages thereof inciting the skilled person, for example by way of preferences expressed or references to other passages, to inevitably read some of the passages cited by the appellant in combination, resulting in the description of a multi-layer film falling within the ambit of claim 1 as granted.

- 2.3 The objection raised by the appellant, based on a presentation of the information content of D3 by which passages of that document describing some of the features of the claim under attack have been selected and presented side by side out of their context giving the impression that such features are disclosed in combination in D3, can thus only be seen as the result of an *ex post facto* and therefore inadmissible interpretation of that document, i.e. made with the knowledge of the subject-matter of granted claim 1 in mind.
- 2.4 As regards D7 meant to show that a film obtained with the blend used in Example 5 and designated sample 5E would provide a permanent set of no more than 14%, this experimental report is not relevant to the issue of whether or not D3 is novelty destroying, since as follows from above points 2.1 to 2.3 the monolayer film made of sample 5E described in Example 5 is not disclosed in D3 to be used in combination with a second layer within the meaning of present claim 1, let alone with a basis weight of no more than 40 gsm for the multilayer film so as to constitute a disclosure for all structural features of operative claim 1.

2.5 For the above reasons, the appellant's objection that claim 1 lacks novelty over D3 must be rejected. It follows that the question whether or not the multilayer elastomeric film alleged by the appellant to be described in D3 would meet the permanent set requirement of present claim 1 is irrelevant and can be left unanswered.

*Novelty over D1*

3. In order to show that D1 describes an embodiment falling within the subject-matter of claim 1 of the patent under dispute the appellant selectively cited multiple passages within the document considered (similarly to the objection based on D3).

3.1 Concerning the requirement of granted claim 1 that the multilayer elastomeric film has a basis weight of no more than 40 gsm, the appellant referred only to paragraph [0088], according to which films used as a backsheet material desirably have a basis weight between 15 g/m<sup>2</sup> (gsm) and 35 g/m<sup>2</sup>, which in the appellant's opinion would mean that such film when used as a substrate would lead to a multilayer film having an approximate basis weight being the double of that of the substrate, i.e. in the range of 30 gsm to 70 gsm. However, the passage referred to by the appellant does not specify the chemical nature of the film, the number of layers of a multilayer films in which it could be used, let alone the basis weight to be used for each of the layer constitutive of said multilayer film.

3.2 Moreover, concerning the chemical nature and the amount of the draw down polymer contained in the first layer defined in granted claim 1, the appellant solely referred to the teaching of paragraphs [0056] and

[0061] of D1, respectively. The reading of D1 made by the appellant requires to isolate in said paragraph [0056] in the absence of any preference indicated therein only linear low density polyethylene, high density polyethylene or homopolypropylene as plastic component for the plasto-elastic composition of D1, whereas several other alternative plastic components are also indicated therein. The reading of D1 made by the appellant also requires at the same time to consider in paragraph [0061] only a part of the concentration range for the plastic component of the plasto-elastic composition described therein, since according to D1 the amount for the plastic component can be as high as 60% by weight, even for the more preferred range, i.e. a maximum amount well above that defined in granted claim 1.

- 3.3 Consequently, in the absence of any indication for a pointer in D1 for a combination of the features highlighted by the appellant, let alone to such a combination in the context of a second layer of a plasto-elastomeric material comprising one of the draw down polymer defined for the second layer of granted claim 1, the reading of D1 by the appellant can thus only be seen as the result of an *ex post facto* interpretation of that document, i.e. made with the knowledge of the invention in mind and with the aim of reconstructing on purpose the claimed multi-layer film. The appellant's objection that granted claim 1 lacks novelty over D1 fails therefore to convince.

#### *Novelty over D2*

4. The appellant also made multiple selections within the teaching of D2 to arrive at the conclusion that the subject-matter of granted claim 1 lacks novelty over

D2. Selections were made not only for the configuration of the layers (selection of two plastoelastic layers as described on page 10, lines 20-21), but also for the amount of plastic material (page 11, lines 24-26), the type of elastomeric material (page 12, lines 21-24), the type of plastic component (page 13, lines 30-32) and the basis weight of the film which may be in the range of 10 gsm to 40 gsm, but is not necessarily in that range (page 19, lines 5-7). In the absence of any indication of a pointer in D2 to combine the features which have been selected by the appellant in its reading of that document, it can only be concluded that the appellant's objection that claim 1 is anticipated by D2 is also based on an *ex post facto* interpretation of that document. This objection therefore cannot convince either.

*Novelty over D4*

5. The appellant also arbitrarily combined several passages of D4 to arrive at the conclusion that the subject-matter of granted claim 1 lacks novelty over D4.
- 5.1 As noted by the appellant, D4 describes in column 5, lines 14-37 a film 32 comprising a polymer 42, which polymer is an ethylene elastomer suitably including a linear low density polyethylene. The reference signs refer to those of Figure 1 of D4 (see column 4, line 45). According to column 5, lines 21-24, the amount of ethylene elastomer is at least 50% by weight, and more suitably from 70 to 100% by weight of the polymeric portion of polymer 42. When read separately, the passage in column 5, lines 14-37 might give the impression that the sole disclosed plastic component of polymer 42 is linear low density polyethylene, i.e. the

draw down polymer required by operative claim 1. However, for the interpretation of any document, in order to determine its true meaning and thus its disclosure, no part of such a document should be construed in isolation from the remainder of the document. On the contrary, each part of such a document had to be construed in the context of the contents of the document as a whole (Case Law, supra, I.C.4.1). According to column 6, lines 8-32 of D4 the plastic component of polymer 42 which may be included in amount of up to 50% by weight is not restricted to linear low density polyethylene, but also includes copolymers of ethylene and/or propylene, e.g. ethylene vinyl acetate (EVA), ethylene methyl acrylate (EMA), ethylene normal butyl acrylate (EnBA), i.e. plastic components which differ from those required for the first layer of granted claim 1. It can already be concluded on that basis that D4 does not render mandatory the use of a layer corresponding to the first layer of granted claim 1.

- 5.2 The appellant also submitted that column 8, lines 15 ff. and column 9, line 59 ff. in combination with the passages in column 8, lines 44-47 and in column 10, lines 8-10 disclose the second layer of the multilayer elastomeric film of granted claim 1. However, even if it were accepted to the benefit of the appellant that the second layer of D4 (i.e. the facing material 12 represented in Figure 1) can comprise a mixture of an elastomeric material and a plastic material, the passages cited by the appellant do not show the mandatory use of a plastic material corresponding to the draw down polymers employed in operative claim 1 for the second layer.



5.3 Consequently, the appellant's selective analysis of D4 without any indication of a pointer or implicit disclosure in that document leading the skilled person in a direct and unambiguous manner to select and read in combination the passages cited by the appellant cannot convince the Board that D4 teaches a multilayer film in accordance with the definition of granted claim 1. Novelty over the subject-matter of claim 1 over D4 is therefore also acknowledged.

6. Accordingly, no case has been made out that the subject-matter of granted claim 1 lacks novelty over the cited prior art.

*Inventive step*

7. Admittance of an objection of lack of inventive step based on D3

7.1 During the oral proceedings before the Board the appellant requested that an objection of lack of inventive step based on document D3 as closest prior art be admitted into the proceedings. The respondent asked the Board not to admit the objection into the proceedings.

7.2 The appellant referred to pages 1, 6 and 11 of the statement of grounds of appeal and pointed out that the issue of inventive step had been addressed in the appeal proceedings from the outset.

7.3 Taking into account the above passages cited by the appellant the Board can only note that an objection of lack of inventive step was only formally addressed in the statement of grounds of appeal. Pages 1 and 6 of the statement of grounds contain nothing more than a

formal reference to Article 100(a) EPC. On page 11 there is a general statement that in case D3 was not considered as novelty destroying it could be taken as starting point for an objection of lack of inventive step since only usual materials were needed to be chosen for a multi-layer construction ("weil lediglich übliche Materialien für einen Mehrschichtaufbau auszuwählen sind"). However, this general statement cannot be regarded as a sufficiently substantiated objection of lack of inventive step. As already noted under point 12.1 of the Board's communication dated 11 December 2019, apart from identifying D3 as starting point for an objection of lack of inventive step *"the appellant did not provide any argumentation in respect of (i) the disclosure within that document representing the starting point for the skilled person, (ii) the features distinguishing the claimed multilayer film from that identified starting point, (iii) the problem successfully solved vis-à-vis that starting point by the claimed subject-matter and (iv) why it would have been obvious for the skilled person in view of the closest prior art, possibly in combination with other prior art or with common general knowledge, to modify this starting point in the manner defined in the granted patent in order to provide a successful solution to the above problem."*

7.4 Thus, a sufficiently substantiated inventive step objection was not raised in writing. It was only intended to be introduced at the oral proceedings after the Board had come to the conclusion that the subject-matter of claim 1 of the patent as granted was novel over the cited prior art.

7.5 In that regard the respondent pointed out that in the event of admittance of the objection it would neither

have the opportunity to study it, nor the possibility to prepare counterarguments or possible amendments to its requests. Thus, admittance would be contrary to the principle of fairness of the proceedings and in case of adjournment of the oral proceedings to the principle of procedural economy.

7.6 The appellant justified its late submission only by arguing that the objection could not have been raised earlier since the Board's opinion as regards the features distinguishing the claimed multilayer film from D3 was not known. As a preliminary remark, this argument already fails to persuade as the appellant was in the position to raise said objection after deliberation of the Board in respect of the question of novelty without having been informed by the Board which features were considered to distinguish the claimed subject-matter from the disclosure of D3. More importantly, the Board does not follow that argument, since the appellant has to build its case with respect to the impugned decision, i.e. in the statement of grounds of appeal it has to indicate the reasons for setting aside the decision impugned ... and the facts and evidence on which the appeal is based (cf. Rule 99(2) EPC). This principle is further specified in Article 12(3) RPBA 2020 (corresponding to Article 12(2) RPBA 2007) providing that the statement of grounds of appeal shall contain a party's complete appeal case, i.e. shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the requests, facts, objections, arguments and evidence relied on. It is absolutely evident that in that stage of the proceedings the appellant has to build its case without being aware of any later opinion of the Board. Thus, the appellant

should have built its objection of lack of inventive step for the event that the subject-matter of claim 1 be considered novel over D3.

7.7 This does not mean that the appellant is absolutely prevented from adapting its objection after having received the Board's preliminary opinion. However, according to Article 13(1) RPBA 2020 any amendment to a party's case after it has filed its grounds of appeal may be admitted and considered at the board's discretion.

7.8 In the present case, the appellant's statement of grounds of appeal did not contain any substantiated objection of lack of inventive step against the claimed subject-matter. Although this fact was explicitly addressed in point 12.1 of the Board's communication dated 11 December 2019, the appellant did not reply in writing. Hence, the introduction of the objection at the oral proceedings would represent an amendment to the appellant's case submitted at the latest possible stage of the appeal proceedings.

7.9 The Board follows the respondent's argument that the appellant should have set out its objection in the statement of grounds of appeal and at the very latest, in a written reply to the Board's communication. Considering that admittance of a substantiated inventive step objection would require careful consideration by the opposing party of all steps of an analysis in accordance with the problem solution approach, admittance of the objection without adjournment of the oral proceedings would have been detrimental to the principle of fairness of the proceedings, and adjournment of the oral proceedings

would have been detrimental to the principle of procedural economy.

7.10 Thus, the Board found it appropriate to exercise its discretion by not admitting the appellant's objection of lack of inventive step based on D3 into the proceedings.

8. The Board thus finds that none of the objections on file prejudices the maintenance of the patent as granted.

## Order

### **For these reasons it is decided that:**

The appeal is dismissed

The Registrar:

The Chairman:



B. ter Heijden

D. Semino

Decision electronically authenticated