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**Datasheet for the decision
of 18 November 2020**

Case Number: T 2155/17 - 3.3.03

Application Number: 10722727.4

Publication Number: 2406313

IPC: C08L23/10

Language of the proceedings: EN

Title of invention:

MACHINE DIRECTION ORIENTED FILM FOR LABELS

Patent Proprietor:

UPM Raflatac Oy

Opponent:

Nowofol Kunststoffprodukte GmbH & Co. KG

Relevant legal provisions:

EPC Art. 56, 123(2)
RPBA Art. 12(4), 13(1)

Keyword:

Amendments - added subject-matter (yes) - Main request
Inventive step - (yes) - Auxiliary request 1
Late filed objection - admitted - (no)
Document submitted with statement of grounds of appeal -
admitted - (yes) - response to findings of decision

Decisions cited:

G 0010/91



Beschwerdekammern

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Case Number: T 2155/17 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 18 November 2020

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
24 July 2017 concerning maintenance of the
European Patent No. 2406313 in amended form.**

Composition of the Board:

Chairman D. Semino
Members: M. C. Gordon
R. Cramer

Summary of Facts and Submissions

- I. The appeal of the opponent lies against the interlocutory decision of the opposition division posted on 24 July 2017 according to which European Patent number 2 406 313 could be maintained in amended form on the basis of auxiliary request 3, submitted at the oral proceedings of 28 June 2017.
- II. The patent was granted with a set of 12 claims, whereby claim 1 read as follows:

"A machine direction oriented plastic film for labels, characterized in that the machine direction oriented plastic film has a multilayer structure including at least one skin layer and a core layer comprising at least one polypropylene homopolymer, polypropylene random copolymer or polypropylene block copolymer or mixture of two or more thereof and a modifier, which is at least one of the following:

- hydrocarbon resin;
- styrene block copolymer."

Claims 2-8 were directed to preferred embodiments of the plastic film of claim 1. Claims 9, 10 and 12 were directed to labels or label products comprising said film and claim 11 to a use of the film of claims 1-8 for labelling an item.

- III. A notice of opposition against the patent was filed in which revocation of the patent on the grounds of Article 100(a) EPC (lack of novelty, lack of inventive step) was requested.

The following documents, *inter alia*, were relied upon by the opponent in the course of the opposition proceedings:

D6: EP-A-1 270 664

D7: EP-A-0 871 567.

IV. The decision was based on the claims of the patent as granted as main request and six sets of claims forming auxiliary requests.

According to the decision D6 and D7, which had been filed outside the 9 month opposition period, were considered *prima facie* relevant and consequently admitted to the procedure.

The main request - the patent as granted - was held not to comply with the requirements of novelty in view of D6 and auxiliary requests 1, 2, 4 and 6 were held not to comply with the requirements of Article 123(2) EPC and/or Rule 80 EPC. The details of these conclusions are not relevant for the present decision.

Auxiliary request 3 contained the additional feature that the skin layer included linear low density polyethylene (hereinafter "LLDPE"), claim 1 thereof reading as follows (deletions compared to claim 1 as granted being shown by ~~striketrough~~, additions by **bold**):

"A machine direction oriented plastic film for labels, characterized in that the machine direction oriented plastic film has a multilayer structure including at least one skin layer and a core layer, **wherein the core layer comprises** ~~comprising~~ at least one polypropylene homopolymer, polypropylene random copolymer or

polypropylene block copolymer or mixture of two or more thereof and a modifier, which is at least one of the following:

- hydrocarbon resin;
- styrene block copolymer,

and wherein the at least one skin layer includes linear low density polyethylene."

Claims 2-12 were unchanged.

The decision did not explicitly address the question of compliance of this request with the requirements of Article 123(2) EPC even if it was mentioned that the feature could be found on page 5 and Table 4 of the original application.

There was no disclosure in any of the cited documents of a two layered film containing LLDPE in the skin layer. Consequently novelty was acknowledged.

Regarding inventive step, the closest prior art was D6, the distinguishing feature being the presence of LLDPE in the skin layer, which was held to result in improved printability.

There was no evidence in the prior art relating to a multilayer film having improved printability as the result of the presence of LLDPE in the skin layer.

Consequently an inventive step was acknowledged.

- V. The opponent (appellant) lodged an appeal against the decision, and raised objections of added subject-matter (Article 123(2) EPC, relating to the feature that the skin layer included LLDPE) and lack of inventive step (Article 56 EPC) in the statement of grounds of appeal

against auxiliary request 3 on which the decision under appeal was based.

A further document was cited:

D8: EP-A-1 508 439

VI. In the reply the patent proprietor (respondent) maintained the set of claims as upheld by the opposition division as the main request and submitted three further sets of claims as auxiliary requests 1 to 3.

Claim 1 of auxiliary request 1 differed from claim 1 of the main request by addition of the following phrase at the end:

"[*linear low density polyethylene*], and wherein the multilayer film consists of the core layer and further at least one printable skin layer, the skin layer including linear low density polyethylene adjoined to the core layer".

Admittance of the objection pursuant to Article 123(2) EPC and of the newly cited D8 was objected to.

VII. The Board issued a summons to oral proceedings and in a communication set out its preliminary position on the case.

The Board considered the objection pursuant to Article 123(2) EPC to be admissible, reference being made to the findings of G 10/91 (OJ EPO 1993, 420) section 19 of the reasons.

Furthermore D8 was considered to be admissible since

the issue in respect of which it had been submitted had arisen only at the oral proceedings before the opposition division.

Even taking the newly cited document into account, the Board could identify no reason to depart from the findings of the opposition division concerning inventive step.

VIII. Oral proceedings were held before the Board on 18 November 2020.

In the course of the oral proceedings the appellant raised a further objection in respect of Article 123(2) EPC against claim 1 of the main request, the objection relating to the replacement of the term "comprising" by "wherein the core layer comprises" and to the combination of features that the film had a multilayer structure with a core layer and a skin layer whereby the core layer mandatorily contained the defined polymers.

IX. The arguments of the appellant can be summarised as follows:

(a) Main request

(i) Added subject-matter (I) - in respect of the feature that the skin layer contained LLDPE (raised in the statement of grounds of appeal)

Regarding the admittance of the objection it was recalled that at the oral proceedings before the opposition division all requests had been withdrawn prior to

submission of a new set of requests. These newly filed requests thus had to be examined for compliance with all requirements of the EPC. Objections raised in respect of the request were therefore not to be seen as the raising of a new ground of opposition, but as part of the normal course of opposition and opposition/appeal proceedings in which amended claims had been filed. Amendments - regardless of when submitted - necessarily had to be checked for compliance with the EPC as set out in G 10/91.

Regarding the substance of the objection the feature that the skin layer included LLDPE was disclosed in the application as filed mandatorily in association with the requirement that the LLDPE containing skin layer was "adjoined" to the core layer. The absence of the term "adjoined" from the claim meant that the subject-matter extended beyond the content of the application as originally filed. Furthermore according to the original disclosure, the film was defined as a "multilayer film" and required to be "printable". The absence of these requirements from the claim likewise constituted added subject-matter.

- (ii) Added subject-matter (II) (raised at the oral proceedings before the Board)

With respect to admittance of the objection it was argued that the ground of Article

123(2) EPC was in the procedure and that merely further arguments under this ground, which could be presented at any time, were being advanced.

For the purposes of the present decision it is not necessary to give details of the substance of this objection.

(b) First auxiliary request

(i) Article 123(2) EPC

It was acknowledged that the amendments made addressed all the objections in respect of added subject-matter submitted with the statement of grounds of appeal.

(ii) Admittance of D8

The feature relating to the presence of LLDPE in the skin layer had only come to prominence at the oral proceedings upon discussion of auxiliary request 3. There had been no opportunity on the occasion of the oral proceedings to consider this new feature in detail, and in particular no opportunity to locate and present relevant prior art. Accordingly it was appropriate to submit a further document on appeal to take account of this changed situation.

(iii) Inventive step

As set out in the statement of grounds of appeal on page 6, second and third complete

paragraphs and page 7, first-third complete paragraphs, it was concurred with the findings of the decision that:

- Closest prior art was D6;
- The subject-matter claimed was distinguished therefrom by the feature that the skin layer contained LLDPE;
- The technical effect arising was improved printability of the surface layer;
- Accordingly, the objective technical problem was to improve the printability of labelling films.

The patent itself acknowledged that polyethylene, in its various forms in particular HDPE, LDPE and LLDPE, was a conventional material for films.

Thus the invention consisted of nothing more than making a selection for the material for the skin layer from a restricted group of those known to be suitable.

D8 was from the same technical area and confirmed that polymer labels had been known in the state of the art for a significant period of time whereby mono- or biaxially oriented polyester or polypropylene films were employed. Clearly, the surface layer was subjected to printing. D8 taught as conventional materials for said surface layer LDPE or LLDPE which therefore had to be seen merely as equally suitable alternatives.

It would be a matter of routine for the skilled person to select one or other, or a mixture of these depending on the ultimate requirements in order to solve the objective problem of the patent in suit. Therefore the presence of an inventive step could not be acknowledged.

X. The arguments of the respondent can be summarised as follows:

(a) Main request

(i) Added subject-matter (I)

Regarding admittance of the objection, the set of claims in question had been filed (then as auxiliary request 5) at the earliest opportunity, namely with the response to the notice of opposition. No objection against this request in respect of added subject-matter had been advanced by the opponent at any stage of the opposition procedure. It was furthermore apparent from the Minutes that the opposition division had considered the question of added subject-matter. Consequently the raising of an objection to this request had to be seen as a fresh ground of opposition. Pursuant to headnote 3 of G 10/91 such new grounds could be addressed in appeal proceedings only with the consent of the patent proprietor, which was not given.

Regarding the substance of the objection

the description provided a disclosure of various possibilities and permutations of materials for the core and skin layers whereby both the text of the description and the tables disclosed that LLDPE could be a component of the skin layer in all the proposed variations. There was no requirement that, when LLDPE was present in the skin layer, such a skin layer had to be adjoined to the core layer which followed in particular from page 5, lines 17-19, the passage bridging pages 9 and 10 and Table 2.

Regarding the feature "printable" this was the inevitable consequence of the constitution of the film, i.e. an inherent property and not an independent technical feature. There was consequently no need to specify this in the claim and the absence thereof did not result in added subject-matter. Moreover a film with a multilayer structure was a "multilayer film".

(ii) Added subject-matter (II)

The objection had been advanced only at the oral proceedings before the Board and was therefore late. There was no justification for raising this issue only at such an advanced stage of the procedure.

Hence the objection should not be admitted.

(b) Auxiliary request 1

(i) Added subject-matter

The amendments made addressed the objections raised in respect of the main request.

(ii) Admittance of D8

The document had been filed late. Contrary to the submissions of the appellant, the subject-matter of the present main request (auxiliary request 3 underlying the decision) had not been introduced only at the oral proceedings but had been filed with letter of 11 July 2016 as auxiliary request 5 in response to the notice of opposition. There had been multiple opportunities to consider this subject-matter and submit appropriate prior art in advance of the oral proceedings before the opposition division, as had indeed been done with D6 and D7. D8 was in any case neither *prima facie* relevant nor more relevant than the other prior art documents already on file. It should therefore not be admitted.

(iii) Inventive step

It was concurred with the findings of the decision and the submissions of the Appellant that:

- The closest prior art was D6;
- The distinguishing feature was the presence of LLDPE in the skin layer;

- The resulting technical effect was an improvement in the printability
- Consequently the objective technical problem was to improve the printability of the labels of D6.

D6 did not contain any disclosure of LLDPE in the skin layer. Indeed the only reference in D6 to any form of low density polyethylene was comparative example 3 in which LDPE was present in the core layer. D8 contained no teaching associating the presence of LLDPE in the skin layer with improvements in printability. According to D8 printability of the skin layer was improved by surface treatment of the film, not as a result of the presence of a particular polymer therein. In the absence of any hint to the proposed solution for solving the posed problem, the presence of an inventive step should be acknowledged.

- XI. The appellant requested that the decision under appeal be set aside and that the patent be revoked.
- XII. The respondent requested that the appeal be dismissed, or alternatively that the decision under appeal be set aside and the patent be maintained on the basis of one of the sets of claims according to one of auxiliary requests 1 to 3 as submitted with the reply to the statement of grounds of appeal.

Reasons for the Decision

1. Main request

1.1 Added subject-matter (I) raised in the statement of grounds of appeal

This objection related to the definition of the skin layer as including LLDPE and the absence of the expressions "multilayer film", "printable" and "adjoined to the core layer".

1.1.1 Admittance

The set of claims in question, which was submitted with the response to the notice of opposition as auxiliary request 5 and renumbered as auxiliary request 3 during the oral proceedings, is a set of claims amended in opposition by introducing an additional feature in claim 1 (that the skin layer includes LLDPE) which was not present in the granted claims, but allegedly can be found in the original description as submitted by the respondent.

The objection of added subject-matter relates to this amendment and not to the combination of features in the claims as granted. Since the objection would not have arisen in respect of the granted patent it does not constitute the raising of a fresh ground of opposition, contrary to the submissions of the respondent.

Consequently the ruling in section 18 of the Reasons of G 10/91, that a new ground of opposition can only be considered with the consent of the patent proprietor is not relevant and does not apply.

Instead section 19 of the Reasons of G 10/91 is relevant. This rules that in the case of amendments of

the claims in the course of opposition or appeal proceedings, these are to be fully examined for compliance with the requirements of the EPC, Article 123(2) EPC being explicitly mentioned.

Consequently the Board is not prevented from examining the compliance of the claims as amended during the opposition procedure with, *inter alia*, this Article.

The objection was submitted in appeal with the statement of grounds of appeal and it is to be taken into account by the Board according to Article 12(4) RPBA 2007 (which applies in view of Article 25(2) RPBA 2020), unless the Board makes use of its power to hold it inadmissible. No arguments were provided by the respondent why the Board should make use of this power and no reason can be found by the Board to hold this objection as inadmissible.

The objection is therefore in the proceedings.

1.1.2 Substantive evaluation

Claim 1 requires that the skin layer includes LLDPE.

According to page 5, lines 17-19 of the application as filed:

"Multilayer film may consist of a core layer and at least one printable skin layer, including linear low-density polyethylene adjoined to the core layer".

The same wording can be found in original claim 9.

The passage on page 5 and claim 9 disclose the presence of LLDPE in the skin layer necessarily in combination

with the feature that the skin layer is **adjoined** to the core layer (Board's emphasis). This limitation is lacking from the claim, meaning that e.g. one or more intermediate layers may be present between the two named layers. This extends the subject-matter of the claim therefore to these embodiments which were not covered by the disclosure on page 5 and in claim 9.

The passage bridging pages 9 and 10, invoked by the respondent in support of the allowability of the amendment, states that "the skin layer preferably includes linear low density polyethylene". However this is, as stated at page 9 lines 36 "according to one embodiment of the invention" and therefore has to be understood as subordinate to, and a special case of, the subject-matter disclosed previously in the description and in particular at page 5 lines 17-19 which is the only previous occasion where LLDPE is mentioned. Thus the passage on pages 9-10 necessarily includes the feature that the two layers are "adjoined".

Table 2, immediately preceding the aforementioned passage bridging pages 9 and 10 also does not provide a basis for the claim in its current generality. This table merely indicates which materials are to be employed in each of the layers and, again, has to be read as subordinate to the requirement set out at page 5, lines 17-19. Accordingly Table 2 also does not provide a basis for the wording of the claim.

Due to the omission of the requirement that, in the case that the skin layer contains LLDPE, this is "adjoined" to the core layer, claim 1 represents an intermediate generalisation with respect to the disclosure of the application as originally filed with

the consequence that the requirements of Article 123(2) EPC are not satisfied.

In view of this conclusion there is no need for the Board to take position on the absence of the expressions "multilayer film" and "printable" in claim 1 of the operative request.

1.2 Added subject-matter (II) - objection raised at the oral proceedings

1.2.1 Admittance

The objection relating to the replacement of the term "comprising" by "wherein the core layer comprises" and to the combination of features that the film had a multilayer structure with a core layer and a skin layer whereby the core layer mandatorily contained the defined polymers had at no point been raised in the entirety of the opposition or (written) appeal proceedings.

Nor was it made credible by the appellant that the objection raised at the oral proceedings before the Board had in some manner emerged as a consequence of submissions made by the respondent in the course of the appeal proceedings or of the preliminary opinion of the Board.

The Board considering the lack of any justification for the submission of the objection at the latest possible opportunity together with the need for procedural economy finds it appropriate to exercise its discretion under Article 13(1) RPBA 2007 (which applies in view of Article 25(3) RPBA 2020) by not admitting the further

objection under Article 123(2) EPC into the proceedings.

1.3 Added subject-matter conclusions

In view of the unallowable amendment in respect of the presence of LLDPE in the skin layer without specifying that said layer is adjoined to the core layer, the main request does not meet the requirements of Article 123(2) EPC and is refused.

2. Auxiliary request 1

2.1 Added subject-matter

It was not disputed by the appellant that the amendments made addressed the deficiencies in respect of added subject-matter identified for the main request and pertaining to the objection under Article 123(2) EPC admitted into the proceedings.

The Board likewise considers that the deficiencies have been overcome.

As there is no other pending objection under Article 123(2) EPC in the proceedings, no further decision on this issue is needed.

2.2 Inventive step

2.2.1 Admittance of D8

D8 was filed with the statement of grounds of appeal in respect of the introduction of the feature that the skin layer includes LLDPE (statement of grounds of appeal, page 8, second paragraph).

As noted above, claims having this restriction had been filed in the opposition proceedings, as auxiliary request 5 in the response to the notice of opposition, renumbered as auxiliary request 3 at the oral proceedings before the opposition division. However in the written submissions before the opposition division beyond indicating that the amendment had been made, the patent proprietor failed to advance any explanations or arguments in support of inventive step with respect thereto, or otherwise explain the rationale for making said amendment (letter of 11 July 2016, page 12, second paragraph). Nor was this aspect addressed in any substantive manner in either of the two written submissions of the patent proprietor sent subsequent to the summons to oral proceedings (letters dated 27 April 2017 and 30 May 2017).

Nor did the opposition division in its communication in preparation of the oral proceedings refer to this feature in any manner.

It was only at the oral proceedings, when discussing auxiliary request 3 (formerly auxiliary request 5) that any significance was attached to the presence of LLDPE in the skin layer.

Accordingly the Board cannot identify any reason arising from the written phase of the opposition proceedings which would have indicated to the opponent that there would have been any need to make submissions specifically with respect to the presence of LLDPE in the skin layer and file further documents relating to this feature.

There are therefore no grounds for concluding that a

document relating to this aspect should have been submitted prior to the oral proceedings before the opposition division.

In consequence, and in application of Article 12(4) RPBA 2007 (which applies in view of Article 25(2) RPBA 2020), the Board can identify no grounds to hold D8 inadmissible with the consequence that it is in the proceedings.

2.2.2 Closest state of the art, distinguishing feature, technical effect, objective technical problem

As noted above, both parties followed the findings of the decision of the opposition division that:

- The closest prior art was D6;
- The distinguishing feature was the presence of LLDPE in the skin layer;
- The technical effect of this was an improvement in printability;
- The technical problem to be solved was thus to improve the printability of the compositions of D6.

The Board has no reason to take a different position on these matters.

However the parties took different positions on the obviousness of the claimed solution to said problem in view of the available prior art.

2.2.3 Obviousness

D6 itself contains no reference to LLDPE in either of the layers.

D8 relates to printable multilayer films and discloses in paragraph 12 that either LDPE or LLDPE can be used for the skin layer. No preference or advantage for either of these is expressed. Paragraph 19 teaches that adhesion of the ink can be improved by subjecting the skin layer to a corona treatment, which teaching is understood to relate to an improvement in printability. However there is no indication here of the type of material to be employed for the skin layer or of any advantage associated with any particular material.

Consequently D8 can provide no suggestion to employ specifically LLDPE in order to improve printability.

The arguments and evidence advanced by the appellant, including the newly cited D8, therefore give no cause to depart from the findings of the opposition division that the subject-matter claimed is not obvious in view of the posed problem.

- 2.2.4 The Board see therefore no reason to overturn the decision of the opposition division regarding the presence of an inventive step.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the order to maintain the patent in amended form on the basis of the claims of auxiliary

request 1 filed with the reply to the statement of grounds of appeal, after any necessary consequential amendment of the description.

The Registrar:

The Chairman:



B. ter Heijden

D. Semino

Decision electronically authenticated