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Datasheet for the decision of 14 February 2022

Case Number: T 1854/20 - 3.3.06

Application Number: 15775625.5

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Language of the proceedings: EN

Title of invention:
LID FILM FOR FOOD PACKAGING

Applicant:
Amcor Flexibles Singen GmbH

Headword:
Amcor/Sterilizable lid

Relevant legal provisions:
EPC Art. 84, 54
RPBA 2020 Art. 12, 12(4)

Keyword:
Claims - clarity - main request (no) - Diffuse scope of demarcation
Novelty - (no)
Amendment to case - amendment admitted (no) - Requests should have been filed earlier

Decisions cited:
T 1399/11, T 1791/16, T 0268/13

Catchword:

Europäisches Patentamt
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Office européen des brevets

Beschwerdekammern

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Case Number: T 1854/20 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 14 February 2022

Appellant: (Applicant)	Amcor Flexibles Singen GmbH Alusingenplatz 1 78224 Singen (Hohentwiel) (DE)
Representative:	Vossius & Partner Patentanwälte Rechtsanwälte mbB Siebertstrasse 3 81675 München (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 5 March 2020 refusing European patent application No. 15775625.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	C. Heath
Members:	S. Arrojo
	R. Elsässer

Summary of Facts and Submissions

I. An appeal was filed by the applicant contesting the decision of the examining division to refuse European patent application No. 15 775 625.5 for non-compliance with the requirements of Articles 84 EPC and 54 EPC in view of documents D1 (WO 01/68475 A1) and D2 (EP 1 935 805 A1).

II. In its statement of grounds of appeal, the applicant and appellant requested to set aside the decision and to grant a patent on the basis of the main request filed therewith (corresponding to the request on which the decision was taken), wherein **claim 1** reads:

"1. Lid film (1) for packaging having a multi-layer structure comprising a sealing layer (3), a barrier layer (5), a print primer layer (7), a print layer (9), an optional print protection layer, and a relief layer (11), whereby the sealing layer (3), the barrier layer (5), the print primer layer, the print layer (9) and the optional print protection layer are essentially flat, whereby the relief layer (11) is arranged at least on a part of the print layer (9) or on the optional print protection layer and comprises at least n three dimensional structures (13) per cm^2, whereby n is at least 1, projecting at an essentially right angle from a surface of the adjacent print layer or the optional print protection layer and said three dimensional structures (13) forming a non-continuous elevated surface (14), whereby the total of said elevated surface (14) area formed by the three dimensional structures (13) equals at 15 least m% of a total surface area of the lid film (1), m being at

least 10%, and whereby the three dimensional structures (13) have a minimal height of 5µm, whereby the lid film (1) is sterilizable."

Alternatively, the appellant requested to grant a patent on the basis of one of auxiliary claim requests 1 to 7 filed with the grounds of appeal on 15 July 2020.

III. In a communication under Article 15(1) RPBA 2020, the board expressed its preliminary opinion that the main request was unclear and was not novel in view of document D1 and that auxiliary requests 1 to 7 should not be admitted into the appeal proceedings under Article 12(4) RPBA 2020.

IV. With a letter dated 6 October 2021 the appellant submitted further arguments to support the admittance of auxiliary requests 1 to 7.

V. At the oral proceedings, which took place in person on 14 February 2022, it was first discussed whether the main request complied with the requirements of Articles 84 and 54 EPC, in particular in view of the interpretation of the term "sterilizable" in claim 1. The admittance of auxiliary requests 1 to 7 was subsequently discussed.

VI. Before the debate was closed, the appellant confirmed that the decision should be based on the requests presented with the statement of grounds of appeal (see point II. above).

Reasons for the Decision

1. Main request - Article 84 EPC

The requirements of Article 84 EPC are not met for the following reasons:

1.1 The appellant argued that the concept "sterilizable" in claim 1 was clear, because this term had a specific meaning within the relevant art and should be interpreted in the light of the description, which indicated (page 1, lines 1-12) that the invention concerned lids for food packages which were capable of withstanding the production conditions. The application further specified (page 6, lines 10-25) that the packages were exposed to sterilisation processes typically carried out at temperatures of 120 to 130°C and pressures of 2 to 3 bar for 20 to 45 minutes.

In the appellant's view, clarity should be assessed taking into account the content of the prior art. In particular, the requirements of Article 84 EPC should be more loosely applied when it was manifest that the cited documents did not anticipate the allegedly unclear feature or when such feature was not decisive for establishing novelty (i. e. because there were other distinguishing features). In the present case, it was apparent that document D1 did not anticipate the feature "sterilizable" in the sense of the application, because this document disclosed (page 3, line 14; page 16, lines 19-24) lids including a swelling agent that decomposed at elevated temperatures, which implied that such lids would not be capable of withstanding the typical sterilisation conditions. The term "sterilizable" was also not required to establish

novelty with respect to other documents such as D2, because there were additional distinguishing features.

The subject-matter of claim 1 at issue therefore complied with the requirements of Article 84 EPC.

1.2 The board disagrees with the arguments of the appellant, because the definition of a "sterilizable" lid film in claim 1 at issue is considered to lead to a problem of diffuse scope of demarcation and therefore to a lack of clarity.

A claim has a diffuse scope of demarcation if a feature used to establish novelty is defined so broadly or ambiguously that it is unclear whether the prior art falls within the scope of the claim once all technically reasonable interpretations of said feature have been considered (see e.g. headnote of decision **T 1791/16** that also applies this rule to questions of compliance with Art. 123(2) EPC). The applicant is therefore correct in that the content of the prior art might play a role in the assessment of the requirement of clarity, because a problem of diffuse demarcation of a claim for the purposes of determining novelty/ inventive step can (in principle) only occur if the contested feature is, in fact, essential for delimiting the scope of the claim (see decision **T 1399/11**, reason 1.5).

In the board's view, however, the appellant overstretches this argument when it concludes that the requirements of clarity would have to be applied more loosely if the prior art manifestly falls outside the contested feature. In particular, the appellant suggests that the clarity problem can be overcome by restricting the meaning of the term "sterilizable" in

the light of the information in the description in a way which would allegedly clearly distinguish the subject-matter of claim 1 from the content of D1. This approach is however contrary to well established case law (see Case Law of the BoA, 9th ed., point II.A. 6.3.4), according to which the description should not be relied upon to read into the claim restrictions which are not suggested by the explicit wording of the claim. The board therefore holds that a clarity problem leading to a diffuse scope of demarcation can only be overcome by amending the wording of the claim in a way which clarifies the meaning of the contested feature and eliminates any doubt as to its scope, irrespective of the prior art cited.

While it is certainly correct that the question as to whether a term is unclear must be answered in the context of the relevant prior art (see the above-mentioned decision **T 1399/11**), this cannot be turned around to mean that in the absence of any prior art, a claim does not need to comply with the requirement of clarity, or only to a lesser extent. Such view would reduce the requirement of clarity to an ancillary consideration of the requirements of novelty, inventive step and Article 123(2) EPC, which would make the distinction between the requirements of patentability (where clarity is mentioned) and the grounds of opposition (where clarity is not mentioned) superfluous. In addition, such view would make clarity a merely retrospect requirement (to be interpreted in the light of prior art), rather than, as case law consistently holds, a prospective requirement directed to a third party wanting to avoid an infringement, or a judge having to determine such (see decision **T 268/13**, reason 3). If the requirement of clarity was dependent on the state of the art, such interpretation would

invariably compromise the principles of foreseeability and legal certainty which are fundamental to the patent system. Only a clearly defined claim allows the patent office to determine the relevant state of the art, third parties to freely develop their business in avoidance of technical monopolies and the courts to distinguish areas of exclusion from those free for all to tread.

1.3 In the present case, the term "sterilizable" in claim 1 is not limited to food products, let alone retort food products and merely implies that the lid must be capable of withstanding a sterilisation process. The claim however fails to indicate what should be sterilised (i. e. the lid, the package, the content of the package, etc.), which type of sterilisation should be used (chemical, thermal, pressure-thermal, radiation, etc.) and which specific conditions would have to be applied during the process. Since virtually any material could be considered to be "sterilizable" or not depending on which type of sterilisation is meant and which conditions are applied in this process, the board considers that this feature cannot clearly delimit the scope of the invention. The board therefore concludes that the term "sterilizable" leads to a problem of diffuse scope of demarcation, which renders claim 1 at issue unclear pursuant to Article 84 EPC.

1.4 For the sake of completeness, the board notes that, even if the content of the description were taken into account, it would still be unclear how to distinguish whether a given lid can indeed withstand the sterilisation conditions. While pages 1-3 of the application refer to certain visual signs (e.g. cracks) once a material does not withstand the sterilization conditions (i.e. is not "sterilizable"), these

indications are relative and would therefore also lead to a diffuse scope of demarcation.

1.5 The requirements of Article 84 EPC are therefore not complied with.

2. Main request - Article 54 EPC

The requirements of Article 54 EPC are not complied with, either, for the following reasons:

2.1 As explained in paragraph 9 of the examining division's decision, document D1 discloses all the features of claim 1. The only aspect which is contested by the appellant is the disclosure of the feature "sterilizable".

2.2 In this respect, the appellant argued that document D1 did not anticipate the feature "sterilizable", because the lid disclosed therein would not withstand the usual pressure and temperature conditions necessary for the sterilisation of food packages (for more details see point 1.1 above).

2.3 The board cannot agree with this argumentation because, as indicated in the discussion of clarity (see points 1.2 - 1.4 above), claim 1 at issue should not be narrowly interpreted in the light of the description. This claim therefore encompasses any lid capable of withstanding any sterilisation process (i. e. any known type of sterilisation carried out under technically reasonable conditions).

A "lid for packaging" as defined in claim 1 can be sterilised using a number of processes, including

temperature/pressure sterilisation (under different conditions), chemical sterilisation or radiation sterilisation. While the appellant argued why (in its opinion) the lid of D1 would not withstand the specific temperature and pressure conditions proposed in the description of the application (page 6, lines 10-24), there is no reason to conclude that the lid would not withstand other sterilisation processes, such as chemical or radiation sterilisation. The board therefore concludes that the lid in D1 is "sterilizable" in the sense of claim 1.

2.4 The subject-matter of claim 1 is therefore not novel in view of document D1.

3. Auxiliary requests 1 to 7 - Admittance

3.1 The statement of grounds of appeal was filed on 15 July 2020, after entry into force of the RPBA 2020. Since none of the auxiliary requests 1 to 7 were submitted during first instance proceedings, their admittance is governed by Article 12 RPBA 2020 (see Article 24(1) and Article 25(2) RPBA 2020).

3.2 The following points of Article 12 RPBA 2020 should be taken into account:

- According to Articles 12(2) and 12(4) RPBA 2020, appeals should be directed to those requests on which the decision was based, and any amendment may be admitted only at the discretion of the Board. If any such amendment (i. e. new auxiliary requests) is introduced, the party should provide reasons for the late submission.

- According to Article 12(4) RPBA 2020 "The Board shall exercise its discretion in view of, inter alia, the complexity of the amendment, the suitability of the amendment to address the issues which led to the decision under appeal, and the need for procedural economy.".

- According to Article 12(6) RPBA 2020 "The Board shall not admit requests, facts, objections or evidence which should have been submitted, or which were no longer maintained, in the proceedings leading to the decision under appeal, unless the circumstances of the appeal case justify their admittance."

3.3 At the oral proceedings, the appellant justified the filing of auxiliary requests 1 to 7 for the first time at the appeal proceedings by arguing that they should have a single opportunity to react to the clarity objections against the term "sterilizable" presented for the first time with the communication dated 24 May 2019. The examining division had issued a refusal directly after the reply to this communication, which was an uncommon way to proceed and had deprived the applicant from the opportunity to file amended requests. While it would have been possible to submit auxiliary requests in response to the communication, the applicant considered that this was not necessary at that point because they were convinced that the arguments would persuade the examining division. Only after - surprisingly - receiving the refusal was it apparent for the applicant that the claims had to be amended to overcome the outstanding issues, so the statement of grounds of appeal effectively represented the first opportunity for the applicant to file the auxiliary requests.

3.4 In order to determine whether the appellant should have filed the requests during first instance proceedings, the board will first assess when and how the different objections were raised and how the applicant reacted during search and examination proceedings:

- In the written opinion of the EPO acting as international searching authority, the examiner indicated (par. 1) that claim 1 as originally filed was not novel in view of D1, and that the lid in this document was also considered to be "sterilizable". The term "sterilizable" was defined in claim 11 as filed (dependent on claim 1), so it was concluded *inter alia* that neither claim 1 nor claim 11 were novel in view of D1.

- With letter dated 17 November 2017 and in response to this opinion, the applicant filed a single new request in which original claim 11 had been combined with original claim 1.

- In a communication under Article 94(3) EPC dated 24 May 2019, the examining division reiterated its novelty objections in view of D1 against the invention based on claim 1 combined with the feature "sterilizable lid" and further added that the term "sterilizable" was also unclear. In the final remarks, the examining division indicated that if the applicant regarded some particular matter as patentable "a new set of claims should be filed taking account of all the above objections...".

- With letter dated 7 January 2020 and in response to the division's communication, the applicant insisted that the claims were clear and patentable, but did

neither submit auxiliary requests, nor requested oral proceedings under Article 116 EPC.

- In response to this letter, the examining division issued the contested decision refusing the European patent application.

3.5 In view of the above chain of events, it is apparent for the board that the appellant had multiple opportunities to address the objections against the feature "sterilizable". In particular, the appellant had a first opportunity to overcome the novelty objections on entry into the European phase, but decided to file a single request based on a combination which had already been considered not to be novel in view of D1. The appellant then had a second opportunity to overcome the objections raised in the communication under Article 94(3) EPC, but decided not to file any additional request or to request oral proceedings. With this course of action, the applicant effectively renounced the opportunity to file additional requests and prevented a substantial discussion and a decision on a clarified and/or more detailed definition of the invention.

3.6 The board also does not share the appellant's view that the issuance of a refusal after the response to the first communication under Article 94(3) EPC would represent an uncommon or surprising course of action. It is in fact standard procedure for the examining division to issue a refusal after the first communication under Article 94(3) EPC if the applicant neither requests oral proceedings nor files further requests, but rather chooses to respond to the outstanding objections with further arguments (provided, of course, that the arguments are not found

convincing by the examining division). The only "uncommon" aspect in this procedure is the absence of a request to hold oral proceedings, an omission which is however the applicant's responsibility.

3.7 For the sake of completeness, it is furthermore noted that it is not even clear whether auxiliary requests 1 and 2 would have sufficed to overcome the outstanding objections, because, as indicated by the examining division, the interpretation of the concept "sterilizable" is inherently diffuse even when the explanations in the description are taken into account or partially adopted in the claims. For example, there is no clear way to distinguish composites with "significant crack formation" or with an "increased corrosion susceptibility" after sterilisation from those not showing these features. This would effectively prevent a skilled person from recognising when they are working within the scope of protection or not.

3.8 All in all, the board concludes that the filing of new auxiliary requests (for the first time) at the appeal phase is not justified by the conduct of the first instance procedure or by any subsequent change in the subject of the proceedings. The filing of these requests therefore constitutes a belated reaction to pursue a new case rather than an attempt to address issues that had become pertinent only in the decision under appeal. The appeal proceedings represent a judicial review of the first instance decision and not an opportunity to start a fresh case by exploring approaches which could and should have been filed earlier in the proceedings.

The board has thus decided to exercise its discretion under Article 12(4) RPBA 2020 and not to admit auxiliary requests 1 to 7 into the appeal proceedings.

4. Since none of the requests presented by the appellant is admissible and allowable, the board concludes that the appeal should be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

A. Pinna C. Heath

Decision electronically authenticated