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**Datasheet for the decision
of 25 March 2014**

Case Number: T 0049/11 - 3.3.09
Application Number: 96922330.4
Publication Number: 871570
IPC: B65B55/14, B65D65/40,
B32B27/10, B32B27/08
Language of the proceedings: EN

Title of invention:

Sterilisation of a filled container manufactured from a packaging laminate based on cardboard and paper

Patent Proprietor:

Tetra Laval Holdings & Finance S.A.

Opponent:

SIG Combibloc GmbH

Headword:

Relevant legal provisions:

EPC Art. 24(3), 123(2), 83, 177(1)
EPC 1973 Art. 24(3)

Keyword:

Transitional provisions of the EPC 2000
Objection of suspected partiality - not admissible
Amendments - added subject-matter (no)
Sufficiency of disclosure - (yes)

Decisions cited:

G 0002/88, G 0001/97, J 0005/91, J 0032/95, J 0010/07,
T 1028/96, T 1366/04, T 0616/08

Catchword:



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Case Number: T 0049/11 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 25 March 2014

Appellant: Tetra Laval Holdings & Finance S.A.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 3 December 2010
revoking European patent No. 871570 pursuant to
Articles 101(2) and 101(3) (b) EPC.**

Composition of the Board:

Chairman: W. Sieber
Members: W. Ehrenreich
F. Blumer

Summary of Facts and Submissions

- I. Mention of the grant of European patent No. 0 871 570 in the name of Tetra Laval Holding & Finance S.A. was announced on 18 June 2008 in Bulletin 2008/25.
- II. The patent was granted with 6 claims, claim 1 reading as follows:

"1. A method of treating a filled, folded moisture and heat resistant container manufactured of a material of laminate type in the form of a sheet or a web, said laminate comprising at least one base layer (1), an outer coating (2) and an inner coating (3), wherein the base layer (1) consists of a liquid absorbing material, the outer coating (2) consists of a polymer selected from polypropylene, oriented polypropylene, metalized oriented polypropylene, high density polyethylene, metalized high density polyethylene, linear low density polyethylene, polyester, metalized polyester and amorphous polyester, and the inner coating (3) consists of a polymer selected from polypropylene, high density polyethylene, linear low density polyethylene, polyester and amorphous polyester, said method comprising heat treatment by autoclaving of the container so as to heat the container under pressure in a humid atmosphere to produce sterilisation by heat, without the dimensional stability of the container being thereby impaired."

Claims 2 to 6 were dependent claims.

- III. An opposition against the patent was filed by

SIG Combibloc GmbH.

The opposition was based on the grounds that the subject-matter of the patent extended beyond the content of the application as filed (Article 100(c) EPC), that the invention was insufficiently disclosed (Article 100(b) EPC) and that the claimed subject-matter was neither novel nor based on an inventive step (Article 100(a) EPC).

IV. With its decision announced orally on 18 November 2010 and issued in writing on 3 December 2010 the opposition division revoked the patent. The decision was based on the proprietor's main request to maintain the patent as granted and on sets of claims according to auxiliary requests 1 to 6.

V. The opponent's objection under Article 100(c) EPC concerned the feature of claim 1 relating to the treatment of "a filled folded moisture and heat resistant container ... by autoclaving of the container so as to heat the container under pressure in a humid atmosphere". The opposition division held that this feature was disclosed in the application as filed, represented by the document WO 97/02140 (D3).

With respect to the opposition ground according to Article 100(b) EPC, the opposition division, however, followed the arguments of the opponent that the feature "without the dimensional stability of the container being thereby impaired" caused a lack of sufficiency of disclosure of the invention. In its view the patent specification neither gave a definition of what this feature actually meant nor defined any criteria as to how the parameter of dimensional stability had to be determined. Because this ground was decisive for all the requests on file, the issues of novelty and inventive step were not dealt with in the decision.

VI. Notice of appeal against the decision was filed by the proprietor (hereinafter: the appellant) on 6 January 2011. The prescribed fee was paid on the same day.

The grounds of appeal were received on 21 March 2011. The appellant disagreed with the opposition division's reasoning as to insufficiency of disclosure and submitted the following document in order to support its position:

D56 Witness Statement by Thorbjorn Andersson.

In the appellant's view the experimental evidence in D56 showed that the skilled person, following the directions in the patent, was able to make containers that are indistinguishable after heat treatment from their shape before heat treatment as regards their ability to resist an externally applied vertical load of over 4 kg.

The appellant requested that the decision be set aside and that the case be referred back to the opposition division for further prosecution in relation to the issues of novelty and inventive step.

VII. The opponent (hereinafter: the respondent) responded with its letter dated 25 September 2011 and maintained its previous objections raised under Articles 100(c) and 100(b) EPC. In respect of its objection under Article 100(b) EPC relating to the feature in claim 1 "... without the dimensional stability of the container being thereby impaired" the respondent presented *inter alia* the document

D57 representing an experimental report numbered "G 9008" and issued by Dipl. Ing. Klaus Behringer.

The respondent further requested that a question be referred to the Enlarged Board of Appeal according to Article 112(1)(a) EPC in the event that the board considered the uncertainty associated with the feature "without the dimensional stability of the container thereby being impaired" to be an objection under Article 84 EPC rather than under Article 83 EPC.

- VIII. By summons dated 12 February 2013 oral proceedings were arranged for 14 August 2013 and the composition of the board was communicated to the parties. With its letter dated 19 February 2013 the respondent informed the board that it would speak German during the oral proceedings and that a translation from English into German would not be necessary. By letter dated 25 March 2013 the respondent enquired whether the board intended to issue a preliminary communication.
- IX. On 26 April 2013 the board issued a communication and made its observations on the issues of added subject-matter and sufficiency of disclosure. The appellant replied with its letter dated 21 May 2013 and presented arguments relating to these issues.
- X. With letter dated 14 June 2013 the respondent objected to the rapporteur under Article 24(3) EPC for suspected partiality and provided its respective arguments. Further arguments relating to the opposition grounds of Article 100(c) and 100(b) EPC were presented. The request to refer the question to the Enlarged Board of Appeal, formulated in the letter dated 25 September 2011 (point VII), was withdrawn.

XI. In its letter dated 8 July 2013 the appellant expressed its view that the respondent's objection under Article 24(3) EPC of suspected partiality was neither admissible nor allowable.

The respondent, with letter dated 15 July 2013, defended its position that its objection to the rapporteur for suspected partiality was both admissible and allowable. In the event that the board refused the request for suspected partiality, it was requested that four questions be referred to the Enlarged Board of Appeal.

XII. In a communication issued on 19 July 2013 the board made its observations on the issue of suspected partiality and informed the parties that the date for oral proceedings on 14 August 2013 would be maintained and that only the issues related to the respondent's objection under Article 24 EPC would be discussed at these oral proceedings. The board in its current composition would discuss with the parties and decide whether the objection was admissible in view of Article 24(3) EPC.

XIII. In the oral proceedings of 14 August 2013 the admissibility of the respondent's objection under Article 24(3) EPC was discussed with the parties. In this context the question arose whether the respondent's letter of response to the summons to oral proceedings dated 19 February 2013 and concerning participation in the oral proceedings and the languages to be used qualified as a "procedural step" within the meaning of Article 24(3) EPC.

- XIV. The respondent requested that its objection under Article 24(3) EPC be admitted into the proceedings and that the proceedings be conducted in accordance with Article 24(4) EPC. Subsidiarily, it was requested that the question arisen above under point XIII be referred to the Enlarged Board of Appeal. A draft of this question was submitted in handwritten form during the oral proceedings. The earlier request for referral submitted with the letter dated 15 July 2013 was withdrawn.
- XV. The appellant requested that the respondent's objection under Article 24(3) EPC be rejected as inadmissible.
- XVI. At the end of the oral proceedings the interlocutory decision held that
- The objection against the present rapporteur under Article 24(3) EPC is rejected as inadmissible.
 - The request for referral to the Enlarged Board of Appeal is rejected.
- XVII. With the summons dated 3 September 2013 second oral proceedings were appointed for 25 March 2014. No further written submissions were filed by the parties prior to the oral proceedings. During these oral proceedings only the issues of added subject-matter and sufficiency of disclosure were discussed. The arguments of the parties relating to these issues are summarized in the following.
- XVIII. Arguments of the respondent
- a) Article 100(c) EPC - Added subject-matter

All references to the application as filed relate to its published version WO 97/02140 A1 (D3, see point V).

(i) The claims as filed are product claims directed to a container. In contrast thereto, the claims in the patent in suit are directed to a method of treating a container. Such a method claim also protects the direct result of the method, namely the treated container. A treated container is not, however, disclosed in the application as filed. The change of claim category from a product claim to a claim which is directed to a method of treating the product thus introduces added subject-matter, contrary to Article 123(2) EPC. Decision G 2/88 was referred to in this context.

(ii) In the feature of claim 1 "without the dimensional stability of the container being thereby impaired", the word "thereby", which was not originally disclosed in this context, expresses a time sequence, a point in time and a time period and therefore implies a technical meaning. Its introduction thus violates Article 123(2) EPC.

(iii) The feature that a filled container is treated under heat by autoclaving the container under pressure in a humid atmosphere has no support in the application as filed. The passage on page 4, lines 23 et seq. of D3 relates to the resistance of the container according to the invention against a humid environment, but not in conjunction with pressure. As far as the disclosure on page page 6, lines 26 et seq.,

refers to the application of pressure, there is no link to the technical measure of autoclaving. As can be derived from page 7, lines 26 et seq. autoclaving is a separate feature and is combined with a specific temperature range of 105 to 121°C.

b) Article 100(b) EPC - Sufficiency of disclosure

(i) The meaning of the technical feature in claim 1 "without the dimensional stability of the container being thereby impaired" is not defined in the patent, nor is a method of measurement given as to how the dimensional stability has to be determined. The test report D56 provided by the appellant is an in-house test which is not disclosed or referred to in the patent specification. D56 itself does not define what "impairment" means, and in particular the test results given in the table in section 9 relating to the outward bulging before and after processing the container at different temperatures/loads do not indicate which percentual changes ("delta values") in dimensional stability are tolerable. The patent thus lacks a definition of a threshold beyond which the dimensional stability has to be considered impaired.

(ii) The patent specification also lacks any information as to the construction of the container. The drawing of Figure 1 is purely schematic and includes other optional layers of the container. It does not, however, indicate which thickness of the base layer, e.g. of the paperboard, and of the other essential layers (2) and (3) are necessary in order to maintain the

dimensional stability under the treatment conditions defined in claim 1.

(iii) Claim 1 indicates two lists, each of them defining polymer classes from which numerous polymers can be selected for the layers (2) and (3) of the container. These two lists, however, allow over 60,000 polymer combinations for the material of layers (2) and (3), and no guidance is given in the patent as to which polymer combinations meet the requirement of claim 1 that the dimensional stability of the container should not be impaired.

(iv) The document

D39 Tetra Recart "Paperboard in a new challenging environment - The Tetra Recart development story"

represents a presentation of the appellant itself on developments of a new packaging material for food which has to be sterilized at temperatures up to 130°C. It is evident from pages 7 and 9 to 11 of D39 that numerous steps concerning the development of the paper board base layer (pages 7, 10) and the selection of the polymer for the outer layers in order to withstand 130°C (page 11) have to be performed in order to meet the various challenges the containers are faced with. However, no selection criteria for the polymers or stability criteria for the paperboard deformation test as depicted on page 7 are defined in the patent.

From the above it follows that the skilled person is not able without undue burden to meet the criterion of claim 1, that the treatment of the container under moist heat by autoclaving should not impair its dimensional stability. The invention is thus insufficiently disclosed.

XIX. Arguments of the appellant

a) Article 100(c) EPC - Added subject-matter

(i) The change in claim category which took place during the examining procedure has its basis in D3 in its whole context, and can be derived, e.g., from the introductory part at page 1 or from page 3, lines 20 et seq.

(ii) Concerning the introduction of the word "thereby" it should be noted that no time regime is originally disclosed concerning the dimensional stability of the container. The word "thereby" is therefore only a filler word and has no technical meaning.

(iii) The technical measure of autoclaving is disclosed at page 6, lines 26 et seq. and page 7, lines 26 et seq. The discussion on autoclaving begins at page 7, line 32 and continues on page 8. In the paragraph bridging pages 7 and 8 the temperature conditions in the autoclaving vessel are discussed. In particular the second (subsequent) paragraph at page 8 refers to "Products included in a container according to the invention ...". This disclosure unambiguously has to be seen in conjunction with the previous paragraph. It implies that a container filled with

a product is treated by autoclaving. Thus, the feature in claim 1 to treat a filled container under heat by autoclaving under pressure is at least implicitly disclosed in the application as filed as one embodiment of the invention.

b) Article 100 (b) EPC - Sufficiency of disclosure

(i) The requirement in claim 1 that the dimensional stability of the container should not be impaired is explained in paragraph [0002] of the patent specification. In the sentence beginning in line 15 it is pointed out that the container should be sufficiently mechanically strong and dimensionally stable in order to withstand external influences to which the container is exposed during normal handling, without the container being deformed or destroyed. In the next paragraph [0003] it is mentioned that one of the drawbacks of paper and board as packaging materials is that they lose their mechanical strength properties when exposed to liquid or moisture, which has to be avoided by coating or lamination. It is therefore evident to a skilled person that the paperboard packaging material should resist well-known stresses and strains to which the container is exposed during normal handling, e.g. under application of load. The evaluation of the dimensional stability thus requires a simple "before and after" test in that a drop-down load is applied to a container before autoclaving the container under moist heat and then after treatment, as indicated in D56. The dimensional stability is not impaired if the container, after autoclaving, is not damaged and has the same shape as before autoclaving. Such a

simple test and the evaluation of the test results can be performed by a skilled person without undue burden. The same applies to the test to be applied during the paperboard development referred to at page 7 of D39.

The respondent's objections under points XIII (b) (i), (ii) above must therefore fail.

(ii) Concerning the respondent's objection referring to the large number of polymer materials defined for the protecting layers (2) and (3) and the numerous possible combinations, it should be noted that no evidence has been provided from the respondent's side that problems with dimensional stability arise when certain groups of polymers or specific combinations of polymer components are applied.

(iii) The challenge presented in D39 to find polymers that resist 130°C has not to be understood in the sense that any container has to meet this challenge. It is well-known in the prior art that, for different purposes, the containers have to meet different requirements. Therefore the temperature resistance depends on the purpose/food product for which the container is used. Temperatures that are customary for foods are defined in the patent specification.

XX. The appellant requested that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution in relation to the issues of novelty and inventive step.

XXI. The respondent requested that the appeal be dismissed. In the event that the Board were to decide that the subject-matter did not extend beyond the content of the application as filed and that the patent did disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, the respondent requested that the case be remitted to the opposition division for consideration of the issues of novelty and inventive step.

Reasons for the Decision

1. The appeal is admissible.
2. The respondent's objection to the rapporteur for suspected partiality according to Article 24 EPC
 - 2.1 Examination of the admissibility and allowability of the partiality objection
 - 2.1.1 In accordance with the procedure described in decision T 1028/96 (OJ EPO 2000, 475), the board in its original composition (including the member objected to) has to decide whether the objection is admissible in view of Article 24(3) EPC. If the objection is admissible, the board must decide in a new composition whether the partiality objection is well-founded and allowable (Article 24(4) EPC). A partiality objection "shall not be admissible if, while being aware of a reason for objection, the party has taken a procedural step" (Article 24(3), second sentence, EPC).
 - 2.1.2 In the present case, the admissibility of the partiality objection was disputed because the respondent, after receiving the summons of 12 February 2013, which made the parties aware of the composition

of the board, filed two letters (dated 19 February 2013 and 25 March 2013) with the board before raising the partiality objection with letter dated 14 June 2013. In the first letter, the respondent, *inter alia*, expressed its intent to speak German at the oral proceedings.

2.2 Difference between Article 24 EPC 2000 and Article 24 EPC 1973

2.2.1 In the present case, the application was filed in June 1996, *i.e.* more than 11 years before the EPC 2000 entered into force on 13 December 2007. The present appeal proceedings, in which the partiality objection under Article 24 EPC was made, started in January 2011, *i.e.* more than 3 years after the EPC 2000 entered into force. As the EPC 2000 is fully applicable only to patent applications filed after 13 December 2007 (and to patents granted in respect of such applications, see point 2.3.1 below), the transitional provisions of the EPC 2000 become relevant at least if the applicable provisions of the old and the revised versions of the EPC differ from each other.

2.2.2 Article 24(3), second sentence, EPC says: "An objection shall not be admissible if, while being aware of a reason for objection, the party has taken a procedural step." This wording of the English language version is identical to the corresponding provision in Article 24(3) EPC 1973. In the French version, a minor amendment was made ("lorsque la partie en cause a accompli des actes de procédure" [EPC 2000] v. "lorsque la partie en cause a fait des actes de procédure" [EPC 1973]). Under the German language version of the EPC 1973, on the other hand, an objection was inadmissible "wenn der Beteiligte im Verfahren Anträge gestellt oder Stellungnahmen abgegeben hat, obwohl er

bereits den Ablehnungsgrund kannte" (if the party made requests or comments). The corresponding provision of Article 24(3) EPC 2000 refers to "Verfahrenshandlungen" (procedural steps) instead of "Anträge" (requests) and "Stellungnahmen" (comments). This amendment brought the German language version into line with the other two language versions. However, the question arises whether the term "Verfahrenshandlungen" is broader than the combination of "Anträge" and "Stellungnahmen". Certain statements commonly made in proceedings before the EPO, such as the withdrawal from representation or the filing of an authorisation, could easily qualify as a procedural step while they could probably not qualify as a request or a comment.

2.2.3 In the present case, the board came to the conclusion that in view of Article 177(1) EPC, which requires that the text of a provision in all official languages has to be considered, the German wording of Article 24(3), second sentence, EPC 1973 would have to be interpreted broadly, taking into account that the drafters of the Convention certainly did not want to establish different provisions in the three official languages. Consequently, the board would have accepted that the term "procedural step" in Article 24(3), second sentence, EPC 1973 covered the respondent's declaration that its representative would speak German during the oral proceedings despite the presence of the terms "Anträge" and "Stellungnahmen" in the German language version of the same provision. However, the board is of the opinion that there has to be clarity about the wording of the provisions on which a decision is based, particularly, where the two potentially applicable texts differ from each other to an extent which could make the difference relevant for the outcome of a case. For this reason, the board had to take a decision on

the applicable version of Article 24(3), second sentence, EPC.

2.3 Transitional provisions / Applicability of Article 24 EPC 2000

2.3.1 Under Article 1 Nos. 1-82 of the Act revising the EPC of 29 November 2000 ("Revision Act", OJ EPO Special Edition 4/2001, 3), the EPC 1973 was extensively revised through the amendment of 72 articles, the deletion of 7 articles and the insertion of 7 new articles (see also the lists in Article 1 Revision Act as shown in the EPC text edition issued by the EPO, 15th edition / September 2013, page 629ss.). Under the heading "Transitional Provisions", Article 7 Revision Act reads as follows: "(1) The revised version of the Convention shall apply to all European Patent applications filed after its entry into force, as well as to all patents granted in respect of such applications. It shall not apply to European patents already granted at the time of its entry into force, or to European patent applications pending at that time, unless otherwise decided by the Administrative Council of the European Patent Organisation. (2) The Administrative Council of the European Patent Organisation shall take a decision under paragraph 1 no later than 30 June 2001 (...)".

2.3.2 Under Article 3 Revision Act, the Administrative Council was furthermore authorised "to draw up (...) a new text" of the EPC. The new wording of the provisions of the Convention should, in particular, "be aligned (...) in the three official languages". Both the new text adopted under Article 3 Revision Act and the decision of the Administrative Council on transitional provisions taken under Article 7(2) Revision Act should

become an integral part of the Revision Act (Articles 3(2), 7(2) Revision Act).

2.3.3 Under Article 7(2) Revision Act, the Administrative Council issued its decision of 28 June 2001 on the transitional provisions under Article 7 Revision Act ("Transitional Provisions", OJ EPO Special Edition 1/2003, 202). These Transitional Provisions refer, *inter alia*, to 34 articles which, in full or in part, "shall apply to European patent applications pending at the time of their entry into force and to European patents already granted at that time" (Article 1 no. 1 Transitional Provisions). However, the Transitional Provisions apply only to articles which were revised or introduced under Article 1 Revision Act (see Article 1 Transitional Provisions: "In accordance with Article 7, paragraph 1, second sentence, of the Revision Act, the following transitional provisions shall apply to the amended and new provisions of the European Patent Convention specified below", emphasis added by the board). Consequently, the Transitional Provisions refer only to articles which were introduced or revised under Article 1 Revision Act but not to articles which remained unamended or which were only aligned under Article 3 Revision Act.

2.3.4 Under Article 3 Revision Act, the Administrative Council issued its decision of 28 June 2001 adopting the new text of the EPC (OJ EPO Special Edition 4/2001, 55). According to the "Explanatory remarks" to this decision, the new text had been "linguistically updated and edited, primarily to standardise terminology in each language, harmonise the three language versions, and correct obvious omissions and linguistic errors" (OJ EPO Special Edition 4/2001, 54, par. 2). It is noteworthy that neither Article 3 Revision Act nor

the decision adopting the new text refer to any "amendment". Under Article 2 of said decision, the decision shall enter into force "upon entry into force of the revised text of the European Patent Convention in accordance with Article 8 of the Revision Act". Article 8 Revision Act merely served to establish the date of the entry into force of the EPC 2000. The decision adopting the new text of the EPC does not contain any other transitional provisions.

2.3.5 Article 24 EPC was not introduced or revised under Article 1 Revision Act but aligned under Article 3(1) Revision Act (see the remarks in the synoptic presentation EPC 1973/2000, OJ EPO Special Edition 4/2007, 26). As the Transitional Provisions remain silent on this group of articles of the EPC (see above point 2.3.3) and the decision of the Administrative Council adopting the new text of the Convention does not contain any transitional provisions (see above point 2.3.4), the question arises as to what extent the general rule set forth in Article 7(1) Revision Act may be applicable (namely, that the revised version of the Convention (...) shall not apply to European patents already granted at the time of its entry into force - see above point 2.3.1, emphasis added by the board).

2.3.6 Article 7 Revision Act ("Transitional provisions") refers to the "revised version of the Convention". The reference may be understood as a reference to the entire EPC (including revised and unchanged articles) or as a reference to the revised articles of the EPC. In the latter case, the general rule of Article 7(1), second sentence, Revision Act would not apply to the articles which had not been revised - which would mean that no transitional provisions would exist for these articles.

2.3.7 If the "revised version of the Convention" referred to in Article 7(1) Revision Act was meant to read "the entire EPC 2000", the entire Article 7 Revision Act would have to be interpreted accordingly, including the reference to the decision to be taken by the Administrative Council under paragraph 2. From the Transitional Provisions issued by the Administrative Council under this provision, on the other hand, it is clear that these provisions were drafted after a detailed analysis of all the articles which were referred to in Article 1 Revision Act (see also above point 2.3.3). No article that remained unchanged or was aligned under Article 3 Revision Act is mentioned in the Transitional Provisions. Nothing suggests that, while drafting the Transitional Provisions, the Administrative Council took a deliberate decision not to include any articles aligned under Article 3 Revision Act in the list of articles which would apply to European patent applications pending before the entry into force of the EPC 2000. On the contrary, it appears that the drafters of the Transitional Provisions just did not see any need for such provisions with respect to articles that remained unchanged or were merely aligned under Article 3 Revision Act. This is corroborated, for example, by the "Table on the transitional provisions of the EPC 2000" as published in OJ EPO Special Edition 1/2001, 221, which does not refer to any article belonging to these groups.

2.3.8 By not taking into account the articles which were not revised but only aligned under Article 3 Revision Act, the Administrative Council did not make full use of its mandate to decide on transitional provisions under Article 7(2) Revision Act - if this mandate is

understood to cover the entire Convention (see point 2.3.6 above). The Transitional Provisions can therefore be relevant only for the articles revised or introduced under Article 1 Revision Act. For the other articles (those unchanged or merely aligned under Article 3 Revision Act), the general rule in Article 7(1), second sentence, Revision Act, is not conclusive either, as it was drafted under the implied condition that the Administrative Council would adopt transitional provisions before 30 June 2001 with respect to these articles too (the entire Article 7 Revision Act referring to the "revised version of the Convention").

2.3.9 Had the drafters of the Transitional Provisions considered the articles that remained unchanged or just aligned under Article 3 Revision Act, they would most probably have used the same principles they used with respect to the articles revised under Article 1 Revision Act when taking individual decisions on which version of every article should be applied. In the document submitted to the Administrative Council together with the proposed Transitional Provisions, the basic principle underlying the proposed provisions is summarised as follows: "These transitional arrangements are designed to ensure that, after the entry into force of the revised version of the EPC, the provisions applied in proceedings before the European Patent Office are as uniform as possible, and that the provisions will quickly take effect in practice. The use of different versions of the EPC over a prolonged period is to be avoided. This is equally important to the Office and to users of the European patent system" (document CA/25/01, par. 5, emphasis added by the board).

2.3.10 In the opinion of this board, the Revision Act in combination with the Transitional Provisions is not conclusive with respect to EPC articles not added or revised under Article 1 Revision Act. To the extent that it is relevant whether the old or the new version of any of these articles is applicable, there may exist a "gap in the law" or "lacuna" ("Gesetzeslücke") which must be closed by case law, considering the existing legislation and the manifest intent of the legislators, and aiming at a reasonable result which is equitable for all parties concerned (G 1/97, OJ EPO 2000, 322, point 3b; J 5/91, OJ EPO 1993, 657, point 5.4; J 32/95, OJ EPO 1999, 713, point 2.4).

2.3.11 Given that Article 24 EPC was not revised but just aligned under Article 3 Revision Act and is therefore not mentioned in the Transitional Provisions, and in the absence of any other indication as to what transitional rules might apply to Article 24 EPC, the board has to close a "gap in the law". In view of the legislator's clear intent (see point 2.3.9 above), the board has decided to apply Article 24 EPC 2000 to the present patent; the board does not see any reason why the old wording of Article 24(3) EPC should apply to a partiality objection made in 2013, more than five years after entry into force of the new text of Article 24(3) EPC. The application of the aligned provision is in line with the principle that any procedural steps should be governed by the law valid at the point in time when the procedural step is taken or due to be taken (*tempus regit actum*; see T 1366/04, point 1.2).

2.4 Transitional provisions / earlier case law

2.4.1 The board is aware of the extensive case law which is based on a different view on the transitional regime of

the EPC 2000. For example, decision J 10/07 (OJ EPO 2008, 567), to which many later decisions refer, came to the conclusion that *inter alia* Article 111 EPC (which had been aligned under Article 3 Revision Act but not revised under Article 1 Revision Act) should be applied in its old version in proceedings concerning a patent application filed before the entry into force of the EPC 2000. The Legal Board of Appeal based its decision on the Transitional Provisions and on the wording of Article 7(1), second sentence, Revision Act (J 10/07, point 6). Deviating decisions remained scarce (for example, T 616/08).

2.4.2 If, in proceedings related to patent applications filed before the entry into force of the EPC 2000, the new text is applied only if the article concerned is listed in the Transitional Provisions and, consequently, the old version is applied for all other articles, consequences arise which may not have been intended by the drafters of the Transitional Provisions (see above point 2.3.9). For example, Article 110 EPC 2000 ("Examination of appeals") has to be applied together with Article 111 EPC 1973 ("Decision in respect of appeals") because only Article 110 is listed in Article 1 Transitional Provisions. Article 52 (referring, *inter alia*, to novelty and inventive step) has to be applied in the new version, while Article 54(1), (2) EPC on novelty and Article 56 EPC on inventive step have to be applied in the old version because only Article 52 is listed in Article 1 Transitional Provisions.

2.4.3 In the vast majority of cases in which boards decided on the applicability of the old or new version of an article of the EPC which had not been revised but just aligned under Article 3 Revision Act, such alignment of

the wording of the articles concerned did not change their material contents (see, for example, J 10/07, point 7). In these cases, the considerations on the transitional regime could be viewed as *obiter dicta* rather than as being decisive for the decisions. The present case is one of the very rare cases in which the changes made to the text of an article under Article 3 Revision Act could be viewed as an amendment to its substantive content (see point 2.2.2 above).

2.4.4 The board is not aware of any decision where the interpretation of Article 7(1) Revision Act and the Transitional Provisions was decisive for the outcome of the proceedings. Also, in the present case, the board would have come to the same result under the old and the new text of Article 24(3), second sentence, EPC (see above point 2.2.3). The interpretation of Article 7(1) Revision Act and the Transitional Provisions in this context is therefore not considered to be "a point of law of fundamental importance" in view of Article 112(1) EPC. The board also doubted whether a referral of the issues arising in the present case to the Enlarged Board of Appeal under Article 112 EPC would be sufficient to ensure uniform application of the transitional regime for any Articles of the EPC aligned under Article 3 Revision Act other than Article 24 EPC. As far as Article 24 EPC is concerned, the board is not aware of any diverging case law under the transitional regime. For these reasons, the board decided not to refer any questions to the Enlarged Board of Appeal under Article 112(1)(a) EPC even though the general approach taken by the boards to the transitional regime is not uniform.

2.5 Letters of the respondent of 19 February 2013 and 25 March 2013 in view of Article 24(3) EPC 2000

- 2.5.1 After receiving the board's summons and thereby learning of the board's composition, the respondent wrote in its letter of 19 February 2013 that the representatives of the respondent intended to speak German at the oral proceedings and that no translation from English (language of the proceedings) was needed. In the letter of 25 March 2013, the respondent asked whether the board would issue a preliminary opinion before the date of the oral proceedings.
- 2.5.2 The statement that a party intends to speak another official language than the language of the proceedings at oral proceedings constitutes, in the board's judgement, a procedural step ("Verfahrenshandlung", "acte de procédure") in the terms of Article 24(3), second sentence, EPC, as it is a formal notification which is required under Rule 4(1) EPC. The respondent's statement that it intended to speak German at the oral proceedings was therefore a procedural step, taken more than three months before the respondent raised the partiality objection. The partiality objection therefore had to be rejected as inadmissible under Article 24(3), second sentence, EPC.
- 2.5.3 Under these circumstances it is not relevant whether or not the other statements in the letters of 19 February 2013 and 25 March 2013 constitute procedural steps in view of Article 24(3), second sentence, EPC.
- 2.6 Referral to the Enlarged Board of Appeal
- 2.6.1 During the oral proceedings of 14 August 2013, when the admissibility of the partiality objection under Article 24(3), second sentence, EPC was discussed, the respondent requested that the the following question be

referred to the Enlarged Board of Appeal (filed in German):

"Liegt eine Verfahrenshandlung im Sinne des Art. 24(3) Satz 2 EPÜ vor, wenn auf eine Übersetzung verzichtet wird?"

In the board's translation:

"Does a party's renouncement of a translation constitute a procedural step in view of Article 24(3), second sentence, EPC?"

- 2.6.2 "In order to ensure uniform application of the law, or if a point of law of fundamental importance arises (...) the Board of Appeal shall, during proceedings on a case (...) refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes." (Article 112(1) EPC)
- 2.6.3 The board had to decide whether at least one of the statements made in the respondent's letters of 19 February 2013 and 25 March 2013 (see point 2.5.1 above) was a "procedural step" in view of Article 24(3) EPC. As the respondent did not refer to diverging case law in this respect and the board is not aware of such diverging case law, the referral is not required to ensure uniform application of the law. The board also came to the conclusion that the question submitted by the respondent does not refer to a point of law of fundamental importance. The statements made by the respondent in its letter of 19 February 2013 are just a few among a large number of possible statements, acts or omissions which may or may not qualify as "procedural steps" under Article 24(3) EPC. Such qualification has to be made by any board concerned on

a case-by-case basis. It is unlikely that the party statement referred to in the referral question will be relevant in a significant number future cases under Article 24(3) EPC. The board therefore does not see any public interest in the referral requested by the respondent.

2.6.4 Regardless of whether or not the declaration that no interpretation is needed at oral proceedings is considered to be a procedural step in view of Article 24(3), second sentence, EPC, the fact remains that the respondent, in its letter of 19 February 2013, also declared that its representative would speak German at the oral proceedings. This second declaration was required under Rule 4(1) EPC, and it constituted a procedural step in itself (see point 2.5.2 above). Under these circumstances, the question of whether there was another procedural step (namely, the renouncement of a translation) does not need to be answered for a decision on the admissibility of the partiality objection in view of Article 24(3), second sentence, EPC. A decision of the Enlarged Board of Appeal is therefore not required for the decision of the present board.

2.6.5 For these reasons, the request for a referral to the Enlarged Board of Appeal had to be rejected.

3. The claims under consideration are the claims as granted.

4. Article 100(c) EPC

In the following, reference is made to the document

D3 WO 97/02140 A1

which represents the contents of the application as filed.

4.1 Change of claim category

- 4.1.1 Claim 1 and dependent claims 2 to 5 of the application as filed were product claims relating to "A folded moisture and heat resistant container ...". After refusal of the application by the examining division, the claim category, during the subsequent appeal proceedings T 1001/04, was changed to method claims.
- 4.1.2 The board in T 1001/04 decided that a set of method claims 1 to 6 according to a new main request, which related to "A method of treating a filled, folded moisture and heat resistant container ..." meets the requirements of Articles 84 and 123(2) EPC. The case was remitted to the examining division for further prosecution on the basis of these claims.
- 4.1.3 During the continued examination proceedings a patent was granted on the basis of amended method claims. The change in claim category thus took place before the grant of a patent and has therefore to be considered exclusively under the provisions of Articles 123(2) or 100(c) EPC, respectively. The respondent's reference to G 2/88, dealing with the change in claim category during opposition proceedings under the provisions of Article 123(3) EPC, is therefore not relevant in this context.
- 4.1.4 It is well established that subject-matter is not added by a change of claim category per se. The relevant question to be answered is whether there is a basis for

the new claim category, in the present case the method of claim 1.

The third paragraph of page 3 of D3 reads:

"However, known containers of a packaging laminate with a liquid absorbing fiber layer cannot be used for heat treatment with moist heat without the desired mechanical rigidity of the packaging laminate and thus the dimensional stability of the container being impaired or lost."

The next paragraph of page 3 reads:

"The purpose of the invention is thus to provide a moisture and/or heat resistant packaging container made of a laminate material of the above mentioned type."

So following on from a discussion of the problem posed by the prior art, i.e. a liability to suffer impairment of dimensional stability under heat treatment using moist heat, D3 announces the intention to provide a moisture and/or heat resistant container made from a defined laminate. Insofar as the teaching regarding the invention will be to avoid the problem of the prior art, it will always require a solution in which impairment of dimensional stability is avoided, whichever of the various heat treatments disclosed in D3 is used, be it hot-filling or autoclaving, for example.

Also, on page 4, lines 23 to 25 it is indicated that "containers made of a laminate of the above mentioned type not only withstand the usual heat treatment but also a treatment under extreme conditions in a humid environment ...".

The change of the claim category as such thus complies with Article 123(2) EPC.

4.2 A method of treating a filled, folded moisture and heat resistant container ... by autoclaving of the container so as to heat the container under pressure in a humid atmosphere (claim 1)

4.2.1 The constructional features of the laminate are described in D3 up to page 6, line 4. Then attention is turned to the description of the various possible heat treatments to which all of the described containers may be subjected.

First, there is described (page 6, first full paragraph) a method of filling a continuously formed tube with hot filling material and dividing the tube into finished containers. That is not the method of claim 1.

Then, there is mentioned the use of more drastic conditions including moisture and/or heat (page 6, lines 18 to 20). It is said explicitly that the laminate according to the invention can be used for producing dimensional stable containers which can be used at "highly extreme conditions" (page 6, line 29). The nature of the highly extreme conditions is then explained to be autoclaving (page 6, line 34) and it is said that this will involve heat treatment with moist heat and above atmospheric pressure (page 6, lines 30/31). Thus, these passages provide a basis for the now claimed autoclaving referred to in claim 1.

4.2.2 The wording that a filled container is treated under moist heat by autoclaving is not expressly mentioned in

the application as filed. It has therefore to be clarified whether there is an unambiguous implicit disclosure of this feature in claim 1.

It is said on page 6, line 32 that at least one of the sides of the containers is exposed to the heat treatment with moist heat and a pressure above atmospheric. The reference to at least one side being exposed indicates to the skilled reader the possibility of food being present in the container, because food in the container will of course block access to the interior surface, so that one side of the container is exposed to the moist heat above atmospheric pressure. This interpretation is also in line with the immediately following sentence (page 6, lines 33 to 35), which states that such harsh environments comprise autoclaving at temperatures and periods which are customary for foods. That sentence would make no sense if there was no food present.

- 4.2.3 However, the presence of food in the container is made more explicit in the passage bridging pages 7 and 8 of D3.

After the description of a third heat treatment method (conventionally referred to as "hot fill" and not claimed), the description of autoclaving continues at page 7, line 26 with a reiteration that the previously described harsh environments include autoclaving at temperatures and periods customary for food. Then various details on autoclaving are given. On page 8, lines 12 to 17 it is stated with respect to the F_r value mentioned in the paragraph before that "Products included in a container according to the invention are not heat treated to a special F_r value, on the contrary to a certain centre temperature guaranteeing a product

which is sufficiently heat treated. (The position of the centre point depends of course on the construction of the container as well as the product in the container)" (emphasis by the board). In other words, the centre temperature of the product in the container dictates the killing effect obtained. Thus, there is a clear disclosure in D3 that the product is in the container during autoclaving.

These considerations are corroborated by the disclosure in the last paragraph on page 8 indicating that liquid products require different heat treatment values F_0 than viscous/semi-solid products and that the F_0 values are dependent on the volume of the container.

It follows from the above that the heat treatment of a filled container by autoclaving is implicitly and unambiguously disclosed as one embodiment in the application as filed.

4.3 The feature in claim 1: "without the dimensional stability ... being thereby impaired"

In this respect the respondent argued (point XVIII (a) (ii) above) that the word "thereby" implies a specific time sequence and therefore has a technical meaning which was not originally disclosed.

The board does not share this position. It is immediately evident that the passage on page 3, lines 20 to 31 of the application as filed, when read in conjunction, implies that it is one purpose of the invention to avoid impairment of the dimensional stability of the container when exposed to heat treatment with moist heat. The word "thereby", although not originally disclosed, can only be understood as a

link between the process measure of the heat-treatment of the container and the avoidance of the impairment of its dimensional stability as a possible negative consequence of this measure. The word "thereby" thus simply underlines this relationship, without introducing any further technical meaning.

4.4 In summary, the opposition ground according to Article 100(c) EPC does thus not prejudice maintenance of the patent on the basis of the amended claims.

5. Article 100(b) EPC - Sufficiency of disclosure

5.1 The relevant issue in respect of sufficiency of disclosure of the claimed invention is the feature in claim 1 that:

the heat treatment of the container in a humid atmosphere by autoclaving of the container does not impair its dimensional stability.

It has therefore to be clarified whether a skilled person, on the basis of his common general knowledge and the information given in the patent specification, is able to determine without undue burden whether the dimensional stability of the container, measured before its treatment in moist heat by autoclaving, is not impaired after the treatment has been carried out. In the board's judgment, this implies that the skilled person is aware of comparison criteria which allow him to evaluate the dimensional stability of the container before and after its treatment by a suitable test method.

5.2 Paragraph [0002] of the patent specification relates to demands on containers intended for foods. Concerning

the construction of the containers it is pointed out that they should give the best possible protection to the products filled and transported in the container and should be sufficiently mechanically strong and dimensionally stable in order to withstand the external influences to which the container is exposed during normal handling without the container being deformed or destroyed (emphasis by the board). Paragraphs [0003] and [0004] indicate that it is the base layer of paper or board which gives the container strength and dimensional stability and that lamination is necessary in order to prevent the container from losing its dimensional stability (e.g. by improving its impermeability against liquid).

According to the above-mentioned passages it thus belongs to the knowledge of a skilled person that the mechanical and dimensional stability of the container in order to withstand mechanical influences during "normal handling" is determined by the paperboard base layer, e.g. its thickness, and that lamination mainly serves for protection of this dimensional stability. This is corroborated by the passages in paragraphs [0017] and [0018] of the patent specification. Paragraph [0017], which relates to Figure 1, states that "Like conventional packaging laminates the packaging laminate in Fig. 1 comprises a relatively thick strengthening base layer". From paragraph [0018] the skilled person learns that the other layers of the packaging materials do not significantly influence the container stability.

5.3 In the light of the above the board takes the position that a skilled person, on the basis of his general knowledge, is able to simulate the "normal" mechanical influences to which a container is exposed, by a simple

qualitative test, e.g. by applying load on top of the container in a apparatus as presented in D56 and to adjust the dimensional stability to these normal influences, inter alia via the material and thickness of the paperboard layer. The test can be repeated after treatment under certain sterilisation conditions and the results for the dimensional stability can be compared with those before treatment, e.g. as shown in sections 7 to 9 of D56. The board sees no reason why this action should be outside the skilled person's general knowledge.

- 5.4 The respondent argues that no definition is given in the patent as to what "impairment of the dimensional stability" means and that no threshold values are given for the dimensional stability. In this respect the argument was provided that the percentual deviations after processing of the container given in the table of D56 show a weakening of the dimensional stability and that no definition is given which threshold values are still tolerable, in the sense that the dimensional stability of the container is not yet impaired.

These arguments are not convincing. The dimensional stability of a food-packaging container is not to be seen as an isolated feature, but has to be considered in relation to its size, volume, geometry and the kind of food in the container, which factors are variable and determine the mechanical influences to which the container can be exposed, e.g. the height of the stacking on a pallet during transportation or on a supermarket shelf. Because a skilled person would consider all these factors on the basis of his general knowledge, there is no need for him to have an exact definition of the dimensional stability in the patent by way of a specific parameter.

Because it has also to be assumed that a skilled person would take into account the intended purpose of a container and would therefore know which deviations from its initial dimensional stability are tolerable when the container is exposed to the usual sterilisation condition, the lack of a definition of a tolerable percentual deviation or a threshold value above which the dimensional stability of the container fails does not give rise to an insufficiency of disclosure but has at most to be considered to be a lack of clarity, contrary to Article 84 EPC.

- 5.5 The board also cannot follow the respondent's argument that the number of polymer classes defined in claim 1 for the layers (2) and (3), allowing over 60,000 combinations, would not enable the skilled person to find, without undue burden, suitable combinations which solve the problem that the dimensional stability of the container is not impaired under the conditions of moist heat by autoclaving.

With regard to paragraph [0018] of the patent specification it should again be noted that the polymer layers (2) and (3) as defined in claim 1 have only a minor influence on container stability. Rather, the passages in [0003], [0004], [0012], [0013] and [0014], when read in context, unambiguously indicate that the main purpose of these layers is the protection of the paperboard base layer (1) against moist heat, which would otherwise impair or destroy its dimensional stability. The number of polymer combinations falling under the definitions for the layers (2) and (3) must therefore be considered from the point of view of whether it is an undue burden for the skilled person to find layer combinations which can provide this

protection function for the dimensional stability. In this context it is noted that the respondent has not presented convincing evidence that any of the combinations falling under the definition for the layers (2) and (3) according to claim 1 fail to protect the paperboard layer against moist heat by autoclaving, with the consequence that the dimensional stability of the paperboard is thereby impaired.

5.6 The invention is thus sufficiently disclosed and the opposition ground according to Article 100(b) EPC does not prejudice the maintenance of the patent.

6. Remittal

In the appealed decision the opposition division has not considered the issues of novelty and inventive step. Because both parties have conditionally requested remittal of the case to the opposition division for further prosecution in relation to the issues of novelty and inventive step and, as shown above, the opposition grounds of Articles 100(b) and (c) EPC do not prejudice maintenance of the patent, the board follows the parties respective requests.

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 for further prosecution.

The Registrar:

The Chairman:



M. Cañueto Carbajo

W. Sieber

Decision electronically authenticated