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**Datasheet for the decision  
of 24 February 2021**

**Case Number:** T 1583/17 - 3.3.06

**Application Number:** 09840260.5

**Publication Number:** 2399741

**IPC:** B32B27/40, C08J7/04, D21H19/82,  
C09D175/04

**Language of the proceedings:** EN

**Title of invention:**

USE OF A FILM FOR THE LAMINATION OF PRINTED MATTER AND  
PRODUCTION METHOD OF SUCH FILM

**Patent Proprietor:**

Taghleef Industries S.L.

**Opponents:**

Vos, Derk  
TroFILMS GmbH  
Cosmo Films Ltd.  
Max Speciality Films Limited  
Hoffmann Eitle

**Headword:**

Use of coated films / Taghleef

**Relevant legal provisions:**

EPC Art. 83

RPBA 2020 Art. 13(2)

**Keyword:**

Sufficiency of disclosure - undue burden (no) - relationship  
between Article 83 and Article 84

Amendment after summons - cogent reasons (no)

**Decisions cited:**

T 0250/15, T 1768/15, T 0626/14, T 2096/12, T 0608/07,

T 0464/05, T 0225/93, G 0002/98

**Catchword:**



**Beschwerdekammern**

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**Chambres de recours**

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**Case Number: T 1583/17 - 3.3.06**

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.06**  
**of 24 February 2021**

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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 14 July 2017  
revoking European patent No. 2399741 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** J.-M. Schwaller  
**Members:** R. Elsässer  
J. Hoppe

## Summary of Facts and Submissions

- I. The proprietor (appellant) appealed against the decision of the opposition division to revoke the patent for insufficiency of disclosure (Article 100 (b) EPC), claims 1 and 8 of which reading as follows:

*"1. A use of a film comprising a substrate of plastic film (1) manufactured by extrusion with a thickness comprising between 10 and 40  $\mu\text{m}$  to which is added by coating a liquid base dispersion of aliphatic polyurethane (2), which contains between 30% and 100% solids depending on the degree of soft touch required, the thickness of said coating, when dry, being comprised between 0.2 and 5  $\mu\text{m}$ , in the lamination of printed matter."*

*"8. A method for manufacturing a film for the lamination of printed matter, the method comprising the steps of:*

- a) providing a plastic film (1) manufactured by extrusion with a thickness comprising between 10 and 40  $\mu\text{m}$ , and*
- b) adding to the plastic film (1) by coating a liquid base dispersion of aliphatic polyurethane (2), which contains between 30% and 100% solids depending on the degree of soft touch required, the thickness of said coating, when dry, being comprised between 0.2 and 5  $\mu\text{m}$ ."*

- II. The following documents are relevant for the present decision:

E20: Product Data Sheet Neorez R-1000

E21: Product Data Sheet Neorez R-1010

E23: Product Data Sheet Neorez R-1010, June 2007

E29: Newchem Corporation Newrane 8400, WebArchive

E30: Newchem Corporation Newrane 8300, WebArchive

E48: Email correspondence from Andre Goos

III. With its grounds of appeal the appellant contested the decision and submitted auxiliary requests 1 - 15 already filed during the opposition proceedings. Further it filed the new documents

E60: General reference manual about the chemistry of polyurethane coatings edited by Bayer Material Science LLC in August 2005

E61: ASTM D 6988-08

E62: ISO 4593: 1993 (Plastics - Film and sheeting - Determination of thickness by mechanical scanning)

and referred to the experimental results reported in a submission made during the examination proceedings on 25 July 2014 (E49).

IV. With their respective replies, the respondents 01 to 05 reiterated their objections under Article 83 EPC, arguing in particular that the invention could not be carried out by the skilled person because its parameters "thickness measured when dry" and "content solids" were ill-defined and no teaching was provided in the patent concerning the coating technique, the

substrate to be used and other aspects of the invention. Moreover, the invention was not enabled across its whole scope since E48 gave evidence for the existence of non-working embodiments within the claimed scope.

Respondents O1, O2 and O4 further requested that E60 - E62 not be admitted into the proceedings and O4 filed a new document E65 (TU Ilmenau, Schichtdickenmessung) as evidence that for uneven coatings having peaks and troughs, it was common practice to establish an average thickness.

V. In its preliminary opinion, the Board held that it had not convincingly shown that the skilled person could not carry out the invention.

VI. At the end of the oral proceedings the final requests of the parties were established as follows:

The appellant requested that the decision under appeal be set aside and the patent be maintained as granted, or, as an auxiliary measure, that the patent be maintained in amended form based on one of auxiliary requests 1 to 15, filed during the opposition proceedings on 21 April 2017.

The respondents requested that the appeal be dismissed.

### **Reasons for the Decision**

1. Sufficiency of disclosure

The board came to the conclusion that Article 100 (b) EPC does not prejudice the maintenance of the patent as

granted for the following reasons.

- 1.1 According to well-established jurisprudence, a claimed invention is considered not sufficiently disclosed if the teaching of the contested patent, even if supplemented by common general knowledge, does not enable the skilled person to carry out the claimed subject-matter.

In the present case, this means that the invention would not be sufficiently disclosed if the skilled person could not carry out one or more of the following steps:

- extruding a plastic film having a thickness comprising between 10 and 40µm;
- coating said plastic film with a liquid base dispersion of aliphatic polyurethane, said dispersion containing between 30% and 100% solids, depending on the degree of soft touch required;
- adjusting the thickness of said coating, when dry, in the range between 0.2 and 5µm;
- using said coated film in the lamination of printed matter.

The respondents' submissions in the appeal proceedings do not convincingly demonstrate an insufficiency of disclosure for the following reasons.

- 1.2 Enablement over the whole range

Contrary to the respondents' arguments, it cannot be deduced from E48 that a coating having the claimed



thickness and a soft touch effect cannot be obtained with NeoRez-1010, or that such a coating would only be obtained if an additive referred to as "IPA" in E48 is added to the coating composition.

With regard to the soft touch effect, the board agrees with the appellant's declaration at the oral proceedings that it is not a feature restricting the scope of the claim, since the formulation "depending on the degree of soft touch required" leaves open the possibility of a very low (or even no) soft-touch effect being present. However, for the sake of argument, the Board accepts that achieving a certain degree of soft touch is necessary for carrying out the invention.

E20, E21, E23, E29 and E30 prove that the terms "soft touch" or "soft feel" as such and their qualitative meaning were well understood in the field and that it was possible to achieve a certain degree of soft touch with methods known in the art.

As the claimed invention does not require the skilled person to measure or quantify the soft touch effect, no insufficiency arises from the fact that the patent does not indicate a specific method for that purpose.

Turning back to E48, this document does not state that the coatings obtained lack a soft-touch effect. Neither does E48 mention that a coating thickness in the claimed range could not be achieved. As a matter of fact, E48 does not mention any thickness value for a dried coating.

It is true that E48 mentions that coatings produced with NeoRez-1010 were considered to be unsatisfactory

because "glossy spots", identified as uncoated areas, were observed and that the appearance of glossy spots could be avoided by the addition of "IPA" to the coating composition. However, the claimed invention does not require the coating to be continuous or free of uncoated areas or of "glossy spots". Nor does the claim define a minimum extension of the coating where defects are excluded. The presence of uncoated areas or "glossy spots" does therefore not prove that the claimed invention cannot be carried out. For the same reasons, the addition of "IPA" is not essential for carrying out the invention.

It is important to note that there is a difference between a product meeting a pre-set quality requirement (here the absence of glossy spots) or not, and a product meeting the requirements set out in a claim or not. In this respect it can be concluded with certainty from E48 that the quality of the coatings obtained with NeoRez-1010 did not satisfy the intended quality standard. However, this conclusion does not mean that said coatings did not satisfy the requirements of claim 1, which is the only relevant point when discussing sufficiency of disclosure.

Therefore, E48 does not prove that the invention cannot be carried out with NeoRez-1010, so that the alleged lack of enablement over the entire range has not been shown.

### 1.3 Determination of the Thickness of the Coating

1.3.1 It is undisputed that neither claim 1 nor the description indicate a method to be used for determining the thickness of the coating. It is also undisputed that different methods for determining the

thickness of a coating are available to the skilled person (see e.g. E65, point 2.3) and that these methods might produce different results, as has been demonstrated for the coating shown in E63, page 14, having an uneven surface. It is therefore not clear which coated films fall into the scope of claim 1 because a given coating might have a thickness within or outside the claimed range, depending on the method used for measuring the thickness. For instance, the thickness of a coating might fall within the claimed range if the average thickness of the coating is measured but might be above the claimed range if only the peaks of the coating are considered, as suggested by the appellant. However, this is first and foremost a clarity problem, which cannot be discussed in these opposition appeal proceedings, since claim 1 is a granted claim (G 3/14).

- 1.3.2 Moreover, while different methods of determining the thickness might yield different results, it has not been shown that this ambiguity affects the whole claim and not only its edges (T 608/07, reasons, 2.5.2 and T 1768/15, reasons, 6.5.2). Turning back to the coating shown in E63, respondent O3 has argued that its thickness could be determined as 2.7  $\mu\text{m}$  or 4.9  $\mu\text{m}$ , depending on the method. However that means that in spite of the variance due to the method, it is clear that the coating has a thickness in the claimed range. In view of the breadth of the thickness range which spans a factor of 25, the lack of a method for determining the thickness does however not prevent the skilled person from practicing the invention.
- 1.3.3 The mere fact that a claim is unclear or its scope ambiguous does not automatically mean that the invention defined by said claim is not sufficiently

disclosed. The requirement of a clear definition of the claimed subject-matter (Article 84 EPC) and the requirement of a sufficient or enabling disclosure (Article 83 EPC) are different and distinct from each other and only the latter corresponds to a ground for opposition (Article 100(b) EPC). According to the current jurisprudence, a lack of a clear definition of the scope of the claims, i.e. of the so-called "forbidden area", should not be considered as a matter related to Article 83 EPC (Case Law of the Boards of Appeal, 9th edition, II.C.6.6.4.). However, this is not to say that an ambiguity cannot also lead to a lack of enablement. In decision T 608/07, reasons 2.5.2, the board confirmed this view but emphasised that care had to be taken that the insufficiency objection was not merely a hidden clarity objection. The board concluded that there was a delicate balance between Article 83 and 84 EPC that had to be assessed on the merits of each individual case. The present board fully endorses this view.

- 1.3.4 Indeed the jurisprudence on this matter shows that the boards have come to different results, depending on the specific circumstance on the case in suit. For instance, in a number of cases, among them those cited by the respondents (T 626/14, T 2096/12, T 464/05 or T 225/93), the boards have decided that the absence of an indication of a method to be used for measuring a parameter was not only a problem under Article 84 EPC but also under Article 83 EPC. However, in the majority of other cases, the boards considered this to be a problem under Article 84 EPC only, see for example T 250/15, reasons 1.2 and T 1768/15, reasons 6.5.2. Other decisions taking a similar view are cited in the Case Law of the Boards of Appeal, 9th edition, section

II.C.8.2.

- 1.3.5 Given the specific circumstances of the case at hand, the present board comes to the conclusion that the absence of an indication of a method for measuring the thickness does not prevent the skilled person from practicing the claimed invention and is therefore not objectionable under Article 100 (b) EPC.
- 1.3.6 As the claimed invention is not restricted to thicknesses measured by a particular method, the skilled person is free to use any suitable method. The selection of a suitable method does not involve an undue burden since measuring the thickness of a coating or of a layer in general is an absolute standard procedure for which many commonly known methods are available, see E65, point 2.3.
- 1.3.7 The board observes that the invention would possibly be not sufficiently disclosed if it could only be carried out with coatings having a thickness measurable only with a specific, yet undisclosed method. In this case, the knowledge of the method for measuring the thickness would be essential for obtaining the claimed soft touch effect. However, there is no evidence on file which supports such a conclusion.

The contested patent itself does not contain any statement from which one could conclude that the exact setting of the thickness in the claimed range is required in order to obtain a soft touch coating. This is a crucial difference to the case underlying decision T 225/93, relied upon by 04, see point 2.1.3 of the reasons. Moreover, the board stresses again that no specific degree of soft touch is required according to the claimed subject-matter.

The only experimental data available, namely the one provided by the appellant itself in E49 show (page 6) that also below (0.1  $\mu\text{m}$  thickness) and above the claimed range (10  $\mu\text{m}$  thickness), some degree of soft-touch effect is observed, because for both types of coatings, a soft feel assessment of more than "one" ("one" being equivalent to a poor soft feel, see E49, page 5, last two lines) could be observed. It is true that on page 6 of E49 it is stated that the soft-touch effect "starts to be noticeable at a coating thickness of 0.2  $\mu\text{m}$ " but this statement constitutes an interpretation of the data shown in the figure, which cannot, however, invalidate the data themselves since, as mentioned above, said data clearly show that also thinner and thicker coatings show at least some degree of soft touch.

The board concludes that there is no evidence on file that shows that the absolute thickness of the coating and thereby the selection of a method for measuring the thickness is critical for carrying out the invention, i.e. for producing a coating having a thickness in the claimed range and a certain degree of soft touch.

- 1.4 The board is further of the opinion that no insufficiency arises from the feature "measured when dry" in claim 1, because drying a coating is standard practice for which the skilled person does not need any guidance in the patent. The allegation that different drying conditions or methods would lead to significantly different coating thicknesses has not been proven. The skilled person would understand that the expression "when dry" refers to a state where the coating is at least substantially dried without being sticky anymore. There is no plausible reason as to why a skilled person would determine the thickness of the

coating in semi-dry conditions. While the thicknesses of a completely and of a substantially dried coating might still differ to some minor extent, the board is of the opinion that this is at most a clarity issue but it does not prevent the skilled person from carrying out the invention.

#### 1.5 Solids content

Similar considerations apply to the objection which concerns the feature "content solids". In this respect it is undisputed that neither claim 1 nor the description indicate whether the solids content mentioned in claim 1 is calculated based on mass or on volume. It is also undisputed that the respective values will differ from each other if the density of the dispersed solid is different from the density of the dispersant. An example for the difference in values can be seen in E29 and E30. These documents also prove that both values are used in practice.

However, this ambiguity does not prevent the skilled person from carrying out the invention. As the invention defined in claim 1 is not restricted in this respect, the skilled person can select any dispersion to make the coating, as long as its solids content, based on mass or on volume, falls within the claimed range.

The claimed feature "which contains between 30% and 100% solids depending on the degree of soft touch required" furthermore links the soft touch effect to the solids content but the Board fails to see that an insufficiency arises from this link, because if the soft touch effect depends on the solids content of dispersion, it is not important whether said solids

content is calculated based on weight or on volume.

#### 1.6 Research program

The board does not agree with the opponents that a research program would be needed in order to carry out the invention, because first of all the skilled person is taught by the patent (par. 0005) that the invention can be carried out by selecting an aliphatic PU dispersion having a solids content of at least 30% and using this dispersion to prepare a coating having a thickness between 0.2 and 5  $\mu\text{m}$  and having a certain degree of soft touch on a plastic film substrate having a thickness between 10 and 40  $\mu\text{m}$ .

1.6.1 It is true that no example of a suitable dispersion is provided in the patent, however the board is convinced that the skilled person would check whether suitable coating compositions are available, for instance by contacting relevant suppliers. In this respect, based on the evidence on file (E20 - E23), it is manifest that soft-touch polyurethane dispersions were not only commercially available but were also explicitly foreseen for providing plastic items (E20, page 1) and films with a soft-touch coating (D23, pages 3 and 4).

1.6.2 Contrary to what has been suggested by the respondents, selecting a commercially available dispersion does not exceed the skills and knowledge of the skilled person. For the board the skilled person is an experienced practitioner in the field who is aware of common general knowledge and has access to everything in the state of the art (Case Law of the Boards of Appeal, 9<sup>th</sup> edition, I.D.8.1.1). In the present case, the state of the art includes the technical data sheets E20-E23. Hence the selection of a suitable dispersion does not



involve an undue burden, in particular in the absence of evidence to the contrary. The board notes in this respect that none of the five opponents has provided at least one set of experimental data showing that it failed in trying to prepare a coating falling within the terms of claim 1 at issue.

- 1.6.3 The respondents have pointed out that E20-E23 do not disclose any detail about the chemical nature of the dispersions but, for the board, in order to put the invention into practice, it suffices that suitable dispersions were available at the filing date of the patent. This has not been questioned by the respondents.
- 1.6.4 The argument that the use of trade names is problematic is irrelevant in the present case, since the contested patent does not refer to any trade name, but to a class of compounds, namely to the class of aliphatic polyurethanes, which includes a myriad of commonly known components.
- 1.6.5 The board notes that after having selected one of such compounds, the skilled person only needs to prepare a dispersion and to coat the dispersion onto a film substrate and adjust its thickness. These steps, however, do not involve an undue burden for the following reasons.

As laid out above, the selection of a suitable method to measure the thickness does not involve an undue burden.

The respondents have objected to the lack of teaching with regard to the coating technique, the type of substrate and some other issues. However, the

respondents have in no case plausibly explained why the skilled person would need additional teaching.

According to established jurisprudence on this matter (Case Law of the Boards of Appeal, 9<sup>th</sup> edition, II.C. 6.6.5.), a patent does not need to provide a piece of information if that information belongs to the common general knowledge in the field.

In this respect it is emphasised that the application of a coating to a substrate is a standard technique and various well-established methods are available to the skilled person, for instance doctor blade coating, kiss coating, spray coating, etc. By varying the amount of coating composition applied to the substrate, the thickness of the coating can be adjusted as desired. Therefore the skilled person does not need any guidance in that respect, unless these well-known methods would not work in the context of the invention. Apart from E48, provided by the patent proprietor itself, no further evidence has been provided in this regard by the opponents. But as mentioned above the arguments based on E48 did not convince the board.

The same applies to the selection of a suitable substrate. No evidence has been provided that a teaching going beyond common general knowledge is needed in order to provide a plastic film having the claimed thickness or that the selection of a specific film would be needed in order to practice the invention.

- 1.7 Therefore it follows from the above considerations that the board is not convinced that the skilled person could not carry out the claimed invention without undue burden, relying on the teaching of the patent and

common general knowledge.

1.8 No decision concerning the admissibility of E60, E61 and E62 needs to be taken as the present decision is not based on either of these documents.

1.9 Late filed objection

During the oral proceedings, respondent O2 further argued that the claimed invention was not sufficiently disclosed since the skilled person did not know how to obtain an aliphatic PU dispersion having a solids content of 100%.

The board notes that this a new objection under Article 100 (b) EPC that includes facts not having been presented before in the appeal proceedings. This objection thus represents an amendment to the party's appeal case, which under Article 13 (2) RPBA 2020 (Article 25 (1) RPBA 2020), shall not be taken into account at this stage of the proceedings, unless justified with cogent reasons.

No such cogent reasons, however, have been provided, nor are they apparent for the board.

The argument brought by respondent O2 that this objection was not new since it formed part of the one raised against the feature "solids content" did not convince the board because the two objections, de facto, concern different issues. The objection raised against the feature "solids content" relies on the question of whether the solids content was calculated based on weight or on volume, while in the other objection, which concerns the dispersion having 100% of solids, the above question does not arise.

Furthermore, the fact that the appellant has referred in item 46 of its grounds of appeal to the experiments reported at page 11 in E63, which include a dispersion having a solids content of 100% does also not justify this late objection. Rather, the respondents could and should have reacted to this issue in their respective replies.

It follows from the above considerations that no cogent reasons have been provided which would justify the late filing of this new objection, which is therefore not considered by the Board (Article 13 (2) RPBA 2020).

2. Remittal

As the appealed decision relied only on Article 100 (b) EPC and since the further objections under Articles 100 (a) and (c) EPC have not been dealt with in the contested decision, it would run against the primary purpose of the appeal proceedings to review the decision under appeal to decide on these issues. These special reasons in the sense of Article 11 RPBA 2020 justify a remittal to the opposition division for further prosecution.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



A. Pinna

J.-M. Schwaller

Decision electronically authenticated