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Datasheet for the decision of 24 March 2023

Case Number: T 0207/20 - 3.3.06

Application Number: 12779250.5

Publication Number: 2766186

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Language of the proceedings: EN

Title of invention:
SHRINK FILM FOR LABEL

Patent Proprietor:
Avery Dennison Corporation

Opponents:
Klöckner Pentaplast Europe GmbH & Co. KG
UPM Raflatac Oy
Cryovac, Inc.

Headword:
Avery/Polyester shrink film

Relevant legal provisions:
EPC Art. 54, 56
RPBA 2020 Art. 12(4)

Keyword:
Novelty - (no)
Inventive step - (no)
Amendment to case - exercise of discretion - amendment admitted (no)

Decisions cited:
T 0131/03, T 2610/11

Catchword:

Europäisches Patentamt
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Beschwerdekammern

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Case Number: T 0207/20 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 24 March 2023

Appellant: (Patent Proprietor)	Avery Dennison Corporation 8080 Norton Parkway Mentor, OH 44060 (US)
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Decision under appeal: **Interlocutory decision of the Opposition Division of the European Patent Office posted on 29 November 2019 concerning maintenance of the European Patent No. 2766186 in amended form.**

Composition of the Board:

Chairman J.-M. Schwaller
Members: S. Arrojo
R. Cramer

Summary of Facts and Submissions

I. The appeals filed by the patent proprietor and by opponent 1 contest the decision of the opposition division to maintain European Patent No. 2 766 186 on the basis of auxiliary request 1 filed during oral proceedings on 23 October 2019.

II. In its statement of grounds of appeal, the proprietor requested that the above decision be set aside and the patent be maintained on the basis of the main request or, as an auxiliary measure, that the patent be maintained in amended form on the basis of the claims according to one of auxiliary requests 1 to 12 filed with the grounds of appeal, with auxiliary request 1 corresponding to the version upheld by the opposition division.

Claim 1 of the **main request** reads:

"1. A multilayered shrink film comprising:
a core layer comprising a glycol modified polyester, the core having an upper and lower surface;
an upper skin layer disposed on the upper surface of the core layer and a lower skin layer disposed on the lower surface of the core layer, the skin layers each individually comprising
(a) a resin material; and
(b) an antiblocking agent;
wherein the glycol modified polyester is derived from a dicarboxylic acid in an amount of 50 mole %; a first difunctional alcohol in an amount of 1 to 49 mole % and a second difunctional alcohol in an amount of 49 to 1 mole %."

Claim 1 of **auxiliary request 1** corresponds to that of the main request with the following amendments (highlighted by the board): *"... wherein the glycol modified polyester is derived from a dicarboxylic acid in an amount of 50 mole %; a first difunctional alcohol in an amount of ~~1 to 49~~ 25 mole % and a second difunctional alcohol in an amount of ~~1 to 49~~ 25 mole %."*

Claim 1 of **auxiliary request 2** reads:

"1. A multilayered shrink film comprising:
a core layer comprising 100% by weight of a glycol modified polyester, the core having an upper and lower surface;
an upper skin layer disposed on the upper surface of the core layer and a lower skin layer disposed on the lower surface of the core layer, the skin layers each individually comprising
(a) a resin material; and
(b) an antiblocking agent
wherein the glycol modified polyester is derived from a carboxylic difunctional acid, ethylene glycol and cyclohexane dimethanol."

Claim 1 of **auxiliary request 3** corresponds to that of auxiliary request 2 with the following amendments (highlighted by the board): *"... wherein the glycol modified polyester is derived from a carboxylic difunctional acid and two difunctional alcohols, the two difunctional alcohols being ethylene glycol and cyclohexane dimethanol."*

Claim 1 of **auxiliary request 4** corresponds to that of auxiliary request 2 with the following amendments

(highlighted by the board): *"(a) a resin material being a glycol modified polyethylene terephthalate material;"*

Claim 1 of **auxiliary request 5** corresponds to that of auxiliary request 4 with the following amendments (highlighted by the board): *" ... wherein the glycol modified polyester is derived from a carboxylic difunctional acid, and two difunctional alcohols, the two difunctional alcohols being ethylene glycol and cyclohexane dimethanol."*

Claim 1 of **auxiliary request 6** corresponds to that of auxiliary request 2 with the following amendments (highlighted by the board): *" ... wherein the glycol modified polyester is derived from ~~a carboxylic difunctional~~ terephthalic acid, ethylene glycol and cyclohexane dimethanol."*

Claim 1 of **auxiliary request 7** corresponds to that of auxiliary request 6 with the following amendments (highlighted by the board):

"1. A multilayered shrink film comprising:
a core layer comprising 90% to 100% by weight of a glycol modified polyester, the core having an upper and lower surface;
an upper skin layer ~~disposed on~~ in contact with the upper surface of the core layer and a lower skin layer ~~disposed on~~ in contact with the lower surface of the core layer, ... "

Claim 1 of **auxiliary request 8** corresponds to that of auxiliary request 7 with the following additional feature: "*... wherein the multilayered shrink film has a shrink initiation temperature of 45 to 65 C.*"

Claim 1 of **auxiliary request 9** corresponds to that of auxiliary request 8 with the following amendments (highlighted by the board): *"... wherein the multilayered shrink film has a ~~shrink initiation temperature of 45 to 65 C~~ free shrink in one direction at 100 C of at least 40%."*

Claim 1 of **auxiliary request 10** corresponds to that of auxiliary request 9 with the following amendments (highlighted by the board): *"... wherein ~~the multilayered shrink film has a free shrink in one direction at 100 C of at least 40%~~ the upper and lower skin layers individually comprise 90 to 99.99% by weight of the resin and 0.01 to 10% by weight of the antiblocking agent."*

Claim 1 of **auxiliary request 11** corresponds to that of auxiliary request 10 with the following amendments (highlighted by the board):
"(a) a resin material comprising the glycol modified polyester; and
(b) an antiblocking agent
wherein the glycol modified polyester is derived from terephthalic acid, ethylene glycol and cyclohexane dimethanol~~; wherein the upper and lower skin layers individually comprise 90 to 99.99% by weight of the resin and 0.01 to 10% by weight of the antiblocking agent~~."

Claim 1 of **auxiliary request 12** corresponds to that of auxiliary request 3 with the following amendments (highlighted by the board):
"(a) a resin material being a glycol modified polyethylene terephthalate material; ..." and *" ... the two difunctional alcohols being ethylene glycol and*

cyclohexane dimethanol; wherein the shrink film has an orientation ratio from 1.1:1 to 4:1."

III. In its statement of grounds of appeal, opponent 1 requested that the decision under appeal be set aside and that the patent be revoked in its entirety, arguing that the main request was unclear and insufficiently disclosed and that its claim 1 was not novel in view of the disclosure of each of D1 (US 2009/0227735 A1), D41 (US 2009/0011263 Al) (in the light of D42 (WO 2009/013284)), D49 (US 5,534,570) and D5 (US 5,859,116) and not inventive with respect to D49 in the light of D13 (H. Zweifel, "*Plastic additives handbook*", 5th edition, 2001) and D53 ("The Wiley Encyclopedia of Packaging Technology", 2009). Furthermore, auxiliary request 1 lacked novelty and/or not inventive step in view of D1 in the light of document D54 (T. Chen et al., "*Poly(ethylene glycol-co-1,4-cyclohexanedimethanol terephthalate) random copolymers: effect of copolymer composition and microstructure on thermal properties and crystallization behavior*", RSC Adv., 2015), submitted with its grounds of appeal.

IV. With its reply, the proprietor inter alia requested not to admit D54 into the appeal proceedings.

V. With its reply, opponent 1 argued that auxiliary requests 2 to 12 did not meet the requirements of Article 123(2) EPC and indicated that the novelty and inventive step objections raised against the main request and auxiliary request 1 applied *mutatis mutandis* to these requests.

VI. With letter of 20 March 2020, opponent 2 withdrew its appeal. With a further letter it informed the board that it would not attend the oral proceedings.

VII. Opponent 3 (also party as of right) requested inter alia to dismiss the proprietor's appeal.

VIII. The board issued a preliminary opinion indicating that claim 1 of the main request did not appear to be novel in view of D1 or D41, that claim 1 of auxiliary requests 1 to 11 appeared to be at least not inventive in view of D1 and that auxiliary request 12 should not be admitted under Article 12(4) and (6) RPBA.

IX. At the oral proceedings, which took place on 24 March 2023, the proprietor withdrew its appeal. The remaining (and final) requests of the parties were thus the following:

The opponent 1 and appellant requests that the decision of the opposition division be set aside and the patent be revoked in its entirety.

The proprietor and respondent requests that the appeal of opponent 1 be dismissed or, as an auxiliary measure, that the patent be maintained on the basis of one of auxiliary requests 2 to 12.

Reasons for the Decision

1. Auxiliary request 1 - Inventive step

The board has concluded that the requirements of Article 56 EPC are not met for the following reasons:

1.1 The alleged invention relates to a polyester shrink film for encapsulating cylindrical objects such as batteries. More particularly (see paras. [0002]-[0008]

of the patent), the polyester film is configured to be printable and to provide sufficient shrinkage to encase the batteries without creating puckering (wrinkles formed when the film shrinks).

1.2 Closest prior art

1.2.1 D1, which relates to polyester shrinkable films used for wrapping and labeling of batteries (see par. [0006]-[0008]), has a technical context very similar to that of the invention. Further, it discloses several examples and comparative examples, all concerning shrinkable polyester films derived from difunctional alcohols and terephthalic acid. In particular, comparative example C3 relates to a film (see par. [0171] and table 1 on page 15) comprising a polyester derived from 50 mole % terephthalic acid, 24.9 mole % cyclohexane dimethanol (from now on "CHDM"), 24.7 mole % ethylene glycol (from now on "EG") and 0.4 mole % diethylene glycol (from now on "DEG").

1.2.2 The proprietor argued that a skilled person would not have selected C3 as the closest prior art, since it is a comparative example and therefore a disadvantageous or less desirable starting point than the exemplary embodiments or the preferred examples 1-10. Thus, if the skilled person regarded D1 as the closest prior art, it would have chosen them as a starting point.

1.2.3 This argument was submitted by the proprietor for the first time in response to the preliminary opinion of the board and the appellant requested not to admit it into the appeal proceedings. However, since the board disagrees that C3 should be disregarded as the closest prior art (see next point), there is no need to address the question of admittance of this late filed argument.

1.2.4 As is usually the case with comparative examples, C3 is presented as a suboptimal alternative representing the prior art which D1 seeks to improve. While the board considers that a disclosure can only represent a suitable and realistic starting point when it is technically close to the underlying invention, this does not imply that the skilled person would require specific reasons or incentives to select one specific disclosure. The closest prior art is namely intended to represent any background art which might realistically be developed into something falling within the scope of protection. Such disclosure does therefore not need to be particularly preferred or advantageous but merely one which is not unrealistic from a technical point of view, i.e. one which is not far removed from the technical context of the invention. In view of these considerations, the board has concluded that C3 should not be discarded as a suitable starting point, because it belongs to the same technical field and its technical purpose is very similar to that of the invention. The board also notes that this conclusion is in line with decision T 2610/11 (Reasons 9.4), in which the board argued that a comparative example should not be disregarded as a starting point, because within the context of the cited document, such comparative examples also represented starting points which the skilled person intended to develop.

1.2.5 The proprietor further argued that claim 1 differed from C3 in that i) upper and lower skin layers were provided with an antiblocking agent, ii) the polyester was derived from only two dialcohols (vs. three in C3 of D1) and iii) the glycol modified polyester was derived from first and second difunctional alcohols in an amount of 25 mole %.

Concerning difference ii), the proprietor argued that the expression *"derived from"* in claim 1 was not an open wording, so the skilled person would understand that the polyester could not be derived from more than two dialcohols. By contrast, example C3 as well as all the examples in D1 included a third difunctional alcohol. Concerning difference iii), the proprietor argued that the amounts of 24.9 mole % CHDM and 24.7 mole % EG in C3 did not anticipate the defined 25 mole%, because rounding the values up to 25 mole % would not be compatible with the presence of 0.4 mole % of DEG and 50 mole % terephthalic acid, as disclosed in table 1 of D1 (i.e. the substances would add up to more than 100 mole %).

1.2.6 The board disagrees with the above arguments, because concerning the presence of an antiblocking agent (feature i), D1 discloses (par. [0172]) that all the examples include such an agent, and so claim 1 can only be considered to differ from C3 in the configuration skin/core/skin, but not in the presence of an antiblocking agent.

Concerning feature ii), the board is not convinced that the expression *"derived from"* should be narrowly interpreted as discarding that the polyester is derived from more than two difunctional alcohols, as there is no clear indication in the claim that only two dialcohols should be used. While the percentages in claim 1 add up to 100%, as explained in the next paragraph, the defined values (25%, 25% and 50%) do not include decimals so the claim encompasses embodiments in which the polyester is derived from two dialcohols and small amounts of other substances such as other dialcohols.

Concerning feature iii), as discussed at the oral proceedings, the definition in claim 1 of 25 mole % without decimals effectively implies that the invention encompasses amounts between 24.5 mole % and 25.4 mole %. Consequently, the values 24.9 mole % and 24.7 mole % disclosed in C3 of D1 fall within the scope of claim 1 even when they are not rounded up. The board thus concludes that claim 1 differs from C3 of D1 only in that the film includes skin layers.

1.3 Problem to be solved

The patent indicates (paras. [0002]-[0008] and [0035]) that the object of the invention is to provide modified polyester films useful in the encapsulation of cylindrical objects such as bottles or batteries, which provide good shrinkage without puckering and which can be printed. To support the alleged effects, the patent discloses (par. [0077]) an example of a three layer film with a skin/core/skin configuration, wherein both the core and the skin layers contain large amounts of glycol modified polyethylene terephthalate. Several properties of this film are provided in the example.

1.3.1 The opposition division argued that the 1:1 ratio of the dialcohols (i.e. the amounts of 25 mole %/25 mole %) represented a narrow range which could be credibly associated with the avoidance of puckering as disclosed in par. [0004] and [0035] of the patent. Furthermore, as the opponents - who carried the burden of proof - had not submitted any evidence to support the argument that this problem would not be solved, there was no reason to conclude that the problem of preventing puckering was not solved.

1.3.2 The proprietor followed a similar line of argumentation and further indicated that the presence of the skin layers facilitated the processing of the shrink film while maintaining the properties of the core layer. Considering the three differentiating features of the invention with respect to C3, it concluded that - in line with paras. [0008] and [0035] of the patent - the problem to be solved was the provision of a printable film which did not suffer from puckering and premature shrinkage.

1.3.3 For the board, as example C3 in D1 anticipates the 1:1 molar ratio of the difunctional alcohols as defined in claim 1 (see point 1.2.6 above), any technical effect associated with this feature would also be achieved by the film of the closest prior art, with the consequence that the invention defined in claim 1 does not provide the technical effect of preventing puckering.

For the sake of completeness, the board also notes that the patent provides no basis to conclude that the 1:1 molar ratio of the dialcohols would provide any specific technical effect. This feature is merely presented as a further embodiment (see par. [0044] of the patent) with no other indication of its technical purpose, and the patent does not contain any evidence to illustrate the effects of this feature, as it only includes an example (see par. [0077]), which does not even indicate the concentration of the dialcohols used to form the polyester. Concerning the burden of proof, the board notes that the molar ratio of the difunctional alcohols has been added from the description in the course of the opposition proceedings, so it should be the proprietor who carries the burden of proof to demonstrate that the amended claims meet the requirements of the EPC.

It is further noted that there is also no basis to conclude that premature shrinkage would be avoided by the invention, as there is no evidence that the proposed solution (i.e. the provision of skin layers) would have any effect in this respect.

On the other hand, the board agrees with the proprietor in that adding skin layers (containing the antiblocking agent) ensures a good processing without negatively affecting the properties of the core layer, because this is a well-known effect of the skin/core/skin configuration. The skilled person is namely aware that antiblocking agents modify the surface properties in ways which prevent different films from sticking together, which facilitates processing. While the film in C3 also includes an antiblocking agent, there is no indication that C3 includes skin layers. In this respect it is noted that when such an agent is incorporated into skin layers rather than into a single monolayer, it fulfills its function without negatively affecting the properties of the polymer in the core layer.

For the board, it follows from the above considerations that the problem underlying the invention is to be reformulated in less ambitious terms, namely in the provision of a film which can be efficiently processed while maintaining its properties.

1.4 Obviousness of the solution

1.4.1 The main reason brought forward by the opposition division to conclude that claim 1 was not obvious in view of C3 in D1 was that the 1:1 molar ratio for the difunctional alcohols as defined in claim 1 was narrow

and could plausibly be associated with the effects proposed in the patent. Since there was no prior art suggesting this specific solution for solving the underlying technical problem, the subject-matter of claim 1 was considered to be inventive. The proprietor also indicated that there was no incentive to eliminate the third dialcohol proposed in D1 or to consider the molar amounts proposed in C3, as this example was a disadvantageous comparative embodiment.

1.4.2 The board cannot follow these arguments, as they are based on features which are considered to be anticipated by the closest prior art example C3 (see point 1.2.6 above). The only relevant question for deciding on obviousness is thus whether using a skin/core/skin configuration would be an obvious way of providing a film which can be efficiently processed while maintaining its properties.

In this respect, the board notes that example C3 does not discard this structure, but simply leaves open whether the film is mono- or multilayered. Since most of the examples in D1 include a skin/core/skin multilayered structure with the skin layers containing an antiblocking agent, the skilled person would readily recognise by reading D1 and in view of its technical knowledge that applying this configuration to manufacture the film in C3 would ensure an efficient processing without affecting the properties of the core layer. In fact, the board considers that the incorporation of skin layers with antiblocking agents constitutes a standard solution in the field for ensuring a good processing without affecting the properties of the polymer/s in the film. The solution proposed in claim 1 is thus considered to be obvious in view of D1 alone.

2. Auxiliary requests 2-4 and 6-11 - Novelty

2.1 Comparative examples C5 and C6 in D1 respectively include 100% of a polyester (A) or of a polyester (B) derived from terephthalic acid, CHDM, EG and DEG (see par. [0182] and table 6). These examples concern multilayered skin/core/skin films, wherein both the core and skin layers contain the above polyesters, and the skin layers also contain 1 wt.% of an antiblocking agent (see paras. [0172] and [0183]).

2.2 Claim 1 of **auxiliary request 2**, unlike that of auxiliary request 1, does not restrict the amounts of the difunctional alcohols, but simply requires the core layer to include 100% of a polyester derived from a dicarboxylic difunctional acid (such as terephthalic acid), CHDM and EG. The subject-matter of this claim is thus anticipated by C5 or C6 of D1.

2.3 Claim 1 of **auxiliary request 3** further specifies that the polyester is derived from *"two difunctional alcohols"*. In the board's view, this feature is a redundant way of expressing that the polyester is derived from the two dialcohols already defined in claim 1 of auxiliary request 2. The board considers that this expression should be interpreted as "at least two difunctional alcohols", as there is no clear indication that the "two" should be narrowly interpreted as "only two". Claim 1 therefore does not exclude that the polyester is derived from more than two dialcohols, so the novelty objections presented for auxiliary request 2 also apply to this request, which is thus not novel in view of C5 or C6 in D1.

2.4 Claim 1 of **auxiliary request 4** specifies that the resin material of the skin layers includes a glycol-modified polyethylene terephthalate (as well as an antiblocking agent). As indicated in point 2.1 above, the skin layers in C5 or C6 of D1 include polyester (A) or (B) and an antiblocking agent, wherein the polyesters are derived from glycols and terephthalic acid, which implies they are glycol-modified terephthalate materials. The subject-matter of claim 1 is therefore also not novel in view of C5 or C6 in D1.

2.5 Claim 1 of **auxiliary request 6** specifies that the carboxylic difunctional acid is terephthalic acid. Since polyesters (A) and (B) in C5 and C6 are also derived from terephthalic acid, these examples anticipate all the features of the claim for the same reasons as the higher ranking requests. The requirement of novelty is therefore not met.

2.6 Claim 1 of **auxiliary request 7** specifies that the upper and lower skin layers are in contact with the surfaces of the core layer, which corresponds to the cap/core/cap or skin/core/skin configuration proposed in C5 and C6. Claim 1 is thus also not novel in view of these comparative examples of D1.

2.7 Claim 1 of **auxiliary request 8** specifies that the shrink initiation temperature of the film is 45 to 65°C. The data in table 8 of D1 appear to indicate that the shrink initiation temperature in C6 is around 60°C and therefore falls within the claimed range. Claim 1 is thus not novel in view of C6 in D1.

Anyway, even if it was concluded that D1 does not provide a direct disclosure of the shrink initiation temperature of C6, the following argumentation would

apply: as argued by the opponent, the parameter "shrink initiation temperature" represents an unusual parameter, particularly considering that there is no clear indication of how it should be measured. According to T 131/03 (see headnote), when there is a strong presumption that an unusual parameter is anticipated by the prior art, it is the proprietor who carries the burden of proof to demonstrate that the parameter establishes novelty. In the board's view, the data in table 8 of D1 at the very least provides a strong indication that the shrink initiation temperature in C6 falls within the claimed range, so the burden is on the proprietor to demonstrate that this example does not anticipate claim 1. Since the proprietor has not provided any evidence (or even arguments) that the shrink initiation temperature of C6 would not fall within the scope of claim 1, it has not discharged its burden in this respect. Thus, claim 1 is not novel in view of C6 in D1 (even under the assumption that this example does not disclose the exact value of the shrink initiation temperature).

2.8 Claim 1 of **auxiliary request 9** specifies that the free shrink in one direction at 100°C is at least 40%. Table 8 of D1 indicates that the shrinkage of C6 in the operator and drive side are respectively 80 and 81% in the machine direction. While no data are provided for the center portion or for 100°C, shrinking increases or remains constant with the temperature, so the table demonstrates that the shrink is at least 40% (in fact, twice as much), or at least provides a strong indication that example C6 anticipates this unusual parameter. Either way, the board concludes that claim 1 is not novel in view of C6 in D1 for reasons analogous to those presented for auxiliary request 8.

2.9 Claim 1 of **auxiliary request 10** specifies that the skin layers comprise 90 to 99.99% by weight of the resin and 0.01 to 10% by weight of the antiblocking agent. As indicated in point 2.1 above, the skin layers in C5 and C6 include the same polyester as the core layer and 1 wt.% of an antiblocking agent. The examples C5 and C6 therefore anticipate the subject-matter of claim 1, which is thus not novel in view of D1.

2.10 Claim 1 of **auxiliary request 11** specifies that the skin layers comprise the glycol modified polyester of the core layer. As indicated in point 2.1 above, the skin layers in C5 and C6 include the same polyester as the core layer. The examples C5 and C6 therefore anticipate the subject-matter of claim 1, which is thus not novel in view of D1.

3. Auxiliary requests 5 and 12 - Admittance

3.1 These requests were filed for the first time at the appeal stage. Since the statement of grounds of appeal was filed after entry into force of the RPBA 2020, their admittance is governed by Article 12(4) RPBA 2020.

3.2 The proprietor argued that the requests should be admitted because they were filed in response to the decision of the opposition division. The requests were also convergent and based on minor modifications of requests filed before the first instance.

3.3 The board however notes that, contrary to the requirements of Article 12(4) RPBA 2020, the proprietor has not substantiated why these requests would overcome the inventive step objections. There is in particular no indication concerning the alleged effect of the

newly added features and/or why these would not be anticipated or obvious in view of the cited prior art.

The board further notes that, on a *prima facie* basis, the added features do not appear to overcome the outstanding objections. In particular, claim 1 of auxiliary request 5 does not appear to overcome the novelty objections against claim 1 of auxiliary requests 2 to 4.

It is also observed that, contrary to the proprietor's argumentation, these requests diverge from some of the highly ranked requests because, unlike the main and first auxiliary requests, the amounts of the dialcohols and of the carboxylic difunctional acid from which the polyester is derived are not restricted in claim 1. Claim 1 of auxiliary request 12 also omits the features added to claim 1 of auxiliary requests 8 or 10.

3.4 In view of the above considerations, the board has exercised its discretion under Article 12(4) RPBA not to admit auxiliary requests 5 and 12 into the appeal proceedings.

4. Since none of the requests submitted by the patent proprietor is admissible and/or allowable, the board concludes that the patent should be revoked. In view of this conclusion there is no need to address the question of admittance of document D54, since it is not relevant to the underlying decision.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar: The Chairman:

A. Pinna J.-M. Schwaller

Decision electronically authenticated