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D E C I S I O N
of 12 December 1996

Case Number: T 0557/94 - 3.2.5

Application Number: 83302965.5

Publication Number: 0095882

IPC: B29C 63/40

Language of the proceedings: EN

Title of invention:

A method of and apparatus for applying labels of heat shrink material to articles and articles so wrapped

Applicant II/Patentee:

B. & H. MANUFACTURING COMPANY, INC.

Applicant I/Opponent III:

KRONES AG Hermann Kronseder Maschinenfabrik

Headword:

-

Relevant legal provisions:

EPC Art. 54(2), 56, 111
TRIPS Art. 32

Keyword:

"The content of an Italian patent application enters the prior art 18 months after the priority date; no remittal to the first instance in order to guarantee a judicial review in case of revocation of the patent; inventive step - (yes)"

Decisions cited:

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Catchword:

-



Case Number: T 0557/94 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 12 December 1996

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Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted 20 June 1994
concerning maintenance of European patent
No. 0 095 882 in amended form.

Composition of the Board:

Chairman: G. O. J. Gall
Members: A. Burkhart
W. D. Weiß

Summary of Facts and Submissions

- I. The appellant I (opponent III) lodged an appeal against the interlocutory decision of the opposition division on the amended form in which the patent No. 0 095 882 can be maintained.

The appellant II (patentee) likewise lodged an appeal against the interlocutory decision of the opposition division.

Opposition was filed by three opponents against the patent as a whole and based on Article 100(a) and (b) EPC (lack of novelty, inventive step and enabling disclosure).

The opponents I and II withdrew their oppositions before the opposition division.

The opposition division held that the grounds for opposition mentioned in Article 100(a) and (b) EPC did not prejudice the maintenance of the patent as amended.

- II. The following prior art documents referred to during the opposition proceedings are also relevant for the present decision:

E11: US-A-4 108 710,
E17: US-A-3 235 433,
CA-A-951 685 (cited in E6).

The appellant I (opponent III) referred for the first time in the appeal proceedings to the document:

E6': IT-A-1 139 281,

which late filed document corresponds to the British family member

E6: GB-A-2 088 819,

which document was already referred to during the opposition proceedings, however, was disregarded by the opposition division since it was published after the priority date of the patent in suit.

III. Oral proceedings were held on 12 December 1996.

- (i) The appellant I (opponent III) requested that the decision under appeal be set aside and that the European patent be revoked.
- (ii) The appellant II (patentee) requested that the decision under appeal be set aside and the patent be maintained as granted (main request) or be maintained in amended form on the basis of the claims 1 to 30 filed on 12 November 1996.
- (iii) The independent claims 1, 19 and 29 of the patent as granted read as follows:

"1. A method of applying heat shrinkable film to an article (10) having a main, vertical body portion (11) and at least one end portion (14, 15) which curves inwardly from the main portion, said method comprising tightly applying the film (16) to the body portion of the article without heat shrinking and with a small projection (20, 21) of the film being allowed over at least one such end portion and then applying heat to the film so that the projecting film is heat-shrunk onto the article, characterised in that prior to the application of heat the film is adhered to the body portion

by narrow regions (46, 47) of adhesion solely at the leading and trailing edges of the film wrapped about the body portion of the article."

"19. Apparatus for applying heat shrink film to articles (10) having a main body portion (11) and at least one end portion (14, 15) adjoining and extending inwardly from the body portion, said apparatus comprising means (55) for wrapping such film as a sheet in unshrunk condition onto and securing it to the main body portion (11) of the articles (10) with a projecting portion (20, 21) extending over at least one such end portion (14, 15), means (60) for moving each article so wrapped through a heating station to shrink the projecting portion onto the or each end portion of the article, characterised in that means are provided for applying adhesive solely in narrow regions of the leading and trailing edges (45, 44) of the sheet (16) of film for securing the film to the article and in that the heating station includes means (72) for applying heat in a localised manner to the or each projecting portion whereby each segment of film is adhered to the body portion of each article without heat shrinking the same."

"29. An article (10) having a main body portion (11) having a vertical surface and at least one end portion (14, 15) adjoining the main body portion and curving inwardly therefrom, heat shrinkable film being adhered to the main body portion and projecting over said curved end portion, the projecting portion of the film being heat shrunk into close engagement with said curved portion, characterised in that at least the majority of the film encompassing

said cylindrical body is relatively unshrunk, and that the only adhesion by means of an adhesive of the film to the container is provided at a narrow band (46) at the leading edge of the film."

- (iv) The appellant I (opponent III) argued essentially as follows:

The late filed document E6' was of particular relevance and should therefore be admitted to the proceedings. The request of the patentee for remittal of the case to the first instance should be rejected, since the opposition division had already evaluated the disclosure of document E6 the content of which was identical with document E6'.

Document E6' represented the closest prior art and disclosed a method comprising all the features of the preamble of claim 1.

Document E6' gave also the teaching that the glue was applied in "a conventional manner". For the person skilled in the art "a conventional manner" of glue application to a label was a method wherein the label was adhered to a container by narrow regions of glue solely at the leading and trailing edges of the label wrapped about the container, as could be seen from document E11 referred to in the patent in suit, from document CA-A-951 685 referred to in the document E6' and from document E17 disclosing strip-glue adherence of a heat-shrinkable film label wrapped around a container.

The person skilled in the art, having in mind a reduction of glue consumption and the possibility of easy removal of the label from the container, would therefore in the method of E6' consider this well known conventional manner of glue application and thus arrive at the method of claim 1 of the patent in suit without the exercise of inventive skill.

- (v) The appellant II (patentee) argued essentially as follows:

The late filed document E6' should not be admitted to the proceedings. If the board admitted document E6', the case should be remitted to the first instance in order to guarantee a judicial review in case the patent should be revoked on the basis of document E6' introduced during appeal proceedings.

Document E6' did not disclose the manner of strip-glue application according to the characterising portion of claim 1 of the patent in suit, since in the method of E6' there was used only one glue roll which could do nothing else but applying glue all over the back surface of the label. The expression in E6', column 5, lines 88 and 89, "Here glue is applied in a conventional manner" did not point to glue applications other than the full-surface glue application disclosed in E6', but had to be seen in the context of the description of figure 2 referring to the one-roll glue applicator assembly which was considered as "conventional".

The reference to CA-A-951 685 in E6' was only made with respect to knife arrangements and had no context with glue application. CA-A-951 685

did not teach to confine the glue application to the leading and trailing edges only, and the glue used in this prior art method was a wet glue which was incompatible with plastic film.

Document E11 taught application of glue to leading and trailing edges of non-shrink paper labels and relied on placement of a strip of adhesive on a cylindrical container. The technology of E11 would be of no interest to a person skilled in the art addressing the problem of how successfully to heat shrink a shrinkable plastic film label onto contoured containers.

Also document E17 was not concerned with contour wrapping. Moreover, document E17 required heat-shrinking of the whole label and could therefore not suggest the combination of the features of claim 1 of the patent in suit.

There was nothing within the state of the art which would have motivated a person skilled in the art to modify the method disclosed in document E6' in the sense that the glue application was confined to the leading and trailing edges of the heat-shrinkable film in order to avoid wrinkling of the label when applying heat for heat shrinking the label, and thus to achieve a perfectly wrapped contoured can with an undistorted label wrapper free of wrinkles.

Therefore, the invention of the patent in suit involved an inventive step.

Reasons for the Decision

1. *Formal matters*

- 1.1 The document E6' represents a state of the art in the meaning of Article 54(2) EPC, for the following reasons:

According to the requirements and implementing regulations of the Italian patent law existing in the year 1982, the originally filed documents of an Italian patent application are made accessible to the public after 18 months from the priority date. Moreover, the Italian Patent Office publishes collections of bibliographic data identifying the patent application about 90 days after the filing date.

Thus, being informed about the existence of the patent application, any interested person may therefore request access to the file at the earliest possible date, i.e. 18 months after the priority date of the patent application (see the commentary "G. Senna, I diritti sulle invenzioni e sui modelli industriali, Milano Dott. A. Giuffrè Editore, 1990, pages 290-292").

Therefore, the content of document E6' entered the prior art (Article 54(2) EPC) on 24 April 1982, i.e. 18 months after its priority date (see also the certificate of the Italian Patent Office, filed on 18 August 1995 by the appellant).

- 1.2 Document E6' is introduced into the proceedings. The fact that this document was not included in the family system until grant of the patent is acceptable as a justification for its being cited late. Furthermore,

the document represents the closest prior art. It is more relevant than E4 (GB-A-1 453 540) because it explicitly discloses localized heating of the projecting parts of the film.

- 1.3 The appellant II (patentee) requested that the case should be remitted to the first instance in order to guarantee a judicial review in case the patent should be revoked on the basis of document E6' introduced during appeal proceedings. In that respect he referred to Article 32 of the Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPS) which provides an opportunity for the judicial review of any decision to revoke the patent.

While recognising that the EPO is not a party to TRIPS the board looked into the question whether the basic principle of judicial review under Article 32 of TRIPS is satisfied by the EPC. According to Article 21 EPC in conjunction with Article 106 EPC, decisions of an opposition division of the EPO are subject to judicial review by the boards of appeal independent of whether the first instance rejected the opposition, thereby maintaining the patent unamended or maintaining it in amended form, or whether the patent was revoked by the opposition division. The board is in any case empowered to decide on the merits of the case (Article 111 EPC, second sentence, first alternative: "...may exercise any power within the competence of the department which was responsible for the decision appealed ...") and is not restricted to the second alternative of Article 111 EPC, second sentence, i.e. to remit the case to the first instance if the decision under attack did not revoke the patent and the board of appeal considers revoking the patent for the first time. It would be alien to at least the majority of legal systems in the EPC contracting states to limit the power of the reviewing instance in such a way that - dependent upon

the "result" of the decision under attack - it would be bound to remit the case to the first instance. The EPC does not provide for such a restriction on the powers of the boards of appeal either. It cannot be assumed that the states negotiating TRIPS would have intended the introduction of such a limitation. Reading Article 32 TRIPS in the context of the usual structure of judicial review in the contracting states of the EPC and the EPC itself, this provision guarantees an instance for judicial review in revocation proceedings. Ordinary legal construction (e.g. Article 31 to 33 of the Vienna Convention for the Law of Treaties) forbids overly literal interpretation which is clearly outside what can conceivably be based on the meaning of the provision taken in context.

Article 32 TRIPS does not oblige the reviewing instance to remit the case for continuation of proceedings to the first instance in cases where the first instance did not revoke the patent and the reviewing instance intends to deviate from the decision of the first instance.

Quite a different matter is whether the rights of the parties to fair proceedings are impaired if a new document is first introduced in appeal proceedings. The case law of the boards of appeal of the EPO calls for careful consideration when such a procedural situation arises.

In the present case the feature of "localized heating" already played an important role before the opposition division. The opposition division, referring to a British family member E6 = GB 2 088 819 containing the same feature of "localised heating" as the Italian document E6' - the former being published after the priority date of the contested patent - had already evaluated the impact of the feature on the

patentability of the subject matter of the patent in suit: "This feature," [=means for applying heat in a localized manner] "for which no example exists in the prior art, therefore lends an inventive step to the apparatus described by the totality of the features of claim 19."

It is clear that the opposition division would have revoked the patent if the feature of applying localized heat had been known from the prior art. E6' discloses such a feature. It would therefore serve no purpose to remit the case to the first instance instead of reviewing the decision under appeal and giving a decision in substance on the patentability of the invention in dispute.

2. *Novelty*

Document E6', which represents the closest prior art, discloses a method comprising all the features of the preamble of claim 1 of the patent in suit.

With respect to the description of a specific embodiment according to figure 2, E6' states: "Here glue is applied in a conventional manner, the applicator assembly being controlled to move out of engagement with the wheel should there be no label on the pad." (see page 30, lines 14 to 19 of E6' and page 5, lines 23 to 27 of the corresponding British patent application E6). This statement refers to the glue applicator assembly as depicted in figure 2 comprising one glue applicator roll. The person skilled in the art understands the functioning of the glue applicator system depicted in figure 2 in the sense that the glue carrying roll is able to come into rolling engagement with the entire back side of the label and thereby applying glue all over the passing back side surface of the label.

Since there can be found no other reference to glue application in document E6', the term "Here glue is applied in a conventional manner" can only be construed as meaning such a full-surface glue application to the film label.

Therefore, document E6' does not disclose the feature of the characterising portion of claim 1 of the patent in suit; i.e. that the film is adhered to the body portion by narrow regions of adhesion solely at the leading and trailing edges of the film wrapped about the body portion of the article.

The methods disclosed in the documents E11, E17 and CA-A-951 685 are more remote from the method of claim 1 than the method disclosed in E6'.

Consequently, the method of claim 1 of the patent in suit is novel.

3. *Inventive step*

3.1 Problem underlying the invention

The problem underlying the invention consists in wrapping a heat-shrinkable film label about an article having a contoured body, i.e. a body comprising a main vertical body portion and at least one end portion which curves inwardly from the main portion, in such a manner that the film label smoothly and accurately fits about the contoured article body without wrinkles.

3.2 Solution

This problem is solved by the method of claim 1 of the patent in suit, notably by the combination of the following features:

- (a) wrapping the film tightly about the main body portion of the article with a small projection of the film being allowed over at least one inwardly curved end portion,
- (b) adhering the film to the body portion by narrow regions of adhesion solely at the leading and trailing edges of the film wrapped about the body portion of the article, and
- (c) then applying heat to the film so that the projection of the film is heat shrunk onto the inwardly curved end portion of the article without heat shrinking the film wrapped about the main body portion of the article.

Owing to the features (b) and (c) the film can, without interference of glue, freely and uniformly shrink onto the contoured end portion of the article, such that the film label smoothly and accurately fits about the contours of the article and wrinkling of the film label is avoided.

- 3.3 The afore-mentioned solution is not rendered obvious by the prior art documents referred to by the appellant, for the following reasons:

As stated already under point 2 above, document E6' discloses a full-surface glue application to the film label, and there is nothing in E6' to suggest that a wrinkle-free labelling could be achieved, if the glue is only applied in narrow strips according to the afore-mentioned feature (b).

Document E17 relates to labelling of cylindrical containers. It teaches that the labels of heat-shrinkable material can be applied on heated or unheated containers, that glue can be applied to the

leading or/and trailing edges of the label or the entire attaching surface of the label, and that the label is heated as a whole to shrink it tightly on the container (see column 2, lines 29 to 52).

Document E17 does not refer to the labelling of contoured articles, i.e. articles having a main vertical body portion and at least one inwardly curved end portion, and therefore E17 does not address the problem of wrinkle-free labelling of contoured articles. The teaching of document E17 by which heat shrinking of the label is achieved by heating the label as a whole (see column 1, lines 36 and 37; column 2, lines 49 to 52), would prevent the person skilled in the art from heating only the small projecting portion of the label and leaving the main portion of the label unheated and unshrunk, as is taught by the invention of the patent in suit.

Therefore, document E17 cannot lead the person skilled in the art to the solution of the invention of the patent in suit, namely that a wrinkle-free labelling on a contoured article can be achieved by the combination of the features "applying the glue in narrow strips" (according to the afore-mentioned feature (b)) and "confining the heat shrinking only to the projecting portion of the label" (according to the afore-mentioned feature (c)).

Document E11 relates to a method of applying paper labels to cylindrical containers, wherein the paper labels are adhered to the container by narrow regions of adhesion solely at the leading and trailing edges of the paper label wrapped about the container. The problem of wrinkle-free labelling of contoured articles

by heat-shrinkable labels does not arise in this method, and therefore, the person skilled in the art confronted with a problem underlying the invention could not expect to find a solution to this problem in document E11.

In any case, there can be seen no reason why the person skilled in the art should have recognised that the method disclosed in document E6' could be improved with respect to wrinkle-free labelling, if the full-surface glue application was replaced by the strip glue application disclosed in E11.

CA-A-951 685 is cited in document E6' (see page 6, last paragraph to page 7 first paragraph), but only as a source of information about knife arrangements. E6' does not rely on what CA-A-951 685 discloses about glue application. It is true that this CA patent mentions strip glue application of the label about a cylindrical container, however this document, similar to document E11, does not relate to the labelling of contoured containers with heat-shrinkable labels.

Therefore, this CA patent (like document E11) cannot render obvious the combination of the features of the method of claim 1 of the patent in suit.

- 3.4 For the reasons set out above, the method of claim 1 of the patent in suit also involves an inventive step within the meaning of Article 56 EPC.
4. Therefore, the method of claim 1 of the patent in suit constitutes a patentable invention within the meaning of Article 52(1) EPC.

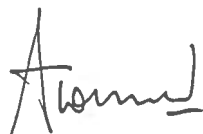
5. The same applies to the apparatus of claim 19 and the article of claim 29 of the patent in suit, the subject-matter of which claims are characterised, in substance, by the same features as claim 1.

Order

For these reasons it is decided that:

1. The appeal of the appellant I (opponent III) is rejected.
2. The decision under appeal is set aside. The patent is maintained unamended.

The Registrar:



A. Townend

The Chairman:



G. Gall

