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D E C I S I O N
of 6 May 1998

Case Number: T 0449/96 - 3.3.3

Application Number: 86307186.6

Publication Number: 0217598

IPC: B32B 27/32

Language of the proceedings: EN

Title of invention:
Heat sealable film laminate

Patentee:
Mobil Oil Corporation

Opponent:
Hoechst Aktiengesellschaft Patent- und Lizenzabteilung

Headword:

-

Relevant legal provisions:
EPC Art. 83, 100(b)

Keyword:
"Sufficiency (yes) - alleged discrepancy between claims and description (no) - evidence of inoperable embodiment (none filed)"

Decisions cited:
T 0292/85, T 0435/91

Catchword:

-



Case Number: T 0449/96 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 6 May 1998

Appellant: Hoechst Aktiengesellschaft
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Representative: -

Respondent: Mobil Oil Corporation
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 6 December 1995,
issued in writing on 20 March 1996 rejecting the
opposition filed against European patent
No. 0 217 598 pursuant to Article 102(2) EPC.

Composition of the Board:

Chairman: C. Gérardin
Members: R. Young
J. A. Stephens-Ofner

Summary of Facts and Submissions

I. The mention of the grant of European patent No. 0 217 598, on the basis of two sets of claims, a first set (Claims 1 to 10) for the Contracting States BE, DE, FR, GB, IT, NL and a second set (Claims 1 to 10) for the Contracting States AT, CH, LI, LU, SE, in respect of European patent application No. 86 307 186.6, filed on 18 September 1986 and claiming a US priority of 26 September 1985 (US 780159) was announced on 22 December 1993 (Bulletin 93/51). Claim 1 of the first set reads as follows:

"An orientated, heat-sealable polymer film laminate comprising:

- (a) a polypropylene core layer, and
- (b) a flame-treated first heat-sealable surface layer for receiving a water-based coating provided on one surface of the core layer (a), the first surface layer being formed from a polymer selected from an ethylene-propylene-butene-1 terpolymer, an ethylene-propylene random copolymer and a blend thereof, said polymer being compounded with an anti-blocking agent but not being compounded with silicone oil;
- (c) a second surface layer on the other surface of core layer (a) and formed from a polymer selected from an ethylene-propylene-butene-1 terpolymer, an ethylene-propylene random copolymer and a blend thereof, said polymer being compounded with an

anti-blocking agent and a silicone oil such that a coefficient of friction-reducing amount of silicone oil is present on the exposed surface of layer (b) as well as the exposed surface of layer (c) following mutual contact of said surfaces."

Claims 2 to 10 are dependent claims directed to elaborations of the laminate according to Claim 1.

The claims of the second set differ from those of the first set only in that the words "flame-treated" are omitted from feature (b) of Claim 1.

II. Notice of Opposition was filed on 21 September 1994 on the sole ground of Article 100(b) EPC in combination with Articles 83 and 84 EPC, that the subject-matter established by the text of the description and the wording of the claims was not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

III. By a decision which was given at the end of oral proceedings held on 6 December 1995 and issued in writing on 20 March 1996, the Opposition Division rejected the opposition.

According to the decision, whilst the laminates as defined in the claims were not expressly devoid of fatty acid amides, contrary to what was specified in the description, any skilled worker, producing a laminate restricted to the features of Claim 1 would arrive at the invention. In particular, it had not been disputed that Example 3, the laminate of which was clearly devoid of fatty acid amides, was reproducible, and that it consequently achieved the requirements targeted. Moreover, the fact that the presence of fatty acid amide could prevent the resulting laminate from being susceptible to receiving a water-based coating meant that such laminates were not within the scope of Claim 1. Any reasoning which ignored the above facts, and concluded that the latter laminates, which had to fail, nevertheless fell within the scope of the invention, was itself contradictory. It was concluded that the requirements of Articles 100(b) and 83 EPC were fulfilled by Claim 1 of both sets of claims.

IV. On 17 May 1996, a Notice of Appeal against the above decision was filed, together with payment of the prescribed fee.

In the Statement of Grounds of Appeal filed on 26 July 1996, as well as at oral proceedings held before the Board on 6 May 1998, the Appellant (Opponent) argued in substance as follows:

(a) According to Article 83 EPC, an invention is in principle sufficiently disclosed when the invention is clearly and sufficiently disclosed in the application **as a whole**. In finding that the

invention was sufficiently disclosed in the claims, however, the decision under appeal had failed to address the question of what the invention in fact was, and in particular which invention was disclosed in the application as a whole and which in the claims.

(b) The omission, from Claim 1, of the feature that the films according to the patent in suit had to be free of fatty acid amides ("amides"), which was admittedly essential for realising the effect of having good receptivity for water-based coatings, and was an integral part of the object of the patent in suit, meant that the subject-matter of Claim 1 was not realisable over the whole scope of the claim. The principle that the protection provided should reflect the contribution made to the art had thus been contravened. Consequently, the disclosure was not sufficient, in the sense of Article 100(b) and 83 EPC, to support such a claim.

(c) Whilst such a deficiency would normally have been dealt with pre-grant, possibly by means of an objection under Article 84 EPC, this had not been done in the present case, and redress had therefore been sought by means of an objection under Article 83 EPC in the course of opposition. The fact that the opposition had not been found inadmissible was itself an indication that the objection was not exclusively relevant to Article 84 EPC, but could properly be considered under the provisions of Article 83 EPC. It was in

any case appropriate that a mechanism be provided for the patent to be contested post-grant for such a fundamental deficiency.

- (d) It had in this connection been confirmed by technical staff of the Appellant's firm that the presence of a certain amount of such amides would, in practice, reduce the hydrophilicity and thus interfere with the receptivity to water-based compositions of the resulting films.

V. The Respondent (Patentee) argued, in submissions filed on 9 April 1997 and 3 April 1998 and at the oral proceedings held on 6 May 1998, essentially as follows:

- (a) A closer reading of the passage of description concerning the amides, relied upon by the Appellant, showed that there was no requirement for an absolute absence of this ingredient. Consequently, it was not necessary for Claim 1 to recite such absence.
- (b) Quite apart from this, the reasoning given by the Appellant did not support an attack under Article 100(b) or 83 EPC, but only one under Article 84 EPC, which was not a ground of opposition. Even an objection under Article 84 EPC was not justified, however.

With the submission received on 3 April 1998, the Respondent referred to two documents cited in the description of the patent in suit:

D1: US-A-4 419 411; and

D2: US-A-4 343 852.

The Respondent also indicated an amendment as the basis of an auxiliary request which consisted in the insertion of the words "substantially free of lubricants" after "layer" on page 11, line 49 of the patent in suit.

VI. The Appellant requested that the decision under appeal be set aside and the patent be revoked in its entirety.

The Respondent requested:

- (i) as main request, that the appeal be dismissed and the patent be maintained as granted; and
- (ii) as auxiliary request, to maintain the patent on the basis of the amendment set out in his letter of 3 April 1998.

Reasons for the Decision

1. The appeal is admissible.
2. *Late-filed documents*

The disclosures of D1 and D2 were referred to by the Respondent in reply to arguments raised by the Appellant. These documents are referred to in a passage of the patent in suit crucial to the case under consideration and are thus potentially highly relevant

to the outcome of the appeal. No objection to the introduction of this matter into the proceedings was raised by the Appellant. Consequently, the content of D1 and D2 was taken into consideration in the appeal proceedings.

3. *Sufficiency*

The sole issue to be decided in this appeal is whether the decision under appeal was right to find that the disclosure of the patent in suit met the requirements of Articles 100(b) and 83 EPC.

The patent in suit is concerned with providing a heat sealable polymer film laminate possessing a low coefficient of friction, good receptivity for water-based coatings and good optical clarity (page 3, lines 6 to 8). The means provided to achieve this aim are set out in Claim 1 (section I., above). It was not disputed that the disclosure of the only illustrative example, Example 3, was reproducible, or that it would lead to a film which was free of any "amides".

Thus the Board has no doubt that the disclosure of the patent in suit fulfils the requirements of Articles 100(b) and 83 EPC to the extent that at least one way (i.e. at least one embodiment) is clearly indicated enabling the skilled person to carry out the invention (T 0292/85, OJ EPO 1989, 275).

- 3.1 The Board is, however, aware that it has been held by another board, on the basis of the same case law, that the disclosure of an invention is only sufficient if

the skilled person can reasonably expect that **substantially all embodiments** of a claimed invention which this skilled person would envisage on the basis of the corresponding disclosure and the relevant common general knowledge can be put into practice (T 0435/891, OJ EPO 1995, 188; Reasons for the decision, point 2.2.2).

3.2 In the light of this latter, more rigorous interpretation of the relevant provisions, the burden of the Appellant's case is that the alleged discrepancy between the claims and description amounts to evidence of an embodiment which is inoperable, since the presence of amides in the films, whilst permitted by Claim 1, would, in the light of the content of the relevant passage in the description, be expected to prevent the films from being receptive to water-based coatings, and hence from fulfilling the stated object.

The relevant passage, which is at page 3, lines 27 to 32 of the patent in suit, reads as follows:

"Unlike the prior art composite films which may contain a **fatty acid amide** such as erucamide, stearamide, behenamide and oleamide, **to impart lubricity or slip to the films**, e.g., the multilayer films described in U.S. Patent Nos. 4,343,852 and 4,419,411, supra, the film of this invention does not contain **such an ingredient** since it usually interferes with the receptivity of the film surface for, and the adhesion of, water-based inks and water-based adhesives. Moreover, when concentrated at the **film surface**, a fatty acid amide can appreciably reduce the optical clarity of the film." (emphasis by

the Board).

3.2.1 Closer examination of the above passage shows that there is no explicit requirement that fatty amides are completely absent from the claimed film. On the contrary, the emphasis is rather that the film does not contain "such an ingredient". Since "such an ingredient" is one which will impart lubricity or slip to the film, the correct interpretation of this passage is, in the Board's view, that the film does not contain a fatty acid amide as a lubricity or slip imparting agent, i.e. as a contributor to reducing coefficient of friction (COF).

3.2.2 To contribute to reducing COF, however, it is not only necessary that a COF reducing amount of such amide be present somewhere in the film, but also that it be available **on the surface** of the film. This is confirmed by the disclosure of D2, cited by the Respondent and referred to in the passage relied upon, which relates to a somewhat similar multilayer laminate film in which the presence of such amides is, however, mandatory. According to D2, if a COF reducing amount of such an amide is to be available at the surface of the film, it must be added at least to the core layer, which is generally thicker than the surface layers, from which it will exude into and through the surface layers. If the amide were solely in the skin layer, during coextrusion and subsequent heat exposure, equilibrium tendencies would force most of the amide into the core layer and insufficient amide would be available to contribute to low COF." (column 3, line 60 to column 4, line 3).

3.2.3 Consequently, it is evident that, according to the passage relied upon by the Appellant, amides may be present in the films, without being in a position to reduce the COF or, therefore, the receptivity of the films to water-based coatings. Such presence of amides at least, therefore, does not imply any failure to achieve the stated object.

3.2.4 The general need to avoid the presence of amides in a way that could interfere with the achievement of the object of the invention is furthermore reflected by the requirement in Claim 1 of the patent in suit that the surface layer be one "for receiving a water-based coating". This is, in the Board's view, a clear functional requirement for such suitability which, whilst not excluding amides, only includes them to the extent that they do not vitiate the receptivity of the film to water-based coatings.

3.2.5 Thus, on a fair reading of the relevant passages, the alleged discrepancy between the claims and description does not exist, and the "invention" defined in the claims is therefore the same as that described. There is thus no lack of clarity or lack of support in the sense of Article 84 EPC.

3.3 Although this finding means that the premise on which the case of the Appellant was based must fail, it leads, in the Board's view, to the further question of the level at which the presence of amides would **in fact** inevitably result in a film which was no longer receptive to water-based coatings and therefore did not fulfil the stated object. This question is relevant to Article 100(b) and 83 EPC. It is furthermore an issue which would normally be decided in the light of relevant experimental evidence. No such evidence was, however, presented by the Appellant, who preferred instead to rely on reported conversations with members of technical staff. According to the latter, a threshold concentration of amides might be reached with certain types of processing, in which scraps from other films, containing amides, were incorporated, which could affect the receptivity to water-based coatings.

3.3.1 Such reported conversations are, however, mere hearsay evidence, and as such carry little weight.

3.3.2 Even were this not the case, they add nothing to what the patent in suit itself already teaches the skilled person, namely that such thresholds should not be exceeded.

3.3.3 It must be emphasised that it was up to the Appellant to show that the skilled person would not have been able to do this, which he has clearly failed to do.

3.4 In summary, it has not been shown to the satisfaction of the Board that there is a deficiency, in the patent in suit, in the sense of Article 100(b) or 83 EPC, or

even in the sense of Article 84 EPC. The tenor of the decision under appeal was therefore correct.

4. The Board therefore concludes that the Appellant's case against the Respondent's main request must fail. Consequently, it is not necessary further to consider the auxiliary request of the Respondent.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

E. Görgmaier C. Gérardin