

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of 7 August 2008**

Case Number: T 0878/06 - 3.2.02

Application Number: 97110527.5

Publication Number: 0887430

IPC: C22C 21/00

Language of the proceedings: EN

Title of invention:

Aluminium alloy support for lithographic printing plate

Patentee:

Sky Aluminium Co., Ltd., et al

Opponent:

Hydro Aluminium Deutschland GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 106(1), 108, 114
EPC R. 99, 101

Relevant legal provisions (EPC 1973):

EPC Art. 107

Keyword:

"Admissibility of appeal (yes)"
"Admissibility of late filed evidence (no)"

Decisions cited:

G 0010/91, T 0252/95

Catchword:

Public prior use submitted for the first time on appeal
(see 3.1)



Case Number: T 0878/06 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 7 August 2008

Appellant: Hydro Aluminium Deutschland GmbH
(Opponent) Ettore-Bugatti-Strasse 6-14
D-51149 Köln (DE)

Representative: Cohausz & Florack
Patent- und Rechtsanwälte
Bleichstrasse 14
D-40211 Düsseldorf (DE)

Respondent: Sky Aluminium Co., Ltd.
(Patent Proprietor) 2-1, Kinshi 1 chome
Sumida-ku
Tokyo (JP)

Representative: TER MEER - STEINMEISTER & PARTNER GbR
Patentanwälte
Mauerkircherstrasse 45
D-81679 München (DE)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
12 April 2006 concerning maintenance of
European patent No. 0887430 in amended form.

Composition of the Board:

Chairman: T. Kriner
Members: R. Ries
A. Pignatelli

Summary of Facts and Submissions

I. The granted European patent No. 0 887 430 was opposed by the present appellant on the ground that its subject matter lacked inventive step (Article 100(a) and 56 EPC) on the basis of (inter alia)

D1: EP-A-0 193 710 and

D4: US-A-5 562 784

II. In its interlocutory decision posted on 12 April 2006, the opposition division decided to maintain the patent in amended form.

The independent claim 1 as amended reads as follows:

"1. An aluminum alloy support for a lithographic printing plate, which is excellent in strength, surface treatment ability, and water receptivity, said aluminum alloy support containing:

0.20 - 0.50 wt% of Fe,

0.05 - 0.20 wt% of Si,

5 - 300 ppm of Cu, and optionally

0.003 - 0.05 wt% of Ti or 0.003-0.05 wt% of Ti in

combination with 1 - 50 ppm of B,

the balance being Al and inevitable impurities, which are set to be within the ranges of

0.05 wt% or less of Mn,

0.05 wt% or less of Mg,

0.05 wt% or less of Zn, and

0.05 wt% or less of others,

wherein a ratio between the maximum length and the maximum width of each of crystal grains in a micro-

surface structure of said aluminum alloy support is within a range of 10 to 30, obtainable by casting the molten metal of aluminum alloy having the above composition, heating the resulting ingot, subjecting the ingot to hot rolling and then cold rolling, and recrystallizing a surface of the rolled product in a period from the ending of hot rolling to completion of cold rolling to form a plate of 0.10 - 0.50 mm in thickness with a reduction ratio of the plate in cold rolling after recrystallization of 80 to 95%."

III. The opponent lodged an appeal received at the EPO on 9 June 2006 against the decision of the opposition division, and the appeal fee was paid on the same date. The statement setting out the grounds of appeal was received at the EPO on 22 August 2006.

In the statement of grounds, an objection of prior use related to sales of cold rolled Al-sheet on the open market by the appellant himself was invoked for the first time. In support thereof, the following documents were relied upon:

- A0: Master data sheet for customer LASTRA
- A1: Invoice No. 200458 of order A: Nr. 97211600; alloy Nr. 99/51, dated 7 January 1994
- A2: Packaging data for order A X97211601, dated 16 December 1993
- A3: Spark spectroscopic analysis of specimen order 971954/02; coil Nr. 4536200100 15.12.1993 F16, alloy Nr. A99/52 and order 972006/01; coil Nr. 4577000300 LASTRA (undated) F16 alloy A99/52

- A4: Machine schedule of the thin strip rolling mill dated 7 December 1993, order Nr. 97211601 VW1; coil Nr. 4577000300 J; alloy Nr. 99/51 LASTRA
- A5: Product specification for offset qualities, dated 9 December 1993, including alloy Nr. 99/51 F15 and alloy Nr. A99/52 F15
- A6: Publication by M. Schippers: Sichtbarmachung des Korngefüges in Schliiffproben von Aluminium durch anodische Oxydation (undated)
- A7: Micrograph Nr. 4 of specimen order Nr. 972116/01; coil Nr. 4577000300; client LASTRA; F16
- A8: Table summarizing the aspect ratios of tested specimen of orders Nr. 971954/02 (order C), 972116/01 (order A), 971599/04 (order B)
- B1: Invoice Nr. 200456, order Nr. 97158800, alloy Nr. 99/51 (order B), dated 7 January 1994
- B2: Package data of order Nr. 97159901, dated 3 January 1994
- B3: Spark spectroscopic analysis specimen coil Nr. 4459801300, alloy Nr. 99/52 F16, charge Nr. R06 KG 040, dated 11 August 2006
- B4: Micrographs 1 to 4 of specimen of coil Nr. 4459801300, alloy Nr. A99/52 F16 LASTRA, dated 2006
- C1: Packaging data order Nr. X 97195402, dated 3 December 1993 (order C)
- C2: Machine schedule of the fine sheet rolling mill, dated 24 November 1993, order Nr. 97195402, coil Nr. 4536200100 J alloy Nr. 99/51
- C3: Micrograph (Photo 1) order Nr. 971954/02, coil Nr. 4536200100 LASTRA F16, dated 2006
- E1: Statutory declaration of Mr R. Dejosez, dated 11 August 2006

- E2: Statutory declaration of Mr B. Kernig, dated
18 August 2006
- E3: Statutory declaration of Mr H. J. Brinkmann, dated
12 June 2008
- E4: Statutory declaration of Mr V. Schlonz, dated
2 July 2008

Apart from the alleged public prior use, the statement did not comprise any other comments or arguments with respect to the decision under appeal.

- IV. To meet the requests of the parties, oral proceeding before the Board took place on 7 August 2008. The following requests were made:

The appellant (opponent) requested that

- the decision under appeal be set aside and
- the European patent No. 887 430 be revoked.

The respondent (patentee) requested that the appeal be dismissed.

- V. The appellant's arguments are summarized as follows:

Given the high relevance of the technical teaching given in document D4, the opposition division did not allow the claims as granted for lack of novelty. The opposition division however held that, by restricting the aspect ratio of the crystal grains in the micro-surface structure of the aluminium alloy support from 6 to 30 to 10 to 30, the subject matter of the claims according to the auxiliary was novel and inventive over the cited pre-published prior art.

As to the prior use submitted for the first time on appeal, it was conceded that it had actually been known to the appellant since 1994, i.e. long before and already within the opposition period. There was, however, a special reason for the late filing of the prior use on appeal. Given that the known Al-sheet had been produced according to the technology described in the detail in document D1, the elongated grain crystal grains of the cold rolled Al-sheet had always been estimated to exhibit an aspect ratio of less than 8. In reaction to the surprising and unforeseeable limitation of the aspect ratio of 10 to 30 that was accepted by the opposition division at the oral proceedings, the opponent started to re-investigate the microstructure of the aluminium sheets which had been produced in 1993 and sold to the client LASTRA in 1994. In fact, the tests revealed an aspect ratio in the range of 9 to 32, with an average ratio of 13, 15 and 17, which were all within the range claimed in the patent. Hence the prior use was filed for the first time on appeal.

Due to the long time elapsed since 1994, the tracing of all the necessary data, customer invoices, packaging data, and the identification of still existing specimen of the Al-sheet delivered to the customer LASTRA as well as the spark spectrometric analysis was very troublesome and laborious, all the more so since the original papers no longer existed and all data had been converted into a computer-storable form. Although the conversion of the data actually resulted in several inconsistencies, all these could be plausibly explained. The entirety of the data submitted in support of proving the public prior use clearly showed that the cold rolled Al-alloy sheet delivered in 1994 to LASTRA

anticipated the subject matter of claim 1 of the patent. Revocation of the patent was therefore justified.

With respect to the late filing of the prior use reference was made to the considerations given in decision T 252/95, where a prior use filed for the first time on appeal was admitted since it was highly relevant to the appealed decision.

VI. The respondent's arguments are summarized as follows:

The opponent's statement of the grounds of appeal did not address even remotely the main reasons given by the opposition division in the contested decision for maintaining the patent in amended form, as requested by the established case law of the Boards of Appeal. Hence, the patentee was unable to understand why the appealed decision was alleged to be wrong. On the contrary, when reading the statement of the grounds of appeal, it was immediately evident that it concerned exclusively the opponent's own prior use which was brought forward for the first time on appeal. In so doing and based on the newly filed documents in support of the prior use, the opponent created a completely new notice of opposition (i.e. a "fresh case") rather than a well founded appeal in response to the opposition division's decision. The opponent's late filing, two and a half years after the expiry of the opposition period, of evidence which undoubtedly could have been submitted much earlier must be considered as a strategic measure to improve its own case and hence represented an abuse of procedure.

Moreover, the submissions and evidence relating to the late allegation of prior use were not only insufficient,

but also showed various inconsistencies and even contradictions leading to the conclusion that the prior use was not proven up to the hilt. Hence the prior use should not be admitted to the appeal proceedings. The opponent's reference to decision T 252/95 referred to in this context was misleading since it related to a different case: in response to the decision of the opposition division the appellant, having opposed the patent already on the basis of a first public prior use in the opposition proceeding, supplemented its argument on appeal by submitting a second public prior use. Due to its relevance, the second prior use supplementing the first one was accepted.

In consequence thereof and given that the evidence in support of the prior use was not admissible, the statement of grounds of appeal failed to comprise a reasoning relating to the appealed decision and therefore, the appeal per se was inadmissible.

Reasons for the Decision

1. This decision is issued after entry into force of the new version of the European Patent Convention (EPC 2000) on 13 December 2007. At this point in time, the patent in dispute had already been granted. Therefore, Article 7(1), second sentence, of the Act revising the EPC of 29 November 2000 together with the decisions of the Administrative Council of 28 June 2001 on the transitional provisions (Special edition Nr. 1/2007, 197) and of 7 December 2006 (Special edition Nr. 1/2007, 89) have to be applied in this case. Articles and Rules cited without date relate to the new version of the EPC.

Articles and Rules of the previous version are indicated with the addition "1973".

2. *Admissibility of appeal*

The appeal meets the requirements for the admissibility stipulated in Articles 106, 108 EPC, 107 EPC 1973 and Rules 99, 101 EPC.

In particular, the statement setting out the grounds of appeal indicates the reasons for setting aside the impugned decision and the facts and evidence on which the appeal is based. Insofar, the appeal satisfies the requirements of both Article 108 and Rule 99(2) EPC.

The function of this requirement is that reasons for setting aside the decision, facts and evidence have to be provided by the appellant to enable the Board and the parties to understand immediately why the decision is alleged to be incorrect, and on what facts and evidence the appellant bases his arguments, without first having to make investigation of their own. The grounds of the appeal have to relate to the grounds given for the decision (see also Case law of the Board of Appeal, 4th edition, VII. D.7.5.1). Whether the alleged reasons, facts and evidence can be taken into account for the decision and are well-founded is a question for the allowability of the appeal.

In the present case, the grounds of appeal dealt with the objection of lack of novelty. Novelty was dealt with in the decision under appeal so that the grounds of the appeal are related to the decision. Facts and evidence have been provided which enable the Board and

the parties to understand immediately why the decision under appeal is alleged to be incorrect. The facts and evidence were submitted for the first time with the statement of grounds of appeal. However, this circumstance relates to the admissibility of the facts and evidence but does not render the appeal itself inadmissible.

3. *Allowability of the appeal*

3.1 Objection based on the prior use

The prior use and the evidence for it were submitted for the first time in appeal proceedings.

The function of the appeal proceedings is to give a judicial decision upon the correctness of the decision given by the department of first instance. Such a review can, in principle, only be based on the reasons already submitted before that department (G 10/91, OJ EPO 1993, 420). It is normally not the function of a Board of Appeal to examine and decide upon issues in the case which have been raised for the first time during appeal proceedings.

On the other hand the Boards have, by virtue of Article 114(1) EPC, to examine the facts on their own motion when the facts are both alleged and properly substantiated by the parties.

When using these powers they can, however, exercise their discretion, conferred upon them by Article 114(2) EPC, to disregard facts and evidence which are not submitted in due time by the parties concerned (see

also Case Law of the Boards of Appeal 4th edition, VII.D.6.4).

- 3.1.1 When deciding whether a fact or piece of evidence was submitted in due time the Boards need to take into account the circumstances of the case, in particular whether the party concerned could have presented its case in an earlier phase of the proceedings or if it had good reasons for not doing so. Only if there are very special reasons for doing so, can a party introduce new facts and evidence at a late stage in the proceedings.

Under the particular circumstances of the present case the prior use, submitted for the first time with the statement of grounds of appeal, was not submitted in due time. As admitted by the appellant himself, the prior use was known to him long before the expiry of the opposition period. Hence he could already have submitted the prior use during the opposition proceedings. However, he did not do so.

According to the appellant, the reason for not submitting the prior use during the opposition proceedings was that he thought at that time that the aspect ratio of the grains in the cold rolled Al-sheet was below 8 so that the prior use was considered to be irrelevant. Furthermore, the collection of the means of proof was considered to be too complicated and difficult. The surprising restriction of the aspect ratio in the opposed patent from 6 to 30 to 10 to 30 by the opposition division, however, initiated the re-testing of the still available specimen of the Al-coils delivered in 1994 to LASTRA which eventually

established that the actual aspect ratio was between 9 and 32 rather than < 8 .

The Board does not find this reasoning convincing. It may be true that at the time of opposition, the appellant's technical experts were convinced that the aspect ratio of the prior used Al-sheet was outside the claimed range, but after the limitation of the aspect ratio to 10 to 30, the aspect ratio of the grains in the micro-surface structure of the claimed aluminium alloy support was even more remote from the known sheet than before. Hence, the limitation would not prompt a skilled person to re-investigate the Al sheet produced according to the technology of D1. On the contrary, if an interest had actually existed in re-checking the aspect ratio of the grains in the known Al sheet, then it was within the opposition period, all the more so since the upper limit of < 8 overlapped with the claimed range of 6 to 30 set out in the patent as granted. At that time, the appellant could have submitted the public prior use as one of his relevant arguments against the novelty of the claimed aluminium alloy support but he did not and the reason for not doing it are not convincing.

The fact that the recollection of all necessary means of proof was complicated and difficult should have prompted the appellant to do it as soon as possible in order not to delay the proceedings.

Therefore the Board decides that the prior use was not submitted in due time.

3.1.2 In exercising its power of discretion the Board has to take into account on the one hand the public's as well as the parties' common interest that opposition proceedings should be speedily concluded, an interest that clearly encompasses appeal proceedings as well, and on the other hand the interest of the parties in presenting their case in a complete manner. The interest in a speedy procedure is best served if the patentee is made aware as soon as possible of the opponent's full and complete case, which he needs to address, in order to keep his patent in force. Furthermore, it has to be taken into account the fact that the retention of information that could have been relevant to the maintenance of patent at the opposition period, and the introduction of such information at a later stage, i.e. by presenting the information "piecemeal wise" much later at the appeal proceedings, lead to a dilatory effect on the procedure and violate the interests of the public in general.

In the present case, the introduction of the alleged public prior use at this late stage would cause an unacceptable delay in the proceedings.

When considering the technical relevance of the documents in support of the prior use, a closer look reveals a plethora of inconsistencies and deficiencies. Particular attention is drawn to the type of alloy specified in orders A and B as 99/51 (see A1, A4, B1), whereas order C fails to give a detailed order sheet at all (only a package list C1). Only the mill schedule C2 reveals that the type of alloy was 99/51.

Contrary thereto, the detailed test results given in documents A3 and B3 were obtained by using a specimen of alloy Nr. A99/52 F16, i.e. a different alloy. The product specification list for offset qualities (A5) indicates that both alloys were produced at that time (see Pos. 12 to 19: 99/51 and Pos. 20: A99/52). It therefore remains doubtful whether the correct alloy has actually been tested.

Apart from the question of "what" was used, the allegation of prior use also lacks the confirmation of delivery to LASTRA. As an example of this uncertainty, the opponent himself merely concludes on the basis of document A1 (order A) that "it should therefore be assumed that the material was delivered to Lastra in the period between 7 January 1994 to first of May 1994" and on the basis of the type of transport and the insured value, the conclusion must be drawn that the delivery had actually taken place (see statement of grounds, page 3, penultimate and ultimate paragraph). This deficiency also applies to order B and C.

According to the appellant, the reason for the inconsistencies is that, due to the long time which had elapsed since the sales, the original documents are no longer available and all the data have to be retrieved from the computer memory. This circumstance, however, is due to the behaviour of the appellant himself because he has waited for over ten years before collecting the documents, although he should have known that the legal obligation to keep administrative documents ceases after a prescribed period.

Thus, his interest in presenting a complete case cannot prevail against the interest of the other party and of the public in a speedy procedure, when the difficulties of proof and the delay caused by them are due to his previous procedural behaviour.

- 3.1.3 For the above reasons, the public prior use must be disregarded. After having exercised the power of discretion given to the Board under Article 114(2) EPC, it therefore decides not to admit the alleged public prior use into the proceedings.

Hence, there is no need to deal with the considerations given in decision T 252/95 which, in fact, is based on a situation different to the present case, as has been correctly pointed out by the respondent.

4. Given this situation and the fact that the statement of grounds of appeal did not comprise any other grounds with respect to the unsoundness of the reasons given in the impugned decision, the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

V. Commare

T. Kriner