

Internal distribution code:

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

**Datasheet for the decision
of 27 June 2018**

Case Number: T 2351/16 - 3.2.05

Application Number: 08158524.2

Publication Number: 1987950

IPC: B41C1/04

Language of the proceedings: EN

Title of invention:

A precursor plate for the manufacture of intaglio printing plates for intaglio printing of sheets of security papers and a method of manufacturing an engraved plate

Applicant:

KBA-NotaSys SA

Relevant legal provisions:

EPC Art. 76(1) sentence 2
EPC 1973 R. 67

Keyword:

Compliance with Article 76(1) EPC (yes)
Remittal to the department of first instance (yes)
Substantial procedural violation (yes)
Reimbursement of the appeal fee (yes)

Decisions cited:

G 0002/10, T 0331/87, T 1852/13

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2351/16 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 27 June 2018

Appellant:
(Applicant)

KBA-NotaSys SA
Avenue du Grey 55
Case Postale 347
1000 Lausanne 22 (CH)

Representative:

Cyril Ganguillet
ABREMA
Agence Brevets & Marques Ganguillet
Avenue du Théâtre 16
P.O. Box 5027
1002 Lausanne (CH)

Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted on 4 May 2016
refusing European patent application No.
08158524.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman P. Lanz
Members: O. Randl
J. Geschwind

Summary of Facts and Submissions

- I. The applicant filed an appeal against the decision of the examining division to refuse European application application No. 08158524.2, which is a divisional application based on international application No. PCT/CH03/00348.

The examining division found the application not to comply with the requirements of Article 76(1) EPC.

- II. Relevant procedural aspects

On 19 November 2010 the examining division issued a Communication pursuant to Article 94(3) EPC based on the European search opinion.

The applicant filed its response by letter dated 20 April 2011.

More than two and a half years later, on 13 January 2014, the applicant asked the examining division when a "further communication in this case" could be expected.

By letter dated 16 January 2014 the applicant was informed that "[h]aving regard to the current workload, the EPO will not be able to supply a communication within the next 12 months".

The examining division issued the decision under appeal on 4 May 2016. There were no oral proceedings before the examining division.

- III. The appellant (applicant) requested that the decision under appeal be set aside and that the case be remitted

to the first instance for further prosecution on the basis of the claims on file. It also requested a reimbursement of the appeal fee.

IV. The independent claims of the sole request on file read as follows:

"1. A precursor plate for the manufacture of intaglio printing plates for intaglio printing of sheets of security papers, wherein said precursor plate comprises a laser-engravable polymer layer."

"6. Use of a precursor plate comprising a laser-engravable polymer layer for the manufacture by laser engraving of an engraved plate for intaglio printing of sheets of security papers."

"9. A method of manufacturing an engraved plate for intaglio printing of sheets of security papers, wherein a non-engraved plate is submitted to a programmed engraving process by a computer-controlled laser engraving tool, characterised in that said non-engraved plate is a precursor plate of an intaglio printing plate comprising a laser-engravable polymer layer and in that said polymer layer of the precursor plate is engraved by said computer-controlled laser engraving tool."

V. The appellant argued as follows:

(a) Substantial procedural violation

The application was refused after only one communication. Although the appellant had not formally requested oral proceedings, it had filed counter-arguments and had also requested that

another communication be issued. The refusal of the application after more than five years of silence, therefore, came as a surprise to the appellant. The argument based on the Guidelines was made for the first time in the decision and the appellant was not offered any opportunity to comment on it. Moreover, the statement that there was no possibility to overcome the objections by amendment is incorrect. As a consequence, the decision was premature and violated the appellant's right to be heard.

The communication dated 19 November 2010, while formally being the first communication, was just a formal communication maintaining the objections which were listed in the Opinion (mirroring the relevant provision of new Rule 70a(1) EPC, which has entered into force on 1 April 2010). The applicant's response of 20 April 2011 could and should have been treated in the same way as a response to a communication pursuant to Rule 70a(1) EPC (*cf.* Guidelines, C-V 14).

The examining division committed a substantial procedural violation by issuing the decision to refuse the application in response to the applicant's reply of 20 April 2011: it has violated the applicant's fundamental right to be heard pursuant to Article 113(1) EPC.

As a consequence, the appeal fee should be reimbursed.

(b) Added matter

For the purpose of the provisions of Article 76(1) EPC, one should examine the content of the earlier application as a whole and not only its claims. The fact that the claims of the instant application were not to be found in the claims of the earlier application as filed is irrelevant.

The examining division appears to have considered that a particular invention can only be claimed in a divisional application if this invention is within the scope of protection of claims of the earlier application. This is a very restrictive and narrow view of the possibilities offered by the provisions of Article 76 EPC.

Considering page 4, fourth paragraph and page 10, paragraphs 4 to 6 of the earlier application, it is clear that the earlier application as a whole contains an explicit and unambiguous disclosure of a precursor plate *per se* as recited in claim 1 of the application under consideration.

The features of claim 1 of the earlier application to which the examining division refers in the search opinion do not as such relate to or have any impact on the particular material nature of the "non engraved plate" that is subjected to the "programmed engraving process" that is detailed in claim 1 of the earlier application.

As a matter of fact, the features which relate to the particular engraving process that is recited in claim 1 of the earlier application do not (and cannot) define the "non engraved plate" *per se*, but

rather explain how this "non engraved plate" is to be engraved to obtain an "engraved plate".

In that respect, claim 1 of the instant divisional application relates to the particular material nature of a "precursor plate" *per se*, which material nature is not affected or modified as a result of the proposed engraving process.

As far as the material nature of the "precursor plate" is concerned, the essential feature resides in the fact that this "precursor plate" comprises a laser-engravable polymer layer as defined in claim 1 (and reflected in claims 6 and 9).

In other words, the omission of the features relating to the particular engraving process does not change or affect the particular material nature of the precursor plate that is to be used as "non engraved plate" for the engraving process.

In that respect, the removal of the features pertaining to the engraving process does not violate Article 76(1) EPC (or Article 123(2) EPC) and actually fully complies with the Guidelines, Part H, Chapter V, point 3.1.

The "precursor plate" that is already described in the earlier application as filed can be claimed *per se* and protection for this particular product can be sought. This forms the subject-matter of claims 1 to 5.

Similarly, the use of a precursor plate comprising a laser-engravable polymer layer for the manufacture by laser engraving of an engraved plate

for intaglio printing of sheets of security papers can be claimed *per se* and protection for this particular use can be sought; *cf.* the subject-matter of claims 6 to 8.

The same applies in relation to the subject-matter of method claims 9 to 15, which are focused on the particular material nature of the non-engraved plate to be engraved.

It is entirely legitimate for the applicant to seek patent protection for the precursor plate *per se* (as well as uses and applications thereof) as this precursor plate is provided as a "consumable" in the form of a non-engraved plate for the engraving process.

Therefore, the examining division's objections under Article 76(1) EPC are unfounded.

Reasons for the Decision

1. Applicable law

The divisional application under consideration was filed on 29 October 2004. According to Article 7 of the Act revising the EPC of 29 November 2000 (OJ EPO 2007, Special edition No. 4, 217) and the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC of 29 November 2000 (OJ EPO 2007, Special edition No. 4, 219), Article 111 EPC 1973 applies in the present case. Reimbursement of the appeal fee is governed by Rule 67

EPC 1973 (see decision J 10/07, point 7 of the reasons, published in OJ EPO 2008, 567).

2. *Substantial procedural violation*

2.1 Refusal after a single communication

The fact that the examining division issued a decision of refusal after only one communication under Article 94(3) EPC as such does not constitute a violation of the appellant's right to be heard. According to the jurisprudence of the boards of appeal, an examining division may refuse an application after a single communication if it does not consider that there is a prospect of a positive result. The refusal of an application after the first communication is justified if decisive objections against patentability remain, particularly where the claimed subject-matter has not been substantially modified (see "Case Law of the Boards of appeal of the EPO", 8th edition, 2016, item IV.B.2.5.1).

Professional representatives have to be aware that, in order to avoid a refusal after only one communication, a precautionary request for oral proceedings should be filed together with the response to the communication (at the latest).

In the present case, the appellant did not file such a request, but requested a further communication. However, the appellant was not entitled to such a communication; Article 94(3) EPC only requires the examining division to invite the applicant "as often as necessary" to file his observations and possibly to amend the application.

2.2 Excessive delay

The fact that the application was refused more than five years after the appellant's response to the communication under Article 94(3) EPC does not lead to another conclusion. It is indeed regrettable that the decision was taken more than five years after the written submission of the appellant (and more than two years after the appellant's enquiry as to when a communication from the examining division could be expected). However, these circumstances do not alter the legal situation in respect of the requirements of Article 94(3) EPC.

2.3 Reasons mentioned for the first time in the decision

Item 7 of the grounds for the decision contains the following statement:

"It cannot come as a surprise to the applicant that in view of his reply, in addition to the arguments already on file, the division would refer to guidelines H V-2 point 3.1. in support of its position."

Apart from the fact that the reference to the Guidelines appears to be erroneous (H-V,3.1 being meant), the boards considers the assertion that the appellant could not be surprised by an additional argument in support of the division's objection to be highly questionable.

As a matter of fact, the cited passage of the Guidelines reproduces the criteria for deleting claim features as developed by decision T 331/87 (three-point "essentiality test"). There is no reference whatsoever to the essentiality test in the European search opinion

on which the communication pursuant to Article 94(3) EPC was based. The applicant could not expect the application to be refused on the basis of such arguments, because it had never been offered the opportunity to comment on them.

The refusal of an application based on a reasoning expressed for the first time in the decision constitutes a violation of the applicant's right to be heard and, therefore, a substantial procedural violation.

2.4 Further issues

2.4.1 Formal communication

The appellant pointed out that the Communication pursuant Article 94(3) EPC was just a formal communication. It argued that its response to this communication could and should have been treated in the same way as a response to a communication pursuant to Rule 70a(1) EPC, which entered into force on 1 April 2010, and which reads:

"In the opinion accompanying the European search report the EPO shall give the applicant the opportunity to comment on the extended European search report and, where appropriate, invite him to correct any deficiencies noted in the opinion accompanying the European search report and to amend the description, claims and drawings within the period referred to in Rule 70, paragraph 1."

The board is unable to endorse this argument. Rule 70a EPC was inserted into the Implementing Regulations by decision of the Administrative Council CA/D 3/09

of 25 March 2009 (OJ EPO 2009, 299) and entered into force on 1 April 2010. Article 2(2) of this Decision reads:

"(2) ... new Rule 70a ... shall apply to European patent applications for which the European search report or the supplementary European search report is drawn up on or after 1 April 2010."

In the present case the extended European search report was communicated to the applicant by letter dated 11 March 2010. It is, therefore, clear that Rule 70a EPC does not apply to the application under consideration.

Moreover, when issuing its Communication pursuant to Article 94(3) EPC, the examining division has offered the applicant the possibility to file observations and to correct any deficiencies.

The fact that the communication is merely "formal", in that it refers to the European search opinion, does not mean that it is not a valid communication under Article 94(3) EPC having all the legal effects of such a communication.

2.4.2 Statement on amendments

The European search opinion contains the following statement:

"4. At least some of the objections raised above are such that there appears to be no possibility of overcoming them by amendment. Refusal of the application under Article 97(2) EPC is therefore to be expected."

In this respect the opinion appears to be somewhat self-contradictory because in the ante-penultimate paragraph on page 2 the possibility of remedying the defects by means of amendments is explicitly suggested. This notwithstanding, the board is unable to see why the statement of point 4 would result in a further violation of the appellant's right to be heard because the communication under Article 94(3) EPC, which was issued subsequently, clearly and unambiguously invited the appellant to file its observations and amendments.

3. *Added matter (Article 76(1) EPC)*

3.1 Article 76(1) EPC reads as follows:

"A European divisional application shall be filed directly with the EPO in accordance with the Implementing Regulations. It may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed; in so far as this requirement is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall enjoy any right of priority."

In order to comply with Article 76(1), second sentence, EPC, the subject-matter of the divisional application must not extend beyond the content of the earlier application as filed.

In the decision under appeal, the examining division made the following statement:

"The division considers that what needs to be assessed is whether the man skilled in the art could directly and

unambiguously derive from the parent application as filed that it also comprises the scope of protection now claimed in the present divisional. Art. 69 defines that this scope of protection is defined in the claims." (point 8.3, second paragraph)

The board considers that the reference to the "scope of protection" and to Article 69 EPC is unfortunate and misleading because it may suggest that the scope of protection of the divisional application has to be comprised by the scope of protection of the earlier application, which is incorrect. The only requirement that has to be ascertained when compliance with Article 76(1) EPC is examined is whether the subject-matter of the divisional application extends beyond the content of the earlier application as filed or not. The scope of protection of the divisional application and its relationship with the scope of protection of the earlier application is irrelevant in this context.

Therefore, the board examines whether the subject-matter of the independent claims is within the content of the earlier application or not.

3.2 Claim 1

3.2.1 Claim 1 is directed at a precursor plate which is suitable for the manufacture of intaglio printing plates for intaglio printing of sheets of security papers and which comprises a laser-engravable polymer layer.

The earlier application discloses "... a precursor of an intaglio printing plate, which is thereafter further processed by metal depositions as known in the prior art" (page 4, antepenultimate paragraph). The earlier

application as a whole concerns the "field of intaglio printing for the production of security papers, especially banknotes" (page 1, first paragraph). The description of Figure 9a mentions that "the engraving tool is a YAG laser and the engraved plate is a polymer plate which serves as a precursor of the intaglio printing plate" (page 10, beginning of second paragraph). Considering these elements, the board is satisfied that the earlier application discloses a precursor plate which is suitable for the manufacture of intaglio printing plates for intaglio printing of sheets of security papers and which comprises a laser-engravable polymer layer.

- 3.2.2 The examining division agreed that such a plate was disclosed in the earlier application. It nevertheless found the subject-matter of claim 1 to extend beyond the content of the earlier application and justified this conclusion as follows:

"... in the parent application, the plate per se is never mentioned as being the invention in the original application, it is never stated to ,in itself, solve a particular problem, and it is always mentioned in combination with a specific method for engraving it.

Throughout the parent application, it is only this specific method for engraving the plate which is described as being the object of the invention and solving the technical problem which is stated to be "the reducing of the processing time and cost of the production of intaglio printing plates by circumventing the tedious steps of engraving vignettes and portraits by hand."

Claiming the precursor plate *per se*, without the engraving method, therefore has to be considered as a removal of a feature (the specific method for engraving it) from the claim and the guidelines H V-2 [sic] point 3.1. apply." (see paragraphs 5 to 7 on page 9 of the grounds of the decision)

As the criteria of the essentiality test laid down in the Guidelines were considered not to have been met, the examining division reached the conclusion that the divisional application did not meet the requirements of Article 76(1) EPC.

- 3.2.3 The present board (in different composition) has repeatedly expressed its point of view that the "essentiality test" based on decision T 331/87 and reproduced in the Guidelines H-V 3.1, is not in line with the actual jurisprudence of the Enlarged Board of appeal and should not be used anymore (see in particular decision T 1852/13, point 2 of the reasons).

The board considers that the correct test to be applied is the "gold standard" reaffirmed in decision G 2/10 of the Enlarged Board of appeal (OJ EPO 2012, 376). In other words, it is to be examined whether the skilled person would derive the claimed subject-matter directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the earlier application.

The fact that in the earlier application, the plate *per se* is never mentioned as being the invention and is never stated to solve a particular problem appears not to be relevant in the present context. Such considerations may become relevant in the context of

inventive step but are not decisive when compliance with Article 76(1) EPC is to be examined.

3.2.4 The examining division also pointed out that in the earlier application the plate as such is always mentioned in combination with a specific method for engraving it. This statement appears to refer in particular to the disclosure of the second paragraph on page 10 of the original earlier application:

"In Figure 9a, the engraving tool is a YAG laser and the engraved plate is a polymer plate which serves as a precursor of the intaglio printing plate. The engraved plate is mounted on a rotating cylinder. The laser is moving in a direction parallel to the axis of the cylinder. The control of the laser movement and of its intensity as well as the movement of the cylinder are performed by a computer which generates in-flight the master depth-map data taking into account the compensation of the sheet deformation which occurs during the intaglio printing process."

However, when considering the earlier application as a whole, the skilled person would understand that the laser to be used for engraving does not have to be a YAG laser (see e.g. the reference to an excimer laser on page 11, line 3 or the very general statement on page 4, beginning of the third paragraph: "Preferably, the engraving tool is a laser engraving machine, ...") and that the way in which the plate is mounted and the laser moves etc. just describe one particular way of engraving the plate which, as correctly observed by the appellant, do not in any way characterise the plate as such.

3.2.5 Therefore, the board reaches the conclusion that the subject-matter of claim 1 does not extend beyond the content of the earlier application as filed.

Strictly speaking the decision under appeal was only based on an objection against claim 1. For the sake of completeness, the board will also consider the subject-matter of the other independent claims from the point of view of compliance with Article 76(1) EPC:

3.3 Claim 6

Claim 6 is directed at the use of a precursor plate comprising a laser-engravable polymer layer for the manufacture by laser engraving of an engraved plate for intaglio printing of sheets of security papers.

The claim covers the use of the precursor plate of claim 1. That the plate is to be used in this way is already expressed in claim 1. Therefore, the findings in respect of claim 1 also apply to the subject-matter of claim 6.

As a consequence, the board reaches the conclusion that the subject-matter of claim 6 does not extend beyond the content of the earlier application as filed.

3.4 Claim 9

Claim 9 covers a method of manufacturing an engraved plate for intaglio printing of sheets of security papers, wherein a non-engraved plate of the kind defined in claim 1 is submitted to a programmed engraving process by a computer-controlled laser engraving tool such that the polymer layer of the

precursor plate is engraved by the computer-controlled laser engraving tool.

The board is satisfied that the subject-matter of claim 9 is disclosed in the earlier application and refers to its considerations in respect of the subject-matter of claim 1 in combination with the disclosure of the second paragraph on page 1 of the earlier application, which defines the method of manufacturing in general terms.

Consequently, the board reaches the conclusion that the subject-matter of claim 9 does not extend beyond the content of the earlier application as filed either.

4. *Remittal to the first instance*

Considering that the examining division has not yet examined the patentability of the claimed subject-matter, it appears appropriate to refer the case back to the examining division for further prosecution.

5. *Reimbursement of the appeal fee*

The board finds the appeal to be allowable. Moreover, reimbursement of the appeal fee is equitable by reason of a substantial procedural violation (see point 2.3 above). Therefore, in application of Rule 67 EPC 1973, the board orders the reimbursement of the appeal fee.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The request for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:



L. Malécot-Grob

P. Lanz

Decision electronically authenticated