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**Datasheet for the decision
of 31 March 2021**

Case Number: T 0014/18 - 3.2.07

Application Number: 12185205.7

Publication Number: 2572802

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Language of the proceedings: EN

Title of invention:

Spreading a viscous masking ink on a press plate by use of a heater

Patent Proprietor:

KINGS MOUNTAIN INTERNATIONAL INC.

Opponent:

HUECK Rheinische GmbH

Headword:

Relevant legal provisions:

EPC Art. 113, 116, 123(2)
RPBA 2020 Art. 12(8), 15(1), 15(3)

Keyword:

Amendments - added subject-matter (yes)

Oral proceedings - withdrawal of request for oral proceedings

Decisions cited:

Catchword:



Beschwerdekammern

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Chambres de recours

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Case Number: T 0014/18 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 31 March 2021

Appellant:

(Opponent)

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Respondent:

(Patent Proprietor)

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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted on
26 October 2017 concerning maintenance of the
European Patent No. 2572802 in amended form.**

Composition of the Board:

Chairman

I. Beckedorf

Members:

A. Cano Palmero

A. Pieracci

Summary of Facts and Submissions

- I. The opponent lodged an appeal in the prescribed form and within the prescribed time limit against the decision of the opposition division to maintain European patent No. 2 572 802 in amended form on the basis of the main request.
- II. The opponent (appellant) requested
- that the decision be set aside and
that the patent be revoked in its entirety.
- III. The patent proprietor (respondent) requested
- that the appeal be dismissed, *i.e.* that the patent be maintained according to the set of claims of the main request which the opposition division held to meet the requirements of the EPC (main request),
or, in the alternative,
when setting the decision under appeal aside,
that the patent be maintained in amended version according to one of the set of claims re-filed as auxiliary requests 1 to 6 with the reply to the statement setting out the grounds of appeal.
- IV. With a communication pursuant to Article 15(1) RPBA 2020 of 5 November 2020, the Board informed the parties of its preliminary assessment of the factual and legal situation, according to which the appeal was likely to be allowed.

Neither the appellant nor the respondent reacted in substance to the Board's preliminary opinion.

V. With letter of 23 December 2020, the respondent withdrew its request for oral proceedings and requested a final decision on the appeal under Article 12(8) RPBA 2020.

VI. **Claim 1 of the main request**, which was held by the opposition division to meet the requirements of the EPC, and on which the present decision and the decision under appeal are based, reads as follows:

"A method for creating a textured press plate by applying radiation-curable ink on the press plate comprising:

dispensing radiation-curable ink (321,421) onto a surface of a substrate (310,410), wherein the substrate is the press plate, wherein the ink at least partially gels after the ink comes into contact with the press plate, wherein the press plate is a metallic press plate;

heating the at least partially gelled ink such that the ink spreads to increase a surface area of the press plate covered by the ink;

irradiating the ink (321,421) such that the ink is at least partially cured, wherein the irradiating occurs after the spreading;

wherein the ink acts to resist a chemical, the method further comprising:

etching the surface of the press plate by exposing the surface to a chemical solution, wherein the etching occurs in portions of the surface not covered by ink after the irradiating, thereby creating the textured press plate."

VII. **Claim 1 of the auxiliary request 1**, is identical to claim 1 of the main request.

- VIII. **Claim 1 of the auxiliary request 2** has been amended with respect to claim 1 of the main request by replacing the feature *"irradiating occurs after the spreading"* with the feature *"irradiating occurs no later than approximately 1.5 seconds after dispensing the ink"*.
- IX. **Claim 1 of the auxiliary request 3** has been amended with respect to claim 1 of the main request to further recite that *"heating the at least partially gelled ink to approximately 65-75 degrees Celsius"*.
- X. **Claim 1 of the auxiliary request 4** has been amended with respect to claim 1 of the main request to further recite that the ink spreads to increase the surface area of the press plate covered by the ink *"by approximately 15-20%"*.
- XI. **Claim 1 of the auxiliary request 5** has been amended with respect to claim 1 of the auxiliary request 4 by replacing the feature *"irradiating occurs after the spreading"* with the feature *"irradiating occurs no later than approximately 1.5 seconds after the ink is dispensed"*.
- XII. **Claim 1 of the auxiliary request 6** has been amended with respect to claim 1 of the main request to read heating *"using a heater"* and to further recite *"wherein the heater is configured to melt the at least partially gelled ink in less than 1 second"*.
- XIII. Since the present decision is based on claim 1 of the main and auxiliary requests, there is no need to reproduce the content of the other independent claims here.

- XIV. The parties' arguments relevant to the decision are those relating to the compliance of Article 123(2) EPC of claim 1 as maintained by the opposition division and of auxiliary requests 1 to 6 and are discussed in detail in the reasons for the decision.

Reasons for the Decision

1. *Transitional provisions - Revised Rules of Procedure of the Boards of Appeal (RPBA 2020)*

The appeal proceedings are governed by the revised version of the Rules of Procedure which came into effect on 1 January 2020 (Articles 24 and 25(1) RPBA 2020), with the exception of Article 12(4) to (6) RPBA 2020 instead of which Article 12(4) RPBA 2007 remains applicable (Article 25(2) RPBA 2020).

2. *Procedural matters - Article 12(8) RPBA 2020*

- 2.1 The case is ready for decision which is taken in written proceedings without holding oral proceedings in accordance with Article 12(8) RPBA 2020 and with Articles 113 and 116 EPC.

- 2.2 The appellant's request for oral proceedings pursuant to Article 116(1) EPC is auxiliary to its main request that the decision under appeal be set aside and that the patent is revoked. Since the appellant's main request is allowed by the Board, its auxiliary request for oral proceedings remains procedurally inactive.

- 2.3 The respondent, after having received the Board's communication pursuant to Article 15(1) RPBA 2020,

withdrew its request for oral proceedings and explicitly requested a final decision on the appeal be taken under Article 12(8) RPBA 2020. Hence the respondent chose to rely on its written submissions only. The principle of the right to be heard pursuant to Article 113(1) EPC is observed since that provision only affords the opportunity to be heard and the party's submissions are fully taken into account (see Case Law of the Boards of Appeal, 9th edition 2019, III.B.2.7.3 and V.A.4.5.3).

- 2.4 As a consequence, the Board is in a position to take the final decision on the basis of the contested decision to be reviewed and the extensive written submissions of the parties (Article 15(3) RPBA 2020), while preserving their rights under Articles 113 and 116 EPC, so that the oral proceedings are cancelled.

3. The reasons for the decision given below correspond to the Board's preliminary opinion provided in the communication pursuant to Article 15(1) RPBA 2020. Said opinion neither has been subsequently commented on nor has it been contested by the parties, in particular by the respondent.

Under these circumstances, the Board - having once again taken into consideration all the relevant aspects put forward in the parties' written submissions - sees no reason to deviate from its above-mentioned preliminary opinion and confirms it.

4. *Main request - patent as maintained by the opposition division - added subject-matter, Article 123(2) EPC*

- 4.1 As mentioned and discussed in the Board's communication pursuant to Article 15(1) RPBA 2020 (point 6), the

appellant argues that claim 1 according to the main request includes *inter alia* the new feature (identified as feature 1.5 by the respondent with emphasis added by the Board):

"wherein the ink **at least partially gels** after the ink comes into contact with the press plate".

- 4.2 According to the appellant, this feature can only be found in paragraph [0016] of the original description, which forms the basis of the original claim 16 and claim 15 as granted. The rest of the features of claim 1 have been extracted from paragraphs [0022] and [0029], but a disclosure of a single embodiment with all the method steps of claim 1 is not originally disclosed.
- 4.3 In point 2.4.3.2 of the decision under appeal, the opposition division found that from the wording of the introductory part of paragraph [0016], that "Still other embodiments of the present invention provide (...)" it is clear that "the method steps are disclosed, not just for a specific embodiment but as possible embodiments of the invention.". The respondent also shares this view.
- 4.4 The Board cannot follow this reasoning and is of the view that the subject-matter of **claim 1 of the main request does not meet the requirements of Article 123(2) EPC**. It is established jurisprudence of the Boards of Appeal that a combination of features pertaining to different separate embodiments, and in the absence of any pointer or indication for such a particular combination, is not directly and unambiguously disclosed for the skilled person, see Case Law of the Boards of Appeal, *supra*, II.E.1.6.1.

Indeed, the Board is convinced that the introductory wording of the paragraph [0016] does not justify the extraction of a single method step pertaining to that embodiment and combining it with the rest of the features pertaining to other embodiment(s) such as paragraph [0014] of the description or original claim 1. There is furthermore no apparent indication in the original disclosure that could justify such a particular combination of method steps, so that a combination of features pertaining to different embodiments contrary to the requirements of Article 123(2) EPC is present.

- 4.5 The respondent additionally relies on paragraphs [0022], [0029] and [0044] of the application as originally filed as basis for feature 1.5. The Board however follows the argument of the appellant (see page 3, penultimate paragraph and page 4, penultimate paragraph of the statement of grounds of appeal) and notes that the paragraphs indicated by the respondent describe a gelling/solidification process of the ink by coming into contact with the press plate after being dispensed from the ink dispenser, while claim 1 as maintained by the opposition division requires that the ink **at least partially gels**, covering thereby not only that the ink gels completely after contacting the press plate, but also the possibility that the ink maintains a mixed liquid/gel state. This possibility is not directly and unambiguously derivable from these paragraphs and as such they cannot be considered as a valid basis for amended feature 1.5.

5. *Auxiliary requests 1 to 6 - Claim 1. Amendments,
Article 123(2) EPC*

The Board noted under point 7 of its communication pursuant to Article 15(1) RPBA 2020 that the same Article 123(2) EPC deficiencies of point 4 above apply *mutatis mutandis* to the subject-matter of claim 1 of the **auxiliary requests 1 to 6**, so that these requests **do not meet the requirements of Article 123(2) EPC**.

6. *Conclusion*

It follows that the appellant has provided convincing arguments that demonstrate the incorrectness of the contested decision as regards the maintenance of the patent in amended form according to the main request, which does not meet the requirements of Article 123(2) EPC. The auxiliary requests 1 to 6 do not comply with provisions of Article 123(2) EPC either. Hence, the decision under appeal shall be set aside and in the absence of any in its substance allowable request the patent shall be revoked.

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:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated