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**Datasheet for the decision
of 10 May 2022**

Case Number: T 0345/18 - 3.2.05

Application Number: 12007228.5

Publication Number: 2583828

IPC: B41F11/02

Language of the proceedings: EN

Title of invention:

Combination printing press

Patent Proprietor:

Komori Corporation

Opponent:

KBA-NotaSys SA

Relevant legal provisions:

EPC Art. 56, 100(a), 108 sentence 3

EPC R. 99(2)

RPBA Art. 12(4)

Keyword:

Admissibility of the appeal (yes)

Inventive step (yes: main request)

Late-filed document - admitted (no)

Decisions cited:

T 0162/97, T 0573/09, T 2556/16



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Case Number: T 0345/18 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 10 May 2022

Appellant:

(Opponent)

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(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 12 December
2017 rejecting the opposition filed against
European patent No. 2583828 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman P. Lanz
Members: O. Randl
T. Karamanli

Summary of Facts and Submissions

I. The opponent filed an appeal against the opposition division's decision to reject the opposition against European patent No. 2 583 828 ("the patent").

II. Among the documents considered by the opposition division, the following are relevant to the appeal proceedings:

D1: JP 2003-127321 A
D2: EP 0 343 107 A2
D3: EP 0 351 366 A2
D4: US 5,555,804
D5: JP 2004-034641 A
D7: WO 2007/042919 A2

The opponent (now: appellant) had requested that the opposition division admit document D9 (US 6,772,709 B2), but later withdrew its request (see point 5 of the minutes of the oral proceedings before the opposition division).

III. In a communication under Article 15(1) RPBA 2020, the board gave its preliminary opinion.

IV. Oral proceedings before the board were held on 10 May 2022.

V. The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested that the appeal be rejected as inadmissible (main request) or,

alternatively, that the appeal be dismissed (first auxiliary request), or that the decision under appeal be set aside and the patent be maintained as amended on the basis of the claims of auxiliary request 1 filed by letter dated 29 May 2018 (second auxiliary request), or auxiliary request 2 filed by letter dated 29 May 2018 (third auxiliary request), or auxiliary request 3 filed by letter dated 29 May 2018 (fourth auxiliary request) or auxiliary request 4 filed by letter dated 29 May 2018 (fifth auxiliary request).

VI. Claim 1 of the patent as granted reads (the feature references used by the opposition division have been added in square brackets):

"1. [F1] A combination printing press including:
[F2] a collect-printing unit (2) including
[F3] a collect-printing subunit (17) and
[F4] a movable inking unit (19),
[F5] the collect-printing subunit (17) having a plurality of pattern plate cylinders (12),
[F6] a collecting blanket cylinder (13) with which the plurality of pattern plate cylinders (12) are in contact and [F7] which has a diameter not less than two times of those of the pattern plate cylinders (12),
[F8] a collecting plate cylinder (14) being in contact with the collecting blanket cylinder (13),
[F9] a blanket cylinder (15) being in contact with the collecting plate cylinder (14), and
[F10] an impression cylinder (16) being in contact with the blanket cylinder (15),
[F11] the movable inking unit (19) supporting a plurality of inking devices (18) and
[F12] being movably supported so as to make the plurality of inking devices (18) capable of moving toward and away from the pattern plate cylinders (12),

[F13] the plurality of inking devices (18) being provided respectively for the plurality of pattern plate cylinders (12) and configured to supply ink to the pattern plate cylinders (12); and

[F14] an offset printing unit (3) configured to perform offset printing on a sheet subjected to the collect-printing by the collect-printing unit (2), the combination printing press characterized in that

[F15] the collect-printing unit (2) has the movable inking unit (19) disposed below a sheet transport route, and [F16] is configured to perform collect-printing on a lower surface of the sheet,

[F17] the offset printing unit (3) includes a lower surface offset printing subunit (3a to 3d) configured to perform offset printing on the lower surface of the sheet, [F18] the lower surface offset printing subunit (3a to 3d) having a plate cylinder (24),

[F19] a blanket cylinder (21) being in contact with the plate cylinder (24),

[F20] an impression cylinder (22) being in contact with the blanket cylinder (21) [F21] and having a diameter which is two times of that of the plate cylinder (24), and [F22] an ink supply unit (23) configured to supply ink to the plate cylinder (24), and

[F23] the impression cylinder (16) of the collect-printing subunit (17) and the impression cylinder (22) of the lower surface offset printing subunit (3a) are connected by a single transport cylinder (20)."

VII. The relevant arguments of the parties may be summarised as follows:

(a) Admissibility of the appeal

(i) Respondent (patent proprietor)

The appeal should be rejected as inadmissible. The statement of grounds of appeal filed by the opponent does not sufficiently address the decision of the opposition division. It does not include any submissions in response to the grounds for the decision under appeal, nor any submissions regarding the causal relationship between the reasons given in the statement of grounds of appeal and the asserted invalidity of the findings of the opposition division. The statement of grounds of appeal merely includes some vague and very general statements with respect to inventive step of the subject-matter of claim 1 of the opposed patent. These statements are based only on document D9, which was withdrawn by the opponent during the oral opposition proceedings, and on documents D4 and D3. It is not apparent from the statement of grounds of appeal why the decision under appeal was wrong and should be set aside. Moreover, the statement of grounds of appeal does not include any statements regarding the auxiliary requests.

(b) Admittance of document D9

(i) Appellant (opponent)

Document D9 should be admitted into the proceedings.

(ii) Respondent (patent proprietor)

Document D9 was first filed by the opponent ten months after receipt of the summons to oral proceedings before the opposition division, one month before the date of the oral proceedings, without any comments. Its filing was not triggered by amendments to the claims on file. During the oral opposition proceedings, the opponent withdrew its request to admit document D9 into the proceedings (see point 7 of the Facts and submissions of the decision under appeal). Consequently, the document was not discussed during the oral proceedings. The document was filed afresh together with the statement of grounds of appeal. It should not be admitted as it was late filed (Article 114(2) EPC and Article 12(4) RPBA).

(c) Inventive step, starting from document D4

(i) Appellant (opponent)

The subject-matter of claim 1 would have been obvious to the skilled person in view of the combination of documents D4 and D3 in the light of the common general knowledge.

Claim 1 concerns a combination printing press with two offset printing units, one of which is configured as a collect-printing unit. The purpose of the invention is to improve the operability and printing quality of a combination printing press (see paragraphs [0008] and [0016] of the patent).

Differences

The subject-matter of document D4 differs from claim 1 of the patent in suit only in that no collect-printing unit is provided in document D4.

Objective technical problem

The advantage of a collect-printing unit is that it offers higher register accuracy. Another advantage is that colours could be applied one after the other.

Starting from document D4, the skilled person was faced with the task of increasing the register accuracy and/or reducing the size of the printing press (see paragraphs [0007] and [0008] of the patent).

When asked by the board whether this objective technical problem was necessarily solved by the distinguishing features, the appellant reformulated the objective technical problem as being either improving the register accuracy [if more than one offset printing unit is replaced] or increasing the number of colours [if only one offset printing unit is replaced].

Obviousness to the skilled person

The claimed solution to the objective technical problem (i.e. to use a collect-printing unit) was suggested to the person skilled in the art by the common general knowledge (as evidenced for example by document D3). The patent itself states that collect-printing units are part of the skilled person's common general knowledge (see paragraph [0003] of the patent). If the skilled person had wished to eliminate register errors which are due to the plurality of printing units, they

would have used a collect-printing process. This process is described in document D3, which discloses a collect-printing unit (Fig. 3, col. 6, line 21 to col. 7, line 53) and explains how this can be put into practice. Providing such a collect-printing unit with its transfer cylinder 34 instead of the printing units 6a of document D4 did not involve any inventive step. All that needed to be done was to replace or adapt one of the printing units of document D4. There were two possibilities:

- The rubber cylinder of the printing unit 6a could be replaced by the elements including the rubber cylinder 34 [sic] and the plate cylinder 10 of Fig. 6 of document D3. For this purpose, the blanket cylinder 34 of document D3 is placed against the impression cylinder 12a of document D4.
- Alternatively, it was possible to start from Fig. 3 of document D3. The plate cylinder 10 bears the printing plate with all the image elements. The plate cylinders 7 do not bear printing plates but only templates (*Schablonen*). They can be understood as parts of a complex inking unit. The plate cylinder 10 is a regular plate cylinder such as the one used in printing unit 6a of document D4.

The replacement of one printing unit by a collect-printing unit would not have led the skilled person to discard all the other printing units because there is a need for special colours provided by dedicated printing units.

Therefore the subject-matter of claim 1 of the patent as granted does not involve an inventive step.

(ii) Respondent (patent proprietor)

Differences

Document D4 describes printing presses configured to perform offset printing on both surfaces of a paper sheet. In contrast, the invention according to present claim 1 is capable of performing both collect-printing and offset printing on the lower surface of a sheet, and differs from the disclosure of document D4 in the first place in terms of technical contents such as the scheme of printing. In the embodiments of Figs. 3 or 4 of document D4 there is no transfer cylinder, but only impression cylinders 12a to 12d and 11a to 11d. If one of these cylinders is taken out, a transfer cylinder is lacking.

Objective technical problem

The problem mentioned in the patent is not suitable because it was defined in view of document D1 rather than document D4.

When asked by the board how the objective technical problem should be defined in view of document D4, the respondent explained that there was no reason why the machine of document D4 should be modified. Not even the appellant had explained what problem was solved when document D4 was used as the starting point. As there are no transfer cylinders in the machine of document D4, register accuracy is not a problem.

Obviousness to the skilled person

Document D4 does not contain anything that suggested the invention according to claim 1. Fig. 4 shows a

machine that already offers all that is needed. There is no reason why the skilled person would have replaced one of the printing units with a collect-printing unit. If the skilled person had seen a need for more colours, they would have added further offset printing units. There is no manifest reason why the skilled person would have contemplated a combination of documents D4 and D3. The appellant's inventive-step objection is based on hindsight.

Reasons for the Decision

1. Admissibility of the appeal

- 1.1 For the appeal to be admissible it must, *inter alia*, meet the requirements of Article 108, third sentence, EPC and Rule 99(2) EPC.

Rule 99(2) EPC provides that in the statement of grounds of appeal the appellant must indicate the reasons for setting aside the decision impugned, or the extent to which it is to be amended and the facts and evidence on which the appeal is based.

It is an established general principle that the grounds of appeal should specify the legal or factual reasons on which the case for setting aside the decision is based. The arguments must be clearly and concisely presented to enable the board to understand immediately why the decision is alleged to be incorrect, and on what facts the appellant bases its arguments, without first having to make investigations of its own (see "Case Law of the Boards of Appeal of the European Patent Office", 9th edition, 2019, V.A.2.6.3 a), and

the cases cited therein, see in particular T 573/09, Reasons, point 1.1).

The examination of whether the requirements of Article 108, third sentence, and Rule 99(2) EPC are met has to be made on the basis of the statement of grounds of appeal and of the reasons given in the contested decision (see T 162/97, Reasons, point 1.1.2; T 2556/16, Reasons, point 4).

1.2 In the decision under appeal, the opposition division found the subject-matter of claim 1 of the patent as granted to be new over the disclosure of document D1 (see point 2.1 of the grounds for the decision under appeal). The opposition division then determined all the features that distinguished the subject-matter of granted claim 1 from the disclosure of documents D1 to D4 and D7. It established that neither of the most relevant documents D1 and D7 disclosed features F15 and F16, and found the subject-matter of granted claim 1 to involve an inventive step because:

- none of documents D1 to D4 disclosed features F17 to F23,
- the skilled person starting from document D4 would not have been led to the claimed invention by document D3 (and in particular its Fig. 3)
- the combination of documents D1 to D4 and D7 would not have led the skilled person to the invention in an obvious way either (see point 2.2.5 of the grounds for the decision under appeal).

1.3 In its statement of grounds of appeal, the appellant:

- requested that document D9, and the English translations of documents D1 and D5 filed by letter dated 7 February 2018, be admitted,
- argued that granted claim 1 differed from the disclosure of documents D4 and D9 only in that a collect-printing unit was included in the press, and that this feature was obvious to the skilled person in view of the common technical knowledge in the relevant technical field. Document D3 was cited as evidence for this common technical knowledge.

There was one objection that was examined by the opposition division and raised again in the statement of grounds of appeal, namely the objection that a combination of documents D4 and D3 would have led the skilled person to the invention in an obvious way.

It is true that the statement of grounds of appeal is very concise and does not explicitly refer to the grounds for the decision under appeal. However, it is clear from the statement of grounds of appeal that the appellant disagreed with the opposition division's conclusion on the objection based on the combination of documents D4 and D3 and why the appellant believed the subject-matter of granted claim 1 to be obvious over this particular combination of documents.

1.4 The board is satisfied that the opponent's statement of grounds of appeal enables the board to establish the reasons why the decision under appeal is alleged to be incorrect. Therefore, the statement of grounds of appeal complies with Article 108, third sentence, and Rule 99(2) EPC. Since it is uncontested that the further admissibility requirements set out in

Articles 106 to 108 EPC and Rules 97 and 99(1) (b) and (c) EPC are met, the appeal is admissible.

2. Admittance of document D9

The appellant filed document D9 together with its statement of grounds of appeal.

In the case in hand, the statement of grounds of appeal was filed before the date on which the revised version of the Rules of Procedure of the Boards of Appeal (RPBA 2020) entered into force, i.e. 1 January 2020 (see OJ EPO 2021, A35). Thus, pursuant to Article 25(2) RPBA 2020, Article 12(4) to (6) RPBA 2020 does not apply. Instead, Article 12(4) of the Rules of Procedure of the Boards of Appeal in the version of 2007 (RPBA 2007 - see OJ EPO 2007, 536) continues to apply.

Document D9 was first filed on 23 October 2017, about ten months after the opposition division had summoned the parties to oral proceedings to be held on 23 November 2017 (summons dated 21 December 2016). The appellant (then: opponent) requested that the document be admitted because of its relevance to the assessment of inventive step. The appellant also stated that a parallel US patent application had been rejected in view of this document in combination with document D3 (see penultimate paragraph on page 1 of the opponent's written submission dated 23 October 2017).

According to point 5 of the minutes of the oral proceedings before the opposition division, the correctness of which was not contested, the request that document D9 be introduced into the proceedings was withdrawn during the oral proceedings.

The appellant has not provided any justification for the requested introduction of document D9 at the appeal stage other than the relevance of the document to the examination of the inventive step involved in the subject-matter of claim 1.

By withdrawing its request for document D9 to be admitted during the oral proceedings before the opposition division, the opponent (now: appellant) prevented the opposition division from deciding on the objection based on that document. Consequently, the board exercised its discretion under Article 12(4) RPBA 2007 and decided not to admit document D9 into the appeal proceedings.

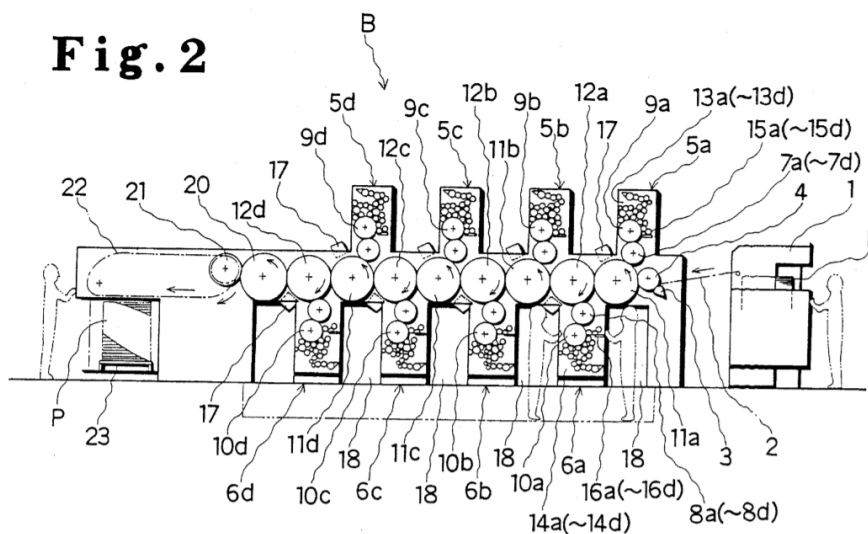
3. Claim interpretation: "collect-printing unit"

Paragraph [0003] of the patent explains the concept of collect-printing (in German: *Sammeldruck*) as follows:

*"The collect-printing is a printing method in which inks in several different colors are attached onto pattern plate cylinders, respectively, collected on a single collecting blanket cylinder, and transferred onto a collecting plate cylinder, and then multi-color printing is performed on a sheet by the collecting plate cylinder at once. The collect-printing is also referred to as *Sammel* printing. The collect-printing has a great counterfeit prevention effect, because the collect-printing has such a characteristic that no registration error occurs at all, when the color is changed in an image."*

4. Inventive step starting from document D4

Document D4 discloses offset printing machines capable of printing on both surfaces of a sheet through a single sheet feeding operation (see col. 1, lines 7 to 12). The disclosed devices (see Fig. 2 reproduced below) comprise a plurality of top surface printing units 5a to 5d and a plurality of back surface printing units 6a to 6d. The top surface printing units and the back surface printing units are alternately arranged in adjacent pairs with their respective impression cylinders in contact with each other such that a line connecting the axes of each impression cylinder extends horizontally to transfer the sheet from the top to the back surface printing unit (see claim 1).



4.1 Differences

In point 2.2.3 of the grounds for the decision under appeal, the opposition division analysed document D4 as follows:

"D4 (the references in parentheses applying to this document) discloses an offset printing press (col. 3, l. 66 - col. 4, l. 51; fig. 2) comprising several offset printing units (5a-5d; 6a-6d), wherein at least four offset printing units (6a-6d) are disposed below a sheet transport path, wherein at least an offset printing unit (6b-6d) is configured to perform offset printing on a lower surface of a sheet subjected to offset printing by at least an offset printing unit (6a), and wherein impression cylinders (12a; 12b-12d) of said offset printing units (6a; 6b-6d) are connected by a single transport cylinder (11b; 11c; 11d). A collect printing unit is however not disclosed in D4. Thus, an offset printing unit configured to perform offset printing on a sheet subjected to collect-printing by a collect-printing unit is also not disclosed in D4.

The subject-matter of claim 1 as granted **differs** therefore from the disclosure of D4 in that the printing press is merely an offset printing press (not a combination printing press) including several offset printing units configured to perform offset printing on sheet substrate. In other words, none of the features F1-F23 of granted claim 1 of the opposed patent is disclosed in D4."

(underlining and bold lettering as in the original)

The appellant argued that the subject-matter of document D4 differs from claim 1 of the patent in suit only in that no collect-printing unit is provided in document D4. However, the relevant question is not how document D4 differs from claim 1, but how the subject-matter of claim 1 differs from the disclosure of document D4.

Document D4 does not disclose a combination printing press including a collect-printing unit. Therefore at least features F2 to F13 and F23 are not disclosed.

4.2 Objective technical problem

The opposition division did not consider document D4 to be the most promising springboard for examining inventive step. Consequently, it did not formulate any objective technical problem in view of this document.

The precise definition of the objective technical problem was discussed in detail during the oral proceedings before the board. When faced with the board's objection that the objective technical problem originally proposed by the appellant (improving register accuracy) was solved by the distinguishing features only if specific assumptions were made (i.e. that more than one printing unit of the machine disclosed in document D4 was replaced by a collect-printing unit), the appellant reformulated the objective technical problem as an alternative: improving the register accuracy [if more than one offset printing unit is replaced] or increasing the number of colours [if only one offset printing unit is replaced].

This formulation is not satisfactory because it depends on the solution contemplated. The application of the problem-solution approach using an objective technical problem involving alternatives based on the type of solution chosen would involve circular reasoning, so the validity of its conclusion would be doubtful. Therefore the board cannot endorse the appellant's formulation of the objective technical problem.

Moreover, there is no other objective technical problem solved by the distinguishing feature that would have been self-evident to the skilled person.

Even if one were to consider the alternative aspects of the technical problem proposed by the appellant separately (i.e. improving the register accuracy, increasing the number of colours) and take into account paragraph [0003] of the patent specification, it would not be apparent why the skilled person, without hindsight, would have considered to fundamentally change the offset printing machine of document D4 and replace one or more of the horizontally aligned offset printing units with the collect-printing unit known from the arrangement of document D3. Such a reconfiguration would have required substantial structural design modifications going beyond mere routine measures.

It follows that the appellant has not made a convincing case that the subject-matter of claim 1 lacks inventive step in view of documents D3 and D4 in the light of the skilled person's common general knowledge. The appellant's objection that the skilled person starting from document D4 would have combined its teaching with the teaching of document D3 in the light of the common general knowledge is based on mere assertions, the merits of which are not apparent to the board.

Consequently, the board concludes that the appellant has not demonstrated that the subject-matter of claim 1 would have been obvious to the skilled person.

It follows that the ground for opposition under Articles 100(a) and 56 EPC does not prejudice maintenance of the patent as granted, so that the appeal has to be dismissed.

Order

For these reasons it is decided that:

1. The appeal is admissible.
2. The appeal is dismissed.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated