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**Datasheet for the decision
of 28 October 2022**

Case Number: T 0436/18 - 3.2.05

Application Number: 07015018.0

Publication Number: 1886811

IPC: B41F11/00

Language of the proceedings: EN

Title of invention:

Intaglio printing press

Patent Proprietor:

Komori Corporation

Opponent:

KBA-NotaSys SA

Relevant legal provisions:

EPC Art. 100(c), 123(2)

RPBA 2020 Art. 13(2)

Keyword:

Added matter (yes: main request and auxiliary requests 1 to 4)
Admittance of auxiliary requests 5 to 8 (no)



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Case Number: T 0436/18 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 28 October 2022

Appellant: Komori Corporation
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 12 December
2017 revoking European patent No. 1886811
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman T. Vermeulen
Members: O. Randl
A. Bacchin

Summary of Facts and Submissions

- I. The patent proprietor appealed against the decision of the opposition division to revoke European patent No. 1 886 811 ("the patent").
- II. The opposition division had decided that neither the main request (patent as granted) nor the second auxiliary request on file met the requirements of Article 123(2) EPC and that the subject-matter of the first auxiliary request on file was obvious in view of the state of the art.
- III. By letter dated 1 July 2021, the board summoned the parties to oral proceedings scheduled to take place on 28 October 2022.
- IV. On 22 August 2022, the board issued a communication pursuant to Article 15(1) RPBA 2020.
- V. Oral proceedings before the board took place on 28 October 2022.
- VI. The appellant (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained as granted (main request), or in amended form based on the claims of one of auxiliary requests 1 to 4 filed with its statement of grounds of appeal or, alternatively, in amended form on the basis of one of auxiliary requests 5 to 8, filed with letter of 28 September 2022.
- VII. The respondent (opponent) requested that the appeal be dismissed.

VIII. Claim 1 of the patent (main request) reads as follows (the feature references used by the board have been added in square brackets):

"1. [1] An intaglio printing press comprising:
[2] a first intaglio printing unit (30), which performs intaglio printing on one surface of a sheet (1);
[3] first drying means (71A to 71C), which dries the one surface of the sheet (1), on which intaglio printing is performed by the first intaglio printing unit (30);
[4] a second intaglio printing unit (50), which performs intaglio printing on the sheet (1) having been dried by the first drying means (71A to 71C); and
[5] printing surface switching means (40), which transfers the sheet (1) from the first intaglio printing unit (30) to the second intaglio printing unit (50) in a manner that a surface of the sheet (1) on which the second intaglio printing unit (50) performs intaglio printing can be switched between any one of the one surface and the other surface of the sheet (1),
[6] wherein each of the first intaglio printing unit and the second intaglio printing unit includes an impression cylinder (32, 36, 52),
[7a] wherein each of the first intaglio printing unit and the second intaglio printing unit includes:
[7b] an intaglio cylinder (33, 37, 53), which is in contact with the impression cylinder (32, 36, 52), and which performs printing on the sheet held by the impression cylinder (32, 36, 52);
[7c] an inking device (34, 38, 56a to 56d) which supplies ink to the intaglio cylinder (33, 37, 53); and
[7d] any one of a doctor (34a, 38a) and a wiping device (58), which scrapes excess ink adhering on a surface of the intaglio cylinder (33, 37, 53);

characterized in that

[8] the printing surface switching means includes a convertible cylinder (44), and

[9] the first drying means is a dryer (71A to 71C), which is arranged to face the impression cylinder (32, 36) or a transfer cylinder (42), and which dries the sheet held and transported by the impression cylinder or the transfer cylinder."

Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that the words "and a transport cylinder (43)" have been added to feature 8 (feature 8').

Claim 1 of auxiliary request 2 differs from claim 1 of the main request in that the words "and a suction cylinder (43)" have been added to feature 8 (feature 8").

Claim 1 of auxiliary request 3 differs from claim 1 of auxiliary request 1 in that feature 9 has been replaced by the feature "[9'] the first drying means is constituted by dryers (71A to 71C), which are arranged to face the impression cylinders (32, 36) and a transfer cylinder (42), and which dry the sheet held and transported by the impression cylinders and the transfer cylinder" (changes with respect to feature 9 have been underlined.)

Claim 1 of auxiliary request 4 differs from claim 1 of auxiliary request 2 in that feature 9 has been replaced by feature 9'.

Claim 1 of auxiliary requests 5 to 8 differs from claim 1 of auxiliary requests 1 to 4, respectively, in that the feature "wherein the convertible cylinder (44)

grips the back edge portion of the sheet (1) transported from the first intaglio printing unit (30) with the forward edge portion of the sheet (1) being held so as to transfer the sheet (1) while turning over the sheet (1), and alternatively grips the forward edge portion of the sheet (1) transported from the first intaglio printing unit (30) with the forward edge portion of the sheet (1) being held so as to transfer the sheet (1) while not turning over the sheet (1)" has been added at the end of features 8' and 8", respectively.

IX. The relevant arguments of the parties can be summarised as follows.

**(a) Main request and auxiliary requests 1 to 4:
compliance with Article 123(2) EPC**

(i) Appellant (patent proprietor)

As disclosed on page 6, lines 15 to 27, of the application as originally filed, the printing surface switching means of the intaglio printing press includes a convertible cylinder. According to page 7, lines 1 to 15, of the original application, the intaglio printing press also has the additional features that the printing surface switching means includes a transport cylinder, which can be a suction cylinder. Thus, the transport cylinder and the suction cylinder, respectively, are merely preferred features. Consequently, it is originally disclosed that the switching means includes a convertible cylinder 44 and may additionally include, as a preferred embodiment, a transport cylinder 43. However, the transport cylinder 43 does not have to be a suction cylinder, see also the passage extending from page 12, line 24, to page 13, line 2. It is also clear from Fig. 1 that the

convertible cylinder 44 interacts not only with the transport cylinder 43, but also with a transfer cylinder 51 at a position downstream of the convertible cylinder 44 - see page 13, lines 24 to 27, of the original application. In summary, the application as originally filed discloses that the convertible cylinder 44 is located between transport/transfer cylinders, i.e. between the transport cylinder 43 and the transfer cylinder 51, wherein the transport cylinder 43 may be a suction cylinder, see also original claims 12 and 13. Dependent claim 12 defines that the printing surface switching means 40 includes, in addition to the convertible cylinder 44, a transport cylinder 43; and claim 13 defines that the transport cylinder 43 is a suction cylinder 43. Thus, the convertible cylinder 44 and the transport cylinder 43 are not inextricably linked to one another. Further, the transport cylinder may be realised as a suction cylinder. It follows that the convertible cylinder 44 is also not inextricably linked to the suction cylinder 43 as was alleged by the opposition division.

The function and purpose of the "convertible cylinder" is clear not only from the term "convertible", but also from the definition of the printing surface switching means (feature 5 of claim 1). The "convertible cylinder" of the printing surface switching means grips either the back edge portion or the forward edge portion of the sheet transported from the first intaglio printing unit while the sheet is (or is not) turned over such that a surface of the sheet on which the second intaglio printing unit performs intaglio printing can be switched between one and the other surface of the sheet. It is not necessary to explain how a device functions if the device as such is known to the skilled person. The expression "convertible

cylinder" is sufficient in this respect. Otherwise, it would be necessary to define the function of all the devices that are part of claim 1, such as the inking device or the drying means. This would result in the claims being unduly long. The convertible cylinder of feature 8 in combination with feature 5 is identical to the convertible cylinder disclosed on page 6, lines 15 to 27, of the original application. Consequently, claim 1 of the main request and auxiliary requests 1 to 4 meets the requirements of Article 123(2) EPC.

(ii) Respondent (opponent)

Feature 8 is not disclosed in its generality in the original documents. The appellant refers to page 6, lines 15 to 27, to demonstrate that the "suction cylinder" is an optional feature. However, it should be noted that the introductory part of the description does not support the specific machine of the pre-characterising part of claim 1 as granted (features 6 and 7a: "each of the first intaglio printing unit and second intaglio printing unit includes ..."). Moreover, the exact mode of operation of the "convertible cylinder" is also specified in this passage, which discloses a very special cylinder unrelated to the pre-characterising part of claim 1 as granted. The expression "convertible cylinder" is very generic. For instance, it can designate a movable cylinder. Consequently, the subject-matter of claim 1 of both the main request and auxiliary requests 1 to 4 is inadmissibly broad.

(b) Admittance of auxiliary requests 5 to 8

(i) Appellant (patent proprietor)

The filing of auxiliary requests 5 to 8 was triggered by the board's communication pursuant to Article 15(1) RPBA 2020. In the last paragraph on page 7, the board raised a completely new objection under Article 123(2) EPC. The appellant reacted to this objection in a timely manner by incorporating the allegedly missing features into claim 1 of all the requests on file.

When asked by the board whether the appellant's reaction to the respondent's objection in section 2.1.1 of its reply to the statement of grounds of appeal did not show that it had understood this objection to be that the function of the convertible cylinder was missing from the claim, i.e. the very objection that was allegedly first raised by the board in its communication (see pages 3 and 4 of the appellant's written submission dated 5 February 2019), the appellant declared that a patent proprietor could not react to any arbitrary objection raised by an opponent. The respondent's abstruse assertion that the skilled person did not know what a convertible cylinder was did not justify the filing of auxiliary requests. The assertion only became serious ("ernstzunehmend") when it was taken up by the board in its communication. Thus, the objection had actually been raised before, among a great number of other objections, but the appellant had seen no reason to react to it because it had considered the argument abstruse. The board's preliminary opinion constituted the first relevant indication that the objection was to be taken seriously.

(ii) Respondent (opponent)

Feature 8 had been objected to under Article 100 c) EPC from the very beginning, even during the opposition proceedings. The respondent had argued that the cylinder was not disclosed in this convertible form. The appellant should have filed corresponding requests with its statement of grounds of appeal. The appellant could have foreseen that the claimed combination of features would be found unallowable. In its communication, the board had given a hint as to how this objection could be overcome, but the objection as such was already on file well before that date (see section 2.1.1 of the respondent's reply to the statement of grounds of appeal).

Reasons for the Decision

1. Main request: ground for opposition pursuant to Article 100 c) EPC
- 1.1 Link between the convertible cylinder and suction cylinder

In section 12.1.3 of the decision under appeal, feature 8 was found not to comply with the requirements of Article 123(2) EPC, for the reason set out below:

"The opposition division is of the opinion, that the amendment leading to feature [8] in claim 1 as granted is an intermediate generalisation such as to be found in the Guidelines under H-V 3.2.1. The characteristics "convertible cylinder" and "suction cylinder" within the printing surface

switching means seem to be a combination of features and to have a structural and functional relationship between each other (see page 12, line 10 to page 13, line 23 of the application as filed). The switching means (4) disclose in all four embodiments of the detailed description a convertible cylinder (44) and a suction cylinder (43) as can be seen e.g. in figures 1, 6, 7 and 8. Thus, extracting such a specific feature in isolation from the originally [sic] disclosure may not be used to delimit claimed subject-matter."

The appellant contested that the convertible cylinder 44 and the transport cylinder 43 are inextricably linked to one another and referred to various parts of the application as filed:

- page 6, lines 15 to 27, according to which the printing surface switching means includes a convertible cylinder;
- page 7, lines 1 to 15, according to which the printing surface switching means includes a transport cylinder, which may be a suction cylinder (see page 12, line 24, to page 13, line 2);
- Fig. 1, which shows that the convertible cylinder 44 interacts not only with the transport cylinder 43 but also with a transfer cylinder 51 at a position downstream of the convertible cylinder 44 (see page 13, lines 24 to 27).

The first two passages cited belong to the part of the description reciting the subject-matter of the original claims. They recite the additional features of dependent claims 11 to 13 of the original application. Claim 11 depends on claim 1 and requires that the switching means include a convertible cylinder.

Claim 12 depends on claim 11 and requires that the switching means also include a transport cylinder. Claim 13 depends on claim 12 and requires this transport cylinder to be a suction cylinder. In view of this claim structure, switching means with a convertible cylinder but without a transport cylinder or a suction cylinder are disclosed. Even though the devices shown in Figures 1 and 6 to 8 all have a suction cylinder 43 interacting with the convertible cylinder, the application as filed goes beyond that disclosure. Consequently, the board is unable to confirm that the convertible cylinder 44 and the transport/suction cylinder 43 are inextricably linked to one another. It follows that this objection is unfounded.

1.2 Function of the convertible cylinder

However, feature 8 is not equivalent to the additional feature of original claim 11 or its counterpart on page 6, lines 15 to 27, according to which the convertible cylinder grips the back edge portion of the sheet transported from the first intaglio printing unit with the forward edge portion of the sheet being held so as to transfer the sheet while turning over the sheet, or which alternatively grips the forward edge portion of the sheet transported from the first intaglio printing unit with the forward edge portion of the sheet being held so as to transfer the sheet while not turning over the sheet. According to claim 1 as it stands, the switching means includes any convertible cylinder, and this has no basis in the original application.

The board cannot endorse the appellant's argument that the precise function of the convertible cylinder can be deduced from its designation. In this respect, a "convertible cylinder" is different from an "inking

device" or "drying means", the function of which can indeed be derived from the designation. A "convertible cylinder" can be understood to be a cylinder "capable of being turned into something else; capable of being changed in form, condition, or properties" (Oxford English Dictionary). The nature of the conversion is unspecified. The definition of the printing surface switching means in feature 5 of claim 1 does not provide a description of the precise function of the convertible cylinder either. Feature 8 only requires a convertible cylinder to be included in the printing surface switching means of feature 5.

Therefore, feature 8 introduces subject-matter which extends beyond the content of the application as filed.

In view of this, it is not necessary to examine the other objections under Article 100 c) EPC raised by the respondent.

1.3 Conclusion

The ground for opposition pursuant to Article 100 c) EPC prejudices the maintenance of the patent as granted.

2. Auxiliary requests 1 to 4

Claim 1 of each of auxiliary requests 1 to 4 contains feature 8, which was found to be objectionable under Article 100 c) EPC (see section 1.). None of the other additional features are suitable for overcoming the objection against claim 1 of the main request. Therefore, none of these requests meets the requirements of Article 123(2) EPC. Consequently, it is

not possible to maintain the patent in amended form on the basis of any of auxiliary requests 1 to 4.

3. Admittance of auxiliary request 5

Auxiliary request 5 was filed with a letter dated 28 September 2022, i.e. after notification of the summons to oral proceedings. Consequently, in accordance with Article 25 RPBA 2020, Article 13(2) RPBA 2020 applies in the present case.

According to this provision, "[a]ny amendment to a party's appeal case made ... after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned".

The appellant argued that the exceptional circumstances consisted in the fact that the objection that feature 8 was not equivalent to the feature of original claim 11 or its counterpart on page 6, lines 15 to 27, had been raised for the first time in section 8.1 of the communication pursuant to Article 15(1) RPBA 2020.

The board cannot endorse this argument for the following reasons.

In section 2.1.1 of its reply to the statement of grounds of appeal, the respondent argued that feature 8 was not disclosed in such general terms in the original documents ("*... ist so allgemein in den ursprünglichen Unterlagen nicht offenbart ...*"). The respondent then discussed the disclosure of page 6, lines 15 to 27, and concluded that the exact mode of operation of the "convertible cylinder" is also specified in this

passage ("*Zudem wird dort auch die genaue Funktionsweise des 'convertible cylinder' vorgegeben.*").

The appellant reacted to this argument in section II.1 of its written submission dated 5 February 2019, repeating its assertion that additional optional characteristics of the "printing surface switching means" are disclosed on page 6, lines 15 to 27, of the original application. The appellant went on to say:

"The function and purpose of the "convertible cylinder" is clear not only from the term "convertible", but also from the definition of the printing surface switching means (see feature [5] of claim 1): [...] It is clear from the above explanations that the convertible cylinder as claimed in feature [8] of claim 1 of the Main Request in combination with feature [5] thereof is identical to the convertible cylinder disclosed on page 6, lines 15-27 of the application as originally filed."

It is apparent from this reaction that the appellant understood that the core of the respondent's objection was that feature 8 did not sufficiently disclose the function disclosed on page 6, lines 15 to 27, of the original application. Rather than reacting to the respondent's reply by filing auxiliary requests overcoming this objection, the appellant contented itself with filing counter-arguments.

In section 8.1 of the board's communication pursuant to Article 15(1) RPBA 2020, the board made the following comment:

"However, it should be noted that feature 8 is not equivalent to the additional feature of original claim 11 or its counterpart on page 6, lines 15 to 27, according to which the convertible cylinder grips the back edge portion of the sheet transported from the first intaglio printing unit with the forward edge portion of the sheet being held so as to transfer the sheet while turning over the sheet, or which alternatively grips the forward edge portion of the sheet transported from the first intaglio printing unit with the forward edge portion of the sheet being held so as to transfer the sheet while not turning over the sheet. According to claim 1 as it stands, the switching means includes just any convertible cylinder, and this appears to have no basis in the original application."

This comment is equivalent to the respondent's objection mentioned above, to which the appellant replied in its written submission dated 5 February 2019. Therefore, the assertion that this objection was raised for the first time in the board's communication is incorrect. Consequently, the circumstances of the case do not constitute "exceptional circumstances" within the meaning of Article 13(2) RPBA 2020.

As no other exceptional circumstances were invoked, the board decided not to take into account auxiliary request 5 pursuant to Article 13(2) RPBA 2020.

4. Auxiliary requests 6 to 8

The reasons that led to the board not taking into account auxiliary request 5 also apply to auxiliary

requests 6 to 8, also filed with the letter dated 28 September 2022. Consequently, these requests are not admitted into the appeal proceedings either.

5. Final result

As none of the appellant's requests on file is both admissible and allowable, the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



N. Schneider

T. Vermeulen

Decision electronically authenticated