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**Datasheet for the decision
of 11 February 2022**

Case Number: T 1912/18 - 3.2.07

Application Number: 13711729.7

Publication Number: 2828432

IPC: D21F1/44, D21F9/04

Language of the proceedings: EN

Title of invention:

ELECTROTYPE FOR FORMING AN IMAGE DURING A PAPER MAKING PROCESS

Patent Proprietor:

Portals Paper Limited

Opponent:

ARJOWIGGINS SECURITY

Headword:

Relevant legal provisions:

EPC Art. 54, 56, 113(1), 123(2), 123(3)

EPC R. 100(2)

RPBA 2020 Art. 12(8), 15(3)

Keyword:

Decision in written proceedings without holding oral proceedings

Novelty - after amendment

Inventive step - (yes)

Amendments - allowable (yes)

Decisions cited:

Catchword:



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Case Number: T 1912/18 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 11 February 2022

Appellant: ARJOWIGGINS SECURITY
(Opponent) 32, Avenue Pierre Grenier
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Respondent: Portals Paper Limited
(Patent Proprietor) Overton Mill
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Representative: Boulton Wade Tennant LLP
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 1 June 2018
rejecting the opposition filed against European
patent No. 2828432 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman I. Beckedorf
Members: A. Pieracci
S. Watson

Summary of Facts and Submissions

- I. The opponent (appellant) lodged an appeal in the prescribed form and within the prescribed time limit against the decision of the opposition division to reject the opposition filed against the European patent No. 2 828 432.
- II. The opposition had been filed against the patent as a whole based on the grounds for opposition pursuant to Article 100(a) and (b) EPC (lack of novelty and inventive step, insufficiency of disclosure). The opposition division found that none of the grounds for opposition prejudiced the maintenance of the patent in suit and rejected the opposition.
- III. The initial requests of the appellant were
- that the appealed decision be set aside and
that the patent be revoked,
or in the alternative,
that oral proceedings be arranged.
- IV. The initial requests of the respondent (patent proprietor) were:
- that the appeal be dismissed,
or, in the alternative,
that, when setting the decision aside, the patent
be maintained in amended form according to
auxiliary requests 1 to 5 filed together with the
reply to the statement setting out the grounds of
appeal.

The respondent also requested that oral proceedings be arranged should the appeal not be dismissed.

- V. Observations by a third party were received with letter dated 29 May 2019, *i.e.* after the reply to the statement setting out the grounds of appeal had been filed by the respondent on 4 February 2019.
- VI. The respondent commented on the third party's observations with its letter dated 9 September 2019.
- VII. With letter dated 29 April 2020 the appellant withdrew its request for oral proceedings.
- VIII. With a communication pursuant to Rule 100(2) EPC dated 9 December 2020 the Board communicated its preliminary assessment of the case to the parties. The Board indicated that

the appellant had convincingly shown the incorrectness of the decision under appeal and its underlining reasons in respect of the issue of novelty of the subject-matter of claim 1 of the patent as granted,

and that

the respondent had plausibly shown the allowability of the second auxiliary request,

such that it appeared that the appeal could be allowed in respect of the patent as granted, but that the patent could be maintained in amended form according to the second auxiliary request.

IX. With letter dated 8 February 2021 the respondent replied to the communication of the Board and filed new requests whereby re-ordering the requests so that former auxiliary request 2 became the new main request.

X. The final requests of the appellant are

that the appealed decision be set aside and that the patent be revoked.

XI. The final requests of the respondent are

that the patent be maintained in amended form according to the new main request filed with letter dated 8 February 2021, corresponding to the second auxiliary request filed with the reply to the statement setting out the grounds of appeal, or, in the alternative, that the patent be maintained according to the first or the second auxiliary requests indicated with letter dated 8 February 2021 and corresponding respectively to the main and the first auxiliary requests filed with the reply to the statement setting out the grounds of appeal.

The respondent also requested oral proceedings to be arranged should the Board not envisage maintaining the patent in amended form according to the new main request.

XII. The following documents are referred to in the present decision:

D1: DE 10 2006 022 059 A1;

D2: US 5 766 416 A.

XIII. The lines of argument of the parties are dealt with in detail in the reasons for the decision.

XIV. Claim 1 according to the (new) main request reads (the amendments with respect to claim 1 of the patent as granted being highlighted by the Board):

An electrotype for attachment to the face cloth of a cylinder mould for forming an image during a paper making process, the electrotype comprising a mesh and at least one image forming element attached to the mesh, in which the one or more image forming elements comprise multiple layers.

XV. Claim 6 according to the main request reads (the amendments with respect to claim 7 of the patent as granted being highlighted by the Board):

A method of forming an electrotype for attachment to the face cloth of a cylinder mould for forming an image during a paper making process, the electrotype comprising a mesh and at least one image forming element attached to the mesh, wherein the method comprises as claimed in any one of the preceding claims ~~comprising~~ the steps of electroforming a first layer comprising a mesh and at least one image forming element.

XVI. In view of the decision taken by the Board there is no need to reproduce the independent claims of the auxiliary requests.

Reasons for the Decision

1. Decision in written proceedings

The present decision is taken in written proceedings without holding oral proceedings.

The respondent's request for oral proceedings is auxiliary to the request of maintaining the patent in amended form according to the main request filed on 8 February 2021.

Thus, since the respondent's main request is followed by the Board, the aforementioned auxiliary request does not become active.

Since the appellant has withdrawn its request for oral proceedings and has been informed of the Board's preliminary assessment of the case, the principle of the right to be heard according to Article 113(1) EPC has been observed since that provision only affords the opportunity to be heard and the party's submissions have been 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)

In view of the fact that the case is ready for decision on the basis of the parties' extensive written submissions the Board issues this decision in written proceedings in accordance with Article 12(8) RPBA and Article 15(3) RPBA 2020.

2. Amendments to the claims of the main request
(Article 123(2) and (3) EPC)

The main request corresponds essentially to the second auxiliary request filed in opposition proceedings and was filed as second auxiliary request with the reply to the statement setting out the grounds of appeal.

Claim 1 of the main request corresponds to the combination of granted claims 1 and 3, while independent method claim 6 corresponds to claim 7 as granted which has been amended by introducing the combination of features of claim 1 as granted in place of the expression "as claimed in any one of the preceding claims".

The appellant has not reacted to the main request, *i.e.* to the second auxiliary request filed with the reply to the statement setting out the grounds of appeal. Furthermore the ground of opposition under Article 100(c) EPC was not raised in opposition proceedings.

In view of the above the Board is of the opinion that the requirements of Article 123(2) and (3) EPC do not hold against the main request.

3. Novelty of the subject-matter of claim 1 of the main request (Article 54 EPC)

3.1 The Board concurs with the respondent that document D1 does not show one or more image forming elements comprising multiple layers, since feature (44) of D1 is the upper screen and not part of the electrotpe (see page 11, penultimate paragraph, reply to the statement setting out the grounds of appeal) and the wording of

the claim indicates unambiguously that a single image forming element should comprise multiple layers, which is not shown in D1 (see page 4, third paragraph, of the respondent's letter dated 9 September 2019).

- 3.2 The above opinion of the Board was communicated to the parties with the communication pursuant to Rule 100(2) EPC, to which the appellant has not reacted. After having reconsidered all the relevant aspects of the case, the Board does not see any reason to deviate from its preliminary opinion and thus finds that the subject-matter of claim 1 is new.
4. Inventive step of the subject-matter of claims 1 and 6 of the main request (Article 56 EPC)
- 4.1 The Board concurs with the respondent (see page 11, final two paragraphs of the reply to the statement setting out the grounds of appeal) that since neither D1 nor D2 discloses "one or more image forming elements comprising multiple layers" even by combining the teaching of D1 and D2 the person skilled in the art would not arrive at an electrotpe according to the subject-matter of claim 1. This is contrary to what was argued by the appellant in opposition proceedings in relation to granted claim 3, which comprises these features (see page 2, seventh and eight line from the bottom, notice of opposition and page 7, point III, first paragraph, appellant's letter dated 12 January 2018).
- 4.2 The Board, independently of the issue of admissibility raised by the respondent (see page 11, second paragraph, of the reply to the statement setting out the grounds of appeal), considers that the objection of lack of inventive step raised on page 8, second

paragraph, of the statement setting out the grounds of appeal, in relation to granted claim 7 (which corresponds to claim 6 of the main request), is not convincing since no state of the art which could be regarded as the closest prior art has been identified.

- 4.3 The above opinion of the Board was communicated to the parties with the communication pursuant to Rule 100(2) EPC, to which the appellant has not reacted. After having reconsidered all the relevant aspects of the case, the Board does not see any reason to deviate from its preliminary opinion and finds that there is no reason to consider that the subject-matter of claims 1 and 6 does not involve an inventive step.

5. Admittance of the objections of the third party into the proceedings

In view of the above assessment of the case, the Board does not consider it necessary to address the issue of the admittance into the proceedings of the objections raised by a third party (see page 1, third paragraph from the bottom to page 2, second paragraph, of the respondent's letter dated 9 September 2019) since the objections have been dealt with in substance in point 3.1 above in relation to the main request, when considering the arguments of the respondent.

6. Amendments to the description

Amendments adapting the description to the amended claims have been submitted by the respondent with letter dated 8 February 2021, to which the appellant has not objected. The Board also does not see any reason to not allow the amendments.

7. Conclusions

As a consequence, the Board, in reviewing all the relevant aspects of the case on the basis of the parties' mutual submissions in the appeal proceedings, has come to the conclusion that the appealed decision cannot be upheld and that there is nothing preventing the maintenance of the patent in amended form according to the respondent's main request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent in amended form on the basis of the following documents:

Description, paragraphs

1 to 11, 14 to 36 of the patent specification,

12 and 13 filed with letter dated
8 February 2021,

Claims

1 to 19 filed with letter dated
8 February 2021,

Drawings

1 to 16 of the patent specification.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated