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**Datasheet for the decision
of 21 October 2021**

Case Number: T 0768/20 - 3.2.05

Application Number: 13757848.0

Publication Number: 2822777

IPC: B41M7/00

Language of the proceedings: EN

Title of invention:

Multi-layer printing process

Patent Proprietor:

Ancor Group GmbH

Opponents:

Gillard, Richard Edward
Hamm&Wittkopp Patentanwälte PartmbB

Relevant legal provisions:

EPC Art. 100(c), 112(1)(a)

Keyword:

Amendment extending beyond the content of the original
application (yes)
Referral to the Enlarged Board of Appeal (refused)

Decisions cited:

G 0003/89, G 0011/91, G 0001/93, G 0001/03, G 0002/03,
G 0002/10, G 0001/16

Catchword:

Exceptions to the "gold standard" (point 2.2 of the reasons)



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Case Number: T 0768/20 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 21 October 2021

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 18 February
2020 revoking European patent No. 2822777
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman P. Lanz
Members: O. Randl
 C. Brandt

Summary of Facts and Submissions

- I. The patent proprietor appealed against the opposition division's decision revoking European patent No. 2 822 777 ("the patent").

The opposition division was of the opinion that the subject-matter of claims 1 and 5 of the patent as granted (main request) extended beyond the content of the application as filed. Auxiliary requests 2B and 3 were found *prima facie* not to overcome the objection under Article 123(2) EPC and were not admitted into the proceedings.

- II. The oral proceedings before the board took place by videoconference on 21 October 2021. As announced in their letters dated 23 September and 31 August 2021, respondents I and II were not represented. In accordance with Rule 115(2) EPC and Article 15(3) RPBA 2020, the oral proceedings were continued without the respondents.

- III. The appellant (patent proprietor) requested that the decision under appeal be set aside and the case be remitted to the opposition division for further prosecution on the basis of the main request (patent as granted).

Moreover, the appellant requested that the board submit the following questions to the Enlarged Board of Appeal, if needed for the decision (highlighting as in the original text):

"1. Does the Gold Standard for assessing the allowability of the subject-matter of amendments under

Article 123(2) EPC apply to **all** amendments irrespective of the context of the amendment made, or is the Gold Standard limited to amendments of the type that provide a technical contribution to the claimed invention?

2. If the answer to question 1 is that the Gold Standard **does** apply to all amendments, are there nevertheless different conditions under the Gold Standard for assessing whether amendments that **do or do not** provide a technical contribution to the claimed invention comply with Article 123(2) EPC ?, i.e. given that amendments that potentially involve subject-matter that would extend beyond the content of the application as filed and as such are associated with an unwarranted advantage, so that for such amendments to establish compliance with Article 123(2) EPC [sic] it needs to be established beyond any reasonable doubt that the potentially added subject-matter does not extend beyond the content of the application as filed, whereas amendments that **do not** involve subject-matter that would extend beyond the content of the application as filed are not associated with an unwarranted advantage and per se comply with Article 123(2) EPC?

3. If the answer to question 1 is that the Gold Standard is limited to amendments of the type that provide a technical contribution to the claimed invention, what criteria apply for demonstrating that amendments that **do not** provide a technical contribution to the claimed invention comply with Article 123(2) EPC?

4. If a claimed feature is qualified by a positive statement "A" that limits the claimed feature to a state "A" and excludes from the claim a state "non-A", where "A" and "non-A" are mutually exclusive opposite

conditions, and where state "A" is a normal state that is not explicitly disclosed in but can be implied from the original disclosure whereas the disclaimed state "non-A" is an abnormal state that is neither explicitly nor implicitly disclosed in the original disclosure, is the limitation of the claim to state "A" considered to not add subject matter to the original disclosure in the sense of Article 123(2) EPC by simple deduction that the normal state "A" is implied from the original disclosure in the absence of evidence that would produce the abnormal state "non-A [sic].

5. If, to comply with Article 123(2)EPC, it must be proven that the normal state "A" is directly and unambiguously derivable from the original disclosure, by a skilled person using is common general knowledge, what are the criteria for establishing such proof? Is it proof on the balance of probabilities, proof beyond reasonable doubt, or proof beyond any doubt?

6. If the Enlarged Board determines that the applicable standard of proof to be applied in dealing with the situation of Question 4 is "proof beyond reasonable doubt", what criteria determine "beyond reasonable doubt" in this context, given that what is expected is: absent any proof of damage in normal operation, which does not correspond to the Case Law."

IV. Respondent II (opponent 2) requested in writing that the appeal be dismissed and that, if the appellant overcame the objections raised by the opposition division, the case be remitted to the opposition division for further prosecution.

Respondent I (opponent 1) did not file any requests.

- V. Claim 1 of the sole request before the board, which corresponds to claim 1 as granted, reads:

*"A process for forming a printed product, said process comprising: applying an energy curable coating to a substrate (16) at a first station (12) using a printing process, said energy curable coating comprising an acrylate material that cures by free radical polymerization;
curing said energy curable coating using an energy curable process including free radical polymerization at a second station (30) downstream of said first station to define a cured energy curable layer (102); routing said substrate to a third station downstream of said second station; and
applying a metallic ink directly to the intact surface of said cured energy curable layer which consists of the cured energy curable coating, to define a metallic ink layer (106) on the cured energy curable layer, characterized in that
said applying said energy curable coating to said substrate (16) at said first station (12) comprises applying said energy curable coating to said substrate at said first station using a gravure cylinder having indicia grooves formed on said gravure cylinder, said indicia grooves being adapted to retain said energy curable coating until contact with said substrate whereby said energy curable coating is applied to said substrate."* (Underlining added by the board.)

- VI. For the sake of concision, the publication "Case Law of the Boards of Appeal of the European Patent Office, 9th edition, 2019" will be referred to as "Case Law" in the following.

VII. The parties' arguments on the ground for opposition under Article 100(c) EPC can be summarised as follows:

(a) Appellant (patent proprietor)

Meaning of "intact"

"Intact" is defined as "1. complete and in the original state; 2. not damaged" (Cambridge English Dictionary), "not altered, broken or impaired; remaining uninjured, sound" (dictionary.com) and "something that is [...] complete and has not been damaged or spoilt" (Collins English Dictionary). The person skilled in the art understands that the "intact" surface of the cured material is its original state in which it has been produced, with no alteration or impairment due to the inclusion of foreign bodies or the action of external damaging means. All renderings in the context of cured energy curable coatings are consistent. They mean or imply that the surface is in the original state. If a cured energy curable layer has been altered to some extent, this means that it is no longer in its original state and, by definition, non-intact. In the context of cured energy curable coatings, practically any alteration that detracts from the original state can be construed as damage because any modification of the coating will deteriorate the quality of the reflection.

Implicit disclosure

As per Case Law, section II.E.1.3.3, subject-matter that is implicitly disclosed to the skilled person, using common general knowledge, in the application as filed is part of the content of the application. The implicit disclosure is what a person skilled in the art would consider was necessarily

implied by the patent application as a whole. The actual teaching conveyed by the original disclosure may contain subject-matter which has not been explicitly revealed as such in the application as filed but nevertheless derives directly and unambiguously from its content. Literal support is not required.

Damage to the surface layer is an abnormal state that would make the energy cured layer virtually useless. The skilled person would always consider the energy cured layer to have an intact outer surface unless there is evidence of damage to it. The word "intact" was not used in the patent because it is not necessary. The cured energy curable coating is stable and will always remain in its original state unless damaged. In the absence of evidence of damage, the skilled person contemplating the original application would have understood that the surface is intact. The fact that the application as filed is silent about damage means that the surface is not damaged. Paragraph [0034] of the patent, which refers to Fig. 2B, states that the metallic ink layer 106 is applied to the cured energy curable layer 102 to provide a high finish quality at station 12I or 12J.

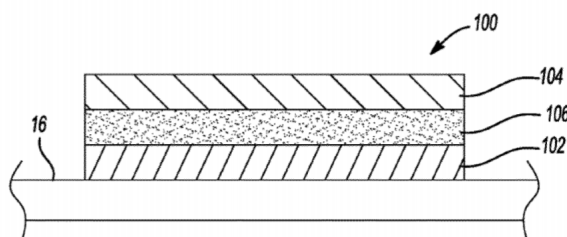


Fig-2B

Although Fig. 2B is schematic it clearly shows an undamaged surface of the cured layer 102. The reference to stations 12I or 12J refers to Fig. 1, which shows a series of stations to which the substrate to be coated and the coated substrate are supplied successively,

without there being any devices that could damage the surface of the energy cured layer on the substrate. This clearly establishes that the surface of the energy cured layer is and was in its normal intact state. There was no need to expressly state this fact because intactness is the normal state that requires no special description or illustration, whereas damage or alteration is an abnormal state that needs to be specifically described or illustrated if it is to be established.

Jurisprudence relating to the "gold standard"

As explained in Case Law, section II.E.1.1, the idea behind Article 123(2) EPC is that an applicant should not be allowed to improve its position by adding subject-matter not disclosed in the application as filed, which would give them an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application. The "gold standard" is discussed in section II.E.1.3.1. Any amendment to the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) is subject to the mandatory prohibition on extension laid down in Article 123(2) EPC and can therefore, irrespective of the context of the amendment made, only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed.

Decision **G 2/10** deals with "disclosed disclaimers". In point 4.3 of the reasons for the decision it is explained that in decision G 1/93 the Enlarged Board

conceded that, where an undisclosed limiting feature - without providing a technical contribution to the subject-matter of the claimed invention - merely excludes protection for part of the subject-matter of the claimed invention as covered by the application as filed, the adding of such a feature cannot reasonably be considered to give any unwarranted advantage to the applicant and is not to be considered as subject-matter extending beyond the content of the application as filed. The decision adds that neither decision G 1/93 nor decision G 1/03 intended to modify the general definition of the requirements of Article 123(2) EPC established in opinion G 3/89 and decision G 11/91, which definition has become the generally accepted or "gold" standard for assessing any amendment for its compliance with Article 123(2) EPC. This finding is consistent with the view that decision G 1/93, which covers amendments without a technical contribution, is not covered by the definition of the gold standard, which concerns amendments which provide a technical contribution. This is in line with the interpretation that the gold standard applies to G 2/10 (disclosed disclaimers) but not to G 1/03 (undisclosed disclaimers). Consequently, the statement that the gold standard covers any amendment is not true because it does not cover the amendments of the type stated in decisions G 1/93 and G 1/03. In point 4.5.4 of the reasons for the decision, decision G 2/10 explains that it is necessary to take into account the relationship of the disclaimed subject-matter with the subject-matter remaining in the claim after the amendment. None of the orders of decision G 2/10 applies to the case in hand because no subject-matter disclosed in the application as filed is disclaimed.

Decision **G 1/03** dealt with undisclosed disclaimers. In point 2 of the reasons it is stated that "[a]ny amendment to a claim is presumed to have a technical meaning, otherwise it would be useless to have it in the claim". The decision then goes on to say that "[a] related but more limited question is whether a feature with a technical meaning contributes to the technical teaching in the application or to the subject-matter of the claimed invention" and that decision G 1/93 made "a distinction between features providing or not providing a technical contribution to the subject-matter of the claimed invention", finding that "the latter features, which merely limit the protection, are not to be considered as subject-matter which extends beyond the application as filed". This issue is decisive in the context of the case in hand.

Decision **G 1/93** deals with the "inescapable trap"; see point 1 of the order. Point 2 of the order states that "a feature which has not been disclosed in the application as filed but which has been added to the application during examination and which, without providing a technical contribution to the subject-matter of the claimed invention, merely limits the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, is not to be considered as subject-matter which extends beyond the content of the application as filed in the sense of Article 123(2) EPC". Point 16 of the reasons provides the explanation for this finding. Again, there is a clear distinction between subject-matter making a technical contribution to the claim and subject-matter that makes no such contribution. The Enlarged Board's statement "merely excludes protection for part of the subject-matter of the claimed invention

as covered by the application as filed" has to be considered carefully. When a claim limitation excludes disclosed subject-matter, this could be regarded as a "negative technical contribution". On the other hand, if a limitation merely excludes subject-matter that is neither explicitly nor implicitly disclosed, it cannot be regarded as providing a technical contribution. It thus falls under the situation that decision G 1/93 deems to be compliant with Article 123(2) EPC.

Any definition of the "gold standard" that purports to apply to all amendments is either wrong or deceptive. There are exceptions (such as the undisclosed disclaimers in decision G 1/03) to the applicability of the gold standard, which must not be ignored. Generally speaking, there are two types of amendments. "Type 1" amendments introduce subject-matter extending beyond the contents of the original application. They do not comply with Article 123(2) EPC unless it is shown that they were directly and unambiguously disclosed to the skilled person using common general knowledge. "Type 2" amendments do not provide a technical contribution to the subject-matter of the claim but merely limit the protection conferred (G 1/93). To establish that the amendment does not provide a technical contribution, all that needs to be done is to show that there is no added subject-matter in the claim. If the gold standard applies to all amendments, it has to be interpreted differently for the two types of amendments. Type 1 amendments are subject to the gold standard, and this has to be established to the rigorous standard "beyond reasonable doubt". The situation is unclear for Type 2 amendments as the test for "directly and unambiguous disclosure" is different in this case.

Disclaimer effect

If a positive claim limitation has the effect of limiting the protection conferred by disclaiming subject-matter that is not disclosed either explicitly or implicitly in the application as filed, it does not add technical subject-matter that extends beyond the content of the application as filed. The amendment under consideration (insertion of "intact") is of that kind. It has the effect of disclaiming non-intact surfaces for which there was no basis in the original application. The effect of disclaiming a non-intact surface by claiming an intact surface (i) removes a non-intact surface from the legal scope of protection and (ii) would remove a non-intact surface from the content of the subject-matter of the application, but only if the non-intact surface were included in the content of the subject-matter of the application as filed. It is necessary to distinguish between the legal scope of protection and the content of the subject-matter of the application. A disclaimer always removes subject-matter from the legal scope of protection, but its allowability depends on whether or not it extends the content of the subject-matter of the application. In this case, the non-intact surface does not form part of the content of the subject-matter of the original application, either explicitly or implicitly; the application contains no disclosure or hint that the surface could be non-intact. In the case in hand, though disclaiming the non-intact surface reduces the legal scope of protection, it does not change the content of the subject-matter of the application because it was not part of the subject-matter before amendment. Therefore the amendment cannot extend the content of the subject-matter of the application. Any such disclaimer meets the requirements of

Article 123(2) EPC even if expressed in positive terms ("intact surface) and not notionally expressed in negative terms ("excluding non-intact surfaces") because it does not extend the subject-matter of the application. The qualification "intact surface" merely describes the normal state of the energy cured layer. The amendment meets the requirement of being directly and unambiguously derived from the disclosure of an energy cured layer using common general knowledge, according to which the surface of an energy cured material remains intact unless there is evidence of damage. It does not add subject-matter.

This effect is completely different from the type of disclaimer dealt with in Case Law, section II.E.1.7.1 ("*... an amendment to a claim resulting in the incorporation therein of a "negative" technical feature, typically excluding from a general feature specific embodiments or areas ...*"; see also G 1/03, point 2 of the reasons). Positively claiming a feature and thus implying a disclaimer effect (removing subject-matter from the periphery of a claim) is clearly not the same as a disclaimer that uses a negative technical feature to exclude subject-matter from a generality (excluding subject-matter from inside the claim). Unlike disclaimers of that kind, the amendment in question has the effect of disclaiming, i.e. removing, subject-matter from the periphery of the claim definition as the result of a positive limitation, whereas a disclaimer as per G 1/03 excludes specific embodiments or areas from a generality. All positive claim limitations have the effect of reducing the scope of the claim and all positive claim limitations generate a disclaimer (i.e. renunciation) effect. However, G 1/03's list of acceptable undisclosed disclaimers is both specific and limited to

the "undisclosed disclaimers". The Enlarged Board was not faced with positive claim limitations that have the effect of disclaiming subject-matter and did not discuss them. Therefore, the abundant jurisprudence on disclaimers is inapplicable to the situation in this case, in which a positive claim limitation generates a "disclaimer effect".

Presence of a technical contribution

According to claim 1, the support with the cured energy curable coating leaving the second station is moved downstream and a metallic ink layer is applied to it. When the support leaves the curing station, it is in its original state because it has just been cured. During the transport, it remains in its original state in normal operating conditions. As can be seen from the drawings, there is nothing between the curing station and the ink applying station that would alter the state of the coating. No damage or alteration is mentioned. The coating thus remains in its original state, which can be expressed by the statement that it is "intact". This is merely a word that disclaims the possibility that the coating could have been damaged. It does not add any technical subject-matter to the claim because the coating remains the same. It is implicit that the coating is in its original state when it leaves the curing station and, for want of any evidence of damage, it remains in the original state until it reaches the next station. The addition of the adjective "intact" does not in any way change the coating. It only disclaims prior-art coatings where foreign bodies disturbing the surface were introduced into the coating. Any possible damage is disclaimed. This is a disclaimer in accordance with decision G 1/93, generating no additional subject-matter. There may be a

technical effect but it comes from the original coating, which has this effect anyway. The amendment only disclaims possible effects of damaged coatings, which are not obtained. What is disclaimed, i.e. a damaged coating, was never part of the original application. The coating itself is not changed, regardless of whether or not it is called "intact". The technical content of the claim is not changed by the disclaimer. There is a difference between disclaiming subject-matter with technical content that has been disclosed in the application, and disclaiming subject-matter with no technical content that has not been disclosed in the application. The disclaimer has an effect solely on the legal scope of protection, not on the content of the application, which remains the same. This is what is explained in G 1/93, namely that if there is no technical contribution to the technical content of the original application, the amendment is allowable. Original claim 1 did not have any limitation. Its legal scope of protection encompassed a damaged coating and the amendment reduced this scope of protection without making a technical contribution to the subject-matter of the application as filed.

Standard of proof for establishing a disclosure

The standard of "beyond reasonable doubt" was developed by the boards of appeal on the basis of cases where the amendment added technical subject-matter and there was a resulting difficulty establishing the common general knowledge. In the case at issue, the amendment does not add any technical subject-matter and there is no problem presenting evidence of the skilled person's knowledge, which is a matter of common sense. Therefore, the standard of "beyond reasonable doubt" is not appropriate. The normal standard of proof on the

balance of probabilities can be applied because the situation in hand does not correlate with that dealt with by the jurisprudence in which it was notoriously difficult to demonstrate common general knowledge.

Questions for the Enlarged Board of Appeal

A referral is needed to clarify or change the description of the gold standard. It is the ambiguous formulation of the gold standard that has led to the opposition division's spurious objections. The board can decide on its own, but a referral would be more authoritative and beneficial to the European patent system as a whole. All the questions concern important points of law. **Question 1** concerns the gold standard itself. An answer is needed to come to the correct decision in this case in order to set aside the opposition division's false statement concerning the gold standard. What is being questioned is not the gold standard itself but the situations to which the gold standard applies. It is a matter of uniform application of the law to set out the correct relationship between the gold standard (mainly G 2/10) and the situation dealt with in decision G 1/93. Only the Enlarged Board should take the initiative to change the gold standard. **Questions 4 and 5** also involve a point of law of fundamental importance. The "gold standard" was confirmed for disclosed disclaimers (G 2/10) but not for undisclosed disclaimers (G 1/03). Questions related to the standard of proof are considered in Case Law, section II.E.5, but none of the tests developed for different cases of amendment corresponds to the situation in hand. Therefore, it is unclear which standard of proof applies. The statement in the board's preliminary opinion that the general question cannot be answered - i.e. by the Enlarged Board - could be

interpreted as saying that the Enlarged Board is incompetent to carry out the tasks entrusted to it. It is not correct to say that **question 4** does not concern a point of law of fundamental importance. The effect of disclaiming subject-matter in the context of exclusive-type disclaimers was deemed to be a point of law of fundamental importance to be decided by the Enlarged Board. The effect of disclaiming subject-matter by a positive claim limitation is different from and not to be confused with the existing jurisprudence on exclusive-type disclaimers. The situation in this case (which is expressed in question 4 in general terms) constitutes a justifiable exception to the consensus that the standard of proof of "beyond reasonable doubt" is appropriate in these situations because it does not correlate with the standard situation in the jurisprudence and the reasons that led to the adoption of this standard of proof do not apply. Establishing an exception of this kind is obviously a point of law of fundamental importance. It is within the common general knowledge of a skilled person that a cured energy curable coating has a stable state and remains in this state unless it is somehow damaged. For want of any evidence that the coating has been damaged, the question of proof is vastly simplified compared with the situation of "normal" undisclosed amendments where claim features are substituted. Moreover, it is not correct to say that the precise standard to be applied is not crucial for the specific case under consideration. When asked by the board whether the expression "can be implied" in question 4 was to be understood as an implicit disclosure, the appellant explained that the problem was that the standard of proof depended on whether or not there was added subject-matter. Therefore the appellant chose not to use the expression "is necessarily implied". The

purpose of **question 5** is to enable the Enlarged Board to ascertain the standard of proof to be applied when dealing with the situation in question 4, which is necessary because it is not dealt with in the established jurisprudence. **Question 6** raises a point of fundamental legal importance because the jurisprudence on the standard of proof for undisclosed amendments deals with different situations and contains no guidance on how "proof beyond reasonable doubt" is ascertained in a situation like that in question 4.

(b) Respondents (opponents)

With regard to the aspect discussed by the opposition division, the features of a claim, such as the features "direct" and "intact" in this case, do serve to distinguish the claimed subject-matter from the state of the art, so substantial claims must be made for the disclosure of the claim features and the feature combinations used in the claims. It is uncontested that there was no literal disclosure for the individual features "intact" and "direct". It is not correct that the features and their combination are implicit from the description and in particular from the figures. The individual claim features, and thus also the combination of them, are intended to have a genuine technical meaning. They are not intended to be self-evident and are technically relevant. However, there are no instructions in the original application for the technical embodiment of the claimed process, namely that the metal lacquer is applied "directly" to the "intact" surface, so the requirements of Article 123(2) EPC are not fulfilled. Moreover, with the claim features a selection was made to apply the metal lacquer (a) directly to the (b) intact surface. The description does not provide any basis for this

selection of possibilities, which the description of the original application does not describe as preferred either individually or in combination. And given that the other features ((c) the application of the radiation curable layer by means of intaglio printing and (d) the use of an acrylate material as the radiation curable layer) also had to be selected from originally disclosed possibilities (see opponent 2's notice of opposition of 11 July 2018, page 4), this interpretation of the additionally included features represents a selection from lists which, in this combination, are not originally disclosed. Therefore, the claims of the current requests do not fulfil the requirements of Article 123(2) EPC.

Reasons for the Decision

1. Claim interpretation: "intact"

Claim 1 requires the metallic ink to be applied directly to the "intact" surface of the cured energy curable layer.

The adjective "intact" is not used, let alone defined, in the original application. Therefore, the term is to be interpreted in accordance with either its common general meaning or its common particular use in the field under consideration, if any such particular use is established.

The Oxford English Dictionary (OED) gives the following definition of the adjective "intact":

"Untouched; not affected by anything that injures, diminishes, or sullies; kept or left entire; unblemished; unimpaired."

This definition is similar to that of the various dictionaries quoted by the appellant:

- Cambridge English Dictionary: "1. complete and in the original state; 2. not damaged"
- dictionary.com: "not altered, broken or impaired; remaining uninjured, sound"
- Collins English Dictionary: "Something that is intact is complete and has not been damaged or spoilt"

Both the OED and the Cambridge English Dictionary acknowledge that the adjective "intact" can designate either something that was not altered ("untouched"; "in the original state") or something that may have been altered to some extent but not in a way that would have diminished its function or usefulness ("unimpaired"; "not damaged"). In claim 1, the word "intact" qualifies the surface of the layer defined by curing the energy curable coating using free radical polymerization. Both meanings of the adjective are possible in this context. Nonetheless, the appellant argued that in the context of the invention, "intact" could only mean "in the original state and not damaged". The board's decision is based on this understanding.

2. Ground for opposition under Article 100(c) EPC

In accordance with Article 100(c) EPC, an opposition may be filed on the ground that the subject-matter of the European patent extends beyond the content of the application as filed. What exactly is to be understood

by the "content of the application as filed" has been elaborated on in the jurisprudence of the boards of appeal. In particular, the boards have developed what is known as the "gold standard", under which an amendment to the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed (see decision G 2/10 of the Enlarged Board of Appeal, point 4.3 of the reasons).

The question before the board is whether the feature whereby the metallic ink is applied "directly to the intact surface" of the cured energy curable layer extends beyond the content of the application as filed.

The basis for the feature of the metallic ink being applied to the surface of the cured layer is found in original claim 4. During the examination proceedings, the applicant (now: appellant) added the feature "intact" to this feature to distinguish the subject-matter of claim 1 from a document belonging to the state of the art under Article 54(2) EPC which the examining division had found to anticipate the subject-matter of the unamended claim. The applicant claimed that the amendment was based on the disclosure of paragraph [0036] and Fig. 2B of the original application (see the applicant's letter dated 19 May 2017, page 2).

All in all, the board has drawn two lines of reasoning in support of the allowability of the amendment from the appellant's submissions. First, the appellant

argued that the amended feature was implicitly disclosed. Second, it argued that the amended feature was one to which the gold standard did not apply because it was covered by the exceptions to this standard allowed by the jurisprudence of the Enlarged Board of Appeal.

2.1 Implicit disclosure

2.1.1 Relevant disclosure of the original application

It is undisputed that the original application does not explicitly use the expression "intact surface".

Fig. 1 of the original application shows a printing system 10 in accordance with the invention.

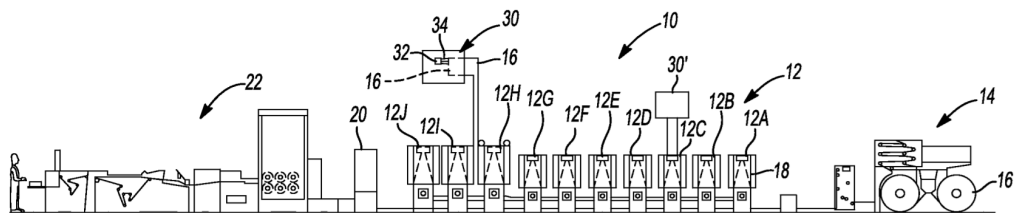


Fig-1

This printing system 10 comprises at least one curing station 30 for curing an energy curable ink deposited on the substrate 16. After the curing step, a metallic ink layer 106 such as the one shown in Fig. 2B is applied to the now-cured energy cured layer 102 to provide a high finish quality (see paragraph [0037] of the published application).

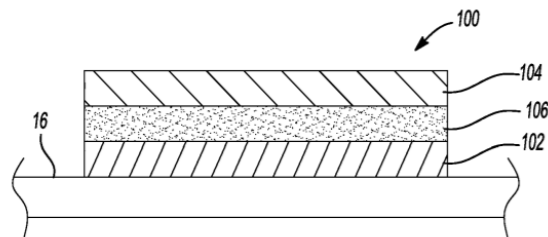


Fig-2B

This is done at station 12I or 12J. The printing system 10 further comprises an inspection station 20 disposed in a downstream position for checking the quality, rate and condition of the printed substrate 16 and the resultant indicia provided on it (see paragraph [0029] of the published application).

Fig. 2B is schematic (see paragraph [0017] of the published application). It is not possible to draw conclusions from it concerning the precise state of the layer 102 and in particular whether it was in its original state when layer 106 was applied.

The appellant argued that the surface of the energy cured layer had to be intact (i.e. in its original condition; see point 1. above) when it reached the stations 12I or 12J because there was no disclosure of any damage done to the surface. Moreover, there were no devices between the curing station 30 and stations 12I or 12J that could damage the surface of the energy cured layer on the substrate. Therefore, the surface of the energy cured layer had to be in its original state.

The board cannot endorse this argument. It is likely that the surface of the layer 102 has not undergone any major changes between the curing station and the station where the metallic ink layer is applied. However, the original application does not concern itself with the state of the layer 102 at all. For want

of any disclosure in this respect, it cannot be said that there is direct and unambiguous disclosure of the fact that the layer 102 is still in its original state when it is being printed on. The mere likelihood or plausibility of this being the case cannot replace direct and unambiguous disclosure.

2.1.2 Question of standard of proof

The appellant expressed the opinion that the decision under appeal was based on the assumption that the implicit disclosure of the feature "intact" had to be proven beyond any doubt. The board sees no reason to assume that the opposition division applied that standard. The relevant jurisprudence of the boards of appeal is summarised in Case Law, section II.E.5:

"In accordance with the established case law of the boards of appeal, in the case of a proposed amendment under Art. 123(2) EPC ... the factual disclosure of a European patent application as originally filed has to be established to a rigorous standard, namely the standard of certainty 'beyond reasonable doubt'."

The applicable standard is thus "beyond reasonable doubt" rather than "beyond any doubt". The very requirement of an "unambiguous" disclosure under the gold standard indicates that a strict standard has to be applied and that the actual existence of a disclosure is not a matter of probabilities.

Incidentally, the board wishes to point out that the practical relevance of the distinction between the "balance of probabilities" standard and the "beyond reasonable doubt" standard is often overestimated.

Both standards are only fulfilled if the deciding body is persuaded that the alleged fact is true, which is not a matter of "just tipping the balance slightly" (see decision T 545/08, point 8 of the reasons). This is also confirmed by the passage in Case Law, section III.G.4.3.1, according to which "the balance of probabilities standard [is] met if, after evaluating the evidence, a board [is] persuaded one way or the other" (underlining by this board).

In the case at issue, the board is not persuaded that the original application can be deemed to implicitly disclose, directly and unambiguously, that the metallic ink is applied directly to the surface of the cured energy curable layer in its original state. The board thus reaches the same conclusion as the opposition division in point 17.7 of the decision under appeal.

2.2 Exception to the "gold standard"?

The appellant's second line of reasoning involved presenting the amendment in hand as being one to which the "gold standard" did not apply. Before this argument can be examined as to its merits, it is necessary to consider the development of the jurisprudence of the Enlarged Board of Appeal in respect of the allowability of amendments.

2.2.1 Development of the jurisprudence of the Enlarged Board of Appeal in respect of the allowability of amendments

Opinion G 3/89 and decision G 11/91 dealt with the allowability of corrections under Rule 88 EPC 1973 (identical except for a slight drafting change to Rule 139 EPC) and found that the parts of a European patent application or of a European patent relating to

the disclosure (the description, claims and drawings) may be corrected under this rule only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed. Any such correction was deemed to be of a strictly declaratory nature and thus did not infringe the prohibition of extension under Article 123(2) EPC.

In decision G 1/93, the Enlarged Board considered the question of the "inescapable trap", i.e. a situation where a feature without a proper basis in the original application had been added to a claim during the grant proceedings. The trap means that it is impossible to maintain the feature (because it violates Article 123(2) EPC) but in some cases the feature cannot be deleted either (because this would lead to a violation of Article 123(3) EPC). In point 16 of the reasons for the decision, the Enlarged Board considered different kinds of features:

"Whether or not the adding of an undisclosed feature limiting the scope of protection conferred by the patent as granted would be contrary to the purpose of Article 123(2) EPC to prevent an applicant from getting an unwarranted advantage by obtaining patent protection for something he had not properly disclosed and maybe not even invented on the date of filing of the application, depends on the circumstances. If such added feature, although limiting the scope of protection conferred by the patent, has to be considered as providing a technical contribution to the subject-matter of the claimed invention, it would, in the view of the Enlarged Board, give an unwarranted advantage to

the patentee contrary to the above purpose of Article 123(2) EPC. Consequently, such feature would constitute added subject-matter within the meaning of that provision. A typical example of this seems to be the case, where the limiting feature is creating an inventive selection not disclosed in the application as filed or otherwise derivable therefrom. If, on the other hand, the feature in question merely excludes protection for part of the subject-matter of the claimed invention as covered by the application as filed, the adding of such feature cannot reasonably be considered to give any unwarranted advantage to the applicant. Nor does it adversely affect the interests of third parties ... In the view of the Enlarged Board, such feature is, on a proper interpretation of Article 123(2) EPC, therefore not to be considered as subject-matter extending beyond the content of the application as filed within the meaning of that provision. It follows that a patent containing such a feature in the claims can be maintained without violating Article 123(2) EPC or giving rise to a ground for opposition under Article 100(c) EPC. The feature being maintained in the claims, there can be no violation of Article 123(3) EPC either." (Underlining added by this board.)

It is not entirely clear what kind of feature the Enlarged Board had in mind when referring to a feature that "merely excludes protection for part of the subject-matter of the claimed invention as covered by the application as filed" without "providing a technical contribution to the subject-matter of the claimed invention". The question referred to the Enlarged Board did not mention features of that kind, and the feature under consideration in the case on

which the referring decision (T 384/91) is based ("substantially free of striae") does not appear to be this kind of feature. Nonetheless, point 7 of the reasons for decision G 1/93 states that the patent proprietor had "referred to the standing practice of allowing disclaimers in order to limit the protection conferred in view of prior art made known to applicants during examination, and submitted that it would be in line with this practice to allow a clearly limiting feature of the kind under consideration in the present case to remain in a claim without invalidating the patent". The Enlarged Board's findings in point 16 of the reasons for the decision and in point 2 of the order thus seem to concern those disclaimers.

The question of disclaimers was later taken up in decision G 1/03 (and G 2/03) of the Enlarged Board of Appeal. In point 2 of the reasons for the decision, the Enlarged Board defined a disclaimer as a "'negative' technical feature, typically excluding from a general feature specific embodiments or areas". It limited its scrutiny to "disclaimers which have not been disclosed in the application as filed", which it called "undisclosed disclaimers". The Enlarged Board decided that these disclaimers were allowable under certain conditions. Its reasoning was mainly based on the purpose of Article 54(3) EPC (see point 2.1.1 of the reasons for the decision). A disclaimer that only excluded subject-matter "for legal reasons" was found to have "no bearing on the technical information in the application" and, therefore, not to be inconsistent with Article 123(2) EPC (see point 2.1.3 of the reasons for the decision). By extension a disclaimer excluding the subject-matter of an accidental anticipation was "assumed not to change the technical information in the application as filed" and, for this reason, also to

comply with the requirements of Article 123(2) EPC (see point 2.2.2 of the reasons for the decision). The Enlarged Board also allowed disclaimers for subject-matter which, under Articles 52 to 57 EPC, is excluded from patentability for non-technical reasons (see point 2.4 of the reasons).

In this board's view, decision G 1/03 is best understood as specifying a limited set of exceptions, namely that, for the sake of consistency of the European patent system and similar teleological reasons, the requirements of Article 123(2) EPC are deemed to be fulfilled even though the amendment does not meet the gold standard. Interestingly, decision G 1/03 repeatedly refers to decision G 1/93, mainly to rebut arguments based on its interplay with decision G 2/98 (see point 2.1.2 of the reasons), but does not build its core argument on point 2 of the order or point 16 of the reasons for decision G 1/93.

Decision G 1/03 did not put an end to the discussion on the allowability of disclaimers, in particular because it was limited to the above-mentioned "undisclosed disclaimers". The question of "disclosed disclaimers" disclaiming subject-matter that was disclosed in the original application led to another referral to the Enlarged Board of Appeal. In its decision G 2/10, the Enlarged Board noted that decision G 1/03 was not applicable to this kind of disclaimer (see point 3 of the reasons for the decision) and concluded that their allowability was to be examined using the criteria set out in opinion G 3/89 and decision G 11/91, i.e. that an amendment to a claim by the introduction of a disclaimer disclaiming from it subject-matter disclosed in the application as filed infringes Article 123(2) EPC if the subject-matter remaining in the claim after

the introduction of the disclaimer is not, explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed (see Order 1a).

In point 4.3 of the reasons for the decision, the Enlarged Board also considered the findings of decision G 1/93. It explained that in introducing the "technical contribution" criterion the Enlarged Board had not been intending to amend the definition concerning when an amendment is allowable under Article 123(2) EPC generally, but that it had merely been seeking a way of avoiding the potentially fatal consequences of the patentee being caught in the "inescapable trap" between the requirements of paragraphs (2) and (3) of Article 123 EPC. The Enlarged Board went on to say:

"It can thus be stated that neither decision G 1/93 nor decision G 1/03 intended to modify the general definition of the requirements of Article 123(2) EPC established in opinion G 3/89 and decision G 11/91, which definition has become the generally accepted, one could also say the "gold" standard, for assessing any amendment for its compliance with Article 123(2) EPC."

The board in this case sees this as a confirmation of its understanding that the findings of decisions G 1/03 and G 1/93 concern exceptions to the general rule governing the allowability of amendments referred to as the "gold standard".

The bold reaffirmation of this standard in decision G 2/10, in particular the assertion that it applied to "any amendment", raised doubts as to whether undisclosed disclaimers only had to comply with the

criteria defined in decision G 1/03 or whether they also had to comply with the gold standard. This question led to another referral to the Enlarged Board of Appeal. In decision G 1/16, the Enlarged Board explained that "the term 'undisclosed disclaimer' relates to the situation in which neither the disclaimer itself nor the subject-matter excluded by it have been disclosed in the application as filed" (see point 14 of the reasons). The Enlarged Board maintained the distinction and confirmed that undisclosed disclaimers were governed by the criteria of decision G 1/03 alone.

In summary, the jurisprudence of the Enlarged Board of Appeal, as understood by this board, specifies that the "gold standard" developed in opinion G 3/89 and decision G 11/91 and reaffirmed by decision G 2/10 is the general rule to be used when examining the compliance of amendments with Article 123(2) EPC. Undisclosed disclaimers constitute an exception to this rule. They are governed by the rules laid down in decision G 1/03. Point 2 of the order of decision G 1/93 (and point 16 of the reasons for the decision) also appears to concern undisclosed disclaimers, which decision G 1/03 examined in greater detail. If there are features other than undisclosed disclaimers that, "without providing a technical contribution to the subject-matter of the claimed invention, merely exclude protection for part of the subject-matter of the claimed invention as covered by the application as filed", they would constitute a second exception to the general rule. To the best knowledge of this board, the jurisprudence of the Enlarged Board of Appeal does not provide for any further exception in the context of Article 123(2) EPC.

2.2.2 Application to the case in hand

(a) Core of the matter

In point 6.2.1 of its communication pursuant to Article 15(1) RPBA 2020, this board examined the alleged "disclaimer effect" of the feature "intact". The board found the amendment not to comply with the criteria set out by decision G 1/03. In response to this provisional assessment, the appellant argued that, despite its "disclaiming effect", the amendment was not an undisclosed disclaimer as per decision G 1/03. According to the appellant, positively claiming a feature and thus implying a "disclaimer effect" (removing subject-matter from the periphery of a claim) was clearly not the same as a disclaimer that involves stating a negative technical feature to exclude subject-matter from a generality (excluding subject-matter from inside the claim).

As has been pointed out above (see point 2.2.1), in the eyes of the board, point 2 of the order of decision G 1/93 concerns undisclosed disclaimers as per decision G 1/03. Nevertheless, for the appellant's sake, the board will assume that in decision G 1/93 the Enlarged Board envisaged something more general than - or completely different from - undisclosed disclaimers as per decision G 1/03 and will examine whether the amendment under consideration "merely excludes protection for part of the subject-matter of the claimed invention as covered by the application as filed" without "providing a technical contribution to the subject-matter of the claimed invention".

(b) Brief explanation of decision G 1/93

Point 2 of the order of decision G 1/93, which expresses the Enlarged Board's relevant finding in the most precise way, requires that the feature

"... without providing a technical contribution to the subject-matter of the claimed invention, merely limits the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed".

This statement requires some clarification.

First, this board understands the expression "subject-matter of the claimed invention" to mean the subject-matter of the claim (or claims). The addition of "as covered by the application as filed" merely expresses the fact that this subject-matter has to be part of the content of the application as filed.

Second, the technical contribution under consideration is a "contribution to the subject-matter of the claimed invention". Consequently, it is the subject-matter of the claim that has to be considered (and not the subject-matter of the original application as a whole). Otherwise the Enlarged Board would have referred to the "invention" rather than to the "claimed invention".

Third, "excludes protection" has to be understood as a reduction of the scope of protection (i.e. the domain covered by the claim(s) as granted).

Fourth, "excluding protection for part of the subject-matter of the claimed invention" is interpreted as a

partial reduction of the scope of protection conferred by the subject-matter of the claim.

Consequently, the requirement set out by the Enlarged Board may be reformulated as follows:

A feature which has not been disclosed in the application as filed but which has been added to the application during examination and which, without providing a technical contribution to the subject-matter of the claim, merely partially reduces the scope of protection of the claim, is not to be considered to be subject-matter which extends beyond the content of the application as filed within the meaning of Article 123(2) EPC.

(c) Effect of inserting the adjective "intact"

Inserting the adjective "intact" undoubtedly, and uncontestedly, partially reduces the scope of protection of the claim. The feature was inserted in order to overcome an objection of lack of novelty over a document of the state of the art under Article 54(2) EPC. The amended claim only covers processes in which the metallic ink is applied directly to an intact surface of the cured energy curable layer, whereas the unamended claim also covers processes in which it is applied to a damaged or altered layer.

The crucial question to be answered by the board is whether the adjective "intact" provides a technical contribution to the subject-matter of the claim.

The appellant argued that it did not. Its core argument was that adding the adjective did not alter the surface of the cured layer because the surface is in its

original state, and that adding the adjective "intact" was equivalent to explicitly stating what is implicit, without there being any substantial modification.

This argument has not persuaded the board because it confuses the subject-matter of the claim and the subject-matter of the application as a whole. The appellant repeatedly referred to the contents of the original application, such as Fig. 1 and 2B and the related description, i.e. the subject-matter of the application as a whole. However, it is the subject-matter of claim 1 that needs to be considered. Before the amendment, the cured layer of the claim did not have to be intact. Regardless of whether the feature "intact surface" has an implicit basis in the original application (for a discussion of this aspect, see point 2.1 above), there is certainly no such basis in the unamended claim. Otherwise, it would not have been necessary to amend the claim to overcome the novelty objection. The fact that the cured layer is intact undoubtedly has a technical consequence because damage to the surface would result in a reduced reflectivity of the printed product (see also paragraph [0037] of the published application emphasising the importance of high reflectivity). Consequently, inserting the feature "intact" provides a technical contribution to the subject-matter of claim 1.

(d) Conclusion

It follows that the amendment does not qualify as an amendment as per point 2 of the order of decision G 1/93. Consequently, this exception to the gold standard does not apply and the allowability of the amendment under Article 123(2) EPC has to be examined using the gold standard.

As there is no explicit disclosure of the feature in the original application (which is uncontested) and the board is unable to confirm its implicit disclosure (see point 2.1 above), the amendment is not allowable pursuant to the gold standard and must be held to extend the subject-matter of claim 1 beyond the content of the application as filed.

2.3 Conclusion

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

3. Referral to the Enlarged Board of Appeal

Under Article 112(1)(a) EPC, in order to ensure uniform application of the law, or if a point of law of fundamental importance arises during proceedings on a case, a board must, either of its own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision of the Enlarged Board is required. If the board of appeal rejects the request, it must give the reasons in its final decision.

The appellant requested that the board refer six questions to the Enlarged Board of Appeal under Article 112(1)(a) EPC.

3.1 Question 1

"Does the Gold Standard for assessing the allowability of the subject-matter of amendments under Article 123(2) EPC apply to **all** amendments irrespective of the context of the amendment made, or is the Gold

Standard limited to amendments of the type that provide a technical contribution to the claimed invention?"

The board agrees that this question concerns a point of law of fundamental importance. However, the board can answer this question on the basis of the existing jurisprudence of the Enlarged Board of Appeal, so no further decision of the Enlarged Board is required to ensure uniform application of the law.

The appellant took issue with the Enlarged Board's statement in point 4.3 of the reasons for decision G 2/10, according to which "the general definition of the requirements of Article 123(2) EPC established in opinion G 3/89 and decision G 11/91 ... has become the generally accepted, one could also say the "gold" standard, for assessing any amendment for its compliance with Article 123(2) EPC" (underlining added by this board).

The board accepts that this statement disregards exceptions to the gold standard established by the Enlarged Board itself in its decisions G 1/93 and G 1/03 (see point 2.2 above). However, the situation has been clarified by decision G 1/16, which confirmed that the gold standard is not to be applied to undisclosed disclaimers, so the uniform application of the law is ensured even without a further referral to the Enlarged Board of Appeal.

3.2 Question 2

"If the answer to question 1 is that the Gold Standard **does** apply to all amendments, are there nevertheless different conditions under the Gold Standard for assessing whether amendments that **do or do not** provide

a technical contribution to the claimed invention comply with Article 123(2) EPC ?, i.e. given that amendments that potentially involve subject-matter that would extend beyond the content of the application as filed and as such are associated with an unwarranted advantage, so that for such amendments to establish compliance with Article 123(2) EPC [sic] it needs to be established beyond any reasonable doubt that the potentially added subject-matter does not extend beyond the content of the application as filed, whereas amendments that **do not** involve subject-matter that would extend beyond the content of the application as filed are not associated with an unwarranted advantage and *per se* comply with Article 123(2) EPC?"

As the jurisprudence of the Enlarged Board of Appeal has established that the gold standard does not apply to all amendments, there is no need to answer this conditional question.

3.3 Question 3

"If the answer to question 1 is that the Gold Standard is limited to amendments of the type that provide a technical contribution to the claimed invention, what criteria apply for demonstrating that amendments that **do not** provide a technical contribution to the claimed invention comply with Article 123(2) EPC?"

The answer to this question is not needed in order to rule on the matter in hand because the amendment under consideration does provide a technical contribution to the claimed invention (see point 2.2.2(c) above).

3.4 Question 4

"If a claimed feature is qualified by a positive statement "A" that limits the claimed feature to a state "A" and excludes from the claim a state "non-A", where "A" and "non-A" are mutually exclusive opposite conditions, and where state "A" is a normal state that is not explicitly disclosed in but can be implied from the original disclosure whereas the disclaimed state "non-A" is an abnormal state that is neither explicitly nor implicitly disclosed in the original disclosure, is the limitation of the claim to state "A" considered to not add subject matter to the original disclosure in the sense of Article 123(2) EPC by simple deduction that the normal state "A" is implied from the original disclosure in the absence of evidence that would produce the abnormal state "non-A."

This question need not be answered in order to rule on the specific case under consideration because the disclosure of the application as filed does not imply the intactness of the cured layer; the original application is not concerned with this question (see point 2.1 above).

3.5 Question 5

"If, to comply with Article 123(2)EPC, it must be proven that the normal state "A" is directly and unambiguously derivable from the original disclosure, by a skilled person using is common general knowledge, what are the criteria for establishing such proof? Is it proof on the balance of probabilities, proof beyond reasonable doubt, or proof beyond any doubt?"

As already mentioned (see point 2.1.2 above), there is a consensus among the boards of appeal that the standard of proof "beyond reasonable doubt" is appropriate in these situations (see Case Law, section II.E.5). Moreover, as the appellant has not persuaded the board that the original application can be deemed to implicitly disclose, directly and unambiguously, that the metallic ink is applied directly to the intact surface of the cured energy curable layer, the precise standard to be applied is not crucial for the specific case under consideration. Therefore, there is no good reason to refer this question to the Enlarged Board.

3.6 Question 6

"If the Enlarged Board determines that the applicable standard of proof to be applied in dealing with the situation of Question 4 is "proof beyond reasonable doubt", what criteria determine "beyond reasonable doubt" in this context, given that what is expected is: absent any proof of damage in normal operation, which does not correspond to the Case Law?"

As is clear from the reference to the absence of proof of damage (of the cured layer) during normal operation (of the claimed process), this question is too specific to be decided by the Enlarged Board. It is unrelated to the uniform application of the law and cannot constitute a point of law of fundamental importance. Moreover, as the situation in hand does not correlate with that set out in question 4, an answer to question 6 is not needed to rule on this case.

3.7 Conclusion

As none of the questions proposed by the appellant meets the requirements for questions to be referred to the Enlarged Board of Appeal in accordance with Article 112(1)(a) EPC, the request for referral has to be refused.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for referral to the Enlarged Board of Appeal is refused.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated