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**Datasheet for the decision
of 26 August 2024**

Case Number: T 1196/23 - 3.5.05

Application Number: 17804139.8

Publication Number: 3555737

IPC: G06F3/12

Language of the proceedings: EN

Title of invention:

Printing method

Applicants:

Siegwerk Druckfarben AG & Co. KGaA
ColorFit GbR

Headword:

Ignoring a relevant request/SIEGWERK

Relevant legal provisions:

EPC Art. 111(2), 113(1), 116(1)

EPC R. 103(1)(a)

RPBA 2020 Art. 11, 12(8)

Keyword:

Substantial procedural violation - (yes): no reasoning as to
the main request

Immediate remittal for further prosecution - (yes)

Reimbursement of the appeal fee in full - (yes)



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Case Number: T 1196/23 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 26 August 2024

Appellant 1: Siegwerk Druckfarben AG & Co. KGaA
(Applicant 1) Alfred-Keller-Str. 55
53721 Siegburg (DE)

Appellant 2: ColorFit GbR
(Applicant 2) Marienweg 3
53545 Linz am Rhein (DE)

Representative: Hepp Wenger Ryffel AG
Friedtalweg 5
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 2 March 2023
refusing European patent application
No. 17804139.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair K. Bengi-Akyürek
Members: K. Schenkel
C. AlMBERG

Summary of Facts and Submissions

- I. The applicants appealed against the examining division's decision to refuse the present application. The examining division had found that a main request did not comply with Article 84 EPC and that the auxiliary request did not comply with Article 56 EPC.
- II. The appellants' substantive requests, on appeal, were that the appealed decision be set aside and that a patent be granted based on the claims of one of five claim requests, all submitted with the statement of grounds. They also requested reimbursement of the appeal fee on the ground that a substantial procedural violation had occurred and argued, amongst others, that the appealed decision contained no reasoning at all as to one of the pending claim requests.
- III. In response to the board's communication under Article 15(1) RPBA indicating that the board is inclined to immediately remit the case to the examining division (Article 11 RPBA) and to order reimbursement of the appeal fee in full (Rule 103(1)(a) EPC), the appellants withdrew their request for oral proceedings.
- IV. The arranged oral proceedings were then cancelled.

Reasons for the Decision

1. Fundamental procedural deficiency (Rule 111(2) EPC)
 - 1.1 At the outset of the oral proceedings before the examining division, four claim requests were pending (see minutes, point 3). Later, two of them were

withdrawn (minutes, point 72), and another one was filed (minutes, point 50). Thus, three claim requests should be subject of the appealed decision. However, one of them is not. This is the main problem.

1.2 Concretely, the appealed decision deals only with the new main request as filed during said oral proceedings (labelled "New Main request" as filed), and the first auxiliary request filed on 17 November 2022 (labelled "Third auxiliary request" as filed, re-labelled at oral proceedings; see minutes, point 72) - whereas the **main request filed on 17 November 2022** is left out.

1.3 The **main request filed on 17 November 2022** was discussed during the oral proceedings before the examining division with respect to clarity and novelty (Articles 84 and 54 EPC, see minutes, points 7 to 41).

After the examining division's conclusion that claim 1 of the main request filed on 17 November 2022 was not novel (Article 54 EPC), the minutes state (point 43):

"The Representative and the First Member discuss the drafting of a new request in an attempt to iron out the differences and solve the outstanding objections."

Then, a new main request was filed (labelled "New Main request" as filed), which was discussed with respect to clarity (Article 84 EPC, see minutes, points 57 to 68).

1.4 However, there is no statement in the minutes that the main request filed on 17 November 2022 was withdrawn, or replaced by the "New Main request". In the absence of any indication to the contrary, the board concludes that the main request filed on 17 November 2022 was

thus still pending. Hence, the examining division decided on the case without deciding on a request relevant to its refusal decision.

- 1.5 Already the fact that no reasoning was provided in the appealed decision regarding the main request filed on 17 November 2022 contravenes Article 113(1) and Rule 111(2) EPC, and amounts to a *fundamental procedural deficiency* and a *substantial procedural violation* within the meaning of Article 11 RPBA and Rule 103(1)(a) EPC, respectively.
- 1.6 By the same token, it is further noted that, in the appealed decision, claim 1 of the **first auxiliary request filed on 17 November 2022** was found to lack an inventive step (Article 56 EPC). However, this conclusion was seemingly drawn without any consideration of the applicants' arguments at the oral proceedings before the examining division (cf. minutes, point 79). In addition, this matter seems, according to the file at hand, to have been properly discussed only at those oral proceedings (see applicants' letter filed on 17 November 2022, pages 2 and 3; cf. scanty notes relating to a telephone conversation held on 17 January 2023).
2. Remittal and reimbursement of the appeal fee
 - 2.1 The above-identified fundamental procedural deficiency constitutes a "special reason" justifying an immediate remittal of the case to the examining division under Article 111(1) EPC and Article 11 RPBA, i.e. without addressing the merits of the case.

2.2 Consequently, the appealed decision is to be set aside and the case to be remitted to the examining division for further prosecution.

2.3 In addition to the occurrence of a substantial procedural violation and the finding of an allowable appeal, full reimbursement of the appeal fee is equitable owing to the causality between the violation and the filing of the present appeal (Rule 103(1)(a) EPC).

3. Decision in written proceedings

The appellants withdrew their request for oral proceedings provided that the case is immediately remitted for further prosecution and the appeal fee is reimbursed in full (cf. point III above). Holding such oral proceedings would also not be expedient (cf. Article 116(1) EPC). Therefore, the decision is handed down in written proceedings (cf. Article 12(8) RPBA).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.
3. The appeal fee is to be reimbursed in full.

The Registrar:

The Chair:



S. Lichtenvort

K. Bengi-Akyürek

Decision electronically authenticated