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Datasheet for the decision of 4 February 2025

Case Number: T 0439/24 - 3.2.05

Application Number: 18833590.5

Publication Number: 3511173

IPC: B41N1/08, B41N3/03, B41C1/10, G03F7/00, G03F7/09, G03F7/11

Language of the proceedings: EN

Title of invention:
Lithographic printing plate precursor, lithographic printing plate manufacturing method, printing method and aluminum support manufacturing method

Patent Proprietor:
FUJIFILM Corporation

Opponents:
AGFA NV
Kodak Holding GmbH
Kodak GmbH
Kodak Graphic Communications GmbH

Relevant legal provisions:
RPBA 2020 Art. 10(3), 11, 12(4), 13(1), 13(2), 14
EPC Art. 54(1), 54(2), 100(a), 111(1)

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Keyword:
Intervention of the assumed infringer - in appeal proceedings
Acceleration of appeal proceedings (yes)
Format of the oral proceedings
Public availability of prior use proven (yes)
Novelty - main request, auxiliary requests 1, 2, 2a, 3, 4, 4a, 5, 6, 6a (no)
Late-filed auxiliary requests - admitted (auxiliary requests 1, 2a, 3, 4, 4a, 5, 6, 6a: yes, auxiliary request 2: admissibly raised, auxiliary request 7: no)
Remittal (no)
Amendment after notification of Art. 15(1) RPBA communication - exceptional circumstances (no)

Decisions cited:
G 0001/92, T 0952/92, T 1833/14, T 1452/16, T 1665/16, T 2951/18, T 0438/19, T 0239/20, T 1540/21

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Case Number: T 0439/24 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 4 February 2025

Appellant: (Opponent 1)	AGFA NV Septestraat 27 2640 Mortsel (BE)
Representative:	De Clercq & Partners Edgard Gevaertdreef 10a 9830 Sint-Martens-Latem (BE)
Respondent: (Patent Proprietor)	FUJIFILM Corporation 26-30, Nishiazabu 2-chome Minato-ku Tokyo 106-8620 (JP)
Representative:	Hoffmann Eitle Patent- und Rechtsanwälte PartmbB Arabellastraße 30 81925 München (DE)
Intervener I: (Opponent 2)	Kodak Holding GmbH Kesselstraße 19 70327 Stuttgart (DE)
Representative:	Vossius & Partner Patentanwälte Rechtsanwälte mbB Siebertstraße 3 81675 München (DE)
Intervener II: (Opponent 3)	Kodak GmbH Kesselstraße 19 70327 Stuttgart (DE)
Representative:	Vossius & Partner Patentanwälte Rechtsanwälte mbB Siebertstraße 3 81675 München (DE)

Intervener III:
(Opponent 4)

Kodak Graphic Communications GmbH
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Representative:

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Decision under appeal:

Decision of the Opposition Division of the European Patent Office posted on 23 January 2024 rejecting the opposition filed against European patent No. 3511173 pursuant to Article 101(2) EPC.

Composition of the Board:

Chairman P. Lanz
Members: T. Vermeulen
M. Blasi

Summary of Facts and Submissions

I. The opponent filed an appeal against the opposition division's decision rejecting the opposition against European patent No. 3 511 173.

II. The opposition was filed against the patent as a whole on the basis of the grounds for opposition under Article 100(a) EPC together with Article 54(1) EPC (lack of novelty) and Article 56 EPC (lack of inventive step), and under Article 100(b) EPC (insufficient disclosure).

III. By separate letters of 22 March 2024, three notices of intervention were filed pursuant to Article 105(1)(a) and Rule 89 EPC. The written reasoned statements by the interveners were identical in substance. The interveners based their interventions on the grounds of Article 100(a) EPC together with Article 54(1) EPC (lack of novelty) and Article 56 EPC (lack of inventive step). Acceleration of the proceedings was requested.

IV. In a communication accompanying the summons to oral proceedings, the board informed the parties that the interveners' request for accelerated appeal proceedings had been granted.

V. By letter dated 2 August 2024 the interveners requested that the oral proceedings be held in the hybrid format.

VI. With its reply to the statement of grounds of appeal, the respondent (patent proprietor) filed sets of claims of auxiliary requests 1 to 6 and requested that the proceedings be stayed in light of the referral G 1/23.

VII. By letters dated 30 and 31 October 2024, 13 December 2024 and 28 January 2025, the opponent (appellant) and the interveners presented further submissions.

VIII. The respondent filed further sets of claims of auxiliary requests 2a, 4a and 6a with a letter dated 3 December 2024 and repeated its request to stay the proceedings.

IX. In a communication pursuant to Article 15(1) RPBA issued on 16 December 2024, the parties were informed of the board's provisional opinion on the issues of the case.

X. By letter dated 8 January 2025, the respondent requested that the oral proceedings be held in the hybrid format or that the use of a private audio channel be allowed during the oral proceedings.

XI. In a communication issued on 10 January 2025, the board informed the parties that the respondent's request to allow the use of a private transmission channel was not granted and that the board did not see any reason to reconsider its view on the format of the oral proceedings.

XII. By letter dated 20 January 2025, the respondent filed further submissions and repeated its request to stay the proceedings.

XIII. In a further communication issued on 24 January 2025, the parties were informed that the date and time set for the oral proceedings were maintained.

XIV. Oral proceedings before the board were held in person on 4 February 2025. During the oral proceedings, the respondent filed a set of claims of auxiliary request 7.

XV. The following documents are mentioned in the present decision.

D13	EP 1 577 115 A2
D18	EP 1 972 460 A1
D37	Declaration by Mr Blum, 15 March 2024
D39	Declaration by Mr Wolber, 22 March 2024
D43	Declaration by Mr Nessler, 15 March 2024
D44	Redacted invoice "T41", 12 October 2017
D44a	List of goods delivered to Laserline
D45	Kodak, "Customer Information Bulletin", 14 December 2017
D46	Redacted email, 14 February 2018, "Naming T41 --> Sonora X"
D47	SAP screenshots and table, batch number 0000253299
D47a	SAP screenshot with wider field "Mat. Short Text"
D48	Declaration by Mr McCullough, 21 March 2024
D49	Redacted invoice "T41", 14 February 2018
D50	Redacted invoice "Son X", 28 February 2018
D51	List of billing documents "Son X" and "T41"
D53	Declaration by Mr Nessler, 21 March 2024
D54	H. Baumann et al., "Imaging Technology, 3. Imaging in Graphic Arts", Ullmann's Encyclopedia of Industrial Chemistry, 2015, pages 10 to 14
D69	Declaration by Mr Merka, 21 March 2024

D80 "Kodak Overview and Solutions - Meeting at Neografia, Martin, 19 October 2017", presentation slides
D82 Declaration by Mr Merka, 30 October 2024
D85 Declaration by Mr McCullough, 12 December 2024

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

The respondent (patent proprietor) requested that the appeal be dismissed, implying that the oppositions be rejected (main request) or, alternatively, that the decision under appeal be set aside and the patent be maintained in amended form on the basis of one of the sets of claims of the following auxiliary requests, in the following order:

- auxiliary requests 1 or 2 filed with the reply to the statement of grounds of appeal
- auxiliary request 2a filed with letter dated 3 December 2024
- auxiliary requests 3 or 4 filed with the reply to the statement of grounds of appeal
- auxiliary request 4a filed with letter dated 3 December 2024
- auxiliary requests 5 or 6 filed with the reply to the statement of grounds of appeal
- auxiliary request 6a filed with letter dated 3 December 2024
- auxiliary request 7 filed at the oral proceedings before the board.

Interveners I to III requested that the decision under appeal be set aside and that the patent be revoked.

XVII. Claim 1 of the main request reads as follows:

> "*1. A lithographic printing plate precursor having an aluminum support and an image recording layer disposed above the aluminum support, wherein the aluminum support includes an aluminum plate and an anodized film of aluminum formed on the aluminum plate, wherein the image recording layer is positioned on the anodized film side of the aluminum support, and wherein when measured over a 400 µm x 400 µm region of a surface of the aluminum support on the image recording layer side using a three-dimensional non-contact roughness tester, pits with a depth from centerline of at least 0.70 µm are present at a density of at least 3,000 pits/mm^2.*"

Claims 17, 18 and 19 of the main request are independent method claims.

XVIII. Claim 1 of auxiliary request 1 is identical to claim 1 of the main request.

Claim 1 of auxiliary request 2 has the following additional features:

> "*and wherein each of the micropores has a large-diameter portion which extends from the surface of the anodized film to a depth of 10 to 1,000 nm and a small-diameter portion which communicates with a bottom of the large-diameter portion and extends to a depth of 20 to 2,000 nm from a communication position between the small-diameter portion and the large-diameter portion, wherein an average diameter of the large-diameter portion at the surface of the*

anodized film is 15 to 60 nm, and wherein an average diameter of the small-diameter portion at the communication position is not more than 13 nm."

Claim 1 of auxiliary request 2a differs from claim 1 of auxiliary request 2 in that the following feature was inserted before the additional features presented above:

"*wherein the anodized film has micropores extending from a surface of the anodized film opposite from the aluminum plate in a depth direction of the anodized film,*"

Compared to claim 1 of auxiliary request 1, claim 1 of auxiliary request 3 was amended by replacing the feature "*at a density of at least 3,000 pits/mm^2*" with "*at a density of 3,000 to 6,000 pits/mm^2*".

Claim 1 of auxiliary requests 4 and 4a differs from claim 1 of auxiliary request 2 and 2a, respectively, by the same amendment as in auxiliary request 3.

Compared to claim 1 of auxiliary request 1, claim 1 of auxiliary request 5 was amended by replacing the feature "*at a density of at least 3,000 pits/mm^2*" of claim 1 with "*at a density of 3,500 to 6,000 pits/mm^2*".

Claim 1 of auxiliary requests 6 and 6a differs from claim 1 of auxiliary request 2 and 2a, respectively, by the same amendment as in auxiliary request 5.

Auxiliary requests 2, 2a, 4, 4a, 6 and 6a do not include any method claims.

Auxiliary request 7 has three independent method claims, which are based on method claims 17, 18 and 19 of the patent as granted and in which the features of the product claims have been incorporated.

XIX. The parties' submissions were essentially as follows:

Stay of the proceedings

- *Interveners*

The respondent's request for a stay of the proceedings in view of the pending referral G 1/23 was not justified and was therefore not to be granted. The proceedings only needed to be stayed if the prior-art product had to be excluded from the state of the art for the sole reason that its composition or internal structure could not be analysed and reproduced without undue burden. As set out below, the reproducibility requirement mentioned in opinion G 1/92 was met by the Sonora X printing plate precursors with batch number 253299. Although there was not yet a final decision in G 1/23, the Enlarged Board of Appeal had issued a very detailed preliminary opinion on 16 August 2024, in which it set out that the enablement requirement foreseen by opinion G 1/92 was also satisfied by the non-reproducible product in its readily available form, so that a physical product was, by definition, enabled by being put on the market. Furthermore, in view of the pending national infringement proceedings, the interveners had a strong interest in early certainty regarding the invalidity of the contested patent. This went against staying the proceedings.

- *Respondent*

As it was not possible to truly reproduce the Sonora X printing plate precursors relied upon by the interveners for their alleged public prior use objection, the pending referral G 1/23 was relevant. The decisive question in G 1/23 was whether or not reproducibility was a relevant criterion for determining the prior-art status of a product. Clarification on the correct legal assessment would shortly be provided in G 1/23. Contrary to the interveners' submissions, the preliminary opinion of the Enlarged Board of Appeal in G 1/23 did not make it possible to anticipate the final decision. One possible outcome might be that a product that was not reproducible did not constitute prior art, in which case the interveners' novelty objection would lack a suitable basis. The prior-art status of the prior-use products was thus a decisive question in the proceedings in this case. The President of the EPO had ordered that all opposition and examination proceedings were to be stayed in which this issue was decisive. The respondent considered that no other approach was to be taken on appeal. It was also noted that referral G 1/23 was not limited to "chemical products". There was thus no basis for assuming that the allegedly commercial products in the present case would not be encompassed by the final decision in G 1/23, even if this decision were to make a distinction between "chemical" and "mechanical" products. The most severe consequence for the appellant and interveners resulting from a stay of the proceedings was a delay by a couple of months. The respondent, on the other hand, was potentially faced with the loss of a valuable patent based on a legal approach that might shortly be qualified as incorrect

once the decision in G 1/23 was issued. Hence, ordering a stay of the proceedings was the only way in which the parties' interests could be fairly balanced.

Prior use by sale of Sonora X printing plate precursors of batch with number 253299 to Laserline

(a) Sale to Laserline

- *Appellant, interveners*

In 2017, Kodak Graphic Communications GmbH developed a new printing plate precursor for its Sonora product line. The first "Sonora X" printing plate precursors that were sold to customers were produced on 28 August 2017, i.e. before the earliest priority date of the patent, in the Osterode plant. On 12 October 2017, 12 boxes (each with 30 plates) of "Sonora X" printing plate precursors were sold to Laserline GmbH ("Laserline") in Germany. The invoice D44 showed the date of shipment, the delivery note number, the customer, the product description with the identifier and the material number, and the amount of boxes sold. It did not reveal an invoicing amount, since this was highly sensitive business information, but document D85 proved that the invoice D44, in its unredacted version, showed an invoice amount which was neither zero nor a nominal amount. Document D44a was further evidence that Laserline actually received the products referred to in document D44. The same information as in the invoice D44 could be seen in the SAP screenshots D47 and D47a (the latter with broader "Mat. Short Text" field), both of which further included the same batch number. The descriptor not only indicated the product but also the dimensions of the precursors, the number of precursors per package, etc.

It was thus clear that the invoice D44 related to products from a batch with number 253299.

The invoice D44 still showed the original project name "T41" because the official rebranding to "Sonora X" only took place on 15 February 2018. Documents D45, D46, D48 and D53 were provided as evidence of this. The new name was not announced to the customers before the official marketing launch, but it had been in internal use in the months leading up to the official rebranding. That was why the screenshots D47 and D47a referred to "SON X" rather than "T41". The respondent's assumption that "T41" would only refer to the substrate and not to a precursor having an image recording layer on the substrate was incorrect. Document D53 referred to both the substrate and the image recording layer. The "T41" product sold to Laserline was thus identical to "Sonora X". Documents D49 and D50 were further invoices and document D51 was a further SAP screenshot that proved that a product with article number "7452162" was sold first with the name "T41" and then as "Sonora X".

According to established case law, a single sale was sufficient to render the article sold available to the public, provided that the buyer (as in the present case) was not bound by an obligation to maintain secrecy. There was no explicit or tacit confidentiality agreement between Kodak and Laserline. The respondent's allegation ignored the basic fact that subsequent "Sonora X" productions were repetitions of the conditions as used on 28 August 2017 for the manufacture of printing plate precursors delivered (amongst other items) to Laserline and that therefore the development phase of "Sonora X" was indeed complete not just by December 2017, but well before that. Merely

stating that a corresponding tacit confidentiality agreement might have been in place without providing any corroborating evidence was a legally flawed approach and was incorrect. The respondent had not demonstrated that one or more parties involved in the prior use had an objectively recognisable interest in maintaining secrecy. The relationship with Laserline was not a joint venture or a special relationship of trust. The sale to Laserline was neither an internal test for research purposes nor a field test for research purposes. Instead, the "Sonora X" printing plate precursors of batch number 253299 were commercially sold and delivered to Laserline under full use of the regular SAP order and delivery system. It was an ordinary commercial transaction. This was also clear from the fact that Laserline obtained 12 packages each containing 30 printing plate precursors, i.e. a total of 360 printing plate precursors, resulting in a total length of more than 7.5 km. This was an enormous amount, suitable for printing many thousands of sheets. Moreover, the products were sent by normal hauler service. The fact that, with document D45, the rebranding of "T41" was announced by way of a general bulletin and that the addressees were referred to as "Dear Kodak Customer" demonstrated that "T41" was publicly available and advertised. The presentation D80 held at Neografia, Slovakia on 19 October 2017 was also proof that, at that time, Kodak's sales force was already actively promoting and advertising "T41" printing plate precursors, not only in Germany but also in other countries.

The respondent made a cryptic reference to the statement of defence in the parallel national infringement proceedings; however, the items mentioned in this statement did not relate to the batch with

number 253299 but to a different, much earlier production run. Furthermore, the product in question was not supplied to Laserline, but to a different company. The substrate prepared in the production run discussed in the statement of defence, the substrate of batch number 253299 and the substrates of the precursors which were commercially available under the trade name "Sonora X" were the same. There was thus no need to submit the statement of defence or the exhibit FBD19 discussed in it.

- *Respondent*

The alleged sales activities of "Sonora X" were not proven. The sale to Laserline lay entirely within the sphere of the interveners. The invoice D44 contained no reference whatsoever to batch number 253299, nor did it contain any other indication that it concerned "Sonora X". All that was apparent was a reference to "T41" ("Ihr Auftrag Nr T 41"), which was an internal project number used for research and development activities (see document D48). There was no real order number, which would have been typical for a normal customer. Moreover, it was not derivable from the invoice D44 whether the substrate was the XLT substrate mentioned in document D48, whether the alleged sale was part of an extensive field study and thus took place under a confidentiality obligation (whether explicit or tacit), or even when the product was produced. The invoice D44 did not reveal an invoicing amount, either. Documents D47 and D47a identified a different material from the invoice D44. It was unclear why the "Mat. Short Text" field in the SAP screenshots referred to "SON X" rather than to "T41", bearing in mind that the name change from "T41" to "Sonora X" was approved only four months later (see document D46). Document D51 was

supposed to be a list of billing documents, but it did not reveal batch number 253299. No customer names were listed. Even the material numbers and the Item Description in document D51 were different from the corresponding information in the invoice D44. As the list of billing documents D51 did not confirm the alleged sale mentioned in the invoice D44, it must be concluded that even the interveners did not consider the exchange with Laserline to form part of their commercial sales activities.

Neither document D49 nor document D50 lent any credibility to the alleged sale of plate precursors with batch number 253299 since these documents related to a different material having a different material description and a different material number compared with documents D44 and D47. As neither of documents D49 and D50 disclosed the alleged customer, they could not be used for public prior use discussions anyway. Based on the above, it was clear that different batches were available during the development phase of "Sonora X". Mr McCullough's statement in declaration D48 that the product that was produced and sold under the name "T41" (including batch 000253299) was the same as that sold under the trade name "Sonora X" thus could not be correct and was misleading at the very least. "T41" did not merely designate a specific single product, just as "SON X" did not relate to a specific product either. According to item 2 of declaration D48, "T41" was a "development project", i.e. a final product had not yet been determined. Furthermore, it followed from item 3 that the R&D project "T41" did not concern the complete precursor, but only the substrate XLT as such; however, the substrate and image recording layer had to be adjusted to each other, i.e. if there were changes to one, this might also have entailed adjustments to the

other. The generality of the statement that "T41" was just the same as "Sonora X" was thus incorrect.

Document D45 was a customer information bulletin allegedly distributed to customers in December 2017, but it only included a draft technical specification and was marked as confidential. The document explained that Kodak carried out internal tests and extensive field trials with its customers. In December 2017, the development phase was thus not yet completed. As observed in declaration D48, the research product also concerned the development of a new substrate that was internally called the XLT substrate. Documents D45 and D48 thus implied that there must have been very close cooperation (and thus a very close relationship) between the "customers" and Kodak. It must thus be assumed that a confidentiality agreement was in place. At the very least, it suggested that the interveners' "customers" were not merely any third party, but that there was a special relationship of trust. Changing the product description from "T41" to "Sonora X" therefore went beyond mere rebranding. None of this was called into question by declaration D53, in which Mr Nessler was very clear that the similarity between the different "Sonora X" batches merely concerned the substrate, not the final product. Insofar as the interveners relied on document D80 to assert that Kodak's sales force was already actively promoting and advertising "T41" printing plate precursors in October 2017, it was noted that there was not just one product that was named "T41". Document D80 accordingly had no value for the present public prior use discussion.

The statement of defence that was filed by the interveners in the parallel national infringement

proceedings shed light on the fact that the purpose of the field trial of "T41" was to investigate the printing behaviour of test products. The substrate prepared in the production run discussed in the statement of defence, the substrate of the batch with number 253299 and the substrates of the precursors which were commercially available under the trade name "Sonora X" were not the same. The interveners were requested to submit redacted versions of the statement of defence and the relevant exhibit FBD19.

(b) *Sample retained by Kodak*

- *Interveners*

The respondent's erroneous assumption based on the production time calculated from the data of document D47 did not take into account that the production lines in Osterode were modern, with the possibility of in-line cutting to take samples at any time before the production of a certain batch was finalised. It was therefore not necessary for an operator to wait until the end of production of a batch to retain a sample required for quality control or other purposes. The retained sample mentioned in document D37 was taken about a quarter of an hour before the production was finished. For the avoidance of doubt, Mr Nessler was offered as a witness to confirm that the manufacturing conditions which were used for producing the printing plate precursors that were delivered to Laserline and the manufacturing conditions which were used for producing the retained printing plate precursors were the same and thus that the printing plate precursors delivered to Laserline and the retained printing plate precursors were the same.

- *Respondent*

Based on the bottom table on page 2 of document D47, the time of manufacture of the batch with number 253299 was from 16.05 hrs to 19.01 hrs, because the speed of manufacture was 43 metres per minute and the specific length was 7 596 metres. In view of the fact that the manufacturing was completed after 19.00 hrs on Monday, 28 August 2017, it was not clear how document D37 could suggest a packaging time of 18.47 hrs. It was also not at all apparent that the product properties remained identical over the entire production of the batch with number 253299, bearing in mind that more than 7.5 kilometres of alloy substrate had been treated at high velocity. Against this background, it could not be concluded with sufficient certainty that all the properties (including specific pit density) of the sample retained by Kodak were identical to the material mentioned in documents D44 and D47.

(c) Reproducibility

- *Interveners*

In the analytical report filed with its infringement suit in the parallel national infringement proceedings, the respondent had already provided evidence that it was possible to determine the macroscopic properties (e.g. pit density) and microscopic properties (e.g. pore structure) of the aluminium support of a printing plate precursor as well as the components of the image recording layer of the precursor. Moreover, following the analysis carried out by the appellant and the interveners, there was no doubt that a skilled person was able to analyse commercial products with respect to the components of the image recording layer and the

structure of the aluminium support. Knowledge of the patent and the specific methods disclosed in it were not required for reproducing such prior-art products. Lithographic printing plate precursors with aluminium supports had been commercially available for several decades. It was commonly known to the skilled person that the aluminium support had to be subjected to several treatment steps like etching, surface graining, desmutting and anodising before applying the image recording layer. These were all standard steps. Even if chemicals were used in the manufacturing process, the final product was essentially a mechanical product characterised by a certain surface topography. Furthermore, the contested patent did not refer to any previously unknown process steps. The skilled person was well aware that the conditions of each treatment step had an influence on the surface structure of the aluminium support. For instance, even before the priority dates of the contested patent, it was well known that the dominant surface graining method was electrochemical graining and that the surface roughness and evenness was determined by current density, AC profile, electrolyte composition, temperature, concentration, etc. The influence of the anodising conditions on the pore structure of the anodised film was also well known before the priority dates of the contested patent. Reference was made to document D13, in which the production of aluminium supports having at least 5 000 pits/mm^2 of a depth from the centerline of at least 0.50 µm within an area of 400 µm x 400 µm was described. Just like the printing plate precursors in document D18, the "Sonora X" printing plate precursors were not manufactured using a mixture of hydrochloric acid and sulfuric acid as specified in claim 19 of the contested patent. The claimed pit density thus could not only be achieved by applying the method in claim 19

of the contested patent, but also by other methods. This was confirmed by declaration D43. A skilled person having analysed a commercial product like a "Sonora X" printing plate precursor was thus able to reproduce it without undue burden.

To additionally demonstrate the reproducibility, reference was made to Mr Merka's declaration D82, according to which he analysed a commercial product of the respondent using common methods that were well known even before the earliest priority date of the contested patent, and then performed reverse engineering by applying common process steps. As was apparent from declaration D82, the original and the reworked plates had the same product features within the usual variations found in this technical field. Mr Merka was an appropriate person skilled in the art. All the analytical procedures and process steps used by Mr Merka were well known in the art on the earliest priority date of the contested patent. This was evidenced by the content of the contested patent. In addition, the pit density, the pore structure and the L* value were amply described in the prior art. It followed from page 19 of declaration D82 that the electrochemical graining was carried out without sulfuric acid, i.e. the process of claim 19 as granted was not necessary for obtaining the pit density. Moreover, declaration D82 provided a detailed analysis report and production protocol. The intention of declaration D82 was not to demonstrate any connection between different commercial products, but to prove that a skilled person was able to analyse a commercial product of a competitor and reproduce the technical features of it.

As regards the necessity to rework the prior-art product, reference was made to decisions T 952/92, T 1540/21 and T 1452/16. The case law was explicit that it was not necessary to exactly rework the product, but merely the claimed features. For these reasons there was no doubt that the reproducibility requirement mentioned in opinion G 1/92 was met by the "Sonora X" printing plate precursors of the batch with number 253299.

The sale of "Sonora X" printing plate precursors to Laserline thus constituted prior art under Article 54(2) EPC.

- *Respondent*

Pursuant to opinion G 1/92, a skilled person had to be capable of reproducing exactly the product at stake and not merely a product that had properties falling within the scope of the claims. Reference was also made to decision T 1833/14. A condition to be fulfilled was that the skilled person knew how to prepare the exact product without undue burden. The mere availability of a sample of a product was not sufficient for the skilled person to be able to prepare it. In addition, the ability to analyse a product in terms of the number and density of pores of a certain depth was not equivalent to the ability to reproduce said feature.

The case law on reproducibility was also applicable to the aluminium plates used as printing plate precursors allegedly sold to Laserline. The law did not provide a basis for applying different criteria for a product to belong to the prior art depending on if it were a "chemical" or a "mechanical" product. In the present case, the "Sonora X" printing plate precursors were

chemical products. They were obtained by electrochemical reactions in an electrolyte bath having a certain composition, which led to the formation of pits by selective dissolution of aluminium. The number, nature and structure of these pits depended on the reaction conditions and in particular on the composition of the electrolyte bath. The resulting aluminium plate was thus the product resulting from physico-chemical treatment of the aluminium precursor plate and thus resulted from a chemical reaction. The pits were not formed by a mechanical treatment, such as drilling or brush graining. The shape, number and depth of pores formed by an electrochemical graining treatment within the aluminium plate were part of the internal structure of the plate. If a skilled person wished to reproduce the "Sonora X" products, they needed to know the chemical composition and the internal (pore) structure of the aluminium plates in order to obtain the same structure and the same properties in use. This was also apparent when considering that a product having the same pore structure, but made of a different aluminium material, was a different product.

It was undisputed that there were many variables that had an impact on the final printing plate precursors, including on their composition and internal structure, but the skilled person did not have access to any specific documents or indications that would have taught them what specific production conditions were to be used for the reproduction. They would have had to rely solely on their common general knowledge to reproduce the plates allegedly delivered to Laserline. The electrochemical graining conditions and electrolyte bath compositions that made it possible to reproduce not just any arbitrary porous aluminium plate, but the

commercial products, lay beyond the skilled person's common general knowledge on the earliest priority date of the contested patent, however. Without this knowledge, a skilled person had no other choice but to enter a veritable research program. This was not an issue of simply testing two or three different conditions and compositions, but indeed hundreds of different bath compositions and electrochemical graining conditions. This constituted an undue burden. It must also be considered that there were various product modifications under the same product series "Sonora X" and "T41", as evidenced by the different material numbers and material descriptions.

Regarding declaration D82, Mr Merka was not a skilled person, but had special knowledge that went beyond the common general knowledge of a skilled person on the earliest priority date of the contested patent. Mr Merka's decision in favour of specific process steps therefore not only failed to reflect the approach a skilled person would have chosen on the earliest priority date of the contested patent, but his analysis was also based on experience and access to equipment that had not been available to the skilled person on the earliest priority date of the contested patent. Declaration D82 failed to disclose a detailed protocol of all those experimental tests that were needed to arrive at the alleged rework. It was thus entirely unclear if Mr Merka had to undertake a complete research program or if he arrived at the results reflected in the declaration in a straightforward manner. In any case, declaration D82 did not meet the requirements established in the case law for experimental evidence; see in particular "Case Law of the Boards of Appeal of the European Patent Office", I.D.4.3.2. Everything that was set out in declaration

D82 demonstrated that, by relying on his personal knowledge in 2024, Mr Merka was able to produce an aluminium plate that was similar to a commercial product. This did not allow it to be concluded that a skilled person was able to perform a reproduction of a commercial product based on common general knowledge in 2017. Declaration D82 thus had no evidentiary value. Furthermore, Figure 22 of declaration D82 showed significant differences in the top-view SEM micrographs of the reworked support (left) and the original printing plate precursor (right). The products were not identical. As no evidence of a technical connection between "Sonora X" and the product analysed by Mr Merka was produced, declaration D82 was irrelevant. It did not demonstrate that the skilled person would have been able to rework a market product on the effective date of the patent, let alone a product for which it was unclear whether it had ever made its way to the public domain before said date.

Since it was questionable whether the "Sonora X" printing plate precursors allegedly sold to Laserline had been made available to the public, they did not constitute prior art in the sense of Article 54(2) EPC.

Main request - ground for opposition under Article 100(a) EPC together with Article 54(1) EPC

- *Appellant, interveners*

According to Mr Blum's declaration D37, a sample of "Sonora X" printing plate precursors with batch number 253299 was retained at the Kodak Graphic Communications GmbH plant in Osterode in a closed envelope. On page 2 of declaration D37, the batch number could be seen on the photograph of the rear side of the sample retained

for analysis. A disk was punched out of this sample, and it was then decoated and sent from the Osterode plant to Eastman Kodak Company in Rochester, USA for analysis of the pit density. The measurements of the pit density were summarised in Mr Wolber's declaration D39. A value of 3 720 pits/mm^2 was obtained. This value fell within the range specified in claim 1 of the contested patent.

With regard to the respondent's position that the interveners' measurement data was unreliable and was to be disregarded because it followed a "trend", it was submitted that the same must then have been true for the respondent's own data presented in the parallel national infringement proceedings, which followed a trend as well. All the measured values inherently had certain variations, even if the same sample was investigated. The standard deviation of 152 had to be taken into account.

Hence, the subject-matter of claim 1 of the patent as granted lacked novelty over the prior-used "Sonora X" printing plate precursors with batch number 253299.

- *Respondent*

The pit density values that were reported on page 5 of the declaration D39 for the "Sonora XP #236277" and the "Sonora X #253299" samples followed the same trend in the table from top to bottom. While this might be a coincidence, it was not credible. It was therefore requested that the original measurement data for the Sonora X #253299 sample as well as sample probes be shared with the respondent, to allow for an independent measurement of the pit density.

Auxiliary requests 1, 2, 2a, 3, 4, 4a, 5, 6 and 6a - admittance

- *Appellant, interveners*

Out of the auxiliary requests filed on appeal, only auxiliary request 2 corresponded to a request filed before the opposition division, namely the seventh auxiliary request however, since the conclusion reached by the opposition division was that the opposition was to be rejected, no decision was taken on the admittance of that request. Hence, at no point was the seventh auxiliary request considered to have been part of the proceedings before the opposition division. The current auxiliary requests 1 and 3 to 6 were not submitted during the proceedings before the opposition division, and were thus completely new. In view of the primary object of appeal proceedings to review the decision under appeal, the appeal case including the reply to the statement of grounds of appeal had to be directed to claim requests on which the decision under appeal was based. Since the decision under appeal was not based on any of auxiliary requests 1 to 6, these therefore had to be regarded as an amendment to the respondent's appeal case pursuant to Article 12(4) RPBA. For this reason alone, none of the auxiliary requests were to be admitted into the appeal proceedings. Furthermore, auxiliary requests 1 to 6 were divergent with respect to one another and the respondent did not explain and justify the amendment to its case, nor was an indication given of a proper basis for the amendments to any of auxiliary requests 3 to 6. The issue of a limited pit density had been in the proceedings from the beginning. Moreover, the respondent failed to provide convincing reasons why the amendments to the auxiliary requests would overcome the

objections raised. Instead, it introduced additional objectionable subject-matter, thereby hindering procedural efficiency. In view of the above, it was requested that none of auxiliary requests 1 to 6 be admitted into the proceedings since they did not *prima facie* overcome the objections raised.

- *Respondent*

The auxiliary requests were to be admitted into the appeal proceedings. The amended set of claims of auxiliary request 1 differed from the main request only in that claims 6 to 8 were omitted, which aided procedural efficiency because it rendered the priority and novelty objections against these claims moot. As auxiliary request 2, an amended set of claims 1 and 2 was submitted which was identical to the seventh auxiliary request filed on 15 September 2023 in the proceedings before the opposition division. It was admissibly filed and maintained in the proceedings leading to the decision under appeal and addressed the novelty and inventive-step objections. Moreover, it had been filed in due time pursuant to Rule 116 EPC and was based on granted claims. Claim 1 of each of auxiliary requests 3 to 6 had limitations to the pit density. These amendments addressed the objections of sufficiency of disclosure and of novelty. The requests were convergent and the amendments had been justified by the respondent. Furthermore, it was to be taken into account that, due to the interventions, a new procedural situation had arisen. The reason for submitting auxiliary requests 2a, 4a and 6a was that they overcame a clarity objection which was raised for the first time by the appellant by letter dated 30 October 2024. The amendments were suitable for resolving the issue and did so without adversely

affecting procedural economy and without giving rise to new objections.

Auxiliary request 1 - novelty

- *Appellant, interveners*

The novelty objection against claim 1 of the main request was applicable, *mutatis mutandis*, to claim 1 of auxiliary request 1.

- *Respondent*

The subject-matter of claim 1 of auxiliary request 1 was novel for the same reasons as set out in respect of the main request.

Auxiliary request 2 - request for remittal

- *Appellant, interveners*

Remittal of the case to the opposition division was not appropriate, particularly since the parallel national infringement proceedings, which required early legal certainty for the parties involved, had been initiated by the respondent. It would contradict the acceleration of the appeal proceedings and would cause unnecessary delay. The respondent had had sufficient time to prepare counter-arguments against the objections raised in respect of the claims of auxiliary request 2. In fact, the interveners' prior-use case had been presented from the outset, also in respect of granted claim 4 which formed the basis for the amendments to claim 1 of auxiliary request 2. The case had not developed any further during appeal proceedings. In addition, the board was able to take a decision on the

merits with regard to auxiliary request 2, especially since it was clear from the submissions on file that the additional features of claim 1 were also fulfilled by the "Sonora X" prior use.

- *Respondent*

It was requested that the case be remitted to the opposition division for further prosecution. This had not been requested in the written proceedings but had actually been pointed out in the board's communication pursuant to Article 15(1) RPBA. The present case was special in that the interventions on appeal had presented objections based on a new allegation of prior use. In decisions T 1665/16, T 2951/18 and T 239/20, too, remittal was ordered after a fresh case had been created by an intervention on appeal. This was thus not a regular case in which remittal could be denied to avoid procedural ping-pong between the two deciding bodies. In claim 1 of auxiliary request 2, a feature was added that had not been considered by the opposition division. This was a special reason to remit the case, particularly in view of the primary object of appeal proceedings to review the decision under appeal. The interveners were not correct that all the details of their prior-use case had been given from the outset. The respondent had identified many gaps which were subsequently filled to the board's satisfaction. In fact, the prior-use discussion had been a very dynamic, step-by-step process in which the interveners were given several opportunities to file more evidence. The hurdle of reproducibility was also new in view of the additional features of claim 1 of auxiliary request 2. The acceleration of the appeal proceedings had provided for shorter deadlines and less opportunity to consider all the facts. Remittal could also be considered fair

to give the respondent a further opportunity to develop a new auxiliary-requests strategy.

Auxiliary request 2 - novelty

- *Appellant, interveners*

According to declaration D69, Mr Merka analysed the decoated sample of "Sonora X" printing plate precursors of the batch with number 253299 with respect to the pore structure. As was evident from the second paragraph on page 7 of declaration D37, he had received the sample from Mr Blum. Several measurements were carried out by Mr Merka. The obtained values fell within the ranges specified in claim 1 of auxiliary request 2. Regarding the reproducibility of the prior-art sample, it was noted that a large number of prior-art documents all disclosed the same pore structure and the same dimensions as in claim 1 of auxiliary request 2. In addition, the analysis of the respondent's commercial product reworked in declaration D82 provided very similar results to the original values. The declaration explained all the process steps necessary to make the product; they were all standard in the art. The respondent did not provide an argument as to which step was missing. Therefore, even if reproducibility were necessary for establishing whether the sample was actually prior art, this would be the case here. Hence, the subject-matter of claim 1 of auxiliary request 2 lacked novelty.

- *Respondent*

The novelty objection based on the "Sonora X" prior use had to fail because the printing plate precursors relied upon by the interveners were not publicly

available before the effective date of the contested patent. In addition, the prior-use sample discussed in declaration D69 was not reproducible and hence did not constitute prior art. The additional features of claim 1 of auxiliary request 2 entailed further complexity, which raised the hurdle for reproducibility. At the time of the earliest priority date of the contested patent, it was not common general knowledge to establish these features. With regard to declaration D82, nowhere did it indicate a textbook in which Mr Merka found the information required to carry out the different process steps. The fact that they might be disclosed in some patent documents did not make them part of common general knowledge. In sum, the subject-matter of claim 1 of auxiliary request 2 was novel.

Auxiliary requests 2a, 3, 4 and 4a - novelty

- *Appellant, interveners*

The definition of the upper limit of the pit density had no influence on the arguments with respect to novelty over the prior-used "Sonora X" printing plate precursors with batch number 253299 since the corresponding pit density values lay in the range of 3 000 to 6 000. Therefore, the subject-matter of claim 1 of auxiliary request 2a, 3, 4 and 4a also lacked novelty.

- *Respondent*

The subject-matter of claim 1 of each of auxiliary requests 2a, 3, 4 and 4a was novel for the same reasons as set out in respect of the higher-ranking requests.

Auxiliary requests 5, 5a, 6 and 6a

- *Appellant, interveners*

The definition of the new lower limit of the pit density had no influence on the arguments with respect to novelty over the prior-used "Sonora X" printing plate precursors with batch number 253299 since the corresponding pit density values lay in the range of 3 500 to 6 000. Therefore, the subject-matter of claim 1 of auxiliary requests 5, 5a, 6 and 6a also lacked novelty.

As regards the respondent's new line of argument presented at the oral proceedings, this came as a surprise. The respondent should have already presented its entire case at the beginning of the appeal proceedings. The value of 3 720 pits/mm^2 mentioned in declaration D39 had already been discussed in the context of the higher-ranking requests. The respondent had not expressed any doubts on the validity of the data at that time. The requirement of 3 500 to 6 000 pits/mm^2 had been in the proceedings since auxiliary request 5 was filed. Therefore, it was requested that this late line of argument not be admitted into the appeal proceedings. Article 14 RPBA provided for this possibility in the event of an intervention. There was no reason for remittal at this stage of the proceedings.

- *Respondent*

Claim 1 of auxiliary request 5 specified a different lower limit for the pit density. Even if declaration D39 mentioned an average value above that lower limit,

it had to be considered that, according to Mr Nessler's declaration D53, the subsequent commercial scale production of "Sonora X" used the same materials and the same settings of the manufacturing line as for batch number 253299. On page 5 of their letter dated 13 December 2024, the interveners gave pit density values for a "Sonora X" product that was relevant in the parallel infringement proceedings. Despite the time that had passed since the production of batch number 253299, this product was manufactured with exactly the same settings. An average value of 3 368 pits/mm^2 was measured for this product. This was 10% away from the value of 3 720 pits/mm^2 mentioned in declaration D39 and raised questions on the accuracy of the latter value and the novelty of the claimed subject-matter.

It was requested that this line of argument be admitted into the appeal proceedings. The respondent had not had any reason to present this line of argument earlier because the board's communication, in the context of the main request, had focused on the very high pit densities of another prior use. In addition, the discrepancy between the measured values had only become relevant in the context of auxiliary request 5 due to the increased lower limit of the pit density range. In any case, only when the interveners had filled the gaps in their prior-use case had the respondent been in a position to consider which further objections were to be raised. The RPBA included provisions for the relationship between the appellant and the respondent but not for the relationship with interveners. Additionally, it was again requested that the interveners share the sample probes of the "Sonora X" prior use so that the respondent could undertake its own analysis. Furthermore, the case was to be remitted

to the opposition division for consideration of this matter.

The same also applied to the subject-matter claimed in auxiliary requests 6 and 6a.

Auxiliary request 7 - admittance

- *Appellant, interveners*

Auxiliary request 7 was not to be admitted into the appeal proceedings. The circumstances justified applying Article 13(2) RPBA, pursuant to Article 14 RPBA. It was filed at the latest possible moment, namely at the end of the oral proceedings on appeal. There were no exceptional circumstances because the claims had already been objected to in the notice of opposition. The respondent could have already filed auxiliary request 7 in response to the notices of intervention and the statement of grounds of appeal, in which objections against the method claims of the patent as granted had been raised. There was a lack of convergence with respect to those previous auxiliary requests from which the method claims had been deleted. This was an abuse of procedure, a tactical move in order to delay the proceedings.

- *Respondent*

Auxiliary request 7 was based on claims 17, 18 and 19 of the patent as granted. The request was thus convergent compared to higher-ranking requests. The claims of this new request were filed in response to the prior-use objections presented by the interveners on appeal. The respondent had to have the opportunity to respond to new objections raised on appeal. The

opposition division would have admitted new requests in response to new objections, especially if they were based on granted claims. The fact that the method claims had been deleted from some previous requests did not mean that the respondent had lost interest. For auxiliary request 7, the circumstances were exceptional in that, according to point 84 of the board's communication, the claims formulated in this request had to be discussed at the oral proceedings. The fact that claims 17 to 19 as granted had already been discussed in the statement of grounds of appeal was an argument in favour of admitting auxiliary request 7.

Reasons for the Decision

Acceleration of the proceedings

1. In their notices of intervention which met the requirements of Article 105(1) and Rule 89 EPC, the interveners requested that the appeal proceedings be accelerated. Considering the pending national infringement actions for which the interveners provided documentary evidence, the board decided to grant this request under Article 10(3) RPBA and informed the parties accordingly in a communication accompanying the summons to oral proceedings.

Request to stay the proceedings

2. In the written appeal proceedings, the respondent requested that the board order a stay of the proceedings in view of the pending referral case G 1/23. The argument was that the prior-art status of the "Sonora X" printing plate precursors which the interveners alleged were made available to the public through a sale to Laserline GmbH was decisive for the outcome of the present appeal case. As long as the Enlarged Board of Appeal had not provided clarity on the question of whether or not reproducibility was a relevant criterion for determining the prior-art status of a product, the proceedings were to be stayed.

3. The board did not see any need to stay the proceedings in view of the referral case G 1/23, for the following reasons.

4. By way of interlocutory decision T 438/19, three questions had been referred to the Enlarged Board of Appeal in G 1/23. The first and central question is worded as follows:

> "*Is a product put on the market before the date of filing of a European patent application to be excluded from the state of the art within the meaning of Article 54(2) EPC for the sole reason that its composition or internal structure could not be analysed and reproduced without undue burden by the skilled person before that date?*"

5. In its communication dated 16 August 2024, the Enlarged Board of Appeal adopted the questions using the wording of the referring board in decision T 438/19.

6. In the present case, the board concluded that the products subject to the prior use in question were reproducible in the sense that their composition and internal structure had been able to be analysed and reproduced without undue burden by the skilled person before the earliest priority date of the contested patent (see points 20. to 26. below). The condition set out in the first question of the referral case G 1/23 ("*for the sole reason that*") therefore did not come into effect.

Format of the oral proceedings

7. After the parties had been summoned to in-person oral proceedings, in a letter dated 2 August 2024 the interveners requested that the oral proceedings be held in the hybrid format "*so that accompanying persons of the party can attend the oral proceedings by videoconference*". This request was repeated in their letters dated 31 October 2024 and 7 January 2025.

8. In a letter dated 8 January 2025, the respondent requested that the board allow the use of a private audio channel during the oral proceedings or, alternatively, that the oral proceedings be held in the hybrid format.

9. Having regard to the board's responsibility to conduct the oral proceedings in a controlled and supervised manner and considering the Notice of the Vice-President of Directorate-General 3 of the European Patent Office dated 16 July 2007 concerning sound recording devices in oral proceedings before the Boards of Appeal of the EPO (OJ EPO 2014, Supplementary Publication 1, 74), the

respondent's request to allow the use of a private audio channel during the oral proceedings was not granted. This was notified to the parties in a communication dated 10 January 2025.

10. Furthermore, the board noted that all parties had announced that they would be represented at the oral proceedings. They had expressed their agreement that an in-person hearing was more expedient in the circumstances of the specific case than a videoconference. The oral proceedings were public and could thus be attended by any person. In view of this, the board did not see any reason to reconsider its view on the format of the oral proceedings.

"Sonora X" prior use

Sale to Laserline GmbH

11. It is alleged by the interveners that, in 2017, Kodak Graphic Communications GmbH manufactured and sold printing plate precursors of the "Sonora X" type with batch number 253299 to Laserline GmbH ("Laserline"). The allegations are supported by an invoice D44, a list of delivered goods D44a and various SAP screenshots filed as D47 and D47a.

12. The invoice D44 was issued on 12 October 2017 ("Belegdatum") by Kodak GmbH and is addressed to Laserline ("Kunden Nr. 575266"). It concerns 12 items with the following descriptor:

"T41 30 0811 1055 M SE002 0030 P1 O
CAT 7452071"

A bill-of-lading number ("Lieferschein Nr.") 257593559 is mentioned together with the date of shipment ("Verladedatum") of 12 October 2017.

The SAP screenshots of documents D47 and D47a list the same bill-of-lading number, the same customer, a posting date of "10/12/2017", and a quantity ("Qty in UnE") of 12 items with material number "7452071" and batch number "0000253299". Apart from a wider field "Mat. Short Txt", the SAP screenshot of document D47a seems identical to the first SAP screenshot of document D47. The following descriptor is indicated:

"SON X 30 0811 1055 M SE002 0030 P1 O"

The list of delivered goods, D44a, contains the date 12 October 2017 and the same bill-of-lading number in respect of goods delivered as 12 packages ("12 PCS") to the final recipient "Laserline Druckzentrum Berlin" with a gross weight of 295 kg and a volume of 0.553 m^3.

13. By way of the document D45 and the email D46, the interveners convincingly demonstrated that the different descriptors used in the invoice D44 and in the field "Mat. Short Text" of the SAP screenshot of document D47a were due to the fact that, in early 2018, the original name "T41" was rebranded to "Sonora X", a name that had already been in internal use before that time. The respondent objected that document D45 bears the label "Kodak Confidential" and has an annex entitled "Draft Technical Specification", yet the document is a marketing bulletin addressed to Kodak customers in Europe ("*Dear Kodak Customer*", "*Scope: Europe*"). It is also consistent with Mr McCullough's

declaration D48, in which printing plate precursors produced on 28 August 2017 with batch number "0000253299" were initially sold as "T41" but changed their name to "Sonora X" at the beginning of 2018. The board notes that the same date is indicated as the "Start Date" in the third SAP screenshot of document D47. In his declaration D53, Mr Nessler confirmed that "T41" printing plate precursors manufactured on 28 August 2017 were based on a substrate internally called the "XLT substrate". The substrate was coated in-line in one continuous process with an image recording layer which remained unchanged for the subsequent commercial sale production of "Sonora X". The items sold under the name "T41" were thus not limited to the substrate, as the respondent argued, but included the image recording layer. The rebranding of "T41" to "Sonora X" is further corroborated by the different descriptor prefixes used in invoices D49 and D50 and the screenshot D51 in the context of sales, albeit to unidentified customers and in respect of printing plate precursors with different batch numbers, on 14 February 2018 ("T41") and 28 February 2018 ("SON X"), respectively, i.e. before and after the rebranding date mentioned in the email D46.

14. In the respondent's view the alleged sale to Laserline was not public due to the existence of a confidentiality agreement or at least a special relationship of trust between Kodak and Laserline in respect of the "T41" items. This argument is not convincing either. The respondent did not demonstrate that either Kodak or Laserline had an objectively recognisable interest in maintaining secrecy. The production of "T41" printing plate precursors with batch number 253299 on 28 August 2017 may have been preceded by a research project involving internal

testing and possible field tests, as Mr McCullough's declaration D48 indicates. It is difficult to conceive, however, of why Kodak would have sold 12 packages of printing plate precursors with a gross weight of 295 kg and a volume of 0.553 m^3 (document D44a) from a batch produced on 28 August 2017 in the form of more than 7 500 cumulative metres of material (see the third SAP screenshot in document D47) if the sale only served the purposes of an internal test for research purposes. Furthermore, there is no reason to assume that the invoicing amount of D44 was zero or a nominal amount, as alleged by the respondent, all the more so since this is explicitly refuted by Mr McCullough in his further declaration D85. Had there been an interest in maintaining secrecy, it is highly unlikely that Kodak would have issued Customer Information Bulletin D45 assuring its customers in Europe "*that the plates supplied to you under the T41 label are identical to those that will be labelled with the new brand*". The presentation of "Sonora T41" next to the established brand "Sonora XP" in the presentation D80 further corroborates the interveners' view that "T41" was not a mere test project.

15. With regard to the respondent's request that the interveners submit a redacted version of their statement of defence presented in the parallel national infringement proceedings or an exhibit referred to as "FBD19", which was allegedly filed together with and discussed in that statement of defence, the board notes that it has no power to oblige any party to submit specific evidence. It is for each party to provide the evidence which it considers appropriate to prove its case. The board's task is to consider whether or not, based on the principle of free evaluation of evidence, it is convinced of a party's allegations in light of

its submitted evidence, thereby also taking into account any allegations and evidence submitted to demonstrate the contrary.

As the interveners pointed out and the respondent did not refute, neither the items mentioned in the statement of defence nor the exhibit FBD19 related to "Sonora X" printing plate precursors of the batch with number 253299. Therefore, the board fails to see the relevance of such submissions to the present case.

16. In view of the above considerations, the board is satisfied that, on 12 October 2017, "Sonora X" printing plate precursors with batch number 253299 were sold and delivered to Laserline without any obligation of confidentiality.

Sample retained by Kodak

17. The interveners submitted that a sample of the "Sonora X" printing plate precursors with batch number 253299 was retained at the Kodak plant in Osterode for the purpose of analysis. Declarations D37 and D39 were filed as proof. The respondent objected that the packaging time of "18:47" appearing on the label of the envelope shown on page 2 of Mr Blum's declaration D37 was at odds with the completion of the manufacturing process implied by the data in the third table of document D47. In the respondent's view, the retained sample thus could not be identical to the material that was subject to the sale to Laserline.

18. The board agrees with the respondent that, with a production start at 16.05 hrs and a speed of 43 metres per minute, the manufacture of 7 596 cumulative metres of material could not have ended before 19.01 hrs;

however, the interveners convincingly counter-argued that the production lines in Osterode allowed in-line cutting so that a sample could be retained while the production of the batch was still ongoing. Therefore, it is credible that a sample was packaged before the production of the batch had been completed.

19. Also considering that the manufacture of a single product in batches implies that the properties (in this case, the specific pit density at the surface) remain identical over the entire batch, the board is persuaded that the analysis of the retained sample carried out by Mr Blum and Mr Wolber according to their declarations, D37 and D39, also applied to the items sold and delivered to Laserline on 12 October 2017 as proven by documents D44, D44a, D47 and D47a.

Reproducibility

20. The respondent questioned whether the skilled person would have known how to reproduce the samples referred to by the interveners in the context of the alleged public prior use without undue burden.

21. In opinion G 1/92, the Enlarged Board of Appeal ruled that the chemical composition of a product is state of the art when the product as such is available to the public and can be analysed and reproduced by the skilled person, irrespective of whether or not particular reasons can be identified for analysing the composition (point 1 of the Conclusion). For the analysis, the skilled person has to rely on their general technical knowledge to gather all information enabling them to prepare the product. Where it is possible for the skilled person to discover the composition or the internal structure of the product

and to reproduce it without undue burden, then both the product and its composition or internal structure become state of the art (Reasons 1.4).

22. In the present case, the product in question is essentially a lithographic printing plate precursor having an aluminium support characterised by a certain surface topography and an image recording layer. There was no dispute between the parties that, on the earliest priority date of the contested patent, it was common general knowledge to manufacture such a support by subjecting an aluminium plate to several treatment steps like etching, surface graining, desmutting and anodising before applying an image recording layer. This is also evidenced by page 13 of document D54, an excerpt from a textbook dated 2015, which, in the right-hand column on page 13, indicates, in the context of the electrochemical surface graining step, that "[T]*he roughness and evenness are determined by the current density, the AC profile, electrode placement, electrolyte composition, temperature and concentration as well as process speed and homogeneity of the electrolyte flow*". The skilled person would thus have been aware of the parameters that had an influence on the surface topography of the aluminium support, including on the amount of pits per mm^2 with a certain depth that were the result of an electrochemical surface graining step. Moreover, in paragraph [0002], the contested patent acknowledges that, before its effective date, it was known that a surface of an aluminium support was grained "*to provide asperities for the purpose of improving scumming resistance and a press life of the resulting lithographic printing plate*". As an example, paragraph [0003] of the patent cites a Japanese patent document, which is a patent family member of document D13 in which the production

of aluminium supports having at least 5 000 pits/mm^2 of a depth from the centerline of at least 0.50 µm within an area of 400 µm x 400 µm is described.

23. The respondent argued that the skilled person did not have access to any specific documents or indications that would have taught which specific production conditions were to be used for the reproduction. The electrochemical graining conditions and electrolyte bath compositions that allowed not just any arbitrary porous aluminium plate, but the commercial products, to be reproduced lay beyond the skilled person's common general knowledge on the earliest priority date of the contested patent.

24. The interveners responded to this point by submitting declaration D82, in which Mr Merka explains how he analysed a commercial product of the respondent using common methods that were well known before the earliest priority date of the contested patent, and then accomplished a reverse engineering process by applying common steps. Pages 19 to 22 of declaration D82 describe in detail the different method steps carried out for reworking the commercial product. It is noteworthy that, for the electrochemical graining step, Mr Merka used an electrolytic solution having a hydrochloric acid concentration of 10 g/L and an aluminium ion concentration of 0.5 g/L. Unlike the method in claim 19 of the contested patent, there is no mention of sulfuric acid in this context. This refutes the respondent's arguments that knowledge of the patent was required to rework a printing precursor plate falling within the scope of claim 1 of the patent as granted. Page 27 of declaration D82 then compares the results of the analysis obtained for the reworked product and the original commercial product. The board

shares the interveners' view that the variations between the values listed in the table, including the pit density, and any visual differences in the SEM micrographs of declaration D82 can be qualified as usual within the specific technical field of lithographic printing plates. In addition, the board is unable to see why Mr Merka, who holds a PhD in physical chemistry and has several years of working experience in the field of lithographic printing plate precursors, cannot be considered to represent the skilled person. The respondent referred to Mr Merka's specialised knowledge seven years after the earliest priority date of the patent and criticised his access to equipment that had not been available to the skilled person in 2017; however, it was not established which of the process steps described on pages 19 to 22 of declaration D82 went beyond the common general knowledge at the time before the earliest priority date of 31 October 2017, nor did the respondent identify any technical equipment that was not already available to the skilled person before the earliest priority date of the contested patent; at the bottom of page 18 of declaration D82, Mr Merka explained that the technical equipment needed for these process steps was found in a regular laboratory dealing with electrochemistry. Incidentally, the board remarks that section I.D.4.3.2 of the book "Case Law of the Boards of Appeal of the European Patent Office" (10th edition of July 2022), upon which the respondent relies in support of its argument that declaration D82 does not meet the requirements established in the case law for experimental evidence, concerns comparative tests presented in the context of inventive step. Nevertheless, the board has no indication, let alone proof, that the results of the tests described in declaration D82 were unverifiable, that the procedure

for performing the tests did not rely on quantitative information enabling the skilled person to reproduce the tests reliably, or that the declaration contained vague and imprecise operating instructions. In sum, with declaration D82, the interveners convincingly demonstrated that, before the earliest priority date of the contested patent, the skilled person was able to analyse a commercially available lithographic printing plate precursor and to reproduce the technical features of it without undue burden.

25. By the same token, no undue burden would have been required to analyse and reproduce the sample retained by Kodak pursuant to declaration D37 and thus any of the "Sonora X" printing plate precursors from the batch with number 253299 sold and delivered to Laserline.

26. In the context of the discussion of reproducibility, the respondent cited decision T 1833/14 and argued that the analysis and reproduction condition set out in opinion G 1/92 was that the skilled person knew how to prepare the *exact* product without undue burden. The board notes that T 1833/14 interpreted the condition of opinion G 1/92 in the sense that the skilled person should know how to prepare the product without undue burden (Reasons 1.5) or, in other words, the skilled person should have been in a position to prepare the product as such (Reasons 1.7). In the board's view, this is exactly what has been shown by declaration D82 by Mr Merka.

Conclusion on the "Sonora X" prior use

27. The prior use of printing plate precursors of the "Sonora X" type with batch number 253299 sold and delivered to Laserline (hereinafter: "Sonora X" prior

use) is proven, and the subject-matter of this prior use thus constitutes prior art under Article 54(2) EPC.

Main request - ground for opposition under Article 100(a) EPC together with Article 54(1) EPC

28. The sample of "Sonora X" printing plate precursors with batch number 253299 retained at the Kodak plant in Osterode was prepared for analysis by Mr Blum. Declaration D37 explains how circular discs were stamped out of the sample plate, their image recording layer was removed, and they were subsequently shipped, *inter alia*, to Mr Wolber at the Kodak Research Laboratories in Rochester for white light interferometry. Mr Wolber's declaration D39 corroborates the receipt of the sample disc. On page 5 of declaration D39, it is described that the pit density measurements of the "Sonora X #253299" sample disc were performed according to the procedure as set out on pages 4 and 5 of the declaration. Accordingly, an optical interferometric microscope Contour GT-X was used to measure the density of the specific pits over an area of 400 x 400 μm^2 before processing the image to search for pits deeper than a threshold of 0.7 µm and calculating the average number of pits per mm^2 with a scaling factor of 6.25. Mr Wolber's measurements were carried out at five different locations on the sample disc. The results of the measurements are summarised in Table 3. Both the average value of 3 720 and the minimum value of 3 606 fall within the range specified in claim 1 of the contested patent. The board therefore concludes that the sample retained at the Kodak plant in Osterode, and hence each of the printing plate

precursors of the "Sonora X" prior use, disclose all the features of the claim as granted.

29. The respondent disputed the values listed in Table 3 of declaration D39 because they followed the same trend as the measurement values listed in Table 2 in respect of "Sonora XP #236277". The board is not persuaded by this. It is credible that the different measurement data had certain variations despite the fact that the same sample was analysed. Also considering that the standard deviation of the data set was 152, as put forward by the interveners, it is not apparent why the values would be unreliable, in particular the average value of 3 720 pits/mm^2. Regarding the respondent's request to share the original measurement data for "Sonora X" batch number 253299 and the corresponding sample probes, the board refers to point 15. above.

30. In sum, the subject-matter of claim 1 of the patent as granted lacks novelty over the "Sonora X" prior use. The ground for opposition under Article 100(a) EPC together with Article 54(1) EPC therefore prejudices the maintenance of the patent as granted. The respondent's main request is thus not allowable.

Auxiliary requests 1, 2, 2a, 3, 4, 4a, 5, 6 and 6a - admittance

31. Article 14 RPBA provides that where, during a pending appeal, notice of intervention is filed, Articles 12 and 13 RPBA shall apply in so far as justified by the circumstances of the case.

Pursuant to Article 12(4) RPBA, any part of a party's appeal case which does not meet the requirements in

Article 12(2) RPBA is to be regarded as an amendment, unless the party demonstrates that this part was admissibly raised and maintained in the proceedings leading to the decision under appeal. Any such amendment may be admitted only at the discretion of the board.

According to Article 13(1) RPBA, any amendment to a party's appeal case after it has filed its grounds of appeal or reply is subject to the party's justification for its amendment and may be admitted only at the discretion of the board. Article 12(4) to (6) RPBA shall apply *mutatis mutandis*. The party shall provide reasons for submitting the amendment at this stage of the appeal proceedings. The board shall exercise its discretion in view of, *inter alia*, the current state of the proceedings, the suitability of the amendment to resolve the issues which were admissibly raised by another party in the appeal proceedings or which were raised by the board, whether the amendment is detrimental to procedural economy, and, in the case of an amendment to a patent application or patent, whether the party has demonstrated that any such amendment, *prima facie*, overcomes the issues raised by another party in the appeal proceedings or by the board and does not give rise to new objections.

32. The board considers that the respondent's filing of auxiliary requests 1 and 3 to 6 with its reply to the statement of grounds of appeal has to be considered a response to a new procedural situation created by the interventions filed shortly after the notice of appeal, in particular since some of the interveners' objections were based on allegations of prior use that had not been presented in the proceedings before the opposition division. The application of Articles 12 and 13 RPBA to

these requests was therefore not justified by the circumstances of the case, in accordance with Article 14 RPBA. Auxiliary requests 1 and 3 to 6 were thus considered by the board.

33. Regarding auxiliary request 2, a claim request with identical wording (the seventh auxiliary request) was already filed in the proceedings before the opposition division, namely the seventh auxiliary request filed by letter dated 15 September 2023. Resubmitting the same claims on appeal was not demonstrably prompted by the interventions. In the board's view, the circumstances of the case thus justified applying Article 12 RPBA, and in particular Article 12(4) RPBA, to auxiliary request 2, in accordance with Article 14 RPBA.

34. The date on which the claims of the seventh auxiliary request were submitted was the final date for making written submissions in preparation for the oral proceedings pursuant to Rule 116 EPC. This date was communicated to the parties with the summons issued by the opposition division. In annex to the summons, the opposition division gave a negative preliminary opinion with regard to the then main request of the respondent. Considering the relevant section E-VI, 2.2.2 of the March 2023 version of the Guidelines, the board is satisfied that the claims of the seventh auxiliary request were thus admissibly raised in the proceedings before the opposition division. The subject-matter claimed by the seventh auxiliary request was not discussed before the opposition division. Instead, by rejecting the opposition, the respondent's higher-ranking main request to maintain the patent as granted was found allowable. In addition, from the minutes of the oral proceedings held before the opposition division, it does not appear that the seventh auxiliary

request was withdrawn. Therefore, it must be considered to have been maintained in the proceedings before the opposition division.

35. Having regard to the above considerations, the board concludes that the seventh auxiliary request, and thus auxiliary request 2 on appeal, was admissibly raised and maintained in the proceedings leading to the decision under appeal. It follows from Article 12(4) RPBA that auxiliary request 2 is not an amendment to the respondent's appeal case, but is part of the appeal proceedings.

36. Auxiliary requests 2a, 4a and 6a were filed at a later stage of the appeal proceedings and were, as argued by the respondent, a response to an objection under Article 84 EPC filed by the appellant. In the board's view, the circumstances of the case thus justified the application of Article 13 RPBA, pursuant to Article 14 RPBA.

37. Given that auxiliary requests 2a, 4a and 6a were filed before the communication under Article 15(1) RPBA was issued, their admittance was governed by the provisions of Article 13(1) RPBA. The respondent convincingly demonstrated that the amendments to the claims in auxiliary requests 2a, 4a and 6a *prima facie* overcame the clarity issues raised by the appellant against claim 1 of each of auxiliary requests 2, 4 and 6. Therefore, in exercising its discretion under Article 13(1) RPBA, the board decided to admit auxiliary requests 2a, 4a and 6a into the appeal proceedings.

Auxiliary request 1 - novelty (Article 54(1) EPC)

38. Claim 1 of auxiliary request 1 is identical to claim 1 of the main request. For the same reasons as set out in the context of the main request above, the subject-matter of claim 1 of auxiliary request 1 lacks novelty over the "Sonora X" prior use (Article 54(1) and (2) EPC). Auxiliary request 1 is thus not allowable.

Auxiliary request 2 - request for remittal

39. At the oral proceedings held before the board, the respondent requested that the case be remitted to the opposition division for further prosecution on the basis of the claims of auxiliary request 2. The appellant and the interveners requested that the case not be remitted.

40. Under Article 111(1), second sentence, EPC the board has discretion over whether to either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution. In accordance with Article 11 RPBA, the board shall not remit a case unless special reasons present themselves for doing so. Criteria which can be taken into account when deciding on remittal include the parties' requests, the general interest that proceedings are brought to a close within an appropriate period of time and whether or not there has been a comprehensive assessment of the undecided issues during the appeal proceedings.

41. In the present case, the proceedings were accelerated at the request of the interveners in view of pending infringement actions initiated by the respondent against the interveners. The interveners thus had an interest in obtaining legal certainty on the outcome of the proceedings before the EPO. The respondent argued that claim 1 of auxiliary request 2 included an additional feature that had not been considered in the opposition division's decision; however, it was not disputed that the additional feature was already part of claim 4 of the patent as granted. The subject-matter of this claim appeared as an independent claim in the respondent's amended main request, which was filed before the summons to oral proceedings held before the opposition division and subsequently withdrawn. Furthermore, a novelty objection in view of the "Sonora X" prior use had also been raised in the notices of intervention and in the statement of grounds of appeal in respect of claim 4 as granted (see point V.3.2.2.4 on page 31 of the notices of intervention; see page 17 of the statement of grounds of appeal). Even if the interveners had subsequently filed, *inter alia*, documents D47a, D80 and D82 with their letters submitted in response to the respondent's reply to the statement of grounds of appeal, the prior-use case had not been further developed in a way that was related to the subject-matter of claim 4 as granted. As regards the discussion of reproducibility, the respondent failed to demonstrate how claim 1 of auxiliary request 2 brought up any new aspects that could not have already been dealt with in the written proceedings. In fact, in point 7.2.1.1 of its reply to the statement of grounds of appeal, in the context of auxiliary request 2, the respondent's response to the novelty objection based on the "Sonora X" prior use consisted in referring to the previous points 4.1.2 and 4.1.3, i.e.

to the submissions on the prior use in respect of the main request. Similarly, in point 6.3.2.1 of its letter dated 3 December 2024, the respondent's position on the novelty objection in view of the "Sonora X" prior use against claim 1 of auxiliary request 2 was limited to a reference to the previous point 4.1.

42. In support of its request for remittal, the respondent referred to various case law decisions; however, the cases underlying these decisions were different from the case in hand. In case T 1665/16, the interventions were withdrawn before the oral proceedings held before the board. It was concluded by the board that any reason of urgency addressed by the intervener was therefore no longer of relevance (Reasons 3.2). In case T 2951/18, all parties requested that, in the event that the intervention and the additional evidence filed with it were considered, the case be remitted to the opposition division for further prosecution (Reasons 7.1). In case T 239/20, too, all parties had requested remittal (Reasons 11.3).

43. In light of the above considerations, the board decided not to remit the case to the opposition division at this stage of the appeal proceedings (Article 111(1) EPC and Article 11 RPBA).

Auxiliary request 2 - novelty (Article 54(1) EPC)

44. At the top of page 7 of declaration D37, Mr Blum indicated that "*samples were taken for internal measurements at KODAK Osterode (i.e. brightness measurement, SEM - Dr. O. Merka)*". In the board's view, this indicates that one of the circular discs punched

out of the sample of the "Sonora X" printing plate precursors with batch number 253299 retained at the Kodak plant in Osterode, after having been prepared for analysis by Mr Blum, was sent within the Kodak plant to Mr Merka for measuring. In declaration D69, Mr Merka states that a "*sample of Sonora X batch #253299 was obtained from Dr. Oliver Richard Blum; the sample was already decoated*", which confirms that he received one of the circular discs prepared by Mr Blum.

45. The results of Mr Merka's analysis by scanning electron microscope (SEM) are summarised at the bottom of page 13 of declaration D69 as follows.

Average diameter of the micropores at the surface	22.1 nm
Depth of the large-diameter portion of the micropores	175.2 nm
Average diameter of the small-diameter portion of the micropores at the communication position	6.9 nm
Depth of the small-diameter portion of the micropores	799.7 nm

Therefore, it can be concluded that each of the micropores of the sample retained at the Kodak plant in Osterode and hence also of the "Sonora X" printing plate precursors of the batch with number 253299 sold and delivered to Laserline has a large-diameter portion which extends from the surface of the anodised film to a depth of 10 to 1 000 nm (second row of the above table) and a small-diameter portion which communicates with a bottom of the large-diameter portion and extends to a depth of 20 to 2 000 nm from a communication position between the small-diameter portion and the large-diameter portion (fourth row of the above table), wherein an average diameter of the large-diameter portion at the surface of the anodised film is 15 to 60 nm (first row of the above table), and wherein an

average diameter of the small-diameter portion at the communication position is no more than 13 nm (third row of the above table), in accordance with the additional features of claim 1 of auxiliary request 2.

46. The respondent submitted that the prior-use sample discussed in declaration D69 was not reproducible, in particular in view of the additional features of claim 1 of auxiliary request 2, and hence did not constitute prior art. The board disagrees. In declaration D82, Mr Merka also carried out geometric measurements on the individual micropores of both the original and the reworked commercial products. The different steps of the reverse engineering process are documented on pages 19 to 22 of declaration D82. The results are summarised in the table on page 27 of declaration D82. All the values for average diameter and depth are similar and lie well within the ranges of claim 1 of auxiliary request. The interveners thus convincingly demonstrated that, before the earliest priority date of the contested patent, the skilled person was able to analyse a commercially available lithographic printing plate precursor and reproduce the technical features of it without undue burden, including those features related to the average diameter and the depth of the micropores.

47. The board concludes that the subject-matter of claim 1 of auxiliary request 2 lacks novelty in view of the prior-used "Sonora X" printing plate precursors (Article 54(1) and (2) EPC). Auxiliary request 2 is thus not allowable.

Auxiliary requests 2a, 3, 4 and 4a - novelty (Article 54(1) EPC)

48. The additional feature of claim 1 of auxiliary request 2a merely specified the arrangement in the anodised film of the micropores already mentioned in claim 1 of auxiliary request 2. It was not disputed by the respondent that this additional feature was also disclosed by the prior-used "Sonora X" printing plate precursors.

49. Compared with the claims of auxiliary request 1, the claims of auxiliary request 3 were amended by introducing an upper limit of 6 000 pits/mm^2 for the pit density in claim 1. Given that the average value of 3 720 and both the minimum and maximum values of the pit density listed in Table 3 of declaration D39 fall within the new range specified in claim 1, the prior-used "Sonora X" printing plate precursors also disclose all the features of claim 1 of auxiliary request 3.

50. Claim 1 of auxiliary requests 4 and 4a differs from claim 1 of auxiliary request 2 and 2a, respectively, by the same amendment as in auxiliary request 3. For the above reasons, the prior-used "Sonora X" printing plate precursors thus also disclose all the features of claim 1 of auxiliary requests 4 and 4a.

51. In sum, the subject-matter of claim 1 of each of auxiliary requests 2a, 3, 4 and 4a lacks novelty (Article 54(1) and (2) EPC). These requests are thus not allowable.

Auxiliary requests 5, 6 and 6a - novelty (Article 54(1) EPC)

52. Similarly to claim 1 of auxiliary request 3, claim 1 of auxiliary request 5 specifies an upper limit of 6 000 pits/mm^2 for the pit density. In contrast to auxiliary request 3, however, the lower limit of the pit density range was increased to 3 500 pits/mm^2. Claim 1 of auxiliary requests 6 and 6a differs from claim 1 of auxiliary request 4 and 4a, respectively, by the same amendment as in auxiliary request 5.

Admittance of respondent's new line of argument

53. It was common ground between the parties that the average value listed in Table 3 of declaration D39 fell within the range of claim 1 of auxiliary request 5. Nevertheless, the respondent objected that the accuracy of the average pit density determined by Mr Wolber should be called into question in view of the substantially lower average pit density reported in the interveners' letter dated 13 December 2024 in respect of a different "Sonora X" product that Mr Nessler had assured, in his declaration D53, was produced with the same settings.

54. This line of argument was presented for the first time at the oral proceedings during the discussion of novelty of the subject-matter claimed in auxiliary request 5. It was thus an amendment to the respondent's appeal case which, insofar as this is deemed justified by the case pursuant to Article 14 RPBA, was subject to the provisions of Article 13(2) RPBA. According to this article, an amendment shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

55. The respondent did not present any convincing explanation for why the circumstances for this late submission were exceptional. The board shares the appellant's and the interveners' view that the respondent could and should have already expressed its doubts on the validity of the pit density values obtained by Mr Wolber in declaration D39 in the written proceedings because these values had been addressed by the parties in their written submissions from the outset of the appeal proceedings. Particularly when introducing the pit density range of 3 500 to 6 000 pits/mm^2 in claim 1 of auxiliary request 5 filed with the reply to the statement of grounds of appeal, the respondent should have presented its line of argument, but it did not. Moreover, when responding to the appellant's and the interveners' letters of 30 and 31 October 2024, respectively, in which these parties confirmed that their novelty objection in view of the "Sonora X" prior use also applied to claim 1 of auxiliary request 5, the respondent had not questioned the average pit density value mentioned in declaration D39. The interveners' initial prior-use case did not undergo any further developments in the appeal proceedings which were related to the subject-matter of claim 1 of auxiliary request 5.

56. The board decided that, pursuant to Article 14 RPBA, the application of Article 13 RPBA was justified by the circumstances of the case and decided not to take the respondent's new line of argument into account in accordance with Article 13(2) RPBA.

57. Regarding the respondent's request to share the sample probes of the "Sonora X" prior use, the board refers to points 15. and 29. above.

58. Furthermore, the respondent did not persuade the board that special reasons applied, at this stage of the proceedings, for remitting the case to the opposition division pursuant to Article 11 RPBA (see also points 41. to 43. above).

Novelty over prior-used "Sonora X" printing plate precursors

59. Since the average value and the minimum and maximum values listed in Table 3 of declaration D39 fell within the range of 3 500 to 6 000 pits/mm^2, and in view of the reasons set out in the context of the main request and auxiliary requests 2 and 2a, the prior-used "Sonora X" printing plate precursors disclose all the features of claim 1 of each of auxiliary requests 5, 6 and 6a. The subject-matter of claim 1 of each of auxiliary requests 5, 6 and 6a thus lacks novelty (Article 54(1) and (2) EPC). Auxiliary requests 5, 6 and 6a are not allowable.

Auxiliary request 7 - admittance

60. The set of claims of auxiliary request 7 was filed at the oral proceedings held before the board. It only contains method claims, which were based on method claims 17, 18 and 19 of the patent as granted and in which the features of the product claims had been incorporated.

61. The filing of this amended set of claims is an amendment to the respondent's appeal case, the admittance of which, insofar as it is deemed justified

by the case pursuant to Article 14 RPBA, is subject to the provisions of Article 13(2) RPBA.

62. The respondent submitted that the new request was a response to objections raised on appeal, that it was converging and that the board had indicated in its communication pursuant to Article 15(1) RPBA that the method claims had to be discussed at the oral proceedings. The board shares the appellant's and the interveners' view that a response to the objections raised in view of the "Sonora X" prior use had already been possible in reply to the notices of intervention and the statement of grounds of appeal. Instead, the respondent had actually deleted the method claims from auxiliary requests 2, 2a, 4, 4a, 6 and 6a. Regarding the board's communication, points 84 and 97 merely expressed the board's preliminary opinion that, depending on the outcome of the assessment of claim 1 as granted, a discussion of novelty and inventive step could be necessary in respect of the further independent claims 17, 18 and/or 19 of the patent as granted. By no means did the board give an invitation to file further auxiliary requests based on these claims. The way in which the opposition division would have responded to a similar late filing does not play a role when deciding on the admittance of a claim request filed on appeal in accordance with Article 13(2) RPBA. Furthermore, the fact that the interveners and the appellant had already taken a position on the method claims in writing did not relieve the respondent from its duty to present its case in a timely manner in readiness for the event that its higher-ranking requests were found not allowable.

63. For the above reasons, the board held that the application of Article 13 RPBA was justified by the

circumstances of the case, in accordance with Article 14 RPBA. In the absence of any cogent reasons justifying exceptional circumstances, the board decided not to admit auxiliary request 7 under Article 13(2) RPBA.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar: The Chairman:

N. Schneider P. Lanz

Decision electronically authenticated