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DECISION
of 12 August 2004

Case Number: T 0888/02 - 3.2.5
Application Number: 97919526.0
Publication Number: 0825927
IPC: B41C 1/10
Language of the proceedings: EN

Title of invention:

Lithographic printing form precursor and its use by heat imaging

Patentee:

Kodak Polychrome Graphics Company Ltd.

Opponents:

Mitsubishi Chemical Corporation
Agfa-Gevaert N.V.
Fuji Photo Film Co., Ltd.

Headword:

-

Relevant legal provisions:

EPC Art. 54, 87, 114(2), 123(2), 125

Keyword:

"Main request: added subject-matter (no), validity of priority (no), novelty (no)"
"Auxiliary requests: not admitted, insufficient substantiation, abuse of process"

Decisions cited:

G 0002/98

Catchword:

-



Case Number: T 0888/02 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 12 August 2004

Appellant: Kodak Polychrome Graphics Company Ltd.
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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 31 May 2002
revoking European patent No. 0825927 pursuant
to Article 102(1) EPC.**

Composition of the Board:

Chairman: W. Moser
Members: W. Zellhuber
H. Schram

Summary of Facts and Submissions

I. The appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division revoking the European patent No. 0 825 927 (hereinafter patent in suit).

II. Oppositions were filed against the patent as a whole and based on Article 100(a) EPC (lack of novelty, Article 54 EPC, and lack of inventive step, Article 56 EPC), 100(b) and 100(c) EPC.

III. The date of filing of the patent in suit is 22 April 1997. The priority documents referred to in the patent in suit are the following:

P1: GB 9608394, 23 April 1996;

P2: GB 9614693, 12 July 1996;

P3: WO PCT/GB96/01973, 13 August 1996;

P4: GB 9700884, 17 January 1997.

IV. The Opposition Division held that none of the priorities claimed in the patent in suit were valid and that the ground for opposition cited in the Article 100(a) EPC (lack of novelty, Article 54 EPC) prejudiced the maintenance of the patent having *inter alia* regard to document

DA4: EP-A 0 823 327.

V. With the statement setting out the grounds of appeal filed on 10 October 2002, cf. page 1, the appellant declared that he wished to proceed in this appeal with the enclosed Main Request (corresponding to Auxiliary Request 1 in the opposition proceedings, which was the only request maintained before the Opposition Division). The appellant maintained his position that the priorities of the patent in suit were valid and that, therefore, document DA4 did not form part of the state of the art and was not to be considered when assessing novelty.

After having received the submissions of respondents I, II, III (opponents 01, 02, 03), all objecting the validity of the priorities claimed in the patent in suit and alleging lack of novelty with regard to document DA4 and other documents, the appellant declared with letter filed on 20 August 2003 that he intended to study each of the replies of the respondents with a view to filing a consolidated response. A consolidated response has not been received however.

On 11 May 2004, the Board dispatched summons to attend oral proceedings on 12 August 2004. In the communication accompanying the summons, the Board made mention that none of the priorities of the patent in suit seemed to be valid and that the subject-matter of claim 1 according to the single request of the appellant appeared not to be novel with regard to document DA4, as pointed out in the decision under appeal. The Board further noted that any written submission should be filed well in advance, i.e. at least one month before the date of oral proceedings.

On 12 July 2004, the appellant filed a new main request (with claim 1 not amended with respect to claim 1 of the former main request) and 29 auxiliary requests. On page 1 of the accompanying letter, he declared that "If the Board does not accept the proprietor's Main Request, we will ask that they consider an Auxiliary Request. If the Board does not accept the nominated Auxiliary Request, we request that they consider another Auxiliary Request. It is proposed to nominate the Auxiliary Requests during the Oral Proceedings having regard to the findings of the Board."

An annex was enclosed summarily indicating a basis in the application as filed in respect of amendments which, for the first time, appeared in a request.

On page 2, seventh paragraph, of the letter accompanying the auxiliary requests, the appellant further declared: "We are not now filing further argumentation as regards the substantive issues. Those issues have already been very well aired by the parties and we do not see much further purpose in providing more argumentation at this stage. We feel that it is better to do so at the Oral Proceedings once we have a better view of how the Board views the respective matters."

In a communication dated 19 July 2004, the Board informed the parties that it may consider not admitting the auxiliary requests 1 to 29. The Board further stated that it appeared that the auxiliary requests filed at the latest moment provided for in the summons

were not sufficiently substantiated and may therefore be disregarded under Article 114(2) EPC.

On 23 July 2004, the appellant filed further comments concerning the subject-matter of claim 1 of the auxiliary requests and the objection of lack of novelty with regard to *inter alia* document DA4.

- VI. Oral proceedings were held before the Board of Appeal on 12 August 2004. Respondent I, having previously informed the Board that he would not attend the oral proceedings, was not present.
- VII. The appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of the following documents filed on 12 July 2004:
- (i) Claims 1 to 20 filed as main request; or
 - (ii) the sets of claims according to auxiliary requests 1 to 29
- VIII. Respondents I, II and III requested that the appeal be dismissed.
- IX. Claim 1 according to the main request reads as follows:
- "1. A positive working lithographic printing form precursor having a coating comprising an oleophilic, heat-sensitive composition on a support having a hydrophilic surface, the composition comprising an aqueous alkaline developer soluble polymeric substance, and a compound which reduces the aqueous alkaline developer solubility of the polymeric substance,

wherein the aqueous alkaline developer solubility of the composition is increased on heating and the aqueous alkaline developer solubility of the composition is not increased by incident UV radiation."

- X. In the written procedure and during oral proceedings, the appellant argued essentially as follows:

Added subject-matter

The subject-matter of claim 1 of the main request was disclosed in the application as filed. In particular, the feature of the composition comprising an aqueous *alkaline* developer soluble polymeric substance was disclosed in the application as filed (printed version) on page 11, lines 9 to 13. In that passage a plurality of developers were cited, and, among them, also alkaline components. The restriction of claim 1 of the main request to an aqueous *alkaline* developer soluble polymeric substance thus focussed the invention on a disclosed feature. Consequently, claim 1 of the main request met the requirements of Article 123(2) EPC.

Priority

The subject-matter of claim 1 of the main request was derivable from the content of priority document P2, taking into consideration the general knowledge of a person skilled in the art. The introductory part of document P2 first directed the reader to the widely known UV-sensitive lithographic printing plates. In the following, it was pointed out that, in contrast to the prior art, the invention concerned heat mode imaging wherein a heated stylus as well as a laser having a

wavelength above 600 nm might be used. It was thus clear to the person skilled in the art that the lithographic printing plate referred to in document P2 was heat sensitive rather than UV-sensitive. Actually, the compositions described in all examples of document P2 were insensitive to incident UV-radiation.

Novelty

The subject-matter of claim 1 of the main request was novel with regard to the disclosure of document DA4. In particular, document DA4 did not disclose the feature of the aqueous alkaline developer solubility of the composition not being increased by incident UV-radiation. Document DA4, cf. page 2, lines 54 to 56, and page 4, lines 9 to 12, did not disclose insensitivity to UV-light in the sense that the solubility was not increased. Moreover, white light was different from UV-light and the passage on page 4, lines 9 to 12, of document DA4 only referred to weak UV-light.

Furthermore, according to page 23, lines 22 to 24, of document DA4, the composition might be sensitive to UV-light, and, according to the examples described in document DA4, imaging of the printing plates was carried out under a yellow lamp. Moreover, the examples mentioned under the heading "Safe light property" on page 36, lines 13ff, of document DA4 were not disclosed in any of the priority documents of document DA4, so that document DA4 was not entitled to the claimed priority dates in this respect.

Admissibility of auxiliary requests 1 to 29

Auxiliary requests 1 to 29, which were filed in due time on 12 July 2004, should be admitted into the proceedings. A patent proprietor should have the right to defend its patent.

The appellant had been hindered from filing auxiliary positions at an earlier stage of the appeal proceedings because doing so would have borne the risk of prejudicing the course of German patent litigation and Japanese opposition proceedings. Only recently, the litigation proceedings had been settled, and the opposition proceedings had come to an end.

At the outset, the appellant had believed in the validity and allowability of the main request. The provisional opinion of the Board of Appeal accompanying the summons, however, changed the way the claims had to be understood. The appellant had managed to file auxiliary requests within the time limit set by the Board of Appeal, although the time for filing amendments had been very short and the case was very complex.

Filing a large number of auxiliary requests could not possibly give rise to an abuse of process. Furthermore, the requests were well structured, and, from the table representing an overview filed with letter of 23 July 2004, it could be seen that, actually, only the subject-matter of six amended claims had to be considered. Furthermore, the appellant had assisted the other parties by indicating the passages in the application as filed forming a basis for the subject-matter of the amended claims according to auxiliary

requests 1 to 29. On 23 July 2004, the appellant had further submitted arguments with regard to the issue of novelty in respect of document DA4 and other documents.

Before the Board could take a decision on admitting auxiliary requests 1 to 29 or not, the appellant should be given the opportunity to present his arguments as to why these requests might be allowable. There was no basis in the European Patent Convention for any need of substantiating a request.

- XI. In the written procedure and during oral proceedings, respondents I, II and III argued essentially as follows:

Added subject-matter

According to the application as filed, cf. in particular claims 4 and 5, the feature of the developer being alkaline was coupled to the feature of the polymer being a phenolic resin. The specific examples 12 to 18 indicated on pages 24 and 25 of the application as filed (printed version) were no basis for a generic disclosure of a composition comprising an aqueous alkaline developer soluble polymer wherein the polymer was not necessarily a phenolic polymeric substance. On page 11, line 9, of the application as filed (printed version), it was indicated that the aqueous developer composition was dependent on the nature of the polymeric substance, and the passage on page 11, lines 14 and 15 of the application as filed (printed version) showed the relationship of alkaline developers to phenolic resins. The list of developers on page 11, lines 10 to 13 of the application as filed (printed version), referred to the common general

knowledge and did not define the invention. The subject-matter of claim 1 of the main request thus extended beyond the content of the application as filed. The requirements of Article 123(2) EPC were therefore not met.

Priority

Priority document P2 disclosed neither implicitly nor explicitly the feature of claim 1 of the main request that "...the aqueous alkaline developer solubility of the composition is not increased by incident UV radiation". At the priority date of the patent in suit, compositions had been known which were UV-sensitive and heat sensitive. There was no indication in priority document P2 that UV-sensitivity should be excluded. Although the materials mentioned in priority document P2 might be insensitive to UV-light, the presence of such an intrinsic or extrinsic property could not be regarded as a basis for an implicit disclosure of the above-mentioned feature of claim 1 of the main request.

The patent in suit was not entitled to the priorities of priority documents P1 and P4 for substantially the same reasons. Priority document P3 was not a first application within the meaning of Article 87(1) EPC.

Novelty

Since none of the priorities referred to in the patent in suit was valid, document DA4, which correctly claimed the priority of 6 August 1996, represented prior art according to Article 54(3) EPC.

Document DA4 disclosed a positive working lithographic printing precursor comprising an oleophilic, heat-sensitive composition having all the features of claim 1 of the main request as pointed out in the decision under appeal. In particular, as a preferred embodiment, document DA4 literally disclosed that the composition was not substantially sensitive to UV-light (cf. page 4, lines 9 to 12, and page 23, lines 25 to 27) which meant nothing else than that the aqueous alkaline developer solubility of the composition was not increased.

Admissibility of auxiliary requests 1 to 29

The filing of auxiliary requests 1 to 29 encompassing 110 pages had been delayed by the appellant solely for tactical reasons in view of other pending proceedings.

The appellant could not have been surprised by the provisional opinion of the Board of Appeal. It did not contradict, but rather confirmed the decision reached by the Opposition Division.

The filing of auxiliary requests 1 to 29 only one month before the oral proceedings gave rise to a new complex situation. The 29 sets of claims, mostly defining new combinations of features that had never been discussed before, were not easily understandable. No statement whatsoever had been provided as regards the validity of the priority claims, or as regards novelty and inventive step, for any of auxiliary requests 1 to 29.

The filing of auxiliary requests 1 to 29 without any additional explanatory arguments as to their

allowability rendered them already unacceptable; they had therefore to be rejected under Article 114(2) EPC.

Reasons for the Decision

Main request

1. *Added subject-matter (Article 123(2) EPC)*

The subject-matter of claim 1 is disclosed in the application as filed in claim 1 in connection with claim 21 and the passage on page 11, lines 9 to 13, of the description (published version). In line 9 of said passage, it is stated that the "aqueous developer composition is dependent on the nature of the polymeric substance", and, in the following lines, common components of aqueous lithographic developers are listed, among them also alkaline components. There is no indication that the use of alkaline components is related to the use of phenolic resins. From the examples 14 to 18 described on pages 24 and 25 of the application as filed (printed version), it can be seen that alkaline developers may be used also with resins other than phenolic resins (cf. points 4.3 and 4.4 of the decision under appeal).

The passage on page 11, lines 14 and 15, and the embodiment claimed in claim 5 of the application as filed (printed version) concern preferred embodiments. In the Board's view, the disclosure of these preferred embodiments does not detract from the general disclosure of the above mentioned passages.

Claim 1 according to the main request thus meets the requirements of Article 123(2) EPC.

2. *Priorities*

- 2.1 Claim 1 according to the main request concerns a positive working lithographic printing form precursor having a coating comprising an oleophilic, heat-sensitive composition wherein the aqueous alkaline developer solubility of the composition is not increased by incident UV-radiation.

Priority document P2 also concerns a positive working lithographic printing form precursor, cf. page 1, line 1. However it is silent about the feature of the aqueous alkaline developer solubility of the composition not being increased by incident UV-radiation.

Admittedly, document P2 refers in the introductory part to the prior art printing form precursors which are sensitive to UV-light (cf. page 1, lines 3 to 11) and teaches the reader that the invention disclosed in document P2 concerns heat-sensitive precursors (cf. page 1, lines 13 to 24). However, there is no direct and unambiguous disclosure of any insensitivity to UV-light of the composition of the printing plate precursor. The fact that the composition is heat-sensitive and that a positive plate is prepared by heat mode imaging does not necessarily imply that the composition is insensitive to UV-light. It may be that the specific compositions described in the examples of document P2 are insensitive to UV-radiation. However, the fact that the cited compositions may have that

property cannot be considered to be tantamount to an implicit disclosure of that feature.

Furthermore, the patent in suit refers to six tests which may be carried out to determine if a polymeric substance is suitable for use in the invention, cf. page 6, lines 7 to 54, of the patent in suit. Whilst they include a test (Test 6) dealing with the sensitivity of the composition to UV-radiation, the three tests recited in document P2 (cf. page 3) for determining if a polymeric substance is suitable for use in the invention according to document P2 do not concern UV-radiation or UV-sensitivity.

Accordingly, the subject-matter of claim 1 of the main request, in particular, the feature that the aqueous alkaline developer solubility of the composition is increased on heating but not increased by incident UV-radiation, is not directly and unambiguously derivable from the priority document P2.

Consequently, according to the opinion of the Enlarged Board of Appeal G 2/98 (OJ EPO 2001, 413), the requirements for claiming the priority of 12 July 1996 (priority document P2) are not met.

- 2.2 Priority document P1, cf. claim 1, relates to a lithographic printing plate comprising a phenolic resin and an infra-red absorbing compound, wherein the plate is imagewise exposed to a laser which emits at above 600 nm. Priority document P1 is silent about the feature of the aqueous alkaline developer solubility of the composition not being increased by incident UV-radiation. Consequently, the requirements for claiming

- the priority of 23 April 1996 (priority document P1) are not met either (cf. point 2.1 above).
- 2.3 As regards priority document P4 of 17 January 1997, the "Test 6" described on page 3 of priority document P4 concerns sensitivity of the compound to UV-light at 300 nm rather than to UV-light in general as claimed in claim 1 of the main request. Consequently, the subject-matter of claim 1 according to the main request is not disclosed in priority document P4, and the requirements for claiming the priority of 17 January 1997 (priority document P4) are not met either (cf. point 2.1 above).
- 2.4 The priority of 13 August 1996 cannot be claimed, because document P3 (WO PCT/GB96/01973) is not a first application within the meaning of Article 87(4) EPC.
- 2.5 Consequently, none of the priorities claimed in the patent in suit is valid, and the filing date of the patent in suit (22 April 1997) thus determines whether or not a document belongs to the prior art.
3. *Novelty*
- 3.1 To the extent that document DA4, which was filed on 5 August 1997, thus after the filing date of the patent in suit, benefits from one or more of the claimed priorities, it represents prior art according to Article 54(3) EPC. The first priority document referred to in document DA4 is JP-A 207013/96 having the filing date of 6 August 1996. An English translation of that priority document was filed as document D1.1.

3.2 Document DA4 and priority document D1.1 both concern a positive working lithographic printing form precursor, cf. page 2, lines 3 to 6, of document DA4 and page 3, lines 3 to 8, of document D1.1. The precursor comprises a support having a hydrophilic surface (aluminium surface, plastic film having hydrophilic treatment, cf. page 24, lines 25 to 34, of document DA4, and page 22, lines 6 to 20, of document D1.1) and thereon a coating comprising a heat-sensitive composition. The composition comprises an aqueous alkaline developer soluble polymeric substance and a compound which reduces the aqueous alkaline developer solubility of the polymeric substance, i.e. a solubility suppressing agent, cf. page 4, lines 2 to 4, and page 22, lines 23 to 26, of document DA4 and page 5, lines 19 to 25, of document D1.1. The aqueous alkaline developer solubility of the composition is increased on heating, cf. page 3, lines 32 to 35, of document DA4 and page 17, line 18 to page 18, line 2, of document D1.1. As generally known, after imaging of a positive working lithographic plate comprising such an alkaline solvable resin, the exposed surface portions of the compositions are dissolved by the alkaline developer, and the non-exposed parts of the coating comprising the heat sensitive composition remain on the plate thus forming the oleophilic ink accepting surface.

According to a preferred embodiment, the solubility suppressing agent has substantially no photosensitivity to ultraviolet light. Processing of the printing plate thus does not require an operation under yellow light, and the operation can be carried out under usual white light containing ultraviolet light, cf. page 23, lines 25 to 27, page 2, lines 54 to 56, page 4, lines 9

to 12, and claim 9 of document DA4, and page 20, lines 18 to 21, page 6, lines 6 to 12, page 5, lines 12 to 15, and claim 7 of document D1.1. In the Board's judgement, it is thus directly and unambiguously derivable from these passages that, according to a preferred embodiment, the heat sensitive composition is insensitive to UV-light, and, consequently, that the aqueous alkaline developer solubility of the composition is not increased by incident UV-radiation.

- 3.3 As shown above, the subject-matter of claim 1 according to the main request is disclosed in document DA4 as well as in priority document D1.1. In this respect, document DA4 thus benefits from the priority of 6 August 1996. The fact that document DA4 comprises further examples which are not comprised in priority document D1.1 is of no relevance.

Therefore, the subject-matter of claim 1 of the main request is not novel within the meaning of Article 54 EPC.

Auxiliary requests 1 to 29

4. According to the Guidance for parties to appeal proceedings and their representatives, cf. OJ EPO 1996, 342, the statement setting out the grounds for appeal should be a succinct but full statement of the appellant's arguments (cf. point 1.2.1), and auxiliary requests should be filed as early as possible (cf. point 3.3). In point 3.2 of the Guidance, it is indicated that "the appeal procedure is primarily a written procedure. Parties should therefore always

develop their arguments in writing and not reserve them for a possible oral hearing."

The appellant and the representative thus should have been aware of the fact that they should have presented any auxiliary request and arguments pertaining to it as early as possible and in writing.

5. In the present case, when filing auxiliary requests 1 to 29, the appellant did not present any argument with regard to the substantive issues of priority, novelty and inventive step. Furthermore, the sets of auxiliary requests 1 to 29 were not clearly structured. The appellant abstained from indicating any hierarchical order of the various auxiliary requests. Moreover, the subject-matter of the patent in suit is rather complex and the subject-matter and the purpose of the auxiliary requests *prima facie* not easily understandable. Accordingly, the submission of the appellant filed on 12 July 2004 was not substantiated and not suitable for the preparation of the oral proceedings.

In the Board's judgment, filing such a large quantity of unstructured sets of claims and referring to the latest possible moment, namely the oral proceedings, for presenting any arguments with regard to essential issues such as priority, novelty and inventive step is not in line with the general rules of respect and fairness and represents an abuse of process.

Auxiliary requests 1 to 29 thus are not sufficiently substantiated and therefore disregarded under Article 114(2) EPC.

6. The reasons presented by the appellant for filing fallback positions at such a late stage of the proceedings and without substantiating them are not deemed persuasive.

The fact that litigation or opposition proceedings were pending before national courts and national instances with respect to sister applications of the patent in suit does not constitute an obstacle hindering the appellant from dealing and presenting his case in full and in all aspects to the Board.

The content of the provisional opinion of the Board accompanying the summons to attend oral proceedings cannot be regarded as a reason for providing fallback positions for the first time one month before the oral proceedings. The provisional opinion merely confirmed the decision of the first instance with regard to the issues of validity of priority claims and novelty.

The opinion of the appellant as regards the allowability of his main request should not hinder him from preparing the case in full thereby considering the possibility that the Board may not share his opinion.

When filing auxiliary requests 1 to 29, the appellant failed to present arguments why, in his view, any of these requests should be prima facie allowable.

Admittedly, the European Patent Convention is silent about the need of substantiation of a request. However, according to Article 125 EPC, in the absence of procedural provisions in this Convention, the European Patent Office shall take into account the principles of

procedural law generally recognised in the Contracting States. Accordingly, the Board has to take care that the general rules of fairness are respected and that any tactical manoeuvres to the detriment of any other party, here filing of auxiliary requests, which are not sufficiently substantiated, are avoided.

Consequently, in the Board's judgement, admitting auxiliary requests 1 to 29 of the appellant at such a late stage of the proceedings, thereby considering the complexity of the case and the form wherein they were presented, i.e. without sufficiently substantiating and clearly structuring the respective requests, would clearly contravene the principles of fairness vis-à-vis the other parties to the appeal proceedings and would thus be detrimental to the interest of these parties.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Dainese

W. Moser