Internal distribution code:
(A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

Datasheet for the decision of 24 July 2015

Case Number: T 0650/10 - 3.2.05

Application Number: 03008828.0

Publication Number: 1356929

IPC: B41C1/10

Language of the proceedings: EN

Title of invention:
Method of preparation of lithographic printing plates

Patent Proprietor:
FUJIFILM Corporation

Opponent:
Agfa Graphics NV

Headword:

Relevant legal provisions:
EPC 1973 Art. 56
RPBA Art. 12(4), 13(1)

Keyword:
Inventive step - (no)
Admittance of auxiliary requests filed with the grounds of appeal - no
Admittance of auxiliary requests after filing of the grounds of appeal - no

Decisions cited:
G 0009/91

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 0650/10 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 24 July 2015

Appellant: (Patent proprietor)	FUJIFILM Corporation 26-30, Nishiazabu 2-chome Minato-ku Tokyo (JP)
Representative:	Hoffmann Eitle Patent- und Rechtsanwälte PartmbB Arabellastraße 30 81925 München (DE)
Respondent: (Opponent)	Agfa Graphics NV Septestraat 27 2640 Mortsel (BE)
Decision under appeal:	**Interlocutory decision of the opposition division of the European Patent Office posted on 22 January 2010 concerning maintenance of the European Patent No. 1356929 in amended form.**

Composition of the Board:

Chairman	M. Poock
Members:	H. Schram
	J. Geschwind

Summary of Facts and Submissions

I. On 23 March 2010 the appellant (patent proprietor) lodged an appeal against the decision of the opposition division posted on 22 January 2010 concerning the maintenance of European patent Nr. 1 356 929 in amended form on the basis of auxiliary request 6 of the appellant. The statement of grounds was filed on 1 June 2010.

The opposition division held that claim 1 of the main request filed on 7 July 2008 and claims 1 of auxiliary requests 2 and 3 filed during the oral proceedings before the opposition division did not meet the requirements of Article 123(2) EPC, that claims 1 of auxiliary requests 1 and 5 filed during said oral proceedings did not meet the requirements of Article 56 EPC 1973, and that auxiliary request 4 did not meet the requirements of Rule 80 EPC.

The opposition division further held that the patent could be maintained in amended form on the basis of claim 1 of auxiliary request 6 filed during said oral proceedings, on the ground that said claim was restricted to the second embodiment of the invention that was not opposed in the notice of opposition, and its validity was prima facie not in doubt (cf the feature "the thermosensitive layer comprising a microcapsule encapsulating an oleophilic compound therein" in said claim 1, see also claim 2 as granted).

II. Oral proceedings were held before the board of appeal on 24 July 2015.

III. The appellant requested that the decision under appeal be set aside and that the patent in suit be maintained

on the basis of any of the sets of claims of the main request or auxiliary requests 1 to 10 filed with the statement setting out the grounds of appeal of 1 June 2010, or auxiliary requests MRa, MRb, 1a to 9a filed with letter of 13 September 2011.

The respondent (opponent) requested that the appeal be dismissed.

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

"A method for preparation of a lithographic printing plate, which comprises the steps of:

imagewise recording on a lithographic printing plate precursor (12) comprising a support having a hydrophilic surface and a thermosensitive layer, the thermosensitive layer comprising polymer particles;

showering the printing plate precursor (12), in which a processing liquid (10) is conveyed into a spray pipe (5) by a circulating pump (11) and supplied to the printing plate precursor (12); and

rubbing the printing plate precursor (12) by a rubbing member (1) in the presence of the processing liquid (10) with an automatic processor provided with the rubbing member (1) to remove the thermosensitive layer of nonimage portions, wherein two or more rotary brush rolls are used as rubbing members."

V. The documents referred to in the appeal proceedings include the following:

D3 EP-A 0 773 648;

D4 EP-A 0 816 070;

D11 US 6,083,664.

VI. The arguments of the appellant, in writing and during the oral proceedings, can be summarized as follows:

Allowability of the amendments – main request

The feature "wherein two or more rotary brush rolls are used as rubbing members" present in claim 1 of the main request was disclosed in paragraph [0257] of the published version of the application as filed. The term "as" in the expression "*two or more rotary brush rolls are used as in the automatic processor of Fig. 1*" in said paragraph was an abbreviation of "such as", which wording merely introduced an illustrative embodiment of using two or more rotary brush rolls. The requirements of Article 123(2) EPC were thus met.

Inventive step - main request

The object of the invention was to provide a simple development processing method capable of efficiently and surely removing a thermosensitive layer of non-image portions of a lithographic printing plate precursor provided with the thermosensitive layer comprising polymer particles, cf paragraph [0014] of the patent in suit. Document D4 was the closest prior art document. This document taught to rub the imaging element with an absorbent means or a brush (column 7, lines 51 to 55). The invention differed from the method known from document D4 in that a circulation pump was used in a closed system and in that two or more brush rolls were used. It was surprisingly found, that adding an additional brush roll to the method known from document D4 in combination with using a circulation pump, which led to a fatigued processing liquid,

resulted in a considerable reduction in the number of stained copies at the time of printing out.

A closer inspection of the experimental data filed one month before the oral proceedings, ie with letter of 23 October 2009, showed that, when Example 1 of the patent in suit was repeated with two brush rolls rotating in the same direction of the conveyance direction of the printing plate (in Example 1 one roll rotates in the opposite direction, cf paragraph [0268] of the patent in suit), and using a fatigued processing liquid rather than new liquid as in Example 1, the number of copies needed to sweep away the ink of non-image portion (when the printing plate thus prepared was installed on a printing machine) was unexpectedly low, namely 20 (cf Example 7). This followed from, on the one hand comparing the number of copies needed in Example 7 with the number of copies needed when the second brush roll was detached (and still using fatigued liquid), namely 35 (cf comparative Example 4), and on the other hand comparing the number of copies needed when new liquid was used with and without a second brush roll, cf Example 6 and comparative Example 3, respectively. More precisely, the effect of adding a second roll using new liquid, starting from comparative Example 3 - number of copies needed 20) lead to a reduction of the number of copies needed of 5, or 25% (cf Example 6: number of copies needed 15), whereas the effect of adding a second roll using fatigued liquid the reduction of the number of copies needed was 15, or 43 %. The same synergistic effect was shown by the comparative experiments filed on 1 June 2010 and 13 December 2011, respectively. This phenomenon was called “synergy” in the statement of grounds.

Based on the results of the comparative experiments, the Examples 1 to 4 in the patent specification and the statement in paragraph [0301] of the patent, the objective technical problem to be solved with respect to document D4 was to provide a method for the preparation of a lithographic printing plate wherein the thermosensitive layer comprised polymer particles which method led to a considerable reduction in the number of stained copies at the time of printing out.

The respondent had contended that, even if the combination "circulation pump/two or more brush rolls" were to produce a synergistic effect, this could not be used as evidence of inventive step, because the claimed combination had been disclosed in many prior art documents. This approach of the respondent disregarded the problem-solution approach for assessing inventive step. The decisive question was whether, in view of existing alternative development and processing techniques (replenish the processing liquid, raise the temperature of the processing liquid, use absorbent means instead of a brush roll) the skilled person would have expected that especially the use of two or more brush rolls and recirculation (fatigued processing liquid) would be particularly effective to achieve a considerable reduction in the number of stained copies resulting from a type of lithographic printing plate, wherein the thermosensitive layer comprised polymer particles.

Document D4 itself did not provide any motivation to modify the method described in that document by the distinguishing features mentioned above. The already cited passage in column 7, lines 51 to 55, did not discuss stain formation but rather spoke in very general terms of "good development" without

distinguishing between rubbing or spraying treatments, or between the use of an absorbent means or a brush, during the application of the developing liquid. Nothing in the teaching of this document would make a skilled person expect that the use of two or more brushes in combination with recirculation of the processing liquid would provide outstanding results for lithographic printing types of the type used in the present invention.

Document D11 showed in Figure 1 an automatic processor comprising two brush rolls as rubbing members. It was questionable whether a skilled person starting from document D4 would have seriously contemplated using the automatic processor of document D11 for solving the objective technical problem mentioned above, since the planographic printing plates of document D11 were different from the lithographic printing plates claimed in claim 1 of the main request. In particular, said planographic printing plates did not have a thermosensitive layer comprising polymer particles. An object of document D11 was to provide a method for producing a planographic plate which did not cause bubbling of a liquid used in the rubbing treatment of the plate, and thus does not cause problems resulting from such bubbling (column 2, lines 9 to 17 and lines 26 to 30). This problem was not related to the objective technical problem of the present invention. It followed that claim 1 of the main request was not obvious to the person skilled in the art but involved an inventive step.

Admittance of the auxiliary requests

The auxiliary requests MR(a), MR(b), 1a to 9a filed on 13 December 2011 were filed as a precautionary measure

in response to the reply of the respondent dated 7 December 2010, wherein it was submitted that there could be no synergy between recirculation and the use of a plurality of brush rollers if the number of brush rollers was high. For that reason the number of brush rollers in said requests was restricted to two. In its communication dated 23 April 2015 the board stated that the amendments conducted in these requests did not prima facie overcome the objection of lack of inventive step, since they did not include any further distinguishing features over a combination of the teachings of documents D4 and D11. Amended claims may be admitted into the proceedings if the introduced amendments were properly justified, eg if they were filed as a response to objections which were not part of the decision under appeal but were raised in writing during the appeal proceedings. This was the case here. Said auxiliary requests were a bona fide attempt to overcome the objections raised by the respondent for the first time in its reply to the appeal. Using considerations regarding inventive step when discussing the admittance of the auxiliary requests, as the board did, was not the correct approach.

The auxiliary requests 1 to 9 were filed along with the grounds of appeal and should be admitted for the following reasons. As a rule, auxiliary requests filed along with the grounds of appeal should be admitted in the proceedings unless exceptional circumstances occurred. In the case at hand no such exceptional circumstances were present. The appellant never tried to avoid a decision by the opposition division on certain issues nor pursued subject-matter relating to fundamentally different embodiments in the appeal proceedings. The amendments conducted in the auxiliary requests 1 to 9 were filed in response to an objection

raised by the opposition division for the first time in the written grounds of the decision, see point 7.3 of the Reasons, page 13, last paragraph. In said passage the opposition division held that the experimental data filed with letter of 23 October 2009 by the appellant did not provide evidence that the alleged surprising synergistic effect was present over the whole scope of the claim, inter alia since the comparative experiments which had been filed referred to a specific composition of the printing plate precursor in combination with a specific composition of the processing liquid. The auxiliary requests 1 to 9 addressed this objection and were restricted to the composition of the printing plate precursor and the composition of the processing liquid as used in the Examples 1 to 4 of the patent in suit.

VII. The arguments of the respondent, in writing and during the oral proceedings, can be summarized as follows:

Allowability of the amendments – main request

The additional feature of claim 1 of the main request with respect to claim 1 as granted, viz "wherein two or more rotary brush rolls are used as rubbing members", was disclosed in paragraph [0257] of the published version of the application as filed, but only in relation to Figure 1, cf "where two or more rotary brush rolls are used as in the automatic processor of Fig. 1". According to said Figure, the liquid was sprayed simultaneously on a brush roll and on the plate. This information had therefore to be included in said claim. The same conclusion was reached when starting from claim 1 of the main request. Said claim encompassed embodiments wherein the processing liquid was only sprayed onto the plate and not on the brush

rolls, or vice-versa. Since there was no disclosure of these embodiments in the application as filed, claim 1 of the main request contained subject-matter extending beyond the contents of the application as filed, contrary to Article 123(2) EPC.

Inventive step - main request

Claim 1 of the main request was, except for cancellation of the embodiment relating to a microcapsule, identical to claim 1 of auxiliary request 1 filed before the opposition division. That request had been rejected by the opposition division as being obvious in view of documents D4 and D11, and there was no reason to deviate from that decision. Document D4, which represented the closest state of the art, disclosed a method for preparing a lithographic printing plate, whereby a lithographic printing plate precursor comprising a support having a hydrophilic surface and a thermosensitive layer comprising polymer particles was imagewise recorded, ie the same lithographic printing plate precursor as claimed in claim 1 of the main request. Claim 1 of the main request was directed to a method for preparation of a lithographic printing plate, the imaging mechanism itself was not part of the claim. The fact that the imaging mechanism in document D11 was different than the one in document D4, was therefore not an obstacle for the person skilled in the art starting from document D4 to consult document D11. This document disclosed in Figure 1 the same automatic processor as shown in Figure 1 of the patent in suit. With this automatic processor the production of a planographic printing plate could be conducted effectively and reliably (column 9, lines 59 to 64), cf the wording “of

efficiently and surely removing" in inter alia paragraphs [0014] to [0016] of the patent in suit.

The appellant had argued that the combination of a recirculating pump and two or more brush rolls provided a synergetic effect (which was not disclosed in the application as filed or in the patent). The skilled person knew that there could not be any synergy between recirculation on the one hand and the use of a plurality of brush rolls on the other hand if the number of brush rolls was high: when many brush rollers were used, the clean-out of the plate was always good, regardless of the quality of the processing liquid; in other words, it did not matter whether fresh (ie no recirculation) or fatigued processing liquid (ie with recirculation) was used if the plate was brushed intensively. In this respect it was noted that claiming two or more brushes in the invention instead of a single brush as in document D4 provided no inventive merit at all since everyone knew that rubbing a surface several times instead of just once provided a better cleaning. "Synergy" implied that two factors each produced a positive effect and that the sum of the combined factors was more than the effect resulting from the separate effects. In this specific case, however, one factor had a positive effect (two brush rolls instead of one, ie better clean-out) and the other factor had a negative effect (recirculation instead of a fresh processing liquid, ie worse clean-out). There could not be a synergy between features having opposite effects. Moreover, the question whether or not the distinguishing features of claim 1 of the main request with respect to document D4 produced a synergistic effect did not pose itself, since said features were known in combination from document D11.

Admittance of the auxiliary requests

In claim 1 of auxiliary request 1 a cyanine dye as light-heat converting agent was introduced for the first time. The dye played a role in the imaging process, but had no interaction with mechanical cleaning. The appellant had shifted the nature of the invention since the filing of the application. Claim 1 as filed was directed to a method for preparation of a lithographic printing plate, wherein the step of removing the thermosensitive layer of nonimage portions was accomplished by mechanical cleaning, viz "rubbing the printing plate precursor by a rubbing member in the presence of the processing liquid with an automatic processor". During the prosecution of the application additional features of the automatic processor (spray pipe, circulation pump) had been added, again in the area of mechanical cleaning. In the opposition proceedings the rubbing member was defined as two or more rotary brush rolls. Since the auxiliary requests filed in the appeal proceedings constituted a shift away from mechanical cleaning towards the chemical properties of the thermosensitive layer and/or the processing liquid, they should not be admitted. The appellant had generously been given the opportunity to file six auxiliary requests during the oral proceedings before the opposition division.

Reasons for the Decision

1. The appeal is admissible.

MAIN REQUEST

2. *Admittance of the main request*

2.1 In principle the statement setting out the grounds of appeal shall contain a party's complete case (cf Article 12(2) RPBA), which shall be taken into account by the board (cf Article 12(4) RPBA, last half-sentence). However, it lies in the discretion of the board to refuse requests which are presented for the first time in appeal or were not admitted in the first instance proceedings (cf Article 12(4) RPBA, first half-sentence), and which would therefore constitute a fresh case. In this respect it is noticed that the Enlarged Board of Appeal stated in its decision G 9/91 (OJ EPO 1993, 408, point 18 of the Reasons) the following: "*The purpose of the appeal procedure inter partes is mainly to give the losing party the possibility of challenging the decision of the Opposition Division on its merits*." It follows from said passage that bringing an entirely fresh case is not in line with the purpose of the appeal proceedings.

2.2 The main request was filed with the statement of grounds of appeal. Claim 1 of said request is, except for cancellation of the embodiment relating to a microcapsule, identical to claim 1 of auxiliary request 1 filed before the opposition division.

2.3 It follows that the main request relates to issues, which have been decided by the first instance. The main request is therefore admitted into the appeal proceedings, Article 12(4) RPBA, last half-sentence.

3. *Admissibility of the amendments, Article 123(2) EPC*

3.1 Claim 1 of the main request differs from claim 1 as granted in that the expression "at least one of polymer particles and a microcapsule encapsulating an

oleophilic compound therein" has been replaced by the wording "polymer particles" and in that the expression "wherein two or more rotary brush rolls are used as rubbing members" has been added at the end of the claim.

3.2 A basis for the expression "two or more rotary brush rolls are used" is page 29, lines 33 to 36, of the application as filed (published version), which reads as follows: "*However, in the case where two or more rotary brush rolls are used as in the automatic processor of Fig. 1, it is preferred that at least one rotary brush roll rotates in the same direction, whereas at least one rotary brush roll rotates in a reverse direction*". Since in Figure 1 precisely two rotary brush rolls, and not more than two, are shown, the person skilled in the art would interpret the term "as" in said passage as "such as", ie she or he will construe the reference to the automatic processor of Figure 1 as an example of an apparatus, wherein two or more rotary brush rolls are used.

3.3 Claim 1 of the main request does not therefore contain subject-matter that extends beyond the contents of the application as filed, Article 123(2) EPC.

4. *Ground for opposition under Article 100(a) EPC 1973 in combination with Article 56 EPC 1973*

4.1 Document D4 discloses (column 2, line 53 to column 3, line 4, and claim 8) a method for obtaining a lithographic printing plate comprising the steps of (a) image- or information-wise exposing an imaging element to light or heat, and (b) developing said exposed imaging element with an aqueous developing solution in order to remove the unexposed areas and thereby form a

lithographic printing plate. The imaging element comprises on a hydrophilic surface of a lithographic base an image forming layer comprising at least hydrophobic thermoplastic polymer particles (column 3, lines 16 to 21) and a light to heat converting compound (cf column 7, lines 2 to 30, in particular lines 19 to 21).

This document therefore discloses a method for preparation of a lithographic printing plate comprising the first step mentioned in claim 1 of the main request, viz "imagewise recording on a lithographic printing plate precursor (12) comprising a support having a hydrophilic surface and a thermosensitive layer, the thermosensitive layer comprising polymer particles".

In the passage in column 7, lines 51 to 55, it is stated that "*For a good development the exposed imaging element is rubbed with e.g. an absorbent means or a brush during the application of the developing liquid or while still being wet with the developing solution or is sprayed with the developing solution*". In this sentence two possible "rubbing members" are mentioned, namely "an absorbent means or a brush". The last part of said sentence, viz "*during the application of the developing liquid or while still being wet with the developing solution or is sprayed with the developing solution*", makes it clear that the rubbing step is performed in the presence of the developing liquid.

Document D4 thus discloses the steps of "showering the printing plate precursor (12)" and "rubbing the printing plate precursor (12) by a rubbing member (1) in the presence of the processing liquid (10) [with an automatic processor provided with the rubbing member

(1)] to remove the thermosensitive layer of nonimage portions", apart from the wording between square brackets.

4.2 The subject-matter of claim 1 of the main request differs from the method for preparation of a lithographic printing plate known from document D4 in that (i) "a processing liquid (10) is conveyed into a spray pipe (5) by a circulating pump (11)" and in that (ii) "[rubbing the printing plate precursor (12)] ... with an automatic processor provided with ... two or more rotary brush rolls ...".

The distinguishing features lead to a more thorough removal of the thermosensitive layer of non-image portions and hence to a reduction in staining during printing.

4.3 The person skilled in the art seeking to obtain a lithographic printing plate according to the method of claim 8 of document D4, having improved lithographic properties such as an increased ink acceptance (cf column 2, lines 32 to 36), and in particular seeking to carry out step (b) thereof, viz "*developing said exposed imaging element with an aqueous developing solution in order to remove the unexposed areas and thereby form a lithographic printing plate*", will try to implement the information provided in the passage in column 7, lines 51 to 55, recited in point 4.1 above. Since said passage does not give further details of how to execute the rubbing step with an absorbent means or a brush, or how to apply or spray the developing liquid onto the imaging element, the person skilled in the art will turn to prior art documents, wherein methods or apparatuses are described for obtaining a lithographic printing plate having improved lithographic properties.

4.4 It follows from the above, that for the person skilled in the art starting from document D4, the objective problem to be solved is to find an apparatus capable of efficiently and surely removing a thermosensitive layer of non-image portions of a lithographic printing plate precursor.

4.5 Document D11 provides a method for producing a planographic printing plate which can be prepared by using laser light, and in which exposed portions of an ink-repellent layer can be removed, and which enables excellent printing (column 2, lines 22 to 26). Since document D11 thus addresses the objective problem above and a problem very similar to the one of document D4, the person skilled in the art will consult this document.

Figures 1 and 2 of document D11 show (column 9, line 7, to 64) automatic treating machines comprising two brush rollers 1, wherein an aqueous solution is supplied from a tank 10 open at the top and located below the treating area via spray pipes 5 onto the printing plate 12. Excess aqueous solution falls downward, is collected in tank 10 and supplied again via spray pipes 5 onto the printing plate 12 by circulation pump 11.

4.6 The person skilled in the art starting from document D4, who seeks to solve the objective problem mentioned in point 4.4 above, will find the apparatus capable of removing the thermosensitive layer of non-image portions efficiently in document D11 (column 9, line 53). The apparatus of said document (cf Figure 1) shows all the distinguishing features of claim 1 of the main request, cf point 4.2 above. The person skilled in the art will thus arrive at the subject-matter of claim 1

of the main request without exercising inventive skills.

4.7 The subject-matter of claim 1 of the main request does therefore not involve an inventive step.

5. *The asserted synergistic effect of the distinguishing features of claim 1 of the main request*

5.1 The appellant has submitted that, starting from document D4, adding a second roll was more effective (in terms of number of copies needed) when a fatigued rather than a new liquid was used. In other words, the distinguishing features (i) "a processing liquid (10) is conveyed into a spray pipe (5) by a circulating pump (11)" and (ii) "[rubbing the printing plate precursor (12)] ... with an automatic processor provided with ... two or more rotary brush rolls ..." produced a synergistic effect.

5.2 A synergistic effect arising between two measures is an effect which is greater than the sum of the individual effects of these measures. In document D4 it is mentioned that rubbing the imaging element with a brush during the application of the developing liquid is beneficial (see the passage in column 7, lines 51 to 55 recited in point 4.1 above.

Comparative Example 3 (new liquid, one brush roll) corresponds to some extent to the situation in document D4. The number of copies needed to sweep away the ink of non-image portions is 20. The effect of "adding a second brush roll in the forward direction" (measure 1) in comparative Example 3 gives a improvement, namely the number of copies needed to sweep away the ink of non-image portions reduces to 15,

cf Example 6 (new liquid, two brush rolls). However, the effect of "replacing the fresh liquid by fatigued liquid" (measure 2) in comparative Example 3 gives a substantial deterioration, ie the number of copies needed to sweep away the ink of non-image portions increases to 35, cf comparative Example 4 (replacing the fresh liquid by fatigued liquid, one brush roll). The combined effect of "adding a second brush roll in the forward direction" and "replacing the fresh liquid by fatigued liquid" starting from comparative Example 3 is nil, cf Example 7 (fatigued liquid, two brush rolls), which falls within the scope of claim 1 of the main request. It is true that the sum of the individual effects of measure 1 (5 copies less needed - a postive effect) and measure 2 (15 copies more needed - a negative effect) is less than the sum of the combined effect, since the latter is nil (no netto effect) and the individual effects add up to "10 copies more needed", a worse result that no effect. In this sense there is in some sense a synergistic effect: the combined affect is not as bad as was to be expected on the basis of the individual effects. It is noticed however that the combined effect of measures 1 and 2 is worse than the effect of measure 1 alone.

The person skilled in the art will expect that in a process of removing the thermosensitive layer of non-image portions comprising a mechanical treatment (rubbing the printing plate precursor with one or more rotary brush rolls) and a chemical treatment (showering the printing plate precursor with a processing liquid) the effects of the mechanical and chemical treatments are interrelated. She or he will expect that increasing the rubbing treatment results in a larger improvement when the effect of the processing liquid is poor, than when the effect of the processing liquid is good.

5.3 The board arrived at the conclusion of point 4.7 above without taking into account the synergistic effect asserted by the appellant, for the simple reason that when a synergistic effect results from using a circulating pump resulting in a fatigued liquid and using two brush rolls (cf the distinguishing features (i) and (ii)), the same synergistic effect results from using the automatic treating machine known from document D11. In other words, taking the synergistic effect into account cannot lead to a different conclusion.

There is a second reason. The appellant has built his case of a synergistic effect of using fatigued liquid on the term “circulating pump” in claim 1 of the main request, and on the number of rotary brush rolls ("two or more"). However, the patent in suit is completely silent about using a fatigued processing liquid. Said claim does not exclude that fresh processing liquid is used for the (first) lithographic printing plate, and that, if the claim is construed to encompass the possibility to process a plurality of lithographic printing plates in succession, fresh processing liquid is used for each subsequent lithographic printing plate (which gives the best results). In order to assess the effect of adding a second brush roll it is necessary to qualify the rubbing effect of the first brush roll. The rubbing effect of a brush roll depends inter alia on the material, diameter and length of the hairs of the brush rolls, on the relative circumferential speed of the brush tip with respect to the lithographic plate and on the duration of time that each area of said plate is rubbed. None of this information is recited in the claim. A single good quality brush roll may do a better job than two poor quality brush rolls.

AUXILIARY REQUESTS 1 to 9

6. *Admittance of auxiliary requests 1 to 9*

6.1 Auxiliary requests 1 to 9 were filed by the appellant with its statement of grounds. It needs to be investigated, whether the filing of these requests is tantamount to bringing a fresh case, cf point 2.1 above.

6.2 Auxiliary requests 1 to 4 and 6 to 9

6.2.1 Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that the expression "and a cyanine dye as light-heat converting agent" has been added after the word "particles".

Claim 1 of auxiliary request 2 differs from claim 1 of auxiliary request 1 in that the expression "and recirculated by circulating pump (11)" has been added after the expression "supplied to the printing plate precursor (12)". The additional feature does not prima facie overcome the objection of lack of inventive step above (cf point 4.3 above), since, first, the expression "circulating pump" in the main request is construed by the board to mean a pump which recirculates part of the processing liquid (see the communication of the board dated 23 April 2015, point 7.2), and, second, a circulating pump is known from document D11 referred to in point 4.5 above.

Claim 1 of auxiliary request 3 differs from claim 1 of auxiliary request 2 in that the expression "into the spray pipe (5)" has been added after the expression

"recirculated by circulating pump (11)". This feature is also known from document D11, see point 4.5 above.

Claim 1 of auxiliary request 4 differs from claim 1 of auxiliary request 2 in that the expression "and recirculated by circulating pump (11)" has been replaced by the expression "wherein the circulating pump (11) recirculates the processing liquid (10)". This feature is also known from document D11, see point 4.5 above.

Claim 1 of auxiliary request 6 differs from claim 1 of auxiliary request 4 in that the expression "and wherein the processing liquid (10) is hydrophilic aqueous solution containing a surfactant" has been added after the expression "recirculates the processing liquid (10)". This feature is also known from document D11, see column 9, lines 36 and 37.

Claim 1 of auxiliary request 7 differs from claim 1 of auxiliary request 6 in that the word "surfactant" has been replaced by the wording "non-ionic surfactant". This feature is also known from document D11, see column 10, line 58, to column 11, line 4.

Claim 1 of auxiliary request 8 differs from claim 1 of auxiliary request 7 in that the expression "having an HLB value of 8 or more" has been added after the word "surfactant". This feature is also known from document D11, see column 11, lines 29 to 33).

Claim 1 of auxiliary request 9 differs from claim 1 of auxiliary request 8 in that the expression "wherein the addition amount of the finely granular polymer particles is 50% by weight or more of the solids content of the thermosensitive layer" has been added

after the word "agent". This feature is known per se from document D3, see column 6, lines 45 to 49.

6.2.2 Auxiliary requests 1 to 4 and 6 to 9 all share the feature "[the thermosensitive layer comprising polymer particles] and a cyanine dye as light-heat converting agent".

This feature is taken from the description of the application as filed, see eg paragraphs [0144] to [0146] in combination with paragraphs [0263] and [0264] of the application as filed (published version). In the latter paragraphs the light-heat converting agent A is disclosed, which is a cyanine dye.

6.2.3 A request containing the feature "and a cyanine dye as light-heat converting agent" has not been presented in the first instance proceedings by the appellant.

6.3 Auxiliary request 5

6.3.1 Claim 1 of auxiliary request 5 differs from claim 1 of auxiliary request 4 in that the expression "and a cyanine dye as light-heat converting agent" has been deleted and in that the expression "and wherein the processing liquid (10) is hydrophilic aqueous solution containing a surfactant" has been added after the expression "recirculates the processing liquid (10)". The additional feature, viz "the processing liquid is hydrophilic aqueous solution containing a surfactant" is taken from claim 10 of the application as filed. This feature (see also point 6.2.1 above) is known from document D11, see column 9, lines 36 and 37.

6.3.2 A request containing the feature "the processing liquid is hydrophilic aqueous solution containing a

surfactant" has not been presented in the first instance proceedings by the appellant (cf point 5.2.2 above, second paragraph).

6.4 At the beginning of the oral proceedings before the opposition division the appellant defended its patent on the basis of its sole request filed on 7 July 2008 in reply to the notice of opposition.

Claim 1 of said request differed from claim 1 as granted in that the expression "wherein two or more rotary brush rolls are used" had been added at the end of the claim. During the oral proceedings the appellant was allowed to file auxiliary requests 1 to 6. Claim 1 of auxiliary request 1 filed before the opposition division differed from claim 1 of the sole request (henceforth referred to as main request) in that the expression "as rubbing member" was added at the end of the claim. Claim 1 of auxiliary request 2 filed before the opposition division differed from claim 1 of auxiliary request 1 filed before the opposition division in that the expression "and recirculated" was added after the expression "supplied to the printing plate precursor (12)". Claim 1 of auxiliary request 3 filed before the opposition division differed from claim 1 of auxiliary request 2 filed before the opposition division in that the expression "into the spray pipe (5)" was added after the expression "and recirculated". Claim 1 of auxiliary request 4 filed before the opposition division differed from claim 1 of auxiliary request 1 filed before the opposition division in that the expression "wherein the circulating pump circulates the processing liquid" was added after the expression "supplied to the printing plate precursor (12)". Claim 1 of auxiliary request 5 filed before the opposition division differed from

claim 1 of auxiliary request 4 filed before the opposition division in that the word "circulates" was replaced by the word "re-circulates". Claim 1 of auxiliary request 6 filed before the opposition division was directed to an embodiment of the invention, which was not opposed in the notice of opposition (see point I above).

6.5 It follows from the above that all of the amendments in auxiliary requests 1 to 5 filed before the opposition division concern constructional details of the automatic processor. In contrast, the feature "the thermosensitive layer comprising ... a cyanine" in auxiliary requests 1 to 4 and 6 to 9 filed in the appeal proceedings and the feature "the processing liquid is hydrophilic aqueous solution containing a surfactant" in auxiliary request 5 filed in the appeal proceedings concern the chemical composition of the lithographic printing plate precursor and of the processing liquid, respectively.

6.6 In the view of the board, the filing of auxiliary requests 1 to 9 in the appeal proceedings constitutes a change in the way the appellant defended its patent before the first instance.

6.7 Each of auxiliary requests 1 to 9 contains features, which have not been presented or discussed in the first-instance proceedings, cf points 6.2.3 and 6.3.2 above, thereby compelling the board either to give a first ruling on this issue or to remit the case to the opposition division, cf Case Law of the Boards of Appeal of the EPO, 7th edition 2013, IV.E.4.3). Not only have these features not been presented, but the amendments to these auxiliary requests go in a

different direction than the amendments filed in the opposition proceedings, cf point 6.6 above.

6.8 As noted in point 2.1 above, it lies in the discretion of the board to refuse requests which are presented for the first time in appeal and would therefore constitute a fresh case.

The board comes to the conclusion that the filing of auxiliary requests 1 to 9 constitutes as fresh case.

6.9 These requests are therefore not admitted into the appeal proceedings, Article 12(4) RPBA, first half-sentence.

AUXILIARY REQUEST 10

7. Claims 1 to 9 of auxiliary request 10 correspond to the set of claims of auxiliary request 6 filed by the appellant in the opposition proceedings, on the basis of which the opposition division intended to maintain the patent, cf point I. above. Auxiliary request 10 amounts to requesting that the appeal be dismissed.

AUXILIARY REQUESTS MR(a), MR(b) and 1a to 9a

8. *Admittance of auxiliary requests MR(a), MR(b) and 1a to 9a*

8.1 Auxiliary requests MR(a) and MR(b) were filed by the appellant as a precautionary measure after it has filed its grounds of appeal. According to Article 13(1) RPBA, any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the board's discretion. The discretion shall be exercised in view of inter alia the complexity

of the new subject matter submitted, the current state of the proceedings and the need for procedural economy.

Requests that are filed at this stage of the proceedings should be prima facie formally allowable (Articles 84 and 123 EPC) and prima facie overcome all substantive objections raised in the opposition appeal proceedings.

8.2 Claim 1 of auxiliary request MR(a) differs from claim 1 of the main request in that the expression "or more" has been deleted.

Claim 1 of auxiliary request MR(b) differs from claim 1 of auxiliary request MR(a) in that after the expression "a processing liquid (10) is conveyed into a spray pipe (5) by a circulating pump (11) and supplied to the printing plate precursor (12)" the expression "wherein the circulating pump (11) recirculates the processing liquid (10)" has been added.

8.3 The restriction to "two rotary brush rolls are used as rubbing members" introduced in claim 1 of auxiliary requests MR(a), MR(b) does not prima facie overcome the objection of lack of inventive step, since document D11 discloses a rubbing step with two rotary brush rolls. The additional feature of auxiliary request MR(b) does not prima facie overcome the objection of lack of inventive step above, since the expression "circulating pump" in the main request is construed by the board to mean a pump which recirculates part of the processing liquid.

8.4 Auxiliary requests 1a to 9a differ from the corresponding auxiliary requests 1 to 9 in that the expression "or more" has been deleted. What has been

stated about the additional features of auxiliary requests 1 to 9 in points 6.2.1 and 6.3 above, namely that said features are known from the prior art, applies mutatis mutandis to auxiliary requests 1a to 9a. The additional features of auxiliary requests 1a to 9a do not prima facie overcome the objection of lack of inventive step.

8.5 Auxiliary requests MR(a), MR(b) and 1a to 9a are therefore not admitted into the appeal proceedings, Article 13(1) RPBA.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

D. Meyfarth M. Poock

Decision electronically authenticated