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**Datasheet for the decision  
of 26 September 2014**

**Case Number:** T 1101/10 - 3.2.05

**Application Number:** 04003271.6

**Publication Number:** 1580022

**IPC:** B41N6/00

**Language of the proceedings:** EN

**Title of invention:**

Self-levelling under-packing for printing cylinders

**Patent Proprietor:**

Printgraph Waterless S.p.A.

**Headword:**

**Relevant legal provisions:**

EPC Art. 123(2), 123(3)

EPC R. 99(1)(c), 139

**Keyword:**

Admissibility of appeal (yes)

Correction of error - immediately evident that nothing else  
could have been intended (no)

Amendments - added subject-matter (yes) -  
extension of the scope of the claims (yes)

**Decisions cited:**

G 0003/89, G 0011/91, T 0689/09

**Catchword:**



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Case Number: T 1101/10 - 3.2.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.05**  
**of 26 September 2014**

**Appellant:** Printgraph Waterless S.p.A.  
(Patent Proprietor) Via Galvani 26/A  
20019 Settimo Milanese MI (IT)

**Representative:** Erik Scheuermann  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 19 March 2010  
revoking European patent No. 1580022 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** M. Poock  
**Members:** P. Lanz  
E. Kossonakou

## **Summary of Facts and Submissions**

- I. The appeal by the patent proprietor is against the decision of the opposition division revoking European patent No. EP-B-1 580 022.
- II. During the opposition proceedings, the grounds for opposition according to Articles 100(a) (lack of novelty and lack of inventive step), 100(b) and 100(c) EPC 1973 were raised.
- III. Both opponents withdrew their respective oppositions during the opposition proceedings, which the opposition division then continued of its own motion according to Rule 84(2), second sentence, EPC. Finally, the opposed patent was revoked on the ground of insufficient disclosure, Article 100(b) EPC 1973.
- IV. Oral proceedings were held before the board of appeal on 26 September 2014.
- V. The appellant requests that the decision under appeal be set aside and the patent be maintained in amended form in accordance with either the main or the auxiliary request, both filed with its submissions dated 25 July 2014.
- VI. The only independent claim of the main request reads as follows:

"1. An under-packing for a blanket cylinder in printing presses, comprising at least one non-elastic layer and at least one elastomeric layer joined inseparably together, the non-elastic layer or layers being polyester-based and the elastomeric layer or layers being polyurethane-based, characterised in that, in

order to achieve the self-levelling of the under-packing, the elastomeric component has the following chemical/physical characteristics:

Shore hardness A	75-95	DIN 53505
Density g/cm <sup>3</sup>	1.10-1.25	DIN 53479
Cyclic compression %	60% compressible	
Resilience %	30-40	DIN 53512
Solvent resistance	resistant	

wherein the cyclic compression test consists of carrying out a cycle of one million compressions (of 60%) without undergoing any thickness [sic] decreases in 5 cm elastomeric discs subjected to 60% compressive load with preload of 2 N, cycle frequency 20 hz [sic]."

VII. The wording of the independent claim of the auxiliary request is as follows:

"1. An under-packing for a blanket cylinder in printing presses, comprising at least one non-elastic layer and at least one elastomeric layer joined inseparably together, the non-elastic layer or layers being polyester-based and the elastomeric layer or layers being polyurethane-based, characterised in that, in order to achieve the self-levelling of the under-packing, the elastomeric component has the following chemical/physical characteristics:

Shore hardness A	75-95	DIN 53505
Density g/cm <sup>3</sup>	1.10-1.25	DIN 53479
Cyclic compression %	60% compressible	
Resilience %	30-40	DIN 53512
Solvent resistance	resistant	

wherein the cyclic compression test consists of carrying out a cycle of one million compressions (of 60% of the compressible side) without undergoing any thickness decrease in 5 cm elastomeric discs subjected

to 60% compressive load on the elastomeric side with preload of 2N, cycle frequency 20 Hz."

VIII. The arguments presented by the appellant in writing and during the oral proceedings can be summarised as follows:

The replacement of the references to DIN 53517 in claim 1 addressed the issue of sufficiency of disclosure. This was an allowable correction of an obvious error under Rule 139 EPC. In fact, DIN 53517 related to a static test of the compression set, while the claim feature in question related to the dynamic parameter of cyclic compression. It was thus obvious that the reference to two different and mutually incompatible tests in claim 1 was erroneous.

As to the correction, the skilled person could consider three possibilities:

- (a) DIN 53517 was the correct reference for measuring the compression as a static parameter.
- (b) The claimed compression was cyclic and measured according to the test specified in paragraph [0020] of the patent.
- (c) The claimed parameter of cyclic compression was measured using a test based on DIN 53517 but modified according to paragraph [0020] of the patent.

Keeping in mind that the patent in suit was directed to an under-packing for a blanket cylinder in printing presses, i.e. an application in which the underpacking is subjected to a large number of very short

compression/relaxation cycles, the skilled person would immediately exclude option (a), since the DIN 53517 standard related to a test for the behaviour of material when submitted to compression over a long period of time. Hence, it could not provide useful information with respect to the suitability of a material as an under-packing. Also option (c) had to be eliminated since the DIN 53517 standard had no overlap with the test proposed in paragraph [0020] of the patent. Consequently, it was immediately obvious that the only sensible correction of the mistake was option (b) consisting in the replacement of the reference to DIN 53517.

Since it would be immediately evident to the skilled person that nothing else was intended, the proposed amendment was also allowable under Article 123(2) and (3) EPC.

IX. In its written communications and during the oral proceedings the board questioned whether it was obvious that an error was in fact present in the contested patent and whether the proposed correction was obvious in the sense that it was immediately evident that nothing else was intended. Moreover, it expressed the preliminary view that this amendment was not in line with the provisions of Article 123(2) and (3) EPC.

## **Reasons for the Decision**

### *1. Admissibility of appeal*

Rule 99(1)(c) EPC requires the notice of appeal to contain a request defining the subject of the appeal, otherwise the appeal is to be rejected as inadmissible.

In the present case, the notice of appeal does not contain such an explicitly formulated request. Since the impugned decision concerns the revocation of the contested patent, the appeal can only be aimed at the impugned decision being set aside in its entirety (cf. T 689/09, Reasons 1).

This interpretation is consistent with the appellant's requests set out in the statement of grounds of appeal, page 8, paragraphs 5.1 and 5.2.

The subject of the appeal is thus implicitly but unambiguously determined. Hence, the provisions of Rule 99(1)(c) EPC are met.

The present appeal also meets the further requirements set out in Articles 106 EPC, 107 EPC 1973 and 108 EPC, as well as in Rules 97 and 99 EPC. It is thus admissible.

2. *Main request - Amendments*

- 2.1 Claim 1 of the main request differs from the independent claim as granted in that the reference to DIN 53517 regarding the cyclic compression is replaced by the feature *"wherein the cyclic compression test consists of carrying out a cycle of one million compressions (of 60%) without undergoing any tickness [sic] decreases in 5 cm elastomeric discs subjected to 60% compressive load with preload of 2 N, cycle frequency 20 hz [sic]."*

The appellant argues that the above amendment is an allowable correction of an obvious error pursuant to Rule 139, second sentence, EPC.



2.2 Rule 139, second sentence, EPC governs the correction of errors in the specification of a patent (application) so that its text is brought into conformity with the intended wording.

In order for a correction in the description, the claims or the drawings to be allowable under Rule 139, second sentence, EPC, it must be established

(i) that it is obvious that an error is in fact present in the document filed with the EPO, the incorrect information having to be objectively recognisable by the skilled person using common general knowledge, and

(ii) that the correction of the error is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction (see G 3/89 and G 11/91, OJ EPO 1993, 117 resp. 125, Reasons 3 to 6).

The Enlarged Board of Appeal held furthermore (G 3/89 and G 11/91, *op. cit.*, Headnote I) that any correction is of a strictly declaratory nature and thus does not infringe the prohibition of extension of subject-matter under Article 123(2) EPC.

2.3 As to condition (i) above, the appellant submits that the DIN 53517 standard relates to a static test of the compression set, while the claim feature in question relates to the dynamic parameter of cyclic compression. It is thus obvious that the references to two different and mutually incompatible tests in claim 1 as granted is erroneous.

2.4 In order to determine whether this information is objectively recognisable as incorrect for a skilled person, using common general knowledge, from the patent as a whole, the board makes reference to independent claim 1 as granted:

*"An under-packing for a blanket cylinder in printing presses, comprising at least one non-elastic layer and at least one elastomeric layer joined inseparably together, the non-elastic layer or layers being polyester-based and the elastomeric layer or layers being polyurethane-based, characterized in that in order to achieve the self-levelling of the under-packing, the elastomeric component has the following chemical/physical characteristics:*

<i>Shore hardness A</i>	<i>75-95</i>	<i>DIN 53505</i>
<i>Density g/cm<sup>3</sup></i>	<i>1.10-1.25</i>	<i>DIN 53479</i>
<i>Cyclic compression %</i>	<i>60% compressible</i>	<i>DIN 53517</i>
<i>Resilience %</i>	<i>30-40</i>	<i>DIN 53512</i>
<i>Solvent resistance</i>	<i>resistant"</i>	

Further reference is made to the pertinent paragraphs [0019] and [0020] of the patent specification (corresponding to paragraphs [0016] and [0017] of the published patent application):

*"In particular the chemical/physical characteristics of the polyurethane are the following:*

<i>Shore hardness A</i>	<i>75-95</i>	<i>DIN 53505</i>
<i>Density g/cm<sup>3</sup></i>	<i>1.10-1.25</i>	<i>DIN 53479</i>
<i>Cyclic compression %</i>	<i>60% compressible</i>	<i>DIN 53517</i>
<i>Resilience %</i>	<i>30-40</i>	<i>DIN 53512</i>
<i>Solvent resistance</i>	<i>resistant</i>	

*The test consisted of carrying out a cycle of one million compressions (of 60% on the compressible side)*

*without undergoing any thickness decrease in 5 cm elastomeric discs subjected to 60% compressive load on the elastomer side with preload of 2N, cycle frequency 20 Hz."*

The board holds that a skilled reader construing the patent in suit with a mind seeking to understand could interpret the above in the sense that the cyclic compression test referred to in claim 1 is based on DIN 53517 but modified according to the instructions given in paragraph [0020]. It is observed that this was also the interpretation proposed by the appellant during the opposition proceedings (cf. impugned decision, page 4, paragraph 11.1).

In view of this possible construction, the board is not convinced that, in the present context, it would be immediately obvious to the skilled person that the references to the parameter of cyclic compression and to the DIN 53517 standard are necessarily mutually incompatible and that in this regard an error is present in claim 1 as granted.

2.5 Even assuming, in the appellant's favour, that this were indeed the case, the correction thereof would not be immediately evident (cf. condition (ii) above).

2.5.1 According to the appellant, the skilled person could consider three possible corrections:

(a) DIN 53517 is the correct reference for measuring the compression as a static parameter.

(b) The claimed compression is cyclic and measured according the test specified in paragraph [0020] of the patent.

(c) The claimed parameter of cyclic compression is measured using a test based on DIN 53517 but modified according to paragraph [0020] of the patent.

It was submitted that the patent in suit is directed to an under-packing for a blanket cylinder in printing presses, i.e. an application in which the under-packing is subjected to a large number of very short compression/relaxation cycles. The skilled person would immediately exclude option (a) since the DIN 53517 standard relates to a test for the behaviour of material when submitted to compression over a long period of time and thus could not provide useful information with respect to the suitability of a material as an under-packing. Also option (c) would have to be eliminated as technically illogical since the DIN 53517 standard has no overlap with the test proposed in paragraph [0020] of the patent. Consequently, it would be immediately obvious that the only sensible correction of the mistake is option (b), consisting in the replacement of the reference to DIN 53517.

2.5.2 The board does not share the appellant's point of view that the correction proposed under (b) is obvious in the sense that it is immediately evident that nothing else could have been intended.

First, it is observed that in its letter dated 8 April 2014 the appellant itself proposed solution (a) as the correct one. It was emphasised that the compression set was the material property relevant for the subject-matter claimed. Thus, the reference to

DIN 53517 was suggested as being correct, while the term "cyclic" was wrong and had to be deleted.

Second, for the reasons presented in paragraph 2.4 above, the board is not convinced that the skilled person would immediately exclude option (c) as technically illogical.

Although the skilled person could indeed consider option (b) as a possible solution, it is not immediately evident that nothing else was intended when the documents of the patent in suit were drafted. Condition (ii) as set out above is hence not fulfilled either.

It is concluded that the requirements of Rule 139, second sentence, EPC are not complied with.

- 2.6 Beyond that, the proposed amendment is not allowable under the provisions of Article 123(2) EPC, since the skilled person would not recognise the reference to DIN 53517 in the patent application forming the basis of the patent in suit as either obviously erroneous or optional. Rather, its deletion would alter the skilled person's understanding of the test conditions for establishing the parameter of cyclic compression so that he would be confronted with information which was not directly and unambiguously derivable from that previously presented by the application. Following established case law of the Boards of Appeal, such an amendment is to be regarded as introducing subject-matter which extends beyond the content of the application as filed and hence as unallowable under the provisions of Article 123(2) EPC (cf. Case Law of the Boards of Appeal of the European Patent Office, 7<sup>th</sup> edition, 2013, chapter II.E.1).

2.7 Moreover, the reference to DIN 53517 was present in the only independent claim as granted and, for the reasons set out in paragraph 2.4, limited the subject-matter claimed as understood by a person skilled in the art. Its deletion would therefore extend the protection conferred by the patent, contrary to the requirements of Article 123(3) EPC.

3. *Auxiliary request - Amendments*

The reasoning given for the main request also applies to claim 1 of the auxiliary request, which consequently does not meet the requirements of Rule 139, second sentence, EPC and of Article 123(2) and (3) EPC.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated