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**Datasheet for the decision
of 9 July 2019**

Case Number: T 1023/15 - 3.2.05

Application Number: 09290092.7

Publication Number: 2095968

IPC: B41J11/00

Language of the proceedings: EN

Title of invention:

Ultraviolet curing-type inkjet printer and printing method used
in Ultraviolet curing-type inkjet printer

Patent Proprietor:

Mimaki Engineering Co., Ltd.

Opponent:

Sagittarius Intellectual Property Consultants Ltd

Relevant legal provisions:

RPBA Art. 13(1), 13(3)

Keyword:

Admissibility of the appellant's requests (no)



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Case Number: T 1023/15 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 9 July 2019

Appellant: Mimaki Engineering Co., Ltd.
(Patent Proprietor) 2182-3, Sigeno-Otsu, Shigeno
Tomi-shi,
Nagano 389-0512 (JP)

Representative: Fédit-Loriot
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Respondent: Sagittarius Intellectual Property Consultants
(Opponent) Ltd
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Representative: Andrew John Teuten
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 4 March 2015
revoking European patent No. 2095968 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. Poock
Members: O. Randl
 D. Rogers

Summary of Facts and Submissions

I. The patent proprietor filed an appeal against the decision of the opposition division to revoke European patent No. 2 095 968.

The opposition division was of the opinion that the main request did not comply with Article 123(2) EPC and that the subject-matter of auxiliary requests 1 to 4 did not involve an inventive step over the state of the art.

II. The notice of appeal was signed by two representatives, Ms Takeuchi and Mr Uchida.

III. On 11 May 2018, the board summoned the parties to oral proceedings to be held on 2 August 2018.

IV. By letter dated 17 May 2018, Ms Takeuchi requested a postponement of the oral proceedings. The request was motivated by the fact that the scheduled day was in the midst of the French school holidays and that the time left was insufficient to translate and convey a forthcoming preliminary communication to the Japanese patent proprietor.

V. The board then cancelled the oral proceedings.

VI. On 29 May 2018 the board issued a communication pursuant to Rule 100(2) EPC. Point 7 of this communication read as follows:

"The oral proceedings that were to be held on 2 August 2018 have been postponed at the appellant's request. Considering the present

workload and schedule of the board, the oral proceedings before the board will most likely not take place before mid-2019. The parties will be summoned in due time. The board intends not to send any further communication before the oral proceedings."

Page 1 of the communication contained the following statement:

"Any reply to the communication sent herewith must be filed within a period of **4 months**."

This time limit expired on 8 October 2018. Only the respondent reacted within the 4-month period.

- VII. On 19 July 2018 the board summoned the parties to oral proceedings to be held on 9 July 2019.
- VIII. By letter dated 31 May 2019 Mr Uchida filed a new main request and new auxiliary requests 1 to 3 replacing the requests on file. He also informed the board that Ms Takeuchi had left the law firm in February 2019 and that he himself would replace his former colleague as the appellant's representative.

The letter also contains the following statement:

"Please accept our apologies for any inconvenience caused by somewhat late submission herewith, as it was not decided until mid-May as to whether or not Ms TAKEUCHI represents the patentee with her new firm."

- IX. The oral proceedings before the board took place on 9 July 2019.

X. The appellant (patent proprietor) requested that the board set aside the decision under appeal and maintain the patent upon the basis of the main request, or alternatively upon the basis of one of auxiliary requests 1 to 3, all filed under cover of a letter dated 31 May 2019, or further upon the basis of the main request, or alternatively upon the basis of one of auxiliary requests 1 to 3, all filed with the statement of grounds of appeal.

XI. The respondent (opponent) requested that the board dismiss the appeal.

XII. The appellant argued as follows:

(a) Admissibility of the requests filed on 31 May 2019

The appellant's representative declared that he was not aware of the four-month time limit. He had no excuse to offer. Things had been complicated by the departure of Ms Takeuchi from the law firm in January 2019. At that time the appellant had not yet decided who would represent them.

When asked by the board whether the law firm had received the communication, the representative explained that if Ms Takeuchi had received something, she must have informed him. He did not ask her, because normally it was always possible to file new requests one month before oral proceedings. He had no doubt about this and Ms Takeuchi had not informed him otherwise. He added that Ms Takeuchi's new place of employment was near Toulouse and thus far away from Paris, which had complicated their communication.

When the board pointed out that the contents of the appellant's letter dated 31 May 2019 showed that the law firm must have received the communication, the representative explained that the communication had been received, but that he was not aware of any time limit set by it. When the board referred him to the cover page, the representative agreed that he must have been aware of the time limit.

(b) Admissibility of the requests filed during the oral proceedings

After the board had decided that the requests filed on 31 May 2019 could not be admitted, the appellant declared his intention to revert to the requests filed together with the statement of grounds of appeal, which had been replaced by the requests filed on 31 May 2019. He therefore asked the board to readmit those requests.

The appellant pointed out that it would be very harsh not to readmit the requests. An error had occurred, but it should be possible to revert to the requests on file before. There is nothing new to be discussed. It would be fair ("équitable") to admit those requests, in particular because the patent had merit, which should take precedence over procedural matters.

When asked by the board whether the objections under Rule 80 EPC expressed in the board's communication were well founded, the representative explained that he did not know, because there were quite a few shortcomings ("pas mal de défauts"). He then referred to auxiliary request 2 filed

on 31 May 2019 and pointed out that it was exactly the same as auxiliary request 1 filed together with the statement of grounds of appeal. As a consequence, the respondent must have been prepared to discuss this request.

XIII. The respondent argued as follows:

(a) Admissibility of the requests filed on 31 May 2019

The respondent requested that the board should not admit the requests, for the following reasons:

(1) The communication of the board pursuant to Rule 100(2) EPC of 29 May 2018 set out a clear deadline of 4 months for reply. The appellant chose to make no reply at all within the set deadline.

(2) The appellant's reference in the submission of 31 May 2019 to "Ms TAKEUCHI having left our firm in February" is entirely irrelevant. The 4-month deadline for reply was due months before the departure of Ms Takeuchi from the firm. Additionally, the submission is signed by Mr Uchida who co-signed the notice of appeal.

(3) The proposed amendments to claim 1 of the main request are complex and do not respond at all to points raised in the summons. Such amendments are inadmissible for reasons of procedural economy under Art 13(1) RPBA. In addition, new legal issues (related to Articles 84, 123(2) and (3) EPC and Rule 80 EPC) are raised by the proposed amendments, which it is unfair to expect the respondent to respond to at such a late stage before oral proceedings (Art 13(3) RPBA).

(4) The proposed amendment to delete the last 3 lines of the new auxiliary request 1 does not correct an obvious error as the appellant claims. The alleged correction would not be immediately obvious to the skilled person. In addition, such an amendment is not occasioned by a ground for opposition and thus contravenes Rule 80 EPC.

The respondent noted that much of the discussion was about a particular individual in the law firm representing the appellant. It was up to the firm to deal efficiently with communications setting deadlines and to have effective working practices. Therefore, the firm was responsible for this and not the individuals employed by the firm.

(b) Admissibility of the requests filed during the oral proceedings

The respondent objected to the readmission of the requests originally submitted with the statement of grounds of appeal. Parties have the right to know which requests they are going to be addressing when turning up at oral proceedings. The original requests had been withdrawn and replaced by new requests. The respondent had prepared for the new requests. It would be unfair to revert to the earlier requests.

When asked by the board why the readmission of the requests would be problematic, the respondent explained that the last amendments must have had some legal substance because otherwise they would not have been filed. In particular, the main request had been reformulated in view of novelty.

Thus, the amendments are clearly substantial. Also, as mentioned in the board's communication, the original requests had issues related to Rule 80 EPC. There were explicit reasons why those claims would not be allowable. If those claims are readmitted, there will need to be further requests. Thus, in terms of the efficiency of procedure, this is not a good way to go.

When asked by the board how the respondent had prepared for the possible situation that the board would refuse the admission of the requests filed on 31 May 2019, the respondent declared that they considered it unfair to have to prepare for requests that are not on file and that they had not prepared for any such requests.

Reasons for the Decision

1. Admissibility of the requests filed on 31 May 2019

Those requests were filed more than seven months after the expiration of the time limit set by the board in its communication pursuant to Rule 100(2) EPC.

The appellant's representative confirmed that the law firm representing the appellant had received the communication. That it had actually been received can also be seen from the fact that the appellant repeatedly referred to it in its letter dated 31 May 2019 (see point 1, second paragraph, and point 5).

The appellant's representative explained that he was not aware of any time limit. This is hardly relevant because at the time the communication was received by the law firm, and even at the end of the time limit set by the board, Ms Takeuchi was still employed by the firm and in charge of the file. The fact that she did not inform her colleague is a matter that relates to the internal organisation of the law firm and is irrelevant in the present case. Also, the fact that Ms Takeuchi left the law firm in January or February 2019 and that subsequently the communication between her and her former employer had become more complicated because of the geographical distance is without relevance because the time limit had already expired in October 2018.

In summary, none of the reasons given by the appellant as to why the time limit was missed were found convincing.

As a consequence, the requests filed on 31 May 2019 cannot be admitted into the appeal proceedings. The board therefore used its discretion under Articles 13(1) of the Rules of proceedings of the boards of appeal (RPBA) and decided not to admit those requests.

2. Admissibility of the requests filed during the oral proceedings

In its communication pursuant to Rule 100(2) EPC the board expressed its provisional opinion that neither the main request nor auxiliary request 1 complied with the requirements of Rule 80 EPC (see point 6). Although this was not explicitly stated, this objection also applies to auxiliary requests 2 and 3. That this was

understood by the appellant can be seen from the fact that all the requests filed on 31 May 2019 were amended accordingly.

The board maintains its objections under Rule 80 EPC. As a consequence, all of the requests originally filed with the statement of grounds of appeal are *prima facie* unallowable and cannot, therefore, be (re)admitted.

Admitting those requests and then allowing the appellant to amend them in order to overcome the Rule 80 EPC objections would be tantamount to admitting the requests filed on 31 May 2019, which the board has already decided not to admit (see point 1.).

The appellant's objection that the consequences of a refusal to readmit those requests would be harsh towards the appellant is not acceptable because this consequence was brought about by the appellant's own behaviour, i.e. their failure to respect the time limit set in the board's communication.

As a consequence, the requests originally filed with the statement of grounds of appeal and which were withdrawn by letter dated 31 May 2019 cannot be readmitted into the appeal proceedings. The board therefore decided not to admit those requests (Articles 13(1) and (3) RPBA).

3. Conclusion

As none of the requests filed by the appellant are admissible, the appeal has to fail.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



N. Schneider

M. Poock

Decision electronically authenticated