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Datasheet for the decision of 23 March 2017

Case Number: T 2031/15 - 3.3.09

Application Number: 09161047.7

Publication Number: 2128704

IPC: G03F7/32

Language of the proceedings: EN

Title of invention:
Processing liquid for lithographic printing plate development and method of producing lithographic printing plates

Patent Proprietor:
FUJIFILM Corporation

Opponent:
Agfa Graphics NV (opposition withdrawn)

Headword:

Relevant legal provisions:
EPC Art. 56

Keyword:
Main request and new first auxiliary request: inventive step (no)
Remaining auxiliary requests: not admitted

Decisions cited:

Catchword:

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Case Number: T 2031/15 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 23 March 2017

Appellant: (Patent Proprietor)	FUJIFILM Corporation 26-30, Nishiazabu 2-chome Minato-ku Tokyo 106-8620 (JP)
Representative:	Grünecker Patent- und Rechtsanwälte PartG mbB Leopoldstraße 4 80802 München (DE)
Respondent: (Opponent)	Agfa Graphics NV Septestraat 27 2640 Mortsel (BE)
Representative:	Goedeweeck, Rudi Agfa Graphics N.V. IP Department 3622 Septestraat 27 2640 Mortsel (BE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 6 August 2015 revoking European patent No. 2128704 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman W. Sieber
Members: N. Perakis
E. Kossonakou

Summary of Facts and Submissions

I. This decision concerns the appeal filed by the patent proprietor against the decision of the opposition division to revoke European patent No. 2 128 704.

The documents cited during the opposition proceedings included:

D4: GB 2 226 150 A,
D8: US 5 155 012 A, and
D9: EP 1 916 568 A2.

Both D8 and D9 were late-filed documents, but admitted into the proceedings in view of their *prima facie* relevance.

The opposition division held *inter alia* that claim 1 of auxiliary request 6 (main request in the present appeal) did not involve an inventive step starting from D9 as the closest prior art in combination with D4 or D8.

II. Independent product claim 1 of auxiliary request 6 reads as follows:

"1. A processing liquid for lithographic printing plate development, comprising (1) a water-soluble amine compound and an ion of the amine compound and (2) a water-soluble polymer compound and a surfactant,

wherein the pH of the processing liquid is 9.2 to 10.8,

wherein the water-soluble polymer compound is selected from soy polysaccharides, modified starches, gum

arabic, dextrin, carboxymethyl cellulose and polyvinyl alcohol; and

wherein the surfactant is a nonionic or cationic surfactant; and

wherein said water-soluble amine compound is

(1-1) an amino acid and the ion of this amine compound is an ion of the acid present in the amino acid, said amino acid being selected from the group consisting of glycine, iminodiacetic acid, lysine, threonine, serine, aspartic acid, parahydroxyphenylglycine, dihydroxyethylglycine, alanine, anthranilic acid and tryptophan;

(1-2) an aliphatic amine sulfonic acid selected from the group consisting of sulfamic acid, cyclohexylsulfamic acid and taurine;

(1-3) an aliphatic amine sulfinic acid being aminoethanesulfinic acid;

(1-4) an amine compound having a phosphonic acid group selected from the group consisting of 2-aminoethylphosphonic acid, 1-aminoethane-1,1-diphosphonic acid, 1-amino-1-phenylmethane-1,1-diphosphonic acid, 1-dimethylaminoethane1,1-diphosphonic acid and ethylenediaminopentamethylenephosphonic acid; or

(1-5) an alkylamine having the hydroxyl group in the alkyl moiety and the ion of this amine compound is the ammonium ion, said alkylamine being selected from the group consisting of monoethanolamine, diethanolamine,

trimethanolamine, triethanolamine, tripropanolamine and triisopropanolamine."

Independent claim 3 relates to a method of producing a lithographic printing plate comprising the step of developing the printing plate precursor with the processing liquid according to claim 1 or 2.

III. On 14 October 2015 the patent proprietor (in the following the appellant) filed a notice of appeal against the opposition division's decision. The statement setting out the grounds of appeal was filed on 16 December 2015 including a main request (corresponding to auxiliary request 6 of the decision under appeal) and ten auxiliary requests (1, 2, 3, 3B, 4, 4B, 5, 6, 7, 7B).

The claims of the ten auxiliary requests were limited to a method of producing a lithographic printing plate, whereby the amendments in these requests were directed to features defining the developing processing liquid. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims of the main request or of any of the auxiliary requests.

IV. With letter of 5 April 2016, the opponent withdrew its opposition against the patent in suit. Thus, it is no longer a party to the proceedings.

V. The board issued a communication on 26 January 2017 in preparation for the oral proceedings. It pointed out that the only issue to be discussed during the oral proceedings regarding the main request was inventive step. In this context, it had not been shown that the claimed subject-matter provided a technical effect over

the closest prior art, namely D9. Regarding the auxiliary requests, the board remarked that their subject-matter diverged from that of the main request.

VI. With letter of 23 February 2017, the appellant filed additional arguments and a further request headed "New First Auxiliary Request". Claim 1 of this new first auxiliary request differed from claim 1 of the main request only in that the water-soluble amine compound was limited to alternative (1-1).

VII. Oral proceedings were held on 23 March 2017 during which the issue of inventive step of the main and the new first auxiliary request and the admissibility of the other auxiliary requests filed with the statement setting out the grounds of appeal were discussed.

VIII. The relevant arguments put forward by the appellant in its written submissions and during the oral proceedings may be summarised as follows:

- D9 was the closest prior-art document which did disclose water-soluble amine compounds but not those of claim 1 of any of the appellant's requests. The technical effect of this difference was excellent printing durability. This was derivable from the technical evidence of the patent despite the absence of a direct comparison with the amine compounds of D9. Since none of the prior-art documents disclosed or suggested excellent printing durability, both immediately after production and even after storage, and almost no decline in printing durability during storage, the claimed invention involved an inventive step.

- The filing of the auxiliary requests with the grounds of appeal was occasioned by the late filing of D8 and D9 during opposition proceedings and was associated with the uncertainty in relation to the position to be taken by the opposition division in connection with the question of admissibility of the documents and evaluation of the prior art (if admitted). It was not possible for the appellant (the then patentee) to foresee all possible outcomes and to prepare and file auxiliary requests in this regard during the opposition proceedings. Adding such auxiliary requests with the substantiation of the appeal was well within the practice of appeal proceedings before the EPO.

- A converging line of defense and argument was present in the ten auxiliary requests submitted with the grounds of appeal, which focused on the method as already present in the claim sets discussed before the opposition division and as contained in the claim set according to the main request forming the basis of the present appeal proceedings.

IX. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims of the main request filed with the statement setting out the grounds of appeal (corresponding to the sixth auxiliary request before the opposition division), or the new first auxiliary request filed with letter of 23 February 2017 or of any of the ten auxiliary requests filed with the statement setting out the grounds of appeal.

Reasons for the Decision

1. Main request

1.1 The opposition division held that the subject-matter of claim 1 of the sixth auxiliary request, which corresponds to the main request in the present appeal, lacked inventive step starting from D9 as the closest prior art in combination with either D4 or D8.

1.2 The board agrees with the opposition division that D9 is the closest prior-art document. This was not contested by the applicant.

1.3 D9 discloses a developing solution for lithographic printing plates and a production method for such plates (paragraph [0001]). The term "developing solution for lithographic printing plates" disclosed in D9 is synonymous with the term "processing liquid for lithographic printing plate development" as used in claim 1.

The developing solution of D9 contains at least one of three compounds represented by specific formulas as a specific surfactant, so that the development can be performed with an aqueous solution at a pH of 2 to 10, without deterioration due to carbonic acid gas, and a lithographic printing plate having a constant quality can be produced (paragraph [0014]). Representative examples of suitable compounds/surfactants include amino acids in their ionic form (paragraph [0019]). Formula (I) of this paragraph encompasses N-methylglycine, which is a derivative of glycine, a compound explicitly mentioned in group (1-1) of claim 1. Thus, the appellant's argument that the

subject-matter of claim 1 of the main request at least differs from the developing solution of D9 by the additional presence of an amine compound is not correct.

The developing solution can also contain a water-soluble polymer, such as soybean polysaccharide, modified starch, gum arabic, dextrin, a cellulosic derivative such as carboxymethyl cellulose and polyvinyl alcohol (paragraphs [0051] and [0052]).

Thus the claimed processing liquid differs from that of D9 in that (i) a different amino acid is used, and (ii) an additional nonionic or cationic surfactant is present.

1.4 The appellant argued that the technical problem was the provision of a processing liquid for lithographic printing plate development which enabled excellent printing durability. In this context it relied on process liquid 27 (paragraph [0293] of the patent in suit), the only exemplified processing liquid remaining within the scope of claim 1. Process liquid 27 has a pH of 9.5 and comprises:

- a nonionic surfactant which is Newcol B13 (Nippon Nyukazai Co. Ltd.),

- a water-soluble polymer which is hydroxyalkylated starch (Penon JE66 from Nippon Starch Chemical Co., Ltd.) and

- an amino acid which is glycine.

The appellant also referred to table 3, where *inter alia* process liquid 27 was evaluated. It provided

excellent printing durability of a lithographic printing plate immediately after production and after one week.

1.5 The board notes, however, that neither the patent in suit nor the file contains any comparative data taking into account a processing liquid according to D9.

Moreover, the examples in the patent cannot demonstrate any particular technical effect over D9 due to the use of the specific amino compounds, in particular the amino acids of alternative (1-1), either alone or in combination with an additional nonionic or cationic surfactant. On the contrary, a comparison of example 5 (process liquid 5) with example 43 (process liquid 27), where the sole difference lies in the use of an anionic surfactant (process liquid 5) instead of a nonionic one (process liquid 27), shows that the surfactant has no impact on the printing durability.

1.6 Since no technical evidence has ever been filed substantiating any technical effect resulting from the specific amino acid, either alone or in combination with the (additional) specific surfactant required in claim 1, the technical problem has to be redefined in a less ambitious manner. Thus, the objective problem is the provision of an alternative processing liquid for lithographic printing plate development.

1.7 The skilled person starting from the developing liquid of D9 and looking for an alternative developing liquid would have consulted D8.

This document also concerns a developing liquid which is suitable for developing negative-working exposed reproduction layers in copying materials without

precipitate formation, phase separation or turbidity formation, which develops rapidly and has ideal development properties (good resolution of the non-image areas and non-attack of the image areas), which does not develop flake and filament formation and which can be used even over a prolonged period of time (column 1, lines 9-14; column 2, lines 33-55). More specifically, the developing liquid of D8 has a pH in the range of 8 to 12. It combines a surfactant, which is anionic, a water-soluble polymer, which is preferably carboxymethylcellulose, and an amino acid, which is glycine, with its metallic anion, the last two creating a buffering system stabilising the pH (column 2, line 63 to column 3, line 5; column 3, line 56 to column 4, line 6; column 3, lines 20-26 and 45-47).

Thus the skilled person would see glycine as a possible alternative for the amine compounds of D9, in particular the amino acids, in view of its close structural relationship with one of the compounds encompassed by one of the formulas of D9.

Furthermore, D9 already suggests the presence of more than one surfactant ("at least one of"), and no particular effect can be attributed to the additional presence of a nonionic or cationic surfactant. In this context the board notes that claim 1 as granted did not further specify the surfactant, it merely referred to "a surfactant"; all types of surfactants were considered suitable, even the anionic surfactant used in D8. As pointed out above, this is supported by the examples in the patent which show that the type of surfactant has no influence on printing performance. Therefore, the selection of a nonionic or cationic surfactant, the amount of which is not indicated in the

claim, is considered to be arbitrary and cannot contribute to inventive step.

1.8 In view of the above, the board comes to the same conclusion as the opposition division, namely that the subject-matter of claim 1 of the main request does not involve an inventive step. Therefore this request is not allowable.

2. New auxiliary request 1 (filed on 23 February 2017)

Compared with claim 1 of the main request, claim 1 of new auxiliary request 1 is limited to alternative (1-1) for the water-soluble amine compound. However, it has already been shown for the main request that one member of this alternative, namely glycine, is disclosed in D8.

Thus, the reasoning provided above for the subject-matter of claim 1 of the main request also applies to the subject-matter of claim 1 of new auxiliary request 1. This request is therefore also not allowable.

3. Remaining auxiliary requests (1, 2, 3, 3B, 4, 4B, 5, 6, 7, 7B filed with the statement setting out the grounds of appeal)

All ten remaining auxiliary requests contain claims exclusively relating to a method of producing a lithographic printing plate which comprises two steps:

- image-wise photo-exposing a negative-working lithographic printing plate precursor, and

- developing the image-wise photo-exposed negative-working lithographic printing place precursor with a processing liquid.

In contrast to the independent process claim of the main request, i.e. claim 3 referring back to the process liquid of claim 1, the processing liquid used in the method of claim 1 of all remaining auxiliary requests no longer has to contain a nonionic or cationic surfactant, it merely requires the presence of a surfactant. Thus, these requests diverge from the main and the new first auxiliary request, which focus on the combination of the amine compound and a particular type of (additional) surfactant.

The appellant has always argued inventive step on the combination of these features. With the remaining requests, the appellant has shifted its case in a different direction and in fact created a fresh case.

In the present case, the board sees no reason why the new line of requests directed to a method and a broad definition of the surfactant should be dealt with for the first time in appeal. Nor has the appellant provided a convincing argument in this respect. In fact, these requests could and should have been filed already during the opposition procedure.

In view of the above, the board holds the remaining ten auxiliary requests, filed with the statement setting out the grounds of appeal, inadmissible (Article 12(4) RPBA).

4. It follows from the preceding conclusions that there is no allowable request on file.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

M. Cañueto Carbajo W. Sieber

Decision electronically authenticated