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**Datasheet for the decision
of 7 April 2022**

Case Number: T 1008/18 - 3.2.05

Application Number: 07864674.2

Publication Number: 2089234

IPC: B41J2/205

Language of the proceedings: EN

Title of invention:

Digital printing plastic containers

Patent Proprietor:

Plastipak Packaging, Inc.

Opponents:

Heidelberger Druckmaschinen AG
AGFA NV
KHS GmbH
Krones AG
ITW Morlock GmbH

Relevant legal provisions:

EPC Art. 123(2)
RPBA Art. 12(4)
RPBA 2020 Art. 25(2)

Keyword:

Admittance of the main request and auxiliary requests 1B, 11 and 12 (yes)

Admittance of objection under Article 123(2) EPC (yes)

Added subject-matter (yes: main request and auxiliary requests 1B, 11, 12)

Decisions cited:

G 0009/91, G 0010/91, G 0002/10



Beschwerdekammern

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Case Number: T 1008/18 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 7 April 2022

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
6 April 2018 concerning maintenance of the
European Patent No. 2089234 in amended form.**

Composition of the Board:

Chairman P. Lanz
Members: B. Spitzer
T. Karamanli

Summary of Facts and Submissions

- I. The patent proprietor and opponents 3 and 4 lodged an appeal against the interlocutory decision of the opposition division finding that European patent No. 2 089 234 as amended according to auxiliary request 4, filed during the oral proceedings on 8 February 2018, meets the requirements of the EPC. The opposed patent is based on an international application published as WO 2008/064248 A2.
- II. The oppositions were filed against the patent as a whole on the basis of the grounds for opposition under Article 100(a) together with Articles 54 and 56 EPC (lack of novelty and lack of inventive step), Article 100(b) EPC and Article 100(c) EPC.
- III. The opposition division concluded that the subject-matter of claim 1 of the patent as granted extended beyond the content of the application as originally filed, that the claims of auxiliary request 1 as filed during the oral proceedings were not clear and that the subject-matter of claim 1 of auxiliary request 2 as filed during the oral proceedings did not involve an inventive step. Auxiliary request 3 was not admitted. Auxiliary request 4 was found to meet the requirements of the EPC.
- IV. By letter dated 28 August 2020 opponent 3 withdrew its appeal.
- V. In a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal in the 2020 version (RPBA 2020, see OJ EPO 2021, A35), issued on 10 March 2022, the parties were informed of the board's

provisional opinion.

VI. Oral proceedings before the board were held on 7 April 2022 by mixed mode in the absence of duly summoned opponents 1, 3 and 6.

VII. *Requests*

Appellant I (patent proprietor) requested as main request that the board decide only on added subject-matter (Article 123(2) EPC) with regard to the claims of the main request as filed with its statement of grounds of appeal and remit the case to the first-instance department for the discussion on novelty and inventive step. Alternatively, it requested that the decision under appeal be set aside and that the European patent be maintained as amended on the basis of the claims of the main request as filed with its statement of grounds of appeal (auxiliary request 0) or on the basis of the claims of one of auxiliary requests 1B, 11 and 12, all filed with its statement of grounds of appeal.

Appellant II (opponent 4), respondent II (opponent 2) and respondent III (opponent 3) requested that the decision under appeal be set aside and that the European patent be revoked.

Respondent I (opponent 1) filed no requests in the appeal proceedings.

Respondent IV (opponent 6) requested that the patent proprietor's appeal be dismissed.

VIII. Claims 1 and 12 of the main request as filed with the patent proprietor's statement of grounds of appeal correspond to claims 1 and 12 as granted with the amendment in claim 12 that the "base coat (90) is digitally printed on the container". These claims have the following wording:

"1. A plastic container comprising a container (10) having a non-planar external surface (20) characterized in that the container includes a base coat, which is a digitally printed base coat and wherein a digital image is printed on at least a portion of the base coat, the digital image being printed thereon by droplets of ink (30), wherein the ink droplets (30), which form the digital image, vary in diameter from 10 to 200 microns and wherein the droplets of ink (30) range from 200 to 1200 drops per inch."

"12. A method (40) for printing digital images on plastic containers (10), comprising: providing a hollow plastic container (10) having a non-planar external surface (20); moving the container (10) along a track past a digital printing location (50) having a plurality of movable print heads (60) that provide droplets of ink (30), characterized by including the step of applying a base coat (90) on the container (10) prior to printing the digital image, wherein the digital image is provided on at least a portion of the base coat (90), wherein the base coat (90) is digitally printed on the container (10), wherein the droplets of ink (30), which form the digital image, have a diameter from 10 to 200 microns and the droplets of ink ranging from 200 to 1200 drops per inch; and printing a digital image on the non-planar container surface (20) by applying the droplets of ink (30) to the base coat (90)

on the container surface (20)."

- IX. In comparison with the main request, in claim 1 of auxiliary request 1B, the feature "*is printed on at least a portion of the base coat*" is amended to "*is printed entirely on the base coat*", and the respective feature of the method claim 11 "*the digital image is provided on at least a portion of the base coat*" is amended to "*the digital image is provided entirely on the base coat*". Claim 1 of auxiliary request 1B corresponds to claim 1 of auxiliary request 1 as filed during the first-instance oral proceedings. Method claim 11 of auxiliary request 1B corresponds to claim 1 of auxiliary request 4 on which the decision under appeal was based.
- X. Claim 1 of auxiliary request 11 corresponds to method claim 12 of the main request as filed with the patent proprietor's statement of grounds of appeal.
- XI. Claim 1 of auxiliary request 12 corresponds to claim 1 of auxiliary request 4 on which the decision under appeal was based and to method claim 11 of auxiliary request 1B.
- XII. The parties' submissions may be summarised as set out below.

Main request as filed with the patent proprietor's statement of grounds of appeal, auxiliary requests 1B and 11: Admittance

- *Patent proprietor*

All requests should be admitted into the proceedings as they were filed within the time limit under

Article 12(1) RPBA 2007. Some requests were filed in response to the decision of the opposition division not to allow the claims directed to a container, and other requests were filed in response to the appeals of the other appellants.

Claim 1 of auxiliary request 1B corresponded to claim 1 of auxiliary request 1 as filed during the first-instance oral proceedings and apart from that contained only minor amendments. Thus, it should be admitted under Article 12(4) RPBA 2007.

- *Opponent 3*

The main request and all auxiliary requests should not be admitted into the proceedings since they could and should have been filed during the opposition proceedings. The patent proprietor had several opportunities to file new requests. By filing amended requests, the principle of an appeal primarily serving the parties' right to a judicial review of the first-instance decision was violated (see decisions G 9/91 and G 10/91 (OJ EPO 1993, 408 and 420)). Furthermore, the auxiliary requests were not convergent, and the patent proprietor did not provide arguments for filing the amendments.

- *Opponents 2 and 4*

Auxiliary requests 1B and 11 should not be admitted into the proceedings as they could and should have been filed in the opposition proceedings. For admittance, it was not relevant whether there were only minor amendments. Furthermore, as the subject-matter of claim 1 of auxiliary request 11 was broader than the subject-matter of claim 1 of auxiliary request 12, auxiliary

request 11 was not convergent and, hence, should not be admitted. No new arguments or documents were raised during the first-instance oral proceedings which could justify the late-filing.

Main request as filed with the patent proprietor's statement of grounds of appeal: Allowability of amendments under Article 123(2) EPC

- *Patent proprietor*

Claims 14 to 16 as originally filed provided a literal basis for the features "*base coat*", "*a digitally printed base coat*" and "*the digital image is printed on at least a portion of the base coat*", respectively. Due to their dependencies, there was clear and unambiguous disclosure of claims 1, 14 and 15 in combination and of claims 1, 14 and 16 in combination.

The person skilled in the art was not a patent attorney but a technician who considered the disclosed technology. The person skilled in the art could directly and unambiguously derive, using common general knowledge, from the application as a whole that the base coat of a container specified by the combination of claims 1, 14 and 16 might be a digitally printed base coat. Also, the reverse argument was possible to demonstrate direct and unambiguous disclosure. By applying common general knowledge, the person skilled in the art would print the digital image on a digitally printed base coat as specified by the combination of claims 1, 14 and 15. Even opponent 4 admitted that it was illogical not to print the digital image on a base coat (see opponent 4's letter dated 28 December 2018, page 29).

Moreover, the person skilled in the art could directly and unambiguously derive, using common general

knowledge, from the published application (WO 2008/064248 A2) as a whole, especially from page 6, lines 16 to 19, that the base coat of a container specified by the combination of claims 1, 14 and 15 was printed on at least a portion of the digitally printed base coat. Since claim 1 as originally filed disclosed the ink droplet diameter and resolution ranges for a digital image on an external surface of the container, these ranges were also disclosed for a digital image printed on the base coat (see claim 17 as originally filed). It was the same image irrespective of whether it was printed on a base coat or a digitally printed base coat. The digital image necessarily had the same dot size and resolution. These parameters applied for all cases, for direct printing on the surface of the container and for printing on a base coat or a digitally printed base coat.

Furthermore, the ink droplet diameter and resolution ranges were disclosed in the paragraph titled "Summary" on page 1 of the published application. This paragraph indicated the core of the invention, including the preferred embodiments, i.e. the ink droplet diameter and resolution ranges for a digital image on the container surface or a base coat. These ranges were consequently also disclosed for a digitally printed base coat as disclosed on page 6, lines 16 to 18 of the published application. The third paragraph on page 3 of the published application described the ink droplet diameter and resolution of the digital image, thus also for a digital image provided on the base coat. A further indication that the ink droplet diameter and resolution ranges also applied for a digitally printed base coat was the "*droplet application system 40*" (see Figure 3 and the fourth paragraph of page 3 of the published application). The person skilled in the art

derived from this passage that the "*droplet application system 40*" was made for applying ink droplets in the claimed ranges. The same system was also used for printing an image on a digitally printed base coat (see page 6, lines 8 to 23 of the published application). According to the patent proprietor, the person skilled in the art would read the description as originally filed such that printing the base coat digitally or not was an additional degree of freedom independent of how the image was printed. Therefore, the digital printing of the base coat was a general option. Reference was made to page 6, lines 8 to 23 and Figure 6 of the published application where a base coat was disclosed and "*if desired*" all or a portion of the base coat might be digitally printed (see claim 15 as originally filed). Lines 18 to 19 of this passage on page 6 explained that "*one or more digital images are printed entirely on the base coat*" (see claim 17 of the published application). "*Further, for some applications, a portion of the base coat and/or a portion of the surface of the container may form a portion of the digital image*" (see published application, page 6, lines 19 to 20). In contrast, in response to the opponents' allegation, these were not non-conflicting embodiments but were clearly related embodiments.

Thus, there was a clear basis for the combined subject-matter of claims 1, 14, 15 and 17. Claim 16 as originally filed ("*the digital image is printed on at least a portion of the base coat*") was a broader version of claim 17 as originally filed ("*the entire digital image is printed on the base coat*"). As claim 17 as originally filed depended on claim 16 as originally filed, the combination of claims 1, 14 to 17 as originally filed was disclosed. Especially from the teaching on page 6, lines 16 to 20 of the published

application, the person skilled in the art would directly and unambiguously derive that the base coat could be a digitally printed base coat in which a digital image was printed on at least a portion of the base coat.

- *Opponent 3*

In contrast to the opposition division's conclusion (see Reasons point 2.2.2 of the decision under appeal), claims 1, 14 to 16 as originally filed did not form a basis for the combination of a digitally printed base coat (claim 15 as originally filed) in combination with the ink droplet diameter and resolution ranges. Claims 15 and 16 as originally filed depended on claim 14 as originally filed, which in turn depended on claim 1 as originally filed. However, claim 16 as originally filed did not depend on claim 15 as originally filed with the result that a combination of a digital image having the claimed ink droplet diameter and resolution ranges and being printed on a digitally printed base coat was not supported by the claims as originally filed. Contrary to the opinion of the opposition division, there was also no basis in the description or the figures. In the summary of the invention in the published application, the diameter and resolution ranges were given as optional: "may vary" and "may range" (see page 1, last paragraph of the published application). Therefore, these ranges were not directly and unambiguously valid for all embodiments. Figures 1 and 2 of the published application did not comprise a base coat and could not be used as a basis for this amendment. Figure 6 and the ink droplet application system 40 of the published application also did not disclose the combination of a digitally printed base coat and the ranges for the ink droplets. The ink droplet application was disclosed as

an embodiment in the fourth paragraph on page 3 of the published application. It was not related to the preceding paragraph, which disclosed the ranges for the ink droplets. The claimed combination of features was a mixture of features of different embodiments not disclosed as such. There was no clear and unambiguous disclosure that the ink droplets had the same ranges whether a digitally printed base coat was used or whether the surface of the container was directly printed on. On the contrary, the person skilled in the art knew that the kind of substrate had an influence on the diameter of the ink droplets on the surface. Thus, the requirements of Article 123(2) EPC were not met.

The description as originally filed only disclosed that one or more digital images were printed entirely on a base coat (see page 6, lines 16 to 19 of the published application). No embodiment was mentioned where the digital image was partly printed on the base coat. The latter did not make sense for the person skilled in the art.

- *Opponent 6*

It was not disclosed that a digital image was printed on at least a portion of a digitally printed base coat. Claims 14 to 16 as originally filed did not provide a basis for this feature due to their dependencies, as brought forward by opponent 3. Page 6, lines 16 to 20 of the published application also did not disclose this feature because it was clear from page 6, lines 3 to 7 and line 8 that a pre-treatment was necessary. The pre-treatment, however, was not claimed.

- *Opponents 2 and 4*

There was no direct and unambiguous disclosure for a digital image printed on a digitally printed base coat having the claimed diameter and resolution ranges. A combination of claims 1, 14 to 16 might be a non-conflicting option, which, however, was not disclosed as such. The embodiments disclosed on page 6, lines 15 to 20 of the published application were different non-linked embodiments. The embodiment "*all or a portion of the base coat may be digitally printed*" did not mention a digital image. The next embodiment, "*one or more digital images are printed entirely on a base coat*", did not disclose a digitally printed base coat. These different embodiments, even if non-conflicting, did not directly and unambiguously disclose the disputed subject-matter.

On page 6, lines 15 to 16 of the published application, the base coat was stated to improve the application of ink droplets. E.g. an improved wettability of the surface meant that a drop of a particular volume had a lower contact angle and a different size on the surface. Therefore, diameter ranges only hold for the container surface but not for a digitally printed base coat. Page 6, lines 8 to 12 of the published application disclosed a system 40 for the application of a base coat. The allegation that the system was the same as the system 40 on page 3, lines 22 to 30 of the published application did not prove that it was a digitally printed base coat since later on page 6, lines 16 to 18 it was disclosed that all or a portion of the base coat might be digitally printed.

Furthermore, page 6 of the published application did not mention the ink droplet diameter and resolution

ranges. These were only mentioned on pages 1 and 3 of the published application.

The summary of the invention on page 1, lines 19 to 23 of the published application did not disclose a sufficient condition, and the passage on page 3, lines 14 to 21 of the published application disclosed the ink droplet diameter and resolution ranges only for a digital image printed directly on the container surface.

The statement on page 29 of opponent 4's letter dated 28 December 2018 that it was illogical not to print the digital image on a base coat was made in the context of inventive step and did not contribute to the discussion of the disclosure of the patent application.

By making a drawing of the different possibilities of the base coat and the digital image on the surface of the container according to page 6, lines 16 to 23 of the published application, it was demonstrated that there was no disclosure of a digital image printed partly on a digitally printed base coat. The system 40 shown in Figure 3 of the published application was used for the application of ink and not for the base coat.

Auxiliary request 1B: Allowability of amendments under Article 123(2) EPC

- *Patent proprietor*

Claim 1 of auxiliary request 1B disclosed the diameter and resolution ranges for the digital image. As the person skilled in the art would always print the image on the base coat, which was explicitly disclosed in dependent claim 17, the ink droplet diameter and

resolution ranges for a digital image printed on a digitally printed base coat were directly and unambiguously disclosed. This could also be seen from Figure 6 as originally filed.

- *Opponents*

Opponent 3, in its written submissions, referred to the objections raised for the main request (see its letter dated 13 December 2018, point 7.2). According to opponents 2 and 4, claim 17 as originally filed depended on claim 16, which in turn depended on claim 14 but not on claim 15. Therefore, the arguments remained the same as for the main request. Figure 6 of the published application did not show the whole digital image but a transverse section. Also the disclosure on page 6, lines 8 to 23 of the published application could not provide a direct and unambiguous basis for the amendments of claim 1 of auxiliary request 1B.

Auxiliary request 11: Admittance of the objection under Article 123(2) EPC for the method claim

- *Patent proprietor*

The objection under Article 123(2) EPC concerning the combination of claims 1, 14, 15 and 16 as originally filed was only raised for the claim relating to the container but not for the method claim. Opponent 3's general reference in point 4.2 of its reply to the statement of grounds of appeal dated 13 December 2018 to the method claim was an unsubstantiated statement. Moreover, this objection had not been raised in the first-instance proceedings for claim 1 of auxiliary request 4, which corresponded to claim 1 of auxiliary

request 12 in appeal proceedings. Therefore, it should not be admitted under Article 12(4) RPBA 2007 or taken into account in view of Article 12(4) and (2) RPBA 2007.

- *Opponents 2 and 4*

In the first-instance proceedings, the objection under Article 123(2) EPC concerning the combination of claims 1, 14, 15 and 16 as originally filed was discussed for claim 1 as granted (see decision under appeal, Reasons, point 2.2). As the corresponding features were the same for the container claim and the method claim, this objection did not constitute a fresh case.

Concerning the substantiation of this objection, the opponents referred to point 4.2 of opponent 3's reply to the statement of grounds of appeal dated 13 December 2018, where this combination of features was discussed for claim 1 of the main request as filed with the patent proprietor's statement of grounds of appeal. In the last paragraph of this point, opponent 3 mentioned that this objection was also valid for method claim 12 of the main request. Point 7.12 of opponent 3's reply explicitly stated that all objections raised for independent claim 12 of the main request were also valid for auxiliary request 11. It was not necessary to exactly repeat the same arguments.

Thus, this objection had been substantiated and should be admitted.

Auxiliary request 11: Allowability of amendments under Article 123(2) EPC

The parties had no further comments on the objection under Article 123(2) EPC against claim 1 of auxiliary request 11. Reference was made to corresponding objections against claim 1 of the main request as filed with the patent proprietor's statement of grounds of appeal.

Auxiliary request 12: Admittance of the objection under Article 123(2) EPC and allowability of amendments under Article 123(2) EPC

The parties had no further comments on the admittance of the objection under Article 123(2) EPC against claim 1 of auxiliary request 12 and the allowability of this request. Reference was made to the corresponding objections against claim 1 of the main request as filed with the patent proprietor's statement of grounds of appeal.

Reasons for the Decision

1. Main request: Admittance
 - 1.1 The claims of the patent proprietor's main request were filed together with its statement of grounds of appeal before the date of entry into force of the revised version of the Rules of Procedure of the Boards of Appeal. In view of the transitional provisions set out in Article 25(2) RPBA 2020, Article 12(4) RPBA of the Rules of Procedure of the Boards in the version of 2007 (RPBA 2007, see OJ EPO 2007, 536) is applicable for deciding on the admittance of the main request. Article

12(4) RPBA 2007 requires the board to take into account everything presented by the parties under Article 12(1) RPBA 2007 if and to the extent it relates to the case under appeal and meets the requirements in Article 12(2) RPBA 2007. However, in accordance with Article 12(4) RPBA 2007, the board has the discretionary power to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first-instance proceedings.

- 1.2 Claims 1 to 11 of the main request are identical to claims 1 to 11 of the patent as granted. However, compared to independent method claim 12 as granted, claim 12 of the main request has been amended to read that the "*base coat (90) is digitally printed on the container*" (amendment is underlined). Dependent claim 13 as granted has been deleted.
- 1.3 The amendment of independent method claim 12 brings this claim into conformity with the corresponding independent product claim 1. The contentious issues remain the same as in the opposition proceedings and the amendments of the claims of the main request do not raise new issues. Thus, the main request is in line with the principle that an appeal primarily serves the parties' right to a judicial review of the first-instance decision. Consequently, the board, exercising its power under Article 12(4) RPBA 2007, decided to admit this request into the appeal proceedings.
2. Main request: Allowability of amendments under Article 123(2) EPC
 - 2.1 When assessing the requirements of Article 123(2) EPC for the present amended claim, it has to be established whether a skilled person would derive directly and

unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the application as filed the claimed combination of features (referred to as the "gold standard" (G 2/10, OJ EPO 2012, 376, Reasons, point 4.3)), i.e. a digital image printed on at least a portion of a digitally printed base coat together with the diameter and resolution ranges for the ink droplets. The presence of non-conflicting options is not sufficient for meeting the conditions for direct and unambiguous disclosure of their combination.

All references to the application as filed cited in this decision refer to the published international application WO 2008/064248 A2 on which the patent in suit is based.

The claims as filed do not, as such, form a basis for the claimed feature combination because claim 16 as filed disclosing that a digital image is printed on at least a portion of the base coat does not depend on claim 15 as filed claiming a digitally printed base coat. Dependent claim 16 as filed depends on claim 14 as filed, which in turn depends on claim 1 as filed, while dependent claim 15 as filed depends on claim 14 as filed, which in turn depends on claim 1. Thus, the set of claims as filed does not disclose a combination of claims 1, 14, 15 and 16. Moreover, the claims as filed mention the diameter and resolution ranges for the ink droplets only for a digital image printed on a non-planar external surface of the container. For these reasons, the claims as filed do not directly and unambiguously disclose the combination of a digital image printed on a digitally printed base coat (claims 15 and 16 as filed) having the claimed diameter and resolution ranges for the ink droplets (claim 1 as

filed).

2.2 Therefore, it must be assessed whether the description and the figures as filed directly and unambiguously disclose this feature combination.

2.2.1 The following two passages of the application as filed disclose the diameter and resolution ranges for the ink droplets (emphasis added):

- page 1, last paragraph "Summary", lines 19 to 23:
"The digital image is printed on the container by application of ink droplets. The ink droplets may vary in diameter from about 10 to about 200 microns and the droplets may range from about 200 to about 1200 drops per inch."
- page 3, third paragraph, lines 14 to 21:
"Individual ink droplets 30, including those associated with a single digital image, can vary in diameter D from about 10 microns to about 200 microns. In a particular embodiment, the diameter D of the droplets can range from about 30 microns to about 90 microns. Additionally, the application of ink drops provided on the surface of the container to form the digital images ranges from about 200 to about 1200 drops per inch (DPI) and, in an embodiment, may range from 300 to 1200 DPI. The resulting digital image formed on a container surface may, for example and without limitation, take the form of a label and may include various text and/or graphics, including color text and graphics."

The chapter "Summary" on page 1, last paragraph, lines 19 to 23 of the application as filed does not disclose a base coat, the ranges refer to a digital image printed on the container surface.

The diameter and resolution ranges disclosed on page 3, third paragraph, lines 14 to 22 of the application as filed are also given for a digital image provided on the surface of the container.

None of these passages concerned with the diameter of the ink droplets and their resolution disclose that the digital image is provided on a base coat.

- 2.2.2 A base coat is disclosed on page 6, lines 8 to 23 and in Figure 6 of the application as filed. Only page 6, lines 16 to 18 of the application as filed discloses a digitally printed base coat and is worded: "*If desired, all or a portion of the base coat may be digitally printed on at least a portion of a surface of the container.*" No diameter and resolution ranges for the ink droplets of the digital image are given in this context.
- 2.2.3 Figure 3 shows an "ink droplet application system 40" described on page 3, fourth paragraph, lines 22 to 30 of the application as filed. Its use for the application of a base coat is not mentioned. Ink is applied on the surface of the container. Page 6, lines 8 to 9 of the application as filed discloses that "*the system 40 may provide for the application of a base coat to a portion of the surface of the container prior to printing a digital image*". However, it is not disclosed whether it is the same ink droplet application system as mentioned previously. Nor is it disclosed that it is used for the application of a digitally printed base coat. Nor are the diameter and resolution ranges for the ink droplets of the digital image disclosed.

2.2.4 Consequently, these passages in the description and Figures 1, 3 or 6 of the application as filed do not disclose the diameter and resolution ranges for the ink droplets of a digital image printed on a digitally printed base coat. Reading various passages of the application as filed together as an indication for such disclosure in the original application as stated by the opposition division in point 2.2.2 of the Reasons for the decision under appeal does not constitute direct and unambiguous disclosure.

2.3 The board is not persuaded by the patent proprietor's argument that it is the same digital image having the same diameter and resolution ranges for the ink droplets irrespective of whether it is printed directly on the container surface, a base coat or a digitally printed base coat. According to Figure 1 of the application as filed, diameter D is the droplet diameter on the surface of a container. As argued by opponent 4 by referring to page 6, lines 15 to 17 of the application as filed, the base coat influences the surface properties, e.g. the wettability, and, consequently, the size of the drop on the surface.

The patent proprietor's argument that the digital image is inevitably printed on the base coat, irrespective of whether it is a digitally printed base coat or not, cannot be accepted. Dependent claims 16 and 17 which claim that the digital image is printed on the base coat do not depend on claim 15, which claims a digitally printed base coat. The pertinent passage on page 6, lines 18 to 19 of the application as filed does not mention a digitally printed base coat. Even if this embodiment was read together with the preceding embodiment, that "all or a portion of the base coat may be digitally printed", the diameter and resolution

ranges for the ink droplets are not disclosed.

The disclosure of the diameter and resolution ranges for the ink droplets in the chapter "Summary" on page 1 of the application as filed cannot unambiguously hold as a mandatory feature for all embodiments in view of its unspecific wording "may vary" and "may range".

The board also does not concur with the patent proprietor's argument that the same system is necessarily used for the application of the ink droplets and the digitally printed base coat. First, there is no direct and unambiguous disclosure that the same system is used. Second, the claimed diameter and resolution ranges for the ink droplets refer to the digital image and not to the print head (see Figure 1 of the application as filed).

The argument that the person skilled in the art would consider the option of a digitally printed base coat as a further option which did not change the remaining parameters is in contradiction to page 6, lines 15 to 17 of the application as filed, according to which the base coat serves to improve the application of ink droplets.

2.4 Conclusion

Amended claim 1 of the main request as filed with the patent proprietor's statement of grounds of appeal does not meet the requirements of Article 123(2) EPC.

2.5 In view of the above conclusion, the claims filed as main request with the patent proprietor's statement of grounds of appeal are not allowable already for the sole reason that the requirements of Article 123(2) EPC

are not met. Therefore, the question of novelty and inventive step is no longer relevant for these claims and a remittal of the case to the opposition division would be pointless. Consequently, the patent proprietor's main request that the decision under appeal be set aside and the case be remitted to the department of first instance for the discussion on novelty and inventive step of the subject-matter of these claims has to be refused. By the same token, the patent proprietor's auxiliary request 0 that the decision under appeal be set aside the patent be maintained on the basis of the claims filed as main request with the patent proprietor's statement of grounds of appeal must be refused.

3. Auxiliary request 1B: Admittance

3.1 Auxiliary request 1B was filed for the first time together with the patent proprietor's statement of grounds of appeal and therefore Article 12(4) RPBA 2007 is applicable for deciding on the admittance of this request (see point 1.1 above). The issue of admittance of this request hinges on whether the filing of this request brings about a fresh case.

3.2 Claim 1 of auxiliary request 1B is identical to claim 1 of auxiliary request 1 as filed during the first-instance oral proceedings. Independent method claim 11 has been brought into conformity with the product claim. It was filed to address the objection under Article 123(2) EPC. Thus, the contentious issues remain the same as in the opposition proceedings.

3.3 Under these circumstances, the board, exercising its power under Article 12(4) RPBA 2007, decided to admit the patent proprietor's auxiliary request 1B into the

appeal proceedings.

4. Auxiliary request 1B: Allowability of amendments under Article 123(2) EPC

4.1 In claim 1 of auxiliary request 1B, the feature of claim 1 of the main request that a digital image "*is printed on at least a portion of the base coat*" is amended to "*is printed entirely on the base coat*". This feature is based on claim 17 as filed, which depends on claim 16 as filed, which in turn depends on claim 14 and claim 1 as filed. This amendment does not affect the disclosure of the diameter and resolution ranges for the ink droplets of a digital image printed on a digitally printed base coat. Therefore, the same question arises as for claim 1 of the main request, irrespective of whether the digital image is printed on at least a portion of or entirely on the digitally printed base coat. The conclusion for claim 1 of the main request equally applies for claim 1 of auxiliary request 1B.

4.2 Conclusion

Claim 1 of auxiliary request 1B as filed with the patent proprietor's statement of grounds of appeal does not meet the requirements of Article 123(2) EPC. Auxiliary request 1B is therefore not allowable.

5. Auxiliary request 11: Admittance

5.1 Auxiliary request 11 was filed for the first time together with the patent proprietor's statement of grounds of appeal and therefore Article 12(4) RPBA 2007 is applicable for deciding on the admittance of this request (see point 1.1 above). Also here the issue of

admittance hinges on whether the filing of this request brings about a fresh case.

- 5.2 Claim 1 of auxiliary request 11 is identical to method claim 12 of the main request. The claims relating to the product have been deleted. Thus, there is no new subject-matter claimed compared to the main request.
- 5.3 In view of the above, the board, exercising its power under Article 12(4) RPBA 2007, decided to admit the patent proprietor's auxiliary request 11 into the appeal proceedings.
- 6. Auxiliary request 11: Admittance of the objection under Article 123(2) EPC for the method claim
 - 6.1 The same objection under Article 123(2) EPC as raised for claim 1 of the main request, which is directed to a container, was raised for method claim 1 of auxiliary request 11. The patent proprietor requested not to admit this objection into the appeal proceedings under Article 12(4) RPBA 2007.
 - 6.2 In the first-instance proceedings, the objection under Article 123(2) EPC concerning the combination of claims 1, 14, 15 and 16 as filed was discussed for independent product claim 1 as granted (see decision under appeal, Reasons, point 2.2). It could also have been raised for independent method claim 1 of auxiliary request 4 in opposition proceedings, which corresponds to auxiliary request 12 in appeal proceedings. Therefore, its admittance is at the discretion of the board. The discretion of the board pursuant to Article 12(4) RPBA 2007 serves the purpose of ensuring fair and reliable conduct of judicial proceedings. In the case at hand, the contested product claim (claim 1 as granted) and

the method claim (claim 1 of auxiliary request 11) comprise corresponding features and are based on the same original dependent claims 14 to 16. Thus, raising this objection at appeal stage also against the independent method claim does not constitute a fresh case.

6.3 Concerning the substantiation of this objection in opponent 3's reply dated 13 December 2018, point 4.2 of this submission discusses the claimed combination of features for claim 1 of the main request as filed with the patent proprietor's statement of grounds of appeal. In the last paragraph of this point, opponent 3 states that this objection was also valid for method claim 12 of the main request. Additionally, point 7.12 of opponent 3's reply explicitly states that all objections raised for independent claim 12 of the main request are also valid for auxiliary request 11. The board is therefore satisfied that the objection under Article 123(2) EPC against independent method claim 1 of auxiliary request 11 was sufficiently substantiated in opponent 3's reply dated 13 December 2018 and does therefore meet the requirements of Article 12(2) RPBA 2007.

6.4 In view of the considerations under points 6.2 and 6.3 and in accordance with Article 12(4) RPBA 2007, the board decided to admit the objection under Article 123(2) EPC raised against claim 1 of auxiliary request 11.

7. Auxiliary request 11: Allowability of amendments under Article 123(2) EPC

7.1 In view of the fact that claim 1 of auxiliary request 11 and claim 1 of the main request comprise

corresponding features, the conclusion drawn in respect of this objection under Article 123(2) EPC against claim 1 of the main request also applies to claim 1 of auxiliary request 11 (see point 2.4).

- 7.2 Amended claim 1 of auxiliary request 11 as filed with the patent proprietor's statement of grounds of appeal does not meet the requirements of Article 123(2) EPC. Auxiliary request 11 is therefore not allowable.

- 8. Auxiliary request 12: Admittance of the objection under Article 123(2) EPC and allowability of amendments under Article 123(2) EPC
 - 8.1 For the same reasons as discussed above for the admittance of the objection against claim 1 of auxiliary request 11, the board decided to admit the objection under Article 123(2) EPC against claim 1 of auxiliary request 12 concerning the disclosure of the diameter and resolution ranges for a digital image printed on a digitally printed base coat in accordance with Article 12(4) RPBA 2007

 - 8.2 In view of the fact that claim 1 of auxiliary request 12 and claim 1 of auxiliary request 1B comprise corresponding features, the conclusion drawn in respect of the objection under Article 123(2) EPC against claim 1 of auxiliary request 1B also applies to claim 1 of auxiliary request 12.

 - 8.3 Amended claim 1 of auxiliary request 12 as filed with the patent proprietor's statement of grounds of appeal does not meet the requirements of Article 123(2) EPC. Auxiliary request 12 is therefore not allowable.

9. Conclusion

Since none of the patent proprietor's requests is allowable, the patent must be revoked (Article 101(3) (b) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated