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**Datasheet for the decision  
of 4 May 2022**

**Case Number:** T 2349/18 - 3.2.05

**Application Number:** 11724441.8

**Publication Number:** 2569165

**IPC:** B41J11/00, B41M7/00, D21H21/36,  
D21H19/10, A61L2/18, C09D5/14

**Language of the proceedings:** EN

**Title of invention:**  
A method of printing

**Patent Proprietor:**  
Touch Guard Ltd

**Opponent:**  
Addmaster (U.K.) Limited

**Relevant legal provisions:**  
EPC Art. 56, 113(1)  
EPC R. 115(2)  
RPBA 2020 Art. 13(2), 15(3), 15(6)

**Keyword:**  
Oral proceedings - held in absence of party  
Admittance of the late-filed main request (yes)  
Inventive step (yes)

**Decisions cited:**

G 0004/92, T 0202/92



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Case Number: T 2349/18 - 3.2.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.05**  
**of 4 May 2022**

**Appellant:** Touch Guard Ltd  
(Patent Proprietor) Brook Mills House  
Carr Lane  
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**Representative:** Bartle Read  
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**Respondent:** Addmaster (U.K.) Limited  
(Opponent 2) Darfin House Priestly Court  
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**Representative:** Appleyard Lees IP LLP  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 24 July 2018  
revoking European patent No. 2569165 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

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

## **Summary of Facts and Submissions**

- I. The patent proprietor lodged an appeal against the opposition division's decision to revoke European patent No. 2 569 165.
- II. The patent was opposed by opponent 2 on the grounds for opposition of 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. Opponent 1's opposition was deemed not to have been filed for non-payment of the opposition fee.
- III. With the statement of grounds of appeal, the appellant (patent proprietor) requested "that the patent be upheld without amendment" and, on an auxiliary basis, that oral proceedings be held. Additionally, it filed claims according to two auxiliary requests.
- IV. In its reply to the statement of grounds of appeal, the respondent (opponent 2) requested that the appeal be dismissed and, on an auxiliary basis, that oral proceedings be held. It argued that claim 1 of the patent as granted was not new and lacked an inventive step. Claim 1 of auxiliary request 1 and claim 1 of auxiliary request 2 lacked an inventive step.
- V. The summons to oral proceedings was issued on 12 May 2021.
- VI. In a communication of 23 March 2022 under Article 15(1) of the Rules of Procedure of the Boards of Appeal in the version of 2020 (RPBA 2020), the parties were informed of the board's preliminary opinion.

VII. With a letter dated 7 April 2022, the appellant filed auxiliary request 3, requested its admittance under Article 13(2) RPBA 2020 claiming exceptional circumstances, and filed the following documents as proof.

Witness statement of Mr Julian Dugdale

Appendix 1: Market development agreement

Appendix 2: Email from Mr Dugdale, 20 November 2020

Appendix 3: Email from Mr Dugdale, 21 November 2020

Appendix 4: Secretary of State's Response,  
Appeal Tribunal Reference Number  
SC944/20/00205

Appendix 5: Letter from Dr Charlotte Monument,  
dated 15 January 2020

VIII. The respondent requested not to admit auxiliary request 3 and raised objections of added subject-matter and lack of inventive step for this request.

IX. By letter dated 20 April 2022, the respondent withdrew its request for oral proceedings and informed the board that it would not be attending oral proceedings.

X. The oral proceedings before the board took place on 4 May 2022 in the absence of the duly summoned respondent. During oral proceedings, the appellant withdrew all previous requests and filed claims 1 to 14 and amended description pages 2 to 6 of a new main request "12.20".

XI. Requests

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained as amended on the basis of the following

documents:

Claims 1 to 14 of the main request "12.20" filed in the oral proceedings on 4 May 2022.

Pages 2 to 6 of the amended description of the main request "12.20" filed in the oral proceedings on 4 May 2022.

Figure 1 of the patent specification.

The respondent (opponent 2) requested that the appeal be dismissed.

XII. The following documents are referred to in this decision:

- D11: R.H. Leach et al., "The Printing Ink Manual", 4th edn., London, Blueprint, 1988, pages 20 to 50, 362 to 365 and 475 to 476;
- D12: Manroland 505LV, Printweek, 27 May 2009;
- D12b: Manroland 505LV, Printweek hard copy version, 29 May 2009;
- D14: US 2004/0084163 A1;
- D15: JP H9-39369;
- D15T: English translation of JP H9-39369.

XIII. The independent claim of the main request "12.20" filed during the oral proceedings before the board has the following wording (amendments with respect to auxiliary request 2 filed with the statement of grounds of appeal are marked):

"1. A method of printing and finishing ~~food packaging~~ on a substrate, the method comprising the following steps, carried out in a single pass of a substrate through a printing press:

a printing step wherein one or more layers of print are

deposited onto one or both sides of the substrate; and a finishing step wherein a liquid finishing composition is applied to the entire surface of one or both sides of the substrate using a doctor blade and chamber system in which the liquid finishing composition is pumped to a chamber and fills cells of a transfer roller, a doctor blade serving to skim off excess liquid finishing composition prior to transfer of the liquid finishing composition to the substrate, and is cured or dried to form a continuous outer protective layer upon the substrate, the finishing composition comprising an antibacterial additive which gives the printed articles antibacterial properties."

XIV. The appellant's submissions can be summarised as set out below.

*Admittance of the main request "12.20" filed during the oral proceedings*

The main request "12.20" was filed in response to the board's preliminary opinion announced at the beginning of the oral proceedings that, having considered the substance of the appeal case at hand on the basis of the board's preliminary opinion expressed in its communication under Article 15(1) RPBA 2020 and taking into account the written submissions by both parties received thereafter, auxiliary request 2 as filed with the statement of grounds of appeal could form a basis for an allowable request. Claim 1 of the main request "12.20" contained only minor amendments compared with claim 1 of auxiliary request 2 as filed with the statement of grounds of appeal. By replacing "food packaging" with "on a substrate" in claim 1 of the main request "12.20", the wording was adapted to claim 1 as granted. This was in line with the view of the

respondent, which argued that food packaging was only briefly mentioned in the patent in suit (see patent in suit, paragraph [0066] and the respondent's reply to the statement of grounds of appeal, page 7, last paragraph). Furthermore, the respondent only raised objections based on lack of inventive step for claim 1 of auxiliary request 2 as filed with the statement of grounds of appeal. The respondent's arguments in this regard were not affected by this amendment. This was explicitly mentioned in the respondent's reply to the statement of grounds of appeal (see paragraph bridging pages 7 and 8). In this paragraph discussing lack of inventive step of claim 1 of auxiliary request 1, one sentence read: "*Simply stating in claim 1 that the packaging is for food cannot change the technical content of the claim (...).*" The respondent's arguments for auxiliary request 2 did not mention food packaging at all.

Additionally, there were exceptional circumstances due to personal problems which hindered the appellant's ability to concentrate on the case and to file the corresponding request earlier.

For these reasons, the main request "12.20" should be admitted.

#### *Inventive step*

Starting from document D15/D15T, there was no prompt to apply the finishing composition with a different system, such as a doctor blade and chamber system as claimed in claim 1 of the main request "12.20". The person skilled in the art had no incentive to deviate from the disclosure of document D15/D15T, which made reference to a four-colour offset printer for the



application of a liquid antibacterial finishing composition. The subject-matter of claim 1 involved an inventive step.

XV. The respondent argued in writing as follows.

*Lack of inventive step*

The subject-matter of claim 1 of auxiliary requests 1 and 2 as filed with the statement of grounds of appeal lacked an inventive step over document D15/D15T for the same reasons as for claim 1 of auxiliary request 1 forming the basis for the decision under appeal (see the decision under appeal, Reasons, point 10). Document D15/D15T disclosed a method of forming the printed and antibacterial coated substrate using a four-colour offset printer (see document D15/D15T, paragraph [0019]). As there was only a brief mention of food packaging in the patent as one of many possible applications, no advantages could be associated with food packaging which, thus, could not change the technical content of the claim. Claim 1 of auxiliary request 2 as filed with the statement of grounds of appeal specified that the liquid finishing composition was applied "using a doctor blade and chamber system (...)". This system was common in the printing arts, as shown by Figure 2.20 of document D11 and as acknowledged in the patent itself (see patent in suit, paragraph [0012], "Tresu process"). The specification of this printing system did not state any special effect or advantage. It was merely one of two equally applicable alternatives for applying the finishing composition.

## **Reasons for the Decision**

1. Non-attendance of the respondent at the oral proceedings before the board

In accordance with Rule 115(2) EPC, if a party duly summoned to oral proceedings before the EPO does not appear as summoned, the proceedings may continue without that party. Pursuant to Article 15(3) RPBA 2020 (which is applicable in accordance with Article 25(1) RPBA 2020), the board is not obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of a duly summoned party, which may then be treated as relying only on its written case.

In the case in hand, both parties requested oral proceedings at the outset of the appeal proceedings. The respondent withdrew its request for oral proceedings and announced that it would not be attending the oral proceedings. By not attending these oral proceedings, the respondent effectively chose not to avail itself of the opportunity to present its observations and counter-arguments orally but instead to rely on its written submissions. The board was in a position to announce a decision at the conclusion of the oral proceedings in accordance with Article 15(6) RPBA 2020, which applies in accordance with Article 25(1) RPBA 2020.

2. Admittance of the main request "12.20"
  - 2.1 A new main request "12.20" was filed in the oral proceedings before the board after the chairman's announcement of the board's preliminary view that

auxiliary request 2 could form a basis for an allowable request. The main request "12.20" is based on auxiliary request 2 as filed with the statement of grounds of appeal with the replacement of the term "food packaging" by "on a substrate", which constitutes an amendment to the appellant's appeal case.

In the case in hand, the summons to oral proceedings was notified after the date on which RPBA 2020 entered into force, i.e. 1 January 2020 (Article 24(1) RPBA 2020). Thus, in accordance with Article 25(1) and (3) RPBA 2020, Article 13(2) RPBA 2020 applies to the question of whether to admit the main request "12.20", which was filed after notification of the summons to oral proceedings and is therefore an amendment within the meaning of Article 13(2) RPBA 2020. As a consequence, the main request "12.20" is, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the appellant.

- 2.2 The reasons advanced by the appellant for the late filing of this request were that it was impaired by personal problems and that the minor amendment was based on the patent as granted and did not affect the discussion of inventive step as compared to auxiliary request 2 as filed with its statement of grounds of appeal.
- 2.3 The board sees no justification for the late filing in the appellant's personal problems as they did not prevent the appellant from filing auxiliary request 3 with its letter dated 7 April 2022. Therefore, the new main request "12.20" could at least have been filed at that time.

2.4 The board concurs with the appellant's view that claim 1 of the main request "12.20" contained only minor amendments compared with claim 1 of auxiliary request 2 as filed with the statement of grounds of appeal. This *per se* is not an argument in favour of the admittance of the main request "12.20". However, there are two issues which constitute exceptional circumstances. First, by replacing the term "food packaging" with the more general term "on a substrate" in claim 1 of the main request "12.20", the wording was adapted to claim 1 as granted. As correctly stated by the respondent, food packaging is not anything special to the patent, and there is only a very brief mention of food packaging in the patent in suit (see the patent in suit, paragraph [0066] and the reply to the statement of grounds of appeal, page 7, last paragraph). Second, this amendment does not have any influence on the inventive-step argument as brought forward by the respondent and in the preliminary opinion of the board (see the board's communication under Article 15(1) RPBA 2020, point 13). The respondent correctly wrote in its reply to the statement of grounds of appeal, page 8, first paragraph that "*[s]imply stating in claim 1 that the packaging is for food cannot change the technical content of the claim and does not mean that a problem associated with providing food packaging has been solved by the disclosure of the Patent when only the briefest mention of food packaging is made*". Consequently, when presenting its arguments for lack of inventive step of the subject-matter of claim 1 of auxiliary request 2, the respondent did not refer to food packaging at all.

Since the respondent only raised objections based on lack of inventive step for claim 1 of auxiliary request 2 as filed with the statement of grounds of

appeal and since its arguments are not influenced by this amendment, the board holds that exceptional circumstances justified with cogent reasons exist.

- 2.5 The respondent was not present at the oral proceedings before the board and was, therefore, not in a position to comment on the amendments made in the appellant's new main request "12.20". According to the decision of the Enlarged Board of Appeal G 4/92 (OJ EPO 1994, 149), a party who fails to appear at oral proceedings must have the opportunity, in accordance with Article 113(1) EPC, to comment on new facts and evidence submitted in the proceedings. In accordance with the established case law (see for example decision T 202/92), the finding in decision G 4/92 does not, however, prevent the admission into the proceedings of new claims of requests introduced only at the oral proceedings before the board, and a decision thereon, where the amendments made overcome objections raised in the written proceedings and the amendments are of a nature that the absent respondent might have expected.

In the case in hand the respondent could have reasonably expected amendments like those made in the claims of the appellant's new request and thus it could not have been taken by surprise. Accordingly, the absence of the respondent was no obstacle to admitting the appellant's main request "12.20" into the proceedings and taking a decision on it.

- 2.6 For these reasons, the board in exercising its discretion under Article 13(2) RPBA 2020 decided to admit the main request "12.20" into the appeal proceedings.

3. Inventive step of the subject-matter of claim 1 of the main request "12.20"
- 3.1 Document D15/D15T discloses a liquid antibacterial liquid finishing composition and a method of forming the printed and antibacterial coated substrate using a four-colour offset printer (Lithron S26) (see document D15/D15T, paragraphs [0009], [0010], [0019] and [0020]). It is a suitable starting point for the examination of inventive step. Starting from document D15/D15T, the distinguishing features are the "single pass" feature and the use of a doctor blade and a chamber system for the application of the liquid finishing composition.
- 3.2 The objective technical problem is to find an alternative way of applying a liquid antibacterial finishing composition.
- 3.3 It is undisputed that a doctor blade and a chamber system is, as such, a standard system in printing (see the patent in suit, paragraph [0012] and document D11, Figure 2.20). However, it is not obvious for the person skilled in the art to choose this well-known alternative for applying the coating in the context of the four-colour offset printer of document D15/D15T. According to paragraph [0019] of document D15/D15T, the four-colour offset printer is used for first printing a three-colour pattern and then applying a liquid antibacterial finishing composition. There is no reason apparent why the skilled person would have deviated from this integrated solution by combining the four-colour offset printer of document D15/D15T with a doctor blade and chamber system for applying the liquid

antibacterial finishing composition.

- 3.4 The respondent did not file further arguments and did not raise further lines of arguments which could have convinced the board. Documents D12 and D14 are less relevant than document D15/D15T and do not disclose a doctor blade and chamber system in the current context.
- 3.5 Consequently, the board concludes that the subject-matter of claim 1 of the main request "12.20" meets the requirements of Article 56 EPC since it is not rendered obvious by the cited prior art.
4. Claims 2 to 14 are dependent claims. Therefore, their subject-matter also involves an inventive step. The amended description according to the main request "12.20" meets the requirements of the EPC. It follows that the main request "12.20" is allowable.

## **Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent as amended on basis of the following documents:

Claims: Nos. 1 to 14 of the main request "12.20" filed at the oral proceedings on 4 May 2022.

Description: pages 2 to 6 of the main request "12.20" filed at the oral proceedings on 4 May 2022.

Drawings: Fig. 1 of the patent specification.

The Registrar:

The Chairman:



D. Hampe

P. Lanz

Decision electronically authenticated