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**Datasheet for the decision  
of 8 March 2023**

**Case Number:** T 0019/20 - 3.3.03

**Application Number:** 14179426.3

**Publication Number:** 2801594

**IPC:** C09D11/101, C09D11/40,  
C09D11/322, C08F2/50

**Language of the proceedings:** EN

**Title of invention:**

Methods for preparing curable pigment inkjet ink sets

**Patent Proprietor:**

AGFA NV

**Opponent:**

Sun Chemical Colors & Effects GmbH

**Relevant legal provisions:**

EPC Art. 123(3)

RPBA 2020 Art. 12(6) sentence 2, 13(2)

**Keyword:**

Amendments - deletion of features (yes) - broadening of claim  
(yes)

Amendment after summons - line of defence - taken into account  
(no)

Late-filed request - should have been submitted in first-  
instance proceedings (yes)

**Decisions cited:**

T 2920/18, T 2988/18, T 0247/20



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 0019/20 - 3.3.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.03**  
**of 8 March 2023**

**Appellant:** Sun Chemical Colors & Effects GmbH  
(Opponent) An der Rheinschanze 1  
67059 Ludwigshafen (DE)

**Representative:** Walz, Irene  
Altmann Stöbel Dick Patentanwälte PartG mbB  
Isartorplatz 1  
80331 München (DE)

**Respondent:** AGFA NV  
(Patent Proprietor) Septestraat 27  
2640 Mortsel (BE)

**Representative:** Strijckers, Hans  
AGFA NV  
Intellectual Property Department  
Septestraat 27  
2640 Mortsel (BE)

**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
27 September 2019 concerning maintenance of the  
European Patent No. 2801594 in amended form.**

**Composition of the Board:**

**Chairman** D. Semino  
**Members:** M. Barrère  
C. Brandt

## Summary of Facts and Submissions

- I. The appeal of the opponent lies against the interlocutory decision of the opposition division concerning maintenance of European Patent number 2 801 594 in amended form on the basis of the claims of auxiliary request 2 filed during oral proceedings on 8 April 2019 and an adapted description.
- II. The following documents were *inter alia* cited in the decision of the opposition division:
- D3: US 2004/0187732 A1
  - D27: Report on spectrophotometer measurements
  - D29: Experimental report, PY 150 absorption spectrum in different solvents
- III. In that decision the opposition division held, amongst others, that:
- The main request complied with the requirements of Article 123 paragraphs (2) and (3) EPC. However, neither the main request nor auxiliary request 1 met the requirements of Article 56 EPC.
  - Claim 1 of auxiliary request 2 involved an inventive step over D3 as the closest prior art.
- IV. The opponent (appellant) filed an appeal against said decision.
- V. With the rejoinder to the statement of grounds of appeal, the patent proprietor (respondent) filed three

sets of claims as main request and auxiliary requests 1 and 2.

- VI. During the oral proceedings, which were held on 8 March 2023 in the presence of both parties, the respondent withdrew auxiliary request 1 (see minutes, page 2, fourth full paragraph).
- VII. The final requests of the parties were as follows:
- (a) The appellant requested that the decision under appeal be set aside and the patent be revoked.
  - (b) The respondent requested that the appeal be dismissed. In the alternative the respondent requested maintenance of the patent in amended form on the basis of auxiliary request 2 filed with the rejoinder to the statement of grounds of appeal.
- VIII. Claim 1 of the main request (which corresponds to auxiliary request 2 in opposition) read as follows:

"1. A curable pigment inkjet ink set including

a yellow inkjet ink Y comprising a photoinitiator and a colorant consisting of C.I. Pigment Yellow 150;

a cyan inkjet ink C comprising a photoinitiator and a  $\beta$ -copper phthalocyanine pigment; and

a magenta inkjet ink M comprising a photoinitiator and a colorant consisting of a mixed crystal wherein a first quinacridone and a second quinacridone enter into the same crystal lattice, with unsubstituted quinacridone C.I. Pigment Violet 19 being present as the first quinacridone in the

mixed crystal in an amount between 75 and 95 % as measured by Probe-MS,

wherein

the yellow inkjet ink Y has absorbances

$ABS(Y)_{500-530} < 5$  and  $ABS(Y)_{400-500} > 60$ ;

the magenta inkjet ink M has absorbances

$ABS(M)_{500-530} > 20$  and  $ABS(M)_{500-600} > 60$

with

$ABS(Y)_{500-530}$  representing the absorbance of the yellow inkjet ink Y between 500 and 530 nm in a normalized absorption spectrum of the yellow inkjet ink Y;

$ABS(Y)_{400-500}$  representing the absorbance of the yellow inkjet ink Y between 400 and 500 nm in a normalized absorption spectrum of the yellow inkjet ink Y;

$ABS(M)_{500-530}$  representing the absorbance of the magenta inkjet ink M between 500 and 530 nm in a normalized absorption spectrum of the magenta inkjet ink M;

$ABS(M)_{500-600}$  representing the absorbance of the magenta inkjet ink M between 500 and 600 nm in a normalized absorption spectrum of the magenta inkjet ink M;

wherein the curable pigment inkjet inks comprise at least three components:

(i) a pigment, (ii) a dispersant and (iii) polymerizable compounds; and

wherein the curable pigment inkjet inks of the curable pigment inkjet ink set contain a photo-initiator;

wherein the numeric average particle size of the pigments in the inkjet inks as measured by dynamic light scattering is no larger than 0.150  $\mu\text{m}$ ;

wherein the second quinacridone is C.I. Pigment Red 202;

wherein the  $\beta$ -copper phthalocyanine pigment is C.I. Pigment Blue 15:4; and further comprising a black inkjet ink."

Claim 1 of auxiliary request 2 corresponded to claim 1 of the main request with the following addition after the definition of ABS(M)<sub>500-600</sub>:

"using a double beam-spectrophotometer with a scan interval of 1 nm on the ink diluted in ethyl acetate to a pigment concentration of 50 ppm for the magenta inkjet ink M and to a pigment concentration of 20 ppm for the yellow inkjet ink Y while using ethyl acetate as blank"

The remaining claims of these requests are not relevant to this decision.

IX. The appellant's submissions, in so far as they are pertinent to the present decision, may be derived from the reasons for the decision below. They were essentially as follows:

(a) Main request

(i) Admittance of the objection under Article 123(3) EPC

The objection under Article 123(3) EPC was not an amendment of the appellant's case.

(ii) Admittance of a line of defence

The respondent's line of defence with respect to an implicit disclosure in claim 1 of the main request was

late-filed and should not be admitted into the proceedings.

(iii) Article 123(3) EPC

Claim 1 of the main request did not comply with the requirements of Article 123(3) EPC.

(b) Auxiliary request 2

Auxiliary request 2 should not be admitted into the proceedings.

X. The respondent's submissions, in so far as they are pertinent to the present decision, may be derived from the reasons for the decision below. They were essentially as follows:

(a) Main request

(i) Admittance of the objection under Article 123(3) EPC

The objection under Article 123(3) EPC was an amendment of the appellant's case and should not be admitted into the proceedings.

(ii) Admittance of a line of defence

The line of defence with respect to an implicit disclosure in claim 1 of the main request was not an amendment of the respondent's case.

(iii) Article 123(3) EPC



Claim 1 of the main request complied with the requirements of Article 123(3) EPC.

(b) Auxiliary request 2

Auxiliary request 2 should be admitted into the proceedings.

### **Reasons for the Decision**

#### **Main request (patent as maintained by the opposition division)**

1. Article 123(3) EPC

With respect to claim 1 as granted, claim 1 of the main request has been amended by deleting the following part (hereinafter referred to as "part B"):

"and wherein  $ABS(X)_{WL1-WL2}$  represents the peak area between the wavelengths WL1 and WL2 calculated by summation of the normalized absorbance values in the range WL1 to WL2 which are obtained by multiplying the absorbance values at each wavelength in the range from 380 to 850 nm by the reciprocal value of the maximum absorbance  $A_{max}$  in the range of 380 to 850 nm using a spectrophotometer with an interval of 1 nm on the ink X diluted in ethyl acetate to a pigment concentration of 40 ppm."

The appellant considers that the deletion of part B leads to an extension of the scope of protection of granted claim 1 contrary to the requirements of Article 123(3) EPC.

1.1 Admittance of the objection

1.1.1 According to the respondent, the opponent did not raise any objection under Article 123(3) EPC against claim 1 of the present main request during the oral proceedings before the opposition division. Therefore the present objection would be an amendment of the appellant's case which should not be admitted into the proceedings.

1.1.2 Article 12(4) RPBA 2020 provides that any part of a party's appeal case which does not meet the requirements in Article 12(2) RPBA 2020 is to be regarded as an amendment. Any such amendment may be admitted only at the discretion of the Board.

1.1.3 The first question to be answered by the Board is therefore whether the objection under Article 123(3) EPC against the present main request constitutes an amendment of the appellant's case.

An amendment to a party's appeal case under Article 12(4) RPBA 2020 (with reference to Article 12(2) RPBA 2020) is a submission which is not directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based. In other words: it goes beyond the framework established therein (see Case Law of the Boards of Appeal, 10th edition 2022, V.A.4.2.1 b)).

1.1.4 It is clear from the minutes of the oral proceedings before the opposition division and from the contested decision that no specific objection under Article 123(3) EPC was raised by the opponent at such oral proceedings against auxiliary request 2 corresponding to the present main request (see point 9.2 of the minutes, see also point 58. of the decision).

However, it is also undisputed between the parties that the present objection under Article 123(3) EPC is exactly the same as the objection raised against the main request of the opposition proceedings. This objection was discussed at the oral proceedings and fully dealt with by the opposition division (see point 3 of the minutes; see also points 26 to 28 of the contested decision). In addition, it is undisputed that the amendments in auxiliary request 2 with respect to the main request in opposition are unrelated to the objection. Already for these reasons, the Board takes the view that the appellant's submission under Article 123(3) EPC is directed to an objection on which the decision was based and is therefore not an amendment of the appellant's case.

- 1.1.5 The respondent further argued that the appellant raised the present objection only in respect of the main request, but did not maintain it when discussing auxiliary request 2 (corresponding to the present main request). Hence this objection should also not be admitted into the proceedings under Article 12(6) RPBA 2020.
- 1.1.6 In the Board's view, the specific objection which was maintained and fully dealt with in the decision under appeal in respect of the main request is to be considered as maintained during the proceedings leading to said decision for a request, such as auxiliary request 2, which differs from the main request by amendments fully unrelated to the objection, also if it is not explicitly repeated. In this respect, the Board considers that the statement of the appellant that there were no objections under Article 123(3) EPC against auxiliary request 2 has to be understood as

expressing that there were no further objections. Hence, the condition of the second sentence of Article 12(6) RPBA 2020 does not apply to the present objection.

1.1.7 For these reasons, the present objection under Article 123(3) EPC is not an amendment of the appellant's case and the Board has therefore no discretion not to take it into account.

1.2 Admittance of a line of defence

1.2.1 During the oral proceedings before the Board, the respondent argued for the first time that the deletion of part B did not change the scope of claim 1 because claim 1 was implicitly limited by said feature in view of the description of the patent. Reference was made to several previously unquoted paragraphs in the patent and to some unspecified common general knowledge. The appellant concluded on that basis that claim 1 of the main request did not infringe Article 123(3) EPC.

1.2.2 The appellant contended that the above line of defence was late-filed and requested that it be excluded from the proceedings.

1.2.3 Article 13(2) RPBA 2020 provides that amendments to a party's case made after notification of oral proceedings are not to be taken into account unless exceptional circumstances, justified by cogent reasons, exist.

The Board concurs with the approach taken in several decisions (T 247/20, point 1.3 of the Reasons; T 2988/18, point 1.2 of the Reasons; T 2920/18, point 3.4 of the Reasons), according to which the examination

under Article 13(2) RPBA 2020 is carried out in two steps. The question to be answered in the first step is whether the submission objected to is an amendment to a party's appeal case. If that question is answered in the negative, then the Board has no discretion not to take the submission into account. If, however, that question is answered in the affirmative, then the Board needs to decide whether there are exceptional circumstances, justified by cogent reasons (second step).

- 1.2.4 The first question to be answered by the Board is therefore whether the present line of defence constitutes an amendment of the respondent's case.

An amendment to a party's appeal case under Article 13 RPBA 2020 is in analogy with Article 12(4) RPBA 2020 (with reference to Article 12(2) RPBA 2020) a submission which is not directed to the requests, facts, objections, arguments and evidence relied on by the party in its statement of grounds of appeal or its reply.

- (a) In the rejoinder to the statement of grounds of appeal, the respondent argued that part B was an added undisclosed feature without any technical meaning. Therefore said feature was non limiting and could be deleted without violating Article 123(3) EPC (see rejoinder, page 3, third paragraph and page 6, first paragraph).
- (b) During the oral proceedings, it was argued that the deletion of part B did not change the scope of granted claim 1 because said claim was implicitly limited by said feature in view of the description of the patent and common general knowledge.

According to the respondent, this line of defence was not new, but merely deepened the arguments presented in writing.

- (c) In the Board's view, the respondent no longer contested that part B limited the scope of granted claim 1, which was the central point of discussion in the written proceedings, but brought forward that the description of the opposed patent would limit the scope of claim 1 to ink sets wherein the absorbances were measured by the method of part B.

Whereas, in the written submissions, the issue under Article 123(3) EPC was limited to the matter as to whether part B could be regarded as a limiting feature of granted claim 1, the line of defence adopted in the oral proceedings extends to new questions such as whether and to what extent the description limits the scope of claim 1. In particular, this line of defence would make it necessary to investigate whether the features of part B were actually disclosed explicitly or implicitly in the description and to discuss whether the scope of claim 1 could be limited by said features in spite of them being absent in the claim. This in turn would raise the question of the interpretation of the claims in the light of the description under Article 69(1) EPC.

Since the present line of defence raises new legal and technical issues, it constitutes a change of the legal and factual framework of the appeal and is therefore an amendment of the respondent's case within the meaning of Article 13(2) RPBA 2020.

1.2.5 The second question to be answered is whether there are exceptional circumstances, supported by cogent reasons, which justify the admittance of the present line of defence into the appeal proceedings.

The respondent offered no explanation for the submission of this line of defence only during the oral proceedings, nor can the Board discern any.

1.2.6 In the absence of any exceptional circumstances, the current line of defence is not taken into account (Article 13(2) RPBA 2020).

1.3 Merit of the objection

1.3.1 As noted previously the appellant considers that the deletion of part B leads to an extension of the scope of protection of granted claim 1 contrary to the requirements of Article 123(3) EPC.

1.3.2 In the rejoinder to the statement of grounds of appeal, the respondent argued that part B was an added undisclosed feature without any technical meaning. As part B did not limit the scope of granted claim 1, its deletion could not lead to a broadening of the scope of protection.

1.3.3 In accordance with the established case law of the boards of appeal (see Case Law of the Boards of Appeal, 10th edition 2022, II.E.5), in the case of a proposed amendment under Article 123(2) EPC or of a correction under Rule 139 EPC, the factual disclosure of a European patent application as originally filed has to be established to a rigorous standard, namely the standard of certainty "beyond reasonable doubt". The same standard applies when assessing the allowability

of amendments under Article 123(3) EPC. Furthermore, the burden of proof rests with the party making the amendment (here the respondent).

1.3.4 Deleted part B concerns a method to measure the absorbance of an ink between two wavelengths.

(a) According to part B, the peak area between the wavelengths WL1 and WL2 is calculated using a scan interval of 1 nm. The appellant argued first that the choice of the scan interval had an effect on the results. This does not appear to be disputed by the opposition division or by the respondent and the Board sees no reason to depart from this view (reference is made to paragraph 2.2.3 of the statement of grounds of appeal).

In the contested decision (see page 11, last paragraph), the opposition division considered however that the opponent did not provide evidence that the effect of the scan interval would also occur at the limit of the absorbance range as defined in claim 1.

However, as pointed out previously, the burden of proof rests with the party making the amendment. Therefore, contrary to the view expressed in the contested decision, the Board considers that it would have been the patentee's responsibility to show that the scan interval had no effect on the result at the limit of the ranges. In the absence of any such evidence, the Board has to come to the conclusion that there are reasonable doubts that the scan interval has an effect on the result over the whole absorbance ranges.



The opposition division further argued that the effect of the measurement method had not been shown for inkjet inks which also meet the other features of claim 1.

For the Board, it is not fully clear what the opposition division's criticism actually was. *Prima facie*, it appears that the inkjet inks of documents D27 and D29 fulfil the other features of claim 1. In any event, the Board considers that any evidence that the method of part B has an effect on the absorption values is sufficient to raise a reasonable doubt that the deletion of said part B infringes the requirement of Article 123(3) EPC. It is therefore not necessary for the absorbance to be measured on inkjet inks having all the other characteristics of claim 1.

- (b) The same conclusion is reached in respect of the deletion of the normalisation method.

The appellant provided evidence that the normalisation method had an effect on the absorbance values (reference is made to paragraph 2.2.5 of the statement of grounds of appeal).

The respondent argued that there was no evidence that the skilled person would be aware of the other mathematical methods, let alone that it would use them in a daily routine.

Again, the Board is of the opinion that the burden of proof lies with the respondent to show that the skilled person would necessarily use the normalisation method of part B. In the absence of

any such proof, the respondent's arguments fail to convince.

- (c) The appellant further argued that the solvent used (ethyl acetate in part B) had an effect on the results.

According to the respondent, the absorbance according to claim 1 is the absorbance of the ink alone, which implies that the absorbance value of the solvent should be deducted. Therefore the experimental data provided in D29 were not obtained in accordance with the teaching of the opposed patent.

The Board notes that the solvent used (ethyl acetate or xylene) has been shown to have an effect on absorption values (see D29, page 3, table). Contrary to the respondent's view, part B does not specify that the absorbance value of the solvent should be deducted. The respondent's argument is therefore not convincing.

- 1.3.5 In conclusion, the Board considers that the method of part B has an effect on the absorbance values. Consequently, there are reasonable doubts that the deletion of part B in claim 1 of the main request (allowing all conceivable methods of measuring absorbance) extends the scope of protection of granted claim 1.

It follows that claim 1 of the main request does not comply with the requirements of Article 123(3) EPC.

## **Auxiliary request 2**

### 2. Admittance

2.1 Auxiliary request 2 is a new request filed by the respondent with the rejoinder to the statement of grounds of appeal. Its admission to the proceedings is subject to the discretionary power of the Board in accordance with Article 12 paragraphs (4) to (6) RPBA 2020.

2.2 Claim 1 of auxiliary request 2 includes the following additional feature after the definition of the absorbances:

"using a double beam-spectrophotometer with a scan interval of 1 nm on the ink diluted in ethyl acetate to a pigment concentration of 50 ppm for the magenta inkjet ink M and to a pigment concentration of 20 ppm for the yellow inkjet ink Y while using ethyl acetate as blank".

2.3 According to the respondent, this request was submitted to overcome the appellant's objections under Article 123(2) and (3) EPC (see rejoinder to the statement of the grounds of appeal, page 6, second paragraph). Specifically, the respondent takes the view that the appellant invoked for the first time in the statement of grounds of appeal an inescapable trap between Article 123(2) and Article 123(3) EPC.

During the oral proceedings before the Board, the respondent further argued that the opposition division was satisfied that claim 1 of the present main request complied with Article 123(3) EPC. Hence, it was not

necessary for the patentee to file auxiliary request 2 during the opposition proceedings.

2.4 The Board notes that the opponent raised for the first time in the notice of opposition an objection against granted claim 1, arguing that there was no basis for the method of part B in the parent application as filed (see notice of opposition, page 4, paragraph III.a). In response, the patentee submitted a main request wherein the method of part B was deleted from claim 1. With the summons to oral proceedings, the opposition division issued a communication indicating its preliminary opinion. In particular, the opposition division pointed out that the deletion of part B did not appear to comply with Article 123(3) EPC (see point 13 of the communication). Therefore, at the latest with the communication of the opposition division, it was clear that the method of part B raised issues under Article 76(1) EPC (if present in claim 1) as well as under Article 123(3) EPC (if deleted from claim 1). In other words, the possibility of an inescapable trap was obvious.

In the Board's view, the patentee had sufficient time between the preliminary opinion of the opposition division and the oral proceedings (about 6 months later) to file a new request in order to overcome the objections in relation to part B. Therefore, the respondent could and should have filed auxiliary request 2 during opposition proceedings.

Furthermore, the respondent held that the filing of auxiliary request 2 was not necessary during opposition proceedings due to the final conclusion of the opposition division. While there is no legal obligation for the patent proprietor to file new requests, it is

not free to complete its case at any time during the opposition or opposition appeal proceedings. If a patent proprietor chooses not to file new requests at the stage of the first-instance proceedings but rather completes its case only in appeal, then it will need to face the prospect of being held to account for such a conduct by the board when exercising its discretion under Article 12(4) to (6) RPBA 2020. This applies in particular if, as in the present case, the present objection under Article 123(3) EPC was known to the patent proprietor before the oral proceedings before the opposition division.

- 2.5 Under these circumstances, the Board finds it appropriate to exercise its discretion under Article 12(6) RPBA 2020 by not admitting auxiliary request 2 into the proceedings.
  
3. Since all the requests of the respondent are not allowable or not admitted into the proceedings, there is no need to deal with any other issue and the patent is to be revoked.

## 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:



D. Hampe

D. Semino

Decision electronically authenticated