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

Case Number: T 0221/20 - 3.2.05

Application Number: 13848246.8

Publication Number: 2910374

IPC: B41F11/00, B41F5/02, B41F5/06,
B41F23/08, B41F13/004,
B41F11/02, B41F13/00,
B41F13/70, B65H29/22,
B65H43/04, B65H5/06

Language of the proceedings: EN

Title of invention:
Combination printer

Patent Proprietor:
Komori Corporation

Opponent:
Koenig & Bauer AG

Relevant legal provisions:
EPC Art. 56, 111(1)
RPBA 2020 Art. 11, 12(2), 12(4)

Keyword:

Main request - inventive step (no)

Admittance - auxiliary requests 1 and 2, documents K7 and K8
(yes)

Remittal to the department of first instance (yes)



Beschwerdekammern

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Case Number: T 0221/20 - 3.2.05

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

Appellant: Koenig & Bauer AG
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Representative: Koenig & Bauer AG
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Respondent: Komori Corporation
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 26 November 2019 rejecting the opposition filed against European patent No. 2910374 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman P. Lanz
Members: B. Spitzer
K. Kerber-Zubrzycka

Summary of Facts and Submissions

- I. The opponent lodged an appeal against the decision of the opposition division to reject the opposition filed against European Patent No. 2 910 374 (the patent).
- II. The opposition was filed against the patent as a whole on the grounds of Article 100(a) together with Article 56 EPC (lack of inventive step) and Article 100(b) EPC.
- III. Oral proceedings before the board were held on 7 October 2022.

IV. *Requests*

The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed (main request) or, in the alternative, that the decision under appeal be set aside and that the patent be maintained as amended on the basis of auxiliary requests 1 or 2, both filed with the reply to the statement of grounds of appeal.

- V. Among the documents cited in the decision of the opposition division, the following are relevant for the appeal proceedings:

K1: EP 2 388 138 A1

K3: JP 2000062134 A and "Patent Abstract of Japan"

K3': Machine translation of document K3

K5: JP 4619287 B2

K5': Machine translation of document K5

K7: WO 2005/008606 A1

K8: EP 2 468 506 A1

VI. Independent claim 1 of the main request (patent as granted) has the following wording (with the parties' feature designations in brackets).

"1. **[M1]** A combination printing press comprising:

[M2] a number printing part including number printing means (116), the number printing means (116) having an impression cylinder (117) configured to hold and convey a sheet (W), a number cylinder (118) being in contact with a lower portion of the impression cylinder (117) and configured to perform number printing on the sheet (W) held by the impression cylinder (117), and ink supplying means (119) for supplying ink to the number cylinder (118);

[M3] a coating part having one-surface coating processing means (135) for coating one surface of the sheet (W) from the number printing part and other-surface coating processing means (126) for coating another surface of the sheet (W) from the number printing part; and

[M4] a sheet delivery part (140) having a plurality of stacking trays (143a, 143b, 143c) on which the sheet (W) from the coating part is stacked;

[M5] characterized in that the number printing part and the coating part are connected to each other only by a cylinder(120, 122)."

VII. Compared to claim 1 as granted, the following feature is added in independent claim 1 of auxiliary request 1.

"and in that the combination printing press further comprises checking means (124) for checking printing

quality of the sheet (W) after the sheet (W) is subjected to number printing in the number printing part and before the sheet is subjected to coating processing in the coating part."

Claim 1 of auxiliary request 2 adds the following feature to claim 1 of auxiliary request 1.

"and in that the plurality of stacking trays (143a, 143b, 143c) consists of:
two stacking trays (143a, 143b) for good items to which the sheets (W) whose printing state is determined to be normal as a result of checking by the checking means (124) are delivered as good items and
one stacking tray (143c) for defective items to which the sheets (W) whose printing state is determined to be abnormal as a result of checking by the checking means (124) are delivered as defective items."

VIII. The submissions of the parties relevant to the decision can be summarised as set out below.

(a) Main request: inventive step of the subject-matter of granted claim 1 in view of a combination of documents K3/K3' and K5/K5' (ground for opposition under Article 100(a) EPC and Article 56 EPC)

(i) Appellant (opponent)

Document K3/K3' as the starting point

Document K3/K3' was a suitable starting point. It related to the printing of securities and the reduction of space and operator's burden by combining several special machines in an inline process (see document K3/K3', paragraphs [0002] and [0005]). Figure 2 and

paragraphs [0036] to [0040] of document K3/K3' disclosed a combination of a double-sided offset printing unit and a number printing unit via transfer cylinders.

Differences

The only difference was the coating part (feature [M3]) and its inclusion in the printing machine (feature [M5]).

Objective technical problem

The objective technical problem was the protection of the numbered sheet. The improvement of quality was inherent and did not change the discussion of obviousness.

Obviousness of the solution

The person skilled in the art would have considered document K5/K5' for several reasons. Firstly, both documents K3/K3' and K5/K5' were based on the same concept, an inline process instead of separate machines. Secondly, these documents had an identical printing unit. Thirdly, in both documents, the transfer was done via cylinders. Document K5/K5' disclosed an offset printing unit and a double-sided coating unit (see document K5/K5', Figures 1 and 2). The fact that document K5/K5' disclosed an offset printing unit and not a number printing unit did not have any influence on the coating. Since both documents K3/K3' and K5/K5' disclosed transfer via cylinders, this transfer would also have been applied without modification to the transfer between the number printing part and the coating part. Thus, the person skilled in the art would

have arrived in an obvious way at the claimed invention.

(ii) Respondent (patent proprietor)

Document K3/K3' as the starting point

Document K3/K3' was concerned with the reduction of installation space and operator's burden, while the invention in suit was concerned with high registration accuracy (see patent in suit, paragraphs [0005], [0015], [0050]). Therefore, the person skilled in the art would not have chosen document K3/K3' as the closest prior art but document K1, which disclosed both a number printing part and a coating part.

Differences and objective technical problem

The differences with respect to document K3/K3' and the objective technical problem, i.e. the improvement of the quality and protection of a numbered sheet, as formulated by the opposition division was not contested.

Non-obviousness of the solution

The person skilled in the art would not have combined the teachings of documents K3/K3' and K5/K5'. Both documents related to inline processes and the reduction of installation space. An incorporation of the coater of document K5/K5' in the printing machine of document K3/K3' would have increased the installation space. Since this was in contradiction with the object of document K3/K3', the person skilled in the art would not have combined these teachings. There was no link between these documents. Rather, there was a technical

barrier since document K5/K5' did not disclose a number printing part. Instead of document K5/K5', the person skilled in the art would have considered document K1, which disclosed both a number printing and a coating part. The relationship between the number printing part and the coating part should be seen as highly relevant. Since no number printing part was present in document K5/K5', the assumption of the combination of documents K3/K3' and K5/K5' relied on hindsight.

Even if the person skilled in the art had combined these documents, it was not evident that they would have arrived at a combination printing press as claimed. There was no reason for combining the number printing part with the coating part via transfer cylinders. Since the transfer between a number printing part and a coating part was known from document K1, the person skilled in the art would have applied the transfer system of document K1, namely a complex chain system.

Furthermore, document K3/K3' disclosed number printing on only one side. The person skilled in the art would have applied the coating known from document K5/K5' only on the side of the number printing because the coating in document K5/K5' was done on both sides only due to the double-sided printing.

Starting from document K3/K3', the person skilled in the art had to make two non-obvious steps: firstly, to add a coating part and secondly, to implement it with high registration accuracy. Consequently, the subject-matter of granted claim 1 involved an inventive step over the combination of documents K3/K3' and K5/K5'.

- (b) Admittance of auxiliary requests 1 and 2, documents K7 and K8; remittal to the department of first instance for further prosecution

After the board had indicated during the oral proceedings that it seemed that auxiliary requests 1 and 2 and documents K7 and K8 had been admissibly raised and maintained in the proceedings leading to the decision under appeal under within the meaning of Article 12(4) RPBA 2020, the parties did not wish to further comment on these issues.

In its reply to the statement of grounds of appeal, the respondent requested to remit the case to the opposition division for the examination of auxiliary requests 1 and 2. The appellant had no objections against the requested remittal.

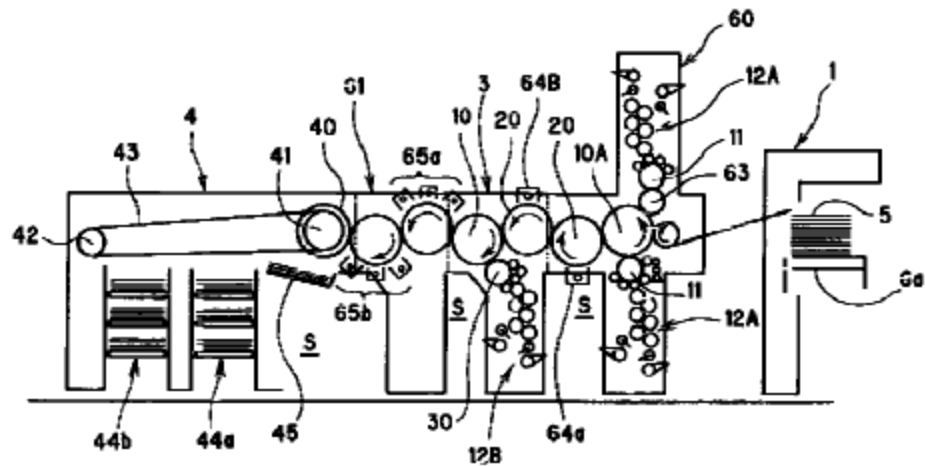
Reasons for the Decision

- 1. Main request: inventive step of the subject-matter of granted claim 1 in view of the combination of documents K3/K3' and K5/K5' (ground for opposition under Article 100(a) EPC and Article 56 EPC)

- 1.1 Disclosure of document K3/K3'

Document K3/K3' is a document from the same field as the patent in suit. It discloses a combination printing press comprising a double-sided offset printing part 60 and a number printing part 3 connected via a transfer cylinder 20 (see document K3/K3', paragraphs [0036] to [0038] and Figure 2, reproduced below). Thus, features [M1], [M2] and [M4] are anticipated by document K3/K3'. This was not disputed by the parties.

【図2】



In view of these similarities with the subject-matter of granted claim 1, document K3/K3' is a suitable starting point for the assessment of inventive step.

The respondent argued that "[i]n any case, K1 is the closest prior art document, not any of the other documents". In this regard, the board refers to the case law (see Case Law of the Boards of Appeal of the European Patent Office, 10th edn., July 2022, I.D.3.1. and I.D.3.4.) and points out that the starting point for the assessment of inventive step should be at least "promising", i.e. there is some probability of a skilled person arriving at the claimed invention. However, if the skilled person has a choice of several workable routes, i.e. routes starting from different documents which might lead to the invention, the rationale of the problem-solution approach requires that the invention be assessed relative to all these possible routes before an inventive step can be acknowledged. Consequently, there is no reason to exclude document K3/K3' as a starting point for the

assessment of inventive step.

1.2 Differences

In point 3.3.3 of the decision under appeal, the opposition division concluded that the subject-matter of granted claim 1 differed from the disclosure of document K3/K3' in that there is a double-sided coating part (feature [M3]) and that the number printing part and the coating part are connected to each other only by a cylinder (feature [M5]). This finding was not contested by the parties.

1.3 Objective technical problem

There is no dispute that the objective technical problem to be solved by the differentiating features [M3] and [M5] is to improve the quality and protection of a numbered sheet (see decision under appeal, Reasons, point 3.3.3).

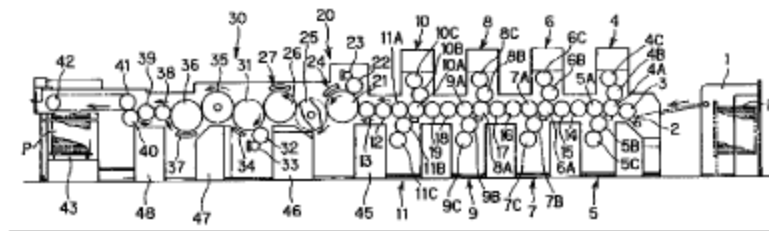
1.4 Obviousness for the person skilled in the art

The board has reached the conclusion that the subject-matter of granted claim 1 lacks an inventive step over the combination of documents K3/K3' and K5/K5' for the reasons set out below.

Document K5/K5' discloses a varnish coating device in a double-sided sheet-fed printing part (see document K5/K5', title). According to paragraph [0001] of document K5/K5', this document is related to a varnish coating apparatus that prevents stains and scratches while improving the appearance of printed matter by applying a varnish to a printed sheet in a double-sided sheet-fed printing press. As an example, plastic banknotes

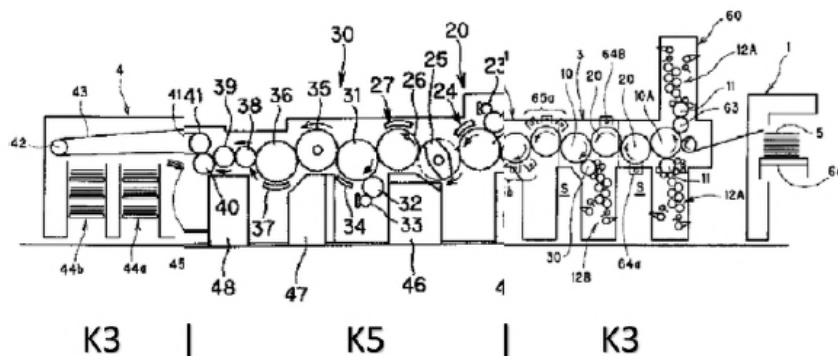
are mentioned (see document K5/K5', paragraph [0002]). Since document K5/K5' is from the same field and addresses the above-mentioned objective technical problem, the person skilled in the art would have considered document K5/K5'.

Document K5/K5' discloses in Figure 1 (reproduced below) surface printing units 4, 6, 8 and 10 and back side printing units 5, 7, 9 and 11. There are transfer cylinders 12 to 19 and, downstream, a surface varnish coating device 20 and a back side varnish coating device 30.



It is not disputed that document K5/K5' discloses a coating part according to feature [M3] and transfer cylinders. The board shares the appellant's view that the person skilled in the art would have incorporated the coating part of document K5/K5' into the one-pass printing press of document K3/K3' by using a transfer cylinder according to feature [M5]. Since transfer cylinders are used in both documents K3/K3' and K5/K5', the person skilled in the art would not have deviated from this concept. Thus, the person skilled in the art would have arrived in an obvious way at the subject-matter of granted claim 1, as illustrated by the appellant in the figure below (see statement of grounds

of appeal, annex 1).



1.5 Counter-argument: increased space contrary to the principle disclosed in document K3/K3'

The opposition division argued as set out below (see decision under appeal, Reasons, point 3.3.3):

"When finding a solution to this problem the skilled person must also take into account the principal goal of K3 in §[0007] to reduce an installation space and an operator's burden.

The documents K4 and K5, which do not disclose numbering devices, propose to enlarge the sheet printing apparatus with coating devices for coating both sides of the sheet.

This solution increases the space and complication of the apparatus and is therefore in conflict with the requirements of K3 to reduce space and operator's burden.

The skilled person would therefore not consider the

solution of K4 and K5 to solve the problem posed."

The board cannot accept this reasoning. It is true that the principal goal of document K3/K3' is the reduction of installation space and operator's burden (see document K3/K3', paragraph [0007]). This is solved in document K3/K3' by performing the different steps in one pass instead of using a plurality of dedicated machines for each purpose (see document K3/K3', paragraphs [0003] and [0007]). In document K5/K5', the different process steps, namely offset printing and coating, are also performed in one pass (see document K5/K5', Figure 1). Therefore, the teaching of document K5/K5' is not in contradiction to that of document K3/K3'. By implementing the double-sided coating unit of document K5/K5' in the process of document K3/K3', the person skilled in the art would not have deviated from the principle of production in one pass. On the contrary, it would have applied this principle also for the coating unit. Thus, the length of the machine would have increased. However, in comparison with single machine components, space and operator's burden would have been reduced. This being in line with the principal teaching of document K3/K3'.

- 1.6 Counter-argument: document K5/K5' does not disclose a number printing part

The argument that the person skilled in the art would not have considered document K5/K5' because it did not refer to number printing is not convincing. Although the respondent emphasised the importance of the relationship between the number printing part and the coating part, no specific arguments for this allegation were provided. The number printing unit is already known from document K3/K3'. Thus, the objective

technical problem is not aimed at number printing but at the protection of the number-printed sheet. In addition, both documents K3/K3' and K5/K5' disclose printing units and a one-pass process. Since these documents disclose the combination of a printing unit and a further unit via a transfer cylinder, the person skilled in the art would have had further incentive to consider document K5/K5'. Additionally, document K5/K5' addresses the objective technical problem of protection of sheets, such as plastic banknotes. Therefore, there was enough motivation for the person skilled in the art to consider document K5/K5'. Whether these sheets are numbered beforehand does not significantly influence the coating step. Consequently, it does not constitute a technical barrier that document K5/K5' does not disclose a number printing part.

1.7 Counter-argument: document K1 instead of document K5/K5'

The board does not agree with the respondent that the person skilled in the art would have instead turned to document K1, which disclosed both a number printing part and a coating part. Document K3/K3' discloses a number printing part. Number printing is not part of the objective technical problem. The person skilled in the art was not looking for a solution to number printing but for an improvement of the quality and protection of a numbered sheet. Moreover, the question is not whether the person skilled in the art, starting from document K3/K3', would have considered document K1, but whether they would have considered document K5/K5' and whether the teaching of this document would have rendered obvious the subject-matter of claim 1. Since this is indeed the case as explained above, it is not relevant whether the conclusion would be different

for a combination of documents K3/K3' and K1.

1.8 Counter-argument: high register accuracy for number printing

According to the respondent, a number printing part had high demands on accuracy and was not compatible with the printing unit of document K5. The board observes that in the current case the number printing part is already known from document K3/K3' and that the kind of printing upstream of the coating does not have any significant influence on the transfer of the sheet to the downstream coating unit, as submitted by the appellant. Apart from this, high-accuracy registration is not part of the objective technical problem.

1.9 Counter-argument: separate offline coating station

The board cannot share the respondent's view that the person skilled in the art combining the teachings of documents K3/K3' and K5/K5' would have provided a protective layer over the printed area in a separate offline coating station to solve the above-mentioned objective technical problem. Since document K3/K3' teaches a one-pass machine instead of single units (see document K3/K3', paragraphs [0007], [0031]), the person skilled in the art would not have had any reason to provide an offline coating station.

1.10 Counter-argument: coating on only one side

Document K3/K3' discloses a double-sided printed sheet. Even if the number printing is done only on one side (see document K3/K3', Figure 2: 3, 30), there is a double-sided offset printing unit (see document K3/K3': Figure 2: 60; paragraph [0036]). Therefore, the person

skilled in the art would have coated the sheet on both sides to protect both sides of the printed sheet as this is also done in document K5/K5' (see document K5/K5, paragraph [0009]).

1.11 Conclusion on inventive step

The subject-matter of granted claim 1 is not inventive over the combination of documents K3/K3' and K5/K5'. Consequently, the ground for opposition pursuant to Articles 100(a) and 56 EPC prejudices the maintenance of the patent as granted. The respondent's main request cannot be allowed.

2. Admittance of auxiliary requests 1 and 2 and documents K7 and K8

2.1 Auxiliary requests 1 and 2 were filed on 12 September 2019 within the time limit set by the opposition division in its summons to attend oral proceedings. Documents K7 and K8 were filed on 27 September 2019 by the opponent. The documents and auxiliary requests were re-filed in the statement of grounds of appeal and the reply to it, respectively.

2.2 The statement of grounds of appeal was filed on 24 January 2020, i.e. after the date of entry into force (1 January 2020) of the revised Rules of Procedure of the Boards of Appeal (RPBA 2020). Pursuant to Article 25(1) and (2) RPBA 2020, Article 12(4) to (6) RPBA 2020 applies to the case in hand.

2.3 Under Article 12(2) RPBA 2020, *"a party's appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based."* Furthermore, Article 12(4) RPBA 2020

states 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 unless the party demonstrates that this part was admissibly raised and maintained in the proceedings leading to the decision under appeal.

- 2.4 The decision under appeal was not based on auxiliary requests 1 and 2 under Article 12(2) RPBA 2020, and documents K7 and K8 were not discussed by the opposition division. However, as auxiliary requests 1 and 2 were filed within the time limit set by the opposition division in its summons and because the filing of documents K7 and K8 two weeks later constitutes a direct reaction to the submission of these amended requests, the board is satisfied that auxiliary requests 1 and 2 as well as documents K7 and K8 were admissibly raised in the proceedings leading to the decision under appeal. Moreover, auxiliary requests 1 and 2 and documents K7 and K8 were maintained until the department of first instance took its decision.

Therefore, in accordance with Article 12(4) RPBA 2020, auxiliary requests 1 and 2 and documents K7 and K8 are not to be regarded as an amendment to the parties' respective appeal cases. Since they are part of the appeal proceedings, the board has no discretion not to admit these requests and documents.

- 2.5 This conclusion is not only uncontested by the parties but also confirmed in the explanatory remarks to Article 12(4) RPBA 2020, which read:

"According to proposed new paragraph 4, parts of the statement of grounds of appeal or the respondent's reply, i.e. parts of a party's appeal case, which are

not directed to requests, facts, etc. on which the decision under appeal was based (see proposed new paragraph 2), are regarded as an amendment. In general, this definition of "amendment" also encompasses requests, facts, objections, arguments and evidence which the party submitted before the department of first instance but on which that department did not base its decision. However, if, on appeal, the party demonstrates that those requests, facts, etc., were admissibly raised, and were also maintained until the department of first instance took its decision, they will not be considered an amendment and, therefore, will be part of the appeal proceedings. Otherwise, this part of the appeal case will be regarded as an amendment and may only be admitted at the discretion of the Board." (see section VI. of document CA/3/19, Supplementary publication 2 - OJ EPO 2020, 56.)

3. Remittal

Auxiliary requests 1 and 2 and documents K7 and K8 filed in reaction to these requests were not assessed by the opposition division. The respondent requested that under these circumstances the case be remitted to the opposition division. The appellant had no objections against the requested remittal. The board, having considered the circumstances of the case, the parties' requests and their written submissions on auxiliary requests 1 and 2, concluded that there are special reasons within the meaning of Article 11 RPBA 2020 for remitting the case to the opposition division, in accordance with the request of the respondent.

Therefore, it is appropriate to remit the case to the opposition division for further prosecution under

Article 111(1), second sentence, EPC and Article 11
RPBA 2020.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated