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**Datasheet for the decision
of 9 February 2023**

Case Number: T 1064/20 - 3.2.05

Application Number: 11724794.0

Publication Number: 2571692

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B65H29/00, B41F33/00

Language of the proceedings: EN

Title of invention:
Printing press for numbering and varnishing of security
documents, including banknotes

Patent Proprietor:
KBA-NotaSys SA

Opponent:
Komori Corporation

Relevant legal provisions:
EPC Art. 56, 100(a), 100(b)

Keyword:

Inventive step - main request (yes)
Grounds for opposition - late-filed ground for opposition -
fresh ground for opposition (yes) - lack of clarity no ground
for opposition

Decisions cited:

G 0010/91, G 0003/14



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Case Number: T 1064/20 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 9 February 2023

Appellant:
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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 17 February
2020 rejecting the opposition filed against
European patent No. 2571692 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman P. Lanz
Members: M. Holz
 A. Bacchin

Summary of Facts and Submissions

I. The opponent appealed the opposition division's decision rejecting the opposition against European patent No. 2 571 692 (the patent).

II. The following documents submitted in the opposition proceedings are relevant to this decision:

E2: EP 0 976 555 A1

E4: WO 2006/129245 A2

E5: WO 2007/060624 A1

E6: GB 2 046 173 A

E7: DE 30 15 489 A1

E8: US 4,365,553

E9: GB 2 092 114 A

E10: US 4,852,491

E11: US 4,393,773

E12: EP 1 153 745 A1

E13: EP 1 916 107 A2

E14: EP 1 918 103 A1

By letter of 9 January 2023, the appellant (opponent) submitted the following document:

E15: JP 56 167457 A

III. Oral proceedings before the board were held on 9 February 2023.

IV. Final requests

The appellant (opponent) requested that the decision under appeal be set aside and the patent be revoked. Alternatively, the appellant requested that the decision under appeal be set aside and the case be remitted to the opposition division for further prosecution on the basis of auxiliary requests I to III.

The respondent (patent proprietor) requested that the appeal be dismissed (main request) or, as an auxiliary measure, that the decision under appeal be set aside and the patent be maintained as amended according to auxiliary request I, II or III filed with the reply to the appellant's statement of grounds of appeal.

V. Claim 1 as granted reads (the feature identification employed by the board is included in square brackets):

"[1] *A sheet-fed printing press*
[1.1] *for numbering*
[1.2] *and varnishing*
[1.3] *of security documents, including banknotes, comprising :*
[2] *- a sheet-feeder (01) for feeding in succession printed material in the form of individual sheets carrying multiple security imprints ;*
[3] *- a numbering group (02) comprising at least one numbering unit (21, 22) for numbering the sheets ;*
[4] *- a varnishing group (03; 03*)*
[4.1] *located downstream of said numbering group (02)*
[4.2] *for applying varnish onto recto and verso sides of said sheets, said varnishing group (03; 03*) comprising*

[4.3] *at least a first varnishing unit (31) for applying varnish on the recto side of the sheets*
[4.4] *and at least a second varnishing unit (32) for applying varnish on the verso side of the sheets ; and*
[5] *- a sheet-delivery system (04) for collecting varnished sheets coming from the varnishing group (03; 03*),*
[6] *wherein said numbering group (02) is coupled to said varnishing group (03; 03*)*
[6.1] *by means of an intermediate sheet gripper system (05)*
[6.2] *comprising endless chains and space-apart gripper bars mounted transversely to the path of the sheets, between the endless chains, for holding the sheets by a leading edge of the sheets and transporting the sheets from the numbering group (02) to the varnishing group (03; 03*)."*

VI. The parties' submissions relevant to this decision may be summarised as follows.

(a) *Main request: Ground for opposition under Article 100(a) EPC in combination with Article 56 EPC*

(i) *Appellant*

The subject-matter of claim 1 as granted did not involve an inventive step in view of document E5 or E7 as the closest prior art.

The subject-matter of claim 1 as granted differed from the content of document E5 in that the subject to be printed was limited to security documents, including banknotes, and in that double-sided coating was performed on security documents on which number

printing was performed (see features 1.3, 4, 4.1, 4.2, 4.3 and 4.4). The objective technical problem with regard to document E5 was how to carry out double-sided coating of security documents on which number printing had been performed. Document E2 disclosed a varnishing group 2A, 2B, 3A, 3B for applying varnish onto recto and verso sides of the sheets. The varnishing group comprised at least a first varnishing unit 2A, 2B for applying varnish on the recto side of the sheets and at least a second varnishing unit 3A, 3B for applying varnish on the verso side of the sheets (see Figures 1 to 4). The sheet on which varnish was applied on both sides was transported to a sheet piling board 20 by a sheet discharging chain 19. The technical problem underlying document E2 was how to apply a coating on both sides of a banknote. In document E5, a person skilled in the art would necessarily select security documents including banknotes as the subject to be printed. The same structure as defined in claim 1 as granted could be obtained by applying, to the sheet-fed printing press disclosed in document E5, the device (impression drum 3 and working cylinder 5, 6) for applying varnish onto the recto side of the sheet transported to the chain conveyor 2 disclosed in document E6 and the device (varnishing device and transport roller 28) for applying varnish onto the verso side of the sheet transported by the transport chain 26 disclosed in document E7.

The subject-matter of claim 1 as granted differed from the content of document E7 only by feature 6.2. Feature 1.3 merely concerned a difference of the matter to be printed by the printing press, this not being a feature of the printing press as such. The printing press of document E7 was suitable for numbering and varnishing security documents. Contrary to the

respondent's allegation, claim 1 did not require that multiple numbers be printed on a single sheet. It was sufficient if each sheet carried a single number. Regarding features 4.2 and 4.4, document E7 disclosed that the transport roller 28 could be used as a pressure cylinder for a coating unit (see page 11, lines 26 to 35). Accordingly, the second back side printing unit (reference numerals 30 to 33) arranged under the transport roller 28 could be designed as a back side coating unit. The second front side printing unit (see page 11, lines 13 to 17) arranged above the transport roller 28 could be designed as a front side coating unit. Document E15 corresponded to document E7 and used the Japanese word "ワニス装置" corresponding to "a coating unit". This Japanese word could also be interpreted as plural coating units because nouns in Japanese did not distinguish between singular and plural forms. Since a first varnishing unit for applying varnish onto the recto side of the sheets was already suggested in document E7, the verso side of the printed sheets was also to be varnished. Feature 6.1 was disclosed in document E7 since the sheets were moved by chain grippers between numbering unit 18 and varnishing unit 30 to 33.

Based on the assumption that features 4.2, 4.4 and 6.2 were the only differentiating features over document E7, the objective technical problem was to adapt the printing press of document E7 for further applications. Regarding features 4.2 and 4.4, a person skilled in the art of securities printing trying to achieve the aim of the contested patent of providing a sheet-fed or web-fed printing press that suitably combined numbering and varnishing in a single pass would have noticed that double-sided coating was essential. It was very straightforward to equip the

printing press shown in Figure 3 of document E7 with a varnishing unit for coating the opposite side of the sheets to achieve double-sided coating. Document E7 proposed arranging an additional printing unit on top of the printing unit comprising the components 30 to 33 (see page 11, lines 10 to 17). Therefore, it was a natural choice to use two varnishing units instead of these two printing units to coat both sides of the sheets. Document E7 was concerned with double-sided printing. Since document E7 already suggested varnishing the recto side of the sheets, this suggestion could thus extend to the verso side as well. In Figures 1, 2 and 3, document E7 presented a logical sequence of embodiments. The skilled person would have recognised that providing a coating on both sides of the sheet was the next logical step of this sequence. Document E7 was even very close to disclosing feature 4.4. To a person skilled in the art, it was a very small step, certainly not inventive, to include this feature. This was all the more true because double-sided varnishing was already known from, for example, document E2, paragraph [0003] and document E6, page 1, lines 88 to 110 and page 1, line 124 to page 2, line 3. It was a common requirement to apply double-sided coating onto a banknote. Accordingly, it would be obvious for a person skilled in the art to apply the apparatus performing recto-side coating disclosed in document E6 to the sheet-fed printing press performing number printing and verso-side coating to apply a coating onto both sides of a sheet on which number printing had been performed. Feature 6.2 was obvious in view of document E7 alone or in view of a combination of document E7 with any of documents E2, E5 and E8 to E14.

The subject-matter of dependent claims 2 to 5 and 7 to 16 as granted did not involve an inventive step either.

(ii) *Respondent*

The subject-matter of the claims as granted involved an inventive step.

In addition to the differentiating features identified by the appellant, the subject-matter of claim 1 as granted differed from document E5 by feature 1.2 since the printing press of document E5 was not suitable for varnishing documents. Document E5 also failed to disclose features 6, 6.1 and 6.2 since the numbering group was not coupled to a varnishing group. The objective technical problem was to further process the sheets numbered in the printing press of document E5, at most to refine and/or protect them. Document E2 related to offset printing and thus to a different printing technology than document E5. The skilled person would not have combined documents E5 and E2. Even if they had, they would not have arrived at the subject-matter of claim 1 in an obvious manner. Starting from document E5, it was not obvious to consider double-sided coating in view of document E6 either.

The subject-matter of claim 1 as granted differed from the content of document E7 by features 1.3, 4.2, 4.4, 6.1 and 6.2. The printing press defined in claim 1 was for numbering and varnishing security documents, including banknotes (see feature 1.3). Document E7, however, did not address printing security documents. According to feature 2, the sheets carried multiple security imprints. The skilled person knew that each

security imprint may be provided with an individual number. The printing machine of document E7 was, however, not suitable for providing a single sheet with multiple numbers and therefore was not suitable for printing security documents as required by feature 1.3. The passages on page 11, lines 13 to 17 and page 11, lines 26 to 35 of document E7, cited by the appellant regarding features 4.2 and 4.4, referred to different embodiments that could not be combined. There was no disclosure in document E7 for cylinder 28 being the transmission cylinder of a varnishing unit. Document E7 also failed to disclose an intermediate sheet gripper system (see feature 6.1) in combination with a sheet-delivery system (see feature 5). The sheet gripper system in document E7 could not be considered to be intermediate since it did not only transport the sheets between two units but also beyond them.

The objective technical problem in view of document E7 was how to adapt the printing press of document E7 for further applications. Document E7 referred primarily to printing units rather than varnishing units. It did not suggest using two varnishing units, let alone two varnishing units for applying varnish to both sides of the sheets. Document E7 did not prompt the skilled person to use the printing press of document E7 for printing security documents, let alone bank notes, either. Document E2 was concerned with bank notes and would therefore not have been considered by the skilled person starting from document E7. In document E2, transfer cylinders were provided to transport the sheets. This was considerably different from the chain gripper system of document E7. Also for this reason, the skilled person would not have combined documents E7 and E2. Document E7 concerned a completely different technical problem than documents E2 and E6. The claimed

subject-matter was therefore not suggested by a combination of document E7 with document E2 or E6. The appellant's submissions were based on unallowable hindsight.

(b) *Main request: Ground for opposition under Article 100(b) EPC*

(i) *Appellant*

The patent did not sufficiently describe the subject-matter of claims 5, 6, 7 and 17 as granted to enable a person skilled in the art to carry them out.

(ii) *Respondent*

The respondent did not agree to admitting the ground for opposition under Article 100(b) EPC into the appeal proceedings.

(c) *Main request: Alleged lack of clarity*

The appellant submits that the subject-matter of claims 5, 6, 7 and 17 as granted was not clear.

Reasons for the Decision

1. Main request: Ground for opposition under Article 100(a) EPC in combination with Article 56 EPC

The appellant takes the view that the subject-matter of granted claim 1 does not involve an inventive step in view of document E5 or E7 as the closest prior art.

1.1 *Inventive step in view of document E5 as the closest prior art*

The appellant submits that the subject-matter of claim 1 as granted differed from the content of document E5 by features 1.3, 4, 4.1, 4.2, 4.3 and 4.4. The board shares the view that document E5 does not disclose these features.

The appellant considers that the objective technical problem with regard to document E5 is how to carry out double-sided coating of security documents on which number printing has been performed.

The board does not share this view. In accordance with established case law (see also "Case Law of the Boards of Appeal of the European Patent Office", Tenth Edition, July 2022 (Case Law), I.D.4.2.1), the technical problem addressed by an invention has to be formulated in such a way that it does not contain pointers to the solution or partially anticipate the solution since including part of a solution offered by an invention in the statement of the problem necessarily results in an *ex post facto* view being taken of inventive step when the state of the art is assessed in terms of that problem.

The formulation of the objective technical problem suggested by the appellant involves a rewording of features 4 to 4.4. Contrary to the above case law, this formulation thus anticipates the solution and is therefore inappropriate.

The respondent submits that the subject-matter of claim 1 differed from document E5, in addition to the

features identified by the appellant, by feature 1.2 (since the printing press of document E5 was not suitable for varnishing documents) and features 6, 6.1 and 6.2 (since the numbering group was not coupled to a varnishing group).

The board shares the respondent's view. Document E5 does not disclose a printing press for varnishing security documents as required by feature 1.2. Moreover, document E5 discloses the use of a "typical" chain gripper system with chain-driven gripper bars for holding a leading edge of the printed sheets (see the last paragraph on page 4). However, it is not disclosed that this chain gripper system is used for coupling the numbering group to a varnishing group and for transporting the sheets from the numbering group to the varnishing group as defined in features 6, 6.1 and 6.2.

In summary, document E5 does not disclose features 1.2, 1.3, 4, 4.1, 4.2, 4.3, 4.4, 6, 6.1 and 6.2.

The respondent considers that the objective technical problem is to further process the sheets numbered in the printing press of document E5, at most to refine and/or protect them.

Applying varnish has the technical effect of protecting the manufactured sheets. In the board's view, the objective technical problem is therefore how to modify the printing press of document E5 to provide protection for the sheets.

According to the appellant, document E2 discloses a varnishing group 2A, 2B, 3A, 3B for applying varnish onto recto and verso sides of the sheets. The varnishing group comprised at least a first varnishing

unit 2A, 2B for applying varnish on the recto side of the sheets and at least a second varnishing unit 3A, 3B for applying varnish on the verso side of the sheets (see Figures 1 to 4). The sheet on which varnish was applied on both sides was transported to a sheet piling board 20 by a sheet discharging chain 19. Document E2 suggested applying a double-sided coating on a banknote as the problem to be solved.

As correctly set out by the appellant, document E2 discloses the coating of sheets with varnish in the context of manufacturing banknotes. The board, however, notes that document E5 does not disclose or hint at using the described printing press for printing banknotes. The problem of applying double-sided coating on a banknote, which the appellant considers to be suggested by document E2, is thus not a problem that the skilled person would have addressed in an obvious manner when starting from document E5. The skilled person starting from document E5 would not have been prompted to consider document E2.

This view is unaffected by the fact that printing security documents, including banknotes, as such is known to the skilled person. The mere knowledge that there are printing presses that are used for manufacturing security documents in itself does not allow the conclusion that the skilled person starting from document E5 and trying to solve the above objective technical problem would have considered using the printing machine of document E5 for printing security documents and, moreover, would have considered excising and implementing features of document E2 in this printing machine in an obvious manner. The appellant alleges that a person skilled in the art would necessarily have selected security documents,

including banknotes, as the subject to be printed. No explanations or evidence to support this allegation have been provided. The appellant has not convincingly shown that it would have been obvious to the skilled person starting from document E5 to use the printing press of document E5 for numbering and varnishing banknotes.

It was therefore not obvious to the skilled person to consider document E2 when starting from document E5 and trying to solve the above objective technical problem.

Even if the skilled person had considered document E2 when starting from document E5, they would not have been led to the subject-matter of claim 1 in an obvious manner. Document E2 suggests the double-sided coating of banknotes based on the consideration that a banknote is printed on both sides (see paragraph [0003]). However, document E5 does not relate to sheets printed on both sides, let alone banknotes. Also, document E2 does not suggest applying varnish on both sides in cases where only one side of the sheet has been numbered.

Also for this reason, the subject-matter of claim 1 involves an inventive step in view of a combination of documents E5 and E2.

According to the appellant, the same structure as defined in claim 1 as granted could be obtained by adding to the sheet-fed printing press disclosed in document E5 the device for applying varnish onto the recto side of the sheet transported to the chain conveyor 2 disclosed in document E6 and the device for applying varnish onto the verso side of the sheet

transported by the transport chain 26 disclosed in document E7.

When considering whether the claimed subject-matter constitutes an obvious solution to an objective technical problem, the question to be answered is whether the skilled person, in the expectation of solving the problem, would have modified the teaching in the closest prior-art document in light of other teachings in the prior art to arrive at the claimed invention (see also Case Law, I.D.5.). Technical feasibility and the absence of obstacles are only requirements for reproducibility; they are not sufficient to render obvious what is actually achievable for the skilled person. The fact that the inherent properties of a technical means were known to the skilled person, meaning that it was intellectually possible for them to apply this means to a conventional device, merely establishes the possibility of using this technical means in such a manner, i.e. that the skilled person could have used it. However, if it is to be established that this intellectual possibility is also a technical measure obvious for the skilled person to use, it is necessary to show that there is a recognisable pointer in the state of the art to combine the known means and conventional device for achieving the intended technical aim, i.e. that the skilled person would have made such a combination. The existence of such a technical reason is dependent on the known properties not only of the means but also of the device. It being theoretically possible for the skilled person to arrive at the invention simply means that they could have used the requisite technical means. If, however, it is to be established that they would have used it, a pointer in the prior art must be found which would have prompted them to do so.

The appellant's allegation that a structure falling within the definition of claim 1 as granted could be obtained by applying to the printing machine disclosed in document E5 a device disclosed in document E6 and additionally a further device disclosed in document E7 is not sufficient to demonstrate that the skilled person would actually have considered such a modification.

In view of the above, it was not obvious to the skilled person starting from document E5 and trying to solve the above objective technical problem to consider providing first and second varnishing units for applying varnish on the recto and verso sides of the sheets as defined in features 4.3 and 4.4. For this reason alone, the subject-matter of claim 1 as granted involves an inventive step in view of document E5 as the closest prior art. Thus, the question of if the other differentiating features of claim 1 identified above were obvious to the skilled person in view of document E5 can be left open.

1.2 *Inventive step in view of document E7 as the closest prior art*

1.2.1 *Differentiating features*

It is common ground between the parties that document E7 does not disclose feature 6.2 of claim 1 as granted.

The respondent perceives a further difference in that the claimed printing press was for numbering and varnishing security documents, including banknotes (see

feature 1.3). Document E7 did not address printing security documents. According to feature 2, the sheets carried multiple security imprints. The skilled person knew that each security imprint may be provided with an individual number. The printing machine of document E7 was not suitable for providing a single sheet with multiple numbers and therefore was not suitable for printing security documents as required by feature 1.3.

The appellant submits that feature 1.3 merely concerned a difference of the matter to be printed by the printing press, this not being a feature of the printing press as such. Claim 1 did not require that multiple numbers be printed onto a single sheet. The printing press of document E7 was suitable for numbering and varnishing security documents.

In the board's view, feature 1.3 pertains to a functional feature requiring that the claimed printing press be suitable for numbering and varnishing security documents, including banknotes. The functional definition of feature 1.3 does not imply any mandatory technical features that are not (at least implicitly) present in the printing press of document E7. The respondent's submission that sheets carrying multiple security imprints were often provided with multiple numbers does not change this view. The respondent has not convincingly shown that the skilled person would consider this a mandatory feature of the printing press defined in claim 1.

Feature 1.3 is thus disclosed in document E7.

The skilled person considers the chain gripper system of document E7 an intermediate chain gripper system as defined in feature 6.1. Neither feature 6.1 itself nor

claim 1 as a whole excludes the possibility that the intermediate chain gripper system is combined with the sheet-delivery system defined in feature 5 to form an overall chain gripper system transferring the sheets across multiple units.

Feature 6.1 is therefore disclosed in document E7.

The appellant is of the opinion that features 4.2 and 4.4 were disclosed in document E7. The transport roller 28 could be used as a pressure cylinder for a coating unit (see page 11, lines 26 to 35). Accordingly, the second back side printing unit (reference numerals 30 to 33) arranged under the transport roller 28 could be designed as a back side coating unit. The second front side printing unit (see page 11, lines 13 to 17) arranged above the transport roller 28 could be designed as a front side coating unit.

The board is not convinced by this view. The passages on page 11, lines 13 to 17 and page 11, lines 26 to 35 cited by the appellant concern different embodiments. There is no suggestion in document E7 that isolated features disclosed in the context of these different embodiments are to be combined. The hypothetical possibility that the second front side printing unit arranged above the transport roller 28 could be designed as a front side coating unit is not sufficient to demonstrate that this was unambiguously and directly derivable from document E7.

This view is not altered by the appellant's reference to document E15. Document E7 is in German and does not include any reference to document E15 regarding the German term "Lackierwerk" used on page 11, line 33. The

skilled person would not have consulted document E15 to interpret the content of document E7 in this regard. Nor would they have referred to the meaning of the Japanese word "ワニス装置" for this purpose.

Features 4.2 and 4.4 are therefore not disclosed in document E7.

The subject-matter of claim 1 as granted thus differs from the content of document E7 by features 4.2, 4.4 and 6.2.

1.2.2 *Objective technical problem*

It is common ground between the parties that the objective technical problem in view of document E7 may be formulated as how to adapt the printing press of document E7 for further applications. The board shares this view.

1.2.3 *Obviousness*

Regarding features 4.2 and 4.4, the appellant sets out that a person skilled in the art of securities printing trying to achieve the aim of the patent of providing a sheet-fed or web-fed printing press that suitably combined numbering and varnishing in a single pass would have realised that double-sided coating was essential.

The board does not share this view. The appellant has not provided any evidence to support its allegation that the skilled person starting from document E7 would have realised that double-sided coating was essential.

The appellant submits that it was very straightforward to equip the printing press shown in Figure 3 of document E7 with a varnishing unit for coating the opposite side of the sheets to achieve double-sided coating.

However, even if such a modification was easily made, this by itself does not imply that it was obvious to the skilled person.

Nor does the board share the appellant's view that providing a coating on both sides of the sheet was the next logical step of the sequence suggested by Figures 1, 2 and 3 of document E7. In document E7, the sequence of Figures 1 to 3 continues with Figures 4 and 5, which do not disclose providing a double-sided coating as suggested by the appellant. Moreover, the appellant has not provided any evidence for the allegation that the skilled person would consider providing a coating on both sides of the sheet to be the next logical step of the sequence suggested by Figures 1, 2 and 3.

The appellant sets out that document E7 proposed arranging an additional printing unit on top of the printing unit comprising the components 30 to 33 (see page 11, lines 10 to 17). Therefore, it was a "natural choice" to use two varnishing units instead of these two printing units to coat both sides of the sheets.

The appellant, however, has not provided any evidence to support this allegation. In contrast, replacing two printing units by two varnishing units was not suggested by document E7.

The appellant submits that document E7 was concerned with double-sided printing. Since document E7 already suggested varnishing the recto side of the sheets, this suggestion might extend to the verso side as well. In other words, document E7 was even very close to disclosing feature 4.4. To a person skilled in the art, it was a very small step, certainly not inventive, to include this feature. This was all the more true because double-sided varnishing was already known from, for example, document E2.

The board, however, observes that in document E7, the coating module ("Lackierwerk") is only mentioned in the context in which a drum serving both as a transport drum and as a cylinder of a counter-pressure unit is used as an impression cylinder of a numbering, imprinting or coating unit arranged above the high-pile delivery unit (see page 11, lines 26 to 35). The skilled person would not have understood this as a suggestion to apply varnish on both sides of the sheet as defined in features 4.2 and 4.4. Nor is the appellant's estimation that these differentiating features represented a very small step sufficient for demonstrating that they were obvious to the skilled person starting from document E7.

The appellant submits that document E2 disclosed double-sided coating units 2A, 2B, 3A, 3B including a cylinder/drum transportation system. In paragraph [0003], document E2 suggested applying double-sided coating on a banknote as the problem to be solved. Thus, it would be obvious for a person skilled in the art to combine document E2 with document E7.

The board does not share this view. Document E2 does not suggest a solution to the above objective technical

problem of adapting the printing press of document E7 for further applications. The offset printing press of document E2 differs considerably from the printing press disclosed in document E7, as submitted by the respondent. The skilled person would therefore not have consulted document E2 when starting from document E7 and trying to solve the above objective technical problem. However, even if they had, they would not have found any solution to this objective technical problem, let alone the solution defined in claim 1 as granted.

In the cited passage in paragraph [0003] of document E2, the provision of double-sided printing is linked to printing banknotes. While its structural and functional features render the printing press of document E7 suitable for printing security documents, including banknotes, document E7 does not hint at using the printing press for this purpose. The mere fact that double-sided coating of banknotes is known from document E2 is therefore not sufficient to motivate the skilled person to use the printing press of document E7 for printing banknotes or, more importantly, to further develop the printing press of document E7 for the purpose of double-sided printing banknotes.

The appellant submits that it was a common requirement to apply double-sided coating onto a banknote. Accordingly, it would be obvious for a person skilled in the art to apply the additional apparatus that performed recto side coating disclosed in document E6 to the sheet-fed printing press that performed number printing and verso side coating to perform double-sided coating onto a sheet on which number printing had been performed.

Even if it was a common requirement to apply double-sided coating onto a banknote, this would not render this feature obvious in view of document E7 since this document does not disclose that the printing press is used for manufacturing banknotes. This also holds true in view of the fact that this printing press is suitable for printing security documents, including banknotes. Moreover, neither document E6 nor document E7 suggests applying varnish on recto and verso sides of a sheet as required by feature 4.2. Therefore, the question whether this could be carried out using the apparatus of document E6 does not arise.

For these reasons, the skilled person starting from document E7 would not have considered providing a second varnishing unit for applying varnish on the verso side of the sheets (see features 4.2 and 4.4) in an obvious manner. The subject-matter of claim 1 as granted therefore involves an inventive step in view of document E7 for this reason alone.

Thus, the question whether feature 6.2 was obvious to the skilled person in view of document E7 alone or in view of a combination of document E7 and one of the documents cited by the appellant in this regard, including documents E5 and E11, can be left open. Even if the appellant's view on feature 6.2 were accepted, this would not result in the subject-matter of claim 1 as granted (including features 4.2 and 4.4) being considered obvious over document E7.

1.3 *Dependent claims: Inventive step*

The appellant objects that the subject-matter of dependent claims 2 to 5 and 7 to 16 did not involve an inventive step.

Since claims 2 to 5 and 7 to 16 are dependent on claim 1 as granted and since the subject-matter of claim 1 as granted involves an inventive step (see above), this also applies to the subject-matter of claims 2 to 5 and 7 to 16.

1.4 *Conclusion on the ground for opposition under Article 100(a) EPC in combination with Article 56 EPC*

The subject-matter of claims 1 to 5 and 7 to 16 as granted involves an inventive step. Consequently, the ground for opposition under Article 100(a) EPC in combination with Article 56 EPC does not prejudice the maintenance of the patent as granted.

2. Main request: Ground for opposition under Article 100(b) EPC

The appellant considers that the patent did not sufficiently describe the subject-matter of claims 5, 6, 7 and 17 as granted to enable a person skilled in the art to carry them out.

The ground for opposition under Article 100(b) EPC was not raised during the opposition proceedings. It was submitted for the first time in the statement of grounds of appeal and thus constitutes a fresh ground

for opposition. As explained in point 7 of the board's communication pursuant to Article 15(1) RPBA 2020, this fresh ground for opposition can only be introduced into the appeal proceedings with the agreement of the patent proprietor (see opinion G 10/91, Reasons 18). The respondent did not agree to admit the ground for opposition under Article 100(b) EPC into the appeal proceedings. Thus, the board has no power to examine this ground for opposition.

Therefore, the ground for opposition under Article 100(b) EPC is not admitted into the appeal proceedings.

3. Main request: Alleged lack of clarity

The appellant submits that the subject-matter of claims 5, 6, 7 and 17 of the granted patent was not clear.

As explained in point 8 of the board's communication pursuant to Article 15(1) RPBA 2020, an alleged lack of clarity is not a ground for opposition under Article 100 EPC which may be raised against a granted patent (see decision G 3/14, Reasons 80.(i)). At the oral proceedings before the board, the appellant merely referred to its written submissions, without providing any argument to rebut this view. Therefore, the board is not in a position to examine this objection.

The objection of lack of clarity is thus not admissible.

4. Conclusions

In view of the above, none of the grounds for opposition raised by the appellant prejudices the maintenance of the patent as granted. The appeal therefore had to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated