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**Datasheet for the decision
of 26 April 2023**

Case Number: T 1333/20 - 3.2.07

Application Number: 12829296.8

Publication Number: 2754506

IPC: B05D7/24, B05D1/26, B32B27/00,
B41M5/00, B41M7/00

Language of the proceedings: EN

Title of invention:
UV INK PRINTING METHOD

Patent Proprietor:
Mimaki Engineering Co., Ltd.

Opponent:
Heidelberger Druckmaschinen AG

Headword:

Relevant legal provisions:
EPC Art. 100(b), 100(c), 111(1)
RPBA 2020 Art. 11, 12(3), 12(5), 13(1)

Keyword:

Grounds for opposition - insufficiency of disclosure (no) -
added subject-matter (no)
Remittal - special reasons for remittal - (yes)
Reply to statement of grounds of appeal - party's complete
appeal case
Amendment to appeal case - exercise of discretion - admitted
(no)
Discretion not to admit submission - requirements of Art.
12(3) RPBA 2020 met (no) - submission admitted (no)

Decisions cited:

T 0182/89, T 0019/90

Catchword:



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Case Number: T 1333/20 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 26 April 2023

Appellant: Mimaki Engineering Co., Ltd.
(Patent Proprietor) 2182-3, Shigeno-Otsu
Tomi-City, Nagano 389-0512 (JP)

Representative: Bandpay & Greuter
30, rue Notre-Dame des Victoires
75002 Paris (FR)

Respondent: Heidelberger Druckmaschinen AG
(Opponent) Kurfürsten-Anlage 52-60
69115 Heidelberg (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 25 March 2020
revoking European patent No. 2754506 pursuant to
Article 101(3)(b) EPC.**

Composition of the Board:

Chairman A. Pieracci
Members: A. Cano Palmero
J. Hoppe

Summary of Facts and Submissions

- I. The patent proprietor (appellant) lodged an appeal against the decision of the opposition division revoking European patent No. 2 754 506.
- II. The opposition was based on all grounds of opposition pursuant to Article 100 EPC.
- III. The opposition division found *inter alia*
 - (a) that the ground for opposition pursuant to Article 100(c) EPC did not prejudice the maintenance of the patent as granted;

but
 - (b) that the ground for opposition pursuant to Article 100(b) EPC prejudiced the maintenance of the patent as granted and in the form of all auxiliary requests, see specially points 4.1 and 4.5 of the reasons.
- IV. The Board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Rule 100(2) EPC dated 18 November 2021, according to which the decision under appeal could be set aside and the case could be remitted to the opposition division for further prosecution.
- V. The respondent replied on the substance to this communication with letter dated 10 March 2022 and submitted documents B1 to B5.

VI. On 28 March 2022 the Board summoned the parties to oral proceedings. In preparation for oral proceedings, scheduled upon both parties' requests, the Board confirmed its preliminary assessment of the case to the parties on 25 October 2022 by means of a communication pursuant to Article 15(1) RPBA 2020, and indicated that the amendment of the respondent's case submitted with letter dated 10 March 2022 was likely not to be admitted into the proceedings under Article 13(1) RPBA 2020.

VII. Oral proceedings before the Board were held on 26 April 2023. At the conclusion of the proceedings the decision was announced. For further details of the oral proceedings, in particular the issues discussed with the parties, reference is made to the minutes.

VIII. The final requests of the parties are as follows:

for the patent proprietor (appellant):

that the decision be set aside and the case be remitted to the opposition division for further prosecution based on the patent as granted (main request), or as an auxiliary measure based on one of the sets of claims according to auxiliary requests 1 to 7, filed with the grounds of appeal,

for the opponent (respondent):

that the appeal be dismissed.

The appellant additionally requested not to admit the new submissions of the respondent filed with letter dated 10 March 2022.

IX. The following evidence has been filed by the respondent with letter of 10 March 2022, *i.e.* after the filing of the reply to the statement setting out the grounds of appeal:

B1: Helmut Kipphan - Handbuch der Printmedien
(excerpts);

B2: Römpf-Lexikon "Lacke und Druckfarben" (keywords "Farbstrahldruck", "UV-Härtung", "Druckfarbentrocknung");

B3: DE 10 2012 016 690 A1;

B4: Wikipedia (keyword "Druckfarbe");

B5: Römpf Chemie Lexikon (keyword "Klebstoffe").

X. The lines of arguments of the parties relevant for the present decision, which are focused on the sufficiency of disclosure of the patent as granted and on the admittance of some of respondent's submissions, are dealt with in detail in the reasons for the decision.

XI. Independent **claim 1** of the patent as granted reads:

"A printing method comprising:

printing an adhesive primer with an inkjet recording apparatus to form a primer layer on a substrate; and

printing a UV ink with the inkjet recording apparatus to form a UV ink coating on the adhesive primer layer, the UV ink exhibiting a surface hardness higher than a pencil hardness H upon being cured, wherein the method comprises the steps of: printing a primer containing a UV curable adhesive paste on the substrate by the inkjet recording apparatus, whereby the adhesive primer layer is formed;

radiating UV light to the primer layer, whereby the primer layer is cured while remaining adhesive; printing the UV ink onto the top surface of the primer layer by the inkjet recording apparatus to form the UV ink coating; and radiating UV light onto the UV ink coating, whereby the UV ink coating is cured."

XII. **Claim 3** of the patent as granted reads:

"The method according to claim 1 or 2, wherein the UV ink comprises monomers and the primer layer is UV curable and not solvent resistant, wherein the step of printing the UV ink onto the top surface of the primer layer comprises melting and adhering the primer layer to the UV ink."

XIII. Since the wording of the other claims of the patent as granted and of the auxiliary requests is not relevant for the present decision, there is no need to reproduce it here.

Reasons for the Decision

1. *Patent as granted - Sufficiency of disclosure, Article 100(b) EPC*
- 1.1 Admittance of the amendment of the respondent's appeal case, Article 13(1) RPBA 2020
- 1.1.1 The respondent submitted for the first time in appeal proceedings with its letter dated 10 March 2022 evidence B1 to B5 and arguments based on these documents with respect to lack of sufficiency of disclosure of the invention according to claims 1 and 3 of the patent as granted (see point 2 of this letter,

page 2, last paragraph to page 4 first paragraph), as well as other reasoned objections on sufficiency against claims 1, 4 and 5 as granted (see second to fifth paragraph on page 4 of this letter).

- 1.1.2 Since these objections and evidence have been submitted by the respondent for the first time in appeal proceedings after its filing of the reply to the statement setting out the grounds of appeal, they constitute an amendment to the respondent's appeal case, the admittance of which is subject to the discretion of the Board under Article 13(1) RPBA 2020.
- 1.1.3 The respondent argued that the filing of these documents was triggered by the preliminary opinion of the Board, which noted that there were no serious doubts substantiated by verifiable facts that could demonstrate a lack of sufficiency of disclosure. Furthermore, documents B1 to B5 did not amount to a fresh argumentation compared to the respondent's reply to the statement setting out the grounds of appeal and only reflected the common general knowledge of the skilled person.
- 1.1.4 The Board is not persuaded by the arguments of the respondent and is rather of the conviction that the respondent/opponent could and should have submitted its complete case, *i.e.* by filing alleged proof of common general knowledge and the objections based thereon, at least when forming its appeal case with its reply to the statement setting out the grounds of appeal. The preliminary opinion as set out in the board's communication did not come as a surprise but merely elaborated the appellant's arguments which was also confirmed by the respondent in the oral proceedings. The appellant had already focused on insufficient

evidence as regards Article 100(b) EPC not only in the opposition proceedings but also with the statement setting out the grounds of appeal, where also relevant case law of the Boards of Appeal had been cited. Thus, according to Article 12(3) RPBA 2020, the respondent could and should have presented its complete case, including the relevant evidence it wished to rely on, at least with its reply to the appeal.

In addition, taking into account that the opposition and the appeal case are focused on the patent as granted, the Board is of the view that the respondent would have been in place to make this submissions already during the opposition proceedings when it chose to base its opposition case *inter alia* on the ground under Article 100(b) EPC.

1.1.5 In the absence of any convincing reasons for submitting the amendment at this stage of the proceedings the Board, exercising its discretion under Article 13(1) RPBA 2020, does not admit this amendment of the respondent's case into the proceedings.

1.2 Claim 1

1.2.1 The opposition division found (point 4.1.2 of the reasons of the decision under appeal) that the evidence R1 ("**Top 10 uses for UV curing adhesives**", from **www.ellsworthadhesives.co.uk**), provided by the appellant-patent proprietor, did not show a UV-curable adhesive in accordance with claim 1 as granted, and expressed its "opinion" that **UV-curable adhesives that remain adhesive even after UV curing are not generally known to the skilled person**. The opposition division concluded that the patent was not sufficiently disclosed following the arguments of the respondent

(then opponent), *i.e.* that the patent in suit was silent on how the "adhesive paste" must be obtained or how it must be used in order to obtain a primer that is adhesive even after UV curing (see point 4.1 of the reasons of the decision under appeal).

The opposition division accepted the respondent-opponent's line of argument that the patent does not provide information on the primer to be used, for example in terms of its chemical composition, so that the skilled person is not able to carry out the invention (see point 4.1 of the reasons of the decision under appeal). Further, according to the respondent (see second full paragraph of page 3 of the reply to the statement of grounds of appeal), the appellant has still not convincingly set out in the statement of grounds of appeal which UV-curable primers in the method of claim 1 still remain adhesive after UV curing and/or which steps must be carried out in the process of claim 1 to ensure that the primer remains adhesive after UV curing.

- 1.2.2 The Board disagrees with the findings of the opposition division and with the arguments of the respondent regarding this point. As correctly indicated by the appellant, it is established jurisprudence of the Boards of Appeal that an objection of lack of sufficiency disclosure presupposes that there are serious doubts substantiated by verifiable facts. **The burden of proof is upon the opponent(s)** to establish on the balance of probabilities that a person skilled in the art, using its common general knowledge, would be unable to carry out the invention (see the Case Law of the Boards of Appeal of the European Patent Office [CLB], 10th edition 2022, II.C.9, first two paragraphs, in particular in relation to T 19/90 and T 182/89).

The Board further notes that it is also established case law of the Boards of Appeal that even in the case that the patent would not give any information as to how a feature of the invention can be put into practice, the burden of proof does not automatically shift to the patent proprietor, rather the opponent still bears the burden to argue in a plausible manner that the common general knowledge would not enable the skilled person to carry out the invention (see CLB, *supra*, II.C.9.1).

1.2.3 In the Board's view, the "opinion" of the opposition division that UV-curable adhesives as required by claim 1 "are not generally known to the skilled person" is in the first place to be considered as a mere unsubstantiated assertion. Furthermore, even if this "opinion" could be considered as being a substantiated fact, it would still not amount to a lack of sufficiency of disclosure. The fact that a particular material is not *generally* known to the skilled person, or that it is not specifically shown by document R1, does not prove that such a material is not available for the skilled person and that consequently the invention cannot be carried out. Moreover, the absence of details on the chemical composition of the primer or its use does not result in an insufficiency of disclosure.

1.2.4 The respondent additionally argued in the reply to the statement of grounds of appeal that UV-curable adhesives, even if they were known to the skilled person, would be either unsuitable to be used in a printing method (page 2, paragraphs 2 to 6) or would not meet the requirements specified in paragraphs [0009] to [0013] and [0019] of the description of the

patent in suit (page 3 third and fourth full paragraphs). The Board, in the absence of any admissibly filed verifiable facts, sees this alleged lack of suitability as mere unsubstantiated statements that cannot justify an objection of insufficiency of disclosure.

1.2.5 The Board concludes that in the present case, the respondent has neither admissibly and convincingly demonstrated that common general knowledge would not enable the skilled person to provide a primer adhesive layer that remains adhesive after UV-curing nor has admissibly submitted serious doubts, substantiated by admissibly filed verifiable facts that could demonstrate the skilled person is not in place of carrying out the invention in accordance with claim 1 as granted.

1.3 Claim 3

1.3.1 The opposition division found in point 4.5 of the reasons for the decision under appeal that the step of claim 3 of printing the UV ink comprises melting and adhering the primer layer to the UV ink is not sufficiently disclosed. According to the opposition division, the skilled person would not be able to carry out the subject-matter of claim 3, since "*...on the one hand, [it is] not clearly and unambiguously be disclosed against which solvents the (cured) primer layer should not be resistant and to what extent. On the other hand, it would not be disclosed what is to be understood in the context of the patent in suit as "melting". (...) The person skilled in the art would thus not know which composition the primer has to have (e.g. its chemical nature or constituents) in order to show the properties mentioned above.*" In this sense,

the respondent additionally argues in the last page of the reply to the statement of grounds of appeal that apart from the fact that the patent in suit does not disclose anything about solvents at all, conventional UV inks do not contain such solvents that could contribute to the "melting" of the primer.

- 1.3.2 The Board disagrees with the conclusions of the opposition division and the view of the respondent, for similar reasons as for claim 1 as granted. Indeed, there appears to be no serious doubts **substantiated by verifiable facts**, that the invention according to claim 3 as granted cannot be carried out by the skilled person.

- 1.3.3 In the present case, the Board notes that claim 3 requires that the primer layer is not solvent resistant. As correctly indicated by the appellant in point 2.3 of the statement of grounds of appeal, in paragraph [0035] of the patent in suit it is indicated that "By being not solvent resistant, the primer can melt and adhere to the UV ink (...)". The Board, in line with the position of the appellant, is convinced that this paragraph indicates that, one possible way of carrying out the step of "melting and adhering" the primer layer to the UV ink is applying a suitable solvent to the primer layer. Contrary to the findings of the opposition division, the lack of indication of such suitable solvents or the composition of the primer layer does not result in an insufficiency of disclosure. On the contrary, the Board is convinced that the skilled person would be in place of choosing an appropriate solvent for a given primer material and thereby carry out the step of melting and adhering the primer layer to the UV ink, in accordance with claim 3.

- 1.3.4 The question discussed by the parties, whether such solvent could be contained in the formulation of the UV ink is not decisive in the Board's view, since this could be just one of the possible ways to carry out the invention. In any case, and in the absence of any further proof, the assertion held by the respondent that conventional UV inks do not contain any kind of solvents at all would be seen by the Board as a mere unsubstantiated statement that cannot justify an objection under Article 100(b) EPC.
- 1.4 It follows from the above that the appellant has convincingly demonstrated the incorrectness of the decision under appeal that the ground for opposition under Article 100(b) EPC prejudices the maintenance of the patent as granted.
2. *Patent as granted - Amendments, Articles 100(c) and 123(2) EPC - Admittance of objections and of the amendment to the respondent's appeal case, Articles 12(3), 12(5) and 13(1) RPBA 2020*
- 2.1 The opposition division came to the conclusion that claim 3 as granted did not contravene the requirements of Article 123(2) EPC (see point 3 of the reasons of the decision under appeal).
- 2.2 The respondent referred in point 4 of the reply to the statement of grounds of appeal to its submissions in opposition proceedings, arguing that the requirements of Article 123(2) EPC are not met.
 - 2.2.1 Due to the mere reference to the submissions in opposition proceedings, the appeal case of the respondent in relation to the ground for opposition

under Article 100(c) EPC is unsubstantiated in the sense of Article 12(3) RPBA 2020.

- 2.3 With its letter dated 10 March 2022, *i.e.* after the respondent filed its reply to the statement setting out the grounds of appeal, the respondent submitted in point 3 arguments as to why the amendments of claim 3 as granted extended beyond the original disclosure.
- 2.3.1 Similarly to the evidence and objections with respect to the ground for opposition on sufficiency of disclosure (see point 1.1 above), these arguments have been submitted by the respondent for the first time in appeal proceedings after its filing of the reply to the statement setting out the grounds of appeal. Therefore, they constitute an amendment to the respondent's appeal case, the admittance of which is subject to the discretion of the Board under Article 13(1) RPBA 2020.
- 2.3.2 The respondent argued that these arguments were highly relevant for the case, since they would demonstrate that the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted.
- 2.3.3 The Board disagrees and rather concurs with the appellant's view that the alleged relevance of the submission does not justify the fact that the respondent could and should have submitted these in a substantiated manner when forming its appeal case, namely with its reply to the statement setting out the grounds of appeal so to present then its complete case as required by Article 12(3) RPBA 2020. In this light, the Board, exercising its discretion under Article 13(1) RPBA 2020, does not admit this amendment of the respondent's case into the proceedings.

2.3.4 As the additional reasoning in the respondent's letter of 10 March 2022 is not admitted, the respondent's submissions concerning Article 123(2) EPC in the reply to the appeal remain unsubstantiated without justification. Therefore, the Board exercised its discretion not to admit them into the proceedings pursuant to Article 12(5) RPBA 2020.

This conclusion reflects the preliminary opinion of the Board communicated to the parties with its communication under Rule 100(2) EPC, which has not been contested or commented upon by the parties either orally or in writing. The Board, after reconsidering all relevant aspects of the case, did not see any reason to depart from this preliminary opinion.

2.4 The Board thus confirms the finding of the opposition division that claim 3 meets the requirements of Article 123(2) EPC, so that the ground for opposition according to Article 100(c) does not prejudice the maintenance of the patent as granted.

3. *Remittal of the case to the opposition division, Articles 11 RPBA 2020 and 111(1) EPC*

3.1 The appellant requested that the case be remitted to the opposition division for further prosecution based on the patent as granted which was not contested by the respondent. The Board is aware that, according to Article 11 RPBA 2020, a remittal for further prosecution should only be undertaken, exceptionally, when special reasons apply.

3.2 The Board notes that the decision under appeal dealt only with the grounds of opposition under

Articles 100(b) and (c) EPC, and that since there are no substantive arguments of the parties present in the appeal proceedings relating to any patentability issues other than Articles 123(2) EPC and 83 EPC of the patent as granted, the Board cannot come to a decision regarding the other grounds of opposition under Article 100(a) EPC (novelty and inventive step) on the basis of the current appeal case alone.

3.3 Against this background, after considering all the relevant circumstances of the case at hand, the Board comes to the conclusion that at least the issues relevant to the ground of opposition in accordance with Article 100(a) EPC (novelty and inventive step), cannot be decided upon without undue burden (see also explanatory notes to Article 11 RPBA 2020, Supplementary publication 2 - OJ EPO 2020, 46, 54).

3.4 Consequently, the Board is convinced that there are special reasons within the meaning of Article 11, first sentence, RPBA 2020 that apply. In this light, following the request of the appellant, and taking into account that a remittal was not objected to by the respondent under the present circumstances, the Board remits the present case to the opposition division for further prosecution based on the patent as granted, in accordance with Article 111(1) EPC.

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 for further prosecution.

The Registrar:

The Chairman:



G. Nachtigall

A. Pieracci

Decision electronically authenticated