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D E C I S I O N
of 8 June 1999

Case Number: T 0818/95 - 3.2.5

Application Number: 84301193.3

Publication Number: 0148549

IPC: B41M 1/14

Language of the proceedings: EN

Title of invention:

Improved colour reproduction process

Patentee:

Mark 1 Marketing Corporation

Opponent:

ailate - Industria Libreria Tipografica Editrice S.p.A.

Headword:

-

Relevant legal provisions:

EPC Art. 100(a)(b)(c), 123(2)(3), 114(2), 111(1)

Keyword:

"Sufficiency of disclosure (yes)"

"Late submitted material - document admitted (yes)"

"Decision re appeals - remittal (yes)"

Decisions cited:

T 0029/96, T 0326/87

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0818/95 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 8 June 1999

Appellant:
(Opponent)

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Respondent:
(Proprietor of the patent)

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Representative:

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Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office posted 10 August
1995 concerning maintenance of European patent
No. 0 148 549 in amended form.

Composition of the Board:

Chairman: A. Burkhart
Members: P. Alting van Geusau
V. Di Cerbo

Summary of Facts and Submissions

I. The mention of the grant of European patent No. 0 148 549 in respect of European patent application No. 84 301 193.3, filed on 24 February 1984, was published on 8 August 1990.

II. Notice of opposition was filed by the appellant (opponent) on 7 May 1991 on the grounds of Article 100(a), (b) and (c) EPC.

In respect of an alleged lack of novelty and inventive step the opposition was supported by a number of prior art documents.

III. By a decision which was given at the end of oral proceedings held on 21 June 1995 and posted on 10 August 1995 the Opposition Division maintained the patent in amended form.

Claim 1 of the amended patent reads as follows:

"1. A method of printing on a sheet member a realistic image of an original, utilizing two different superimposed impressions with two different colouring media, the method including the steps of creating a first printing plate by the interposition of filter means between the original and a means for recording a first optical image, creating a second printing plate by the interposition of filter means between the original and means for recording a second optical image, and using the first and second plates to print the different impressions with two different colouring media, the first printing plate being created by the

interposition of at least two different filters between the original and the said means for recording a first optical image, said different filters being adapted to filter out colours or combination of colours, characterised in that the exposure of said first optical image obtained utilizing one of said at least two different filters is considerably less than the exposure of said first optical image obtained utilizing the other of said at least two different filters."

The Opposition Division was of the opinion that the amended patent fulfilled the requirements of Article 123(2) and (3) EPC, that the invention as claimed was disclosed in a manner sufficiently clear to be carried out by the skilled person and that the cited prior art was not suitable to throw doubt on the novelty and inventive step of the method defined in claim 1 of the amended patent.

- IV. On 28 September 1995 a notice of appeal was lodged against that decision and the appeal fee was paid on the same day.

In the statement of grounds of appeal, which was filed on 6 December 1995, the appellant cited the further prior art document:

D17: "Principles of Colour Reproduction" by J.A.C. Yule, John Wiley and Sons, Inc., New York, 1967, Preface, Table of Contents, pages 2 to 5 and 250 to 255.

- V. In a communication issued in preparation for oral proceedings the Board noted that the appellant no

longer appeared to raise objections in respect of Article 123(2) and (3) EPC against the amended patent documents.

In respect of the objection under Article 100(b) EPC, the opponent appeared to be of the opinion that incomplete disclosure of the characterising features of claim 1 - without sufficient detail derivable from the description for clarifying the claimed subject-matter - led to insufficient disclosure of the invention claimed.

The Board noted that in this respect at least the examples disclosed on page 5 of the application as filed appeared feasible in view of the explanations given by the respondent in its letter dated 29 May 1996.

It would appear that the introduction of D17 concerned evidence in support of submissions already presented in the opposition proceedings so as to fill a gap in the initial line of argumentation of the opponent. Therefore, the citing of D17 could not be considered an abuse of proceedings because it took place at the earliest possible moment and could also not be considered as introducing a totally new line of attack. Under such circumstances a relevant document filed after the 9-month period of Article 99 EPC could be allowed into the proceedings.

VI. Oral proceedings were held on 8 June 1999.

The appellant requested setting aside the decision under appeal and revocation of the patent in its

entirety (main request) or as an auxiliary request, to remit the case to the first instance for consideration of the objections under Article 100(a) and (b) EPC.

The respondent requested that the appeal be dismissed (main request) or, as an auxiliary request, to remit the case to the first instance if the Board considered the late filed document D17 to be relevant.

VII. In support of its requests the appellant essentially relied upon the following submissions:

Although the amended patent documents no longer gave rise to objections under Article 123(2) and (3) EPC, the question of insufficient disclosure under Article 100(b) EPC remained. Since claim 1 could not be considered self-explanatory the skilled person needed further information from the description of the patent. However, in view of the fact that the two examples presented in the patent description were wrong the person skilled in the art would never be able to reproduce, even by extensive trial and error, the solution called for in the characterising portion of claim 1. In particular the use of a yellow filter for the second exposure of the first film could not lead to the alleged results and therefore the skilled person was uninformed about the selection of the filters for making the first printing plate.

In this respect it was also to be noted that during the earlier stages of the procedure the patent proprietor steadily tried to convince the EPO that the use of a yellow filter was an error requiring correction but that now exactly the contrary is stated i.e. that

yellow is the right designation of the filter colour.

Since the issues of inventive step and sufficient disclosure were closely linked in the present case it would be appropriate to have these two issues considered together and remit the case to the first instance for further prosecution in respect of these linked issues.

Initially the material submitted in the opposition proceedings was considered sufficient for showing that the sequential exposure of a film for making the first printing plate in a two colour printing method lacked an inventive step. At that stage there was thus no necessity to have filed the document D17 earlier. Only from the decision under appeal did it become fully clear that the Opposition Division considered the disproportional exposure of significance. Exactly that feature was shown by D17 and because this textbook related to the colour printing art its teaching was considered to represent the mere background knowledge of the skilled person. No inventive activity was seen in the application of such common knowledge in producing a film from which the printing plate was derived.

VIII. The respondent disputed the appellant's view and its arguments may be summarised as follows:

The method disclosed in the present patent related to a two colour printing method rather than the standard four colour printing process. Therefore the skilled person was well aware of the necessity for correction and some experimentation to arrive at the best results

for a realistic image of the original, as was also referred to in the prior art cited in the patent in suit.

The examples presented in the description of the patent could not be taken to limit the extent of the method claimed. The filters in these examples were nothing more than probable candidates without any limitation on the use of other colour filters depending on the colours in the image to be reproduced. In this respect the appellant could also not be followed in that a wrong filter was used in the examples, i.e. the yellow filter. Considering the underlying problem to be solved by the subject-matter of the patent, i.e. the removal of the unbalanced nature of a printed reproduction made with only two impressions, colour reduction of the first printing plate was very well possible when using a yellow or in fact any other filter, selected in accordance with the colours of the image to be reproduced.

As regards the late cited document D17, no convincing arguments had been presented by the appellant as to why this document had not been filed within the 9-month period of Article 99 EPC. Furthermore, since this document was not relevant its introduction into the proceedings should be refused for that reason too. As to the latter, D17 related to four colour printing which posed entirely different requirements on the printing plates when compared to two- colour printing.

Reasons for the Decision

1. The appeal is admissible.

2. *Amendments*

2.1 The amendments to the patent essentially concern amendments to bring the text of the description back to the originally filed text.

The amendments to the claims concern clarifications (claim 1) based on the explanations given in the description of the patent, correction of obvious errors (claims 2 and 3) and the introduction of a further colour for the filters used in the method disclosed in the patent in suit.

In view of these assessments no objections pursuant to Article 123(2) and (3) EPC arise against the present patent documents.

2.2 Since also the appellant no longer maintained its objection under Article 100(c) EPC against the present patent documents, no further consideration of this issue is considered necessary.

3. *Sufficiency of disclosure (Article 100(b) EPC)*

3.1 The method claimed in claim 1 starts in its pre-characterising part from the known two-colour interpretation disclosed in the document

D16 "Ilford Manual of Process Work" by L.B. Clerc, fifth edition, 1951, published by Ilford Limited, Ilford, London, pages 415 to 417.

As was already indicated in the decision under appeal, the prior art process disclosed in D16 also makes use of two different filters for providing a first optical image, whereby each exposure is one-half the exposure which by itself would give a normal image (see D16, end of point 407).

In accordance with the description of the patent the problem to be solved by the subject-matter claimed is the removal of the unbalanced nature of the printed reproduction made with only two printing inks, which, as can be derived from the text in column 3, lines 28 to 34, means that the amount of the first printing colour should be adjusted by a disproportion of the exposures through the different filters.

This is achieved by the additional features of the characterising part of claim 1 in that the exposure time of the first optical image obtained utilizing the first filter is considerably less than the exposure of said first optical image obtained utilizing the other filter.

Starting from the known method disclosed in D16 clear instructions are thus given to the skilled person as to what has to be changed i.e. instead of a fifty-fifty exposure the exposure time through the second filter should be considerably less than the exposure time through the first filter.

- 3.2 The appellant essentially argued that since no specific amount of the disproportion of exposures was disclosed the skilled person was obliged to carry out extensive tests on the basis of the examples given in the

description, which experimentation, because of a wrong colour specified for filter used for the second exposure, could never lead the skilled person to the desired results. In this respect the appellant also noted that the respondent had indicated in earlier proceedings that the use of a yellow filter in the examples was wrong.

The Board is of the opinion that the skilled person must be considered to be well aware of the fact that in two-colour interpretation a realistic image of an original might require an experimental approach but that the results achieved during the experiments would allow the skilled person to determine the direction of experimentation to be followed for achieving the best compromise. Such converging experimentation process does not constitute an undue burden for carrying out the method of claim 1 of the patent in suit.

Furthermore, although the appellant is right in that a yellow filter as used in the four colour separation process blocks its complementary colour (blue light) and that therefore the blue coloured areas in the original image of the examples discussed in the patent in suit would not lead to further exposure of the first optical image in those areas, the colour "blue" in the examples (the blue eyes of the baby and the blue background) obviously does not closely relate to the complementary colour "primary blue" blocked by the yellow filter as used in the four colour separation process.

This means that also in the examples disclosed in the present patent the first optical image from which the

printing plate for the red colour is produced will be further exposed through the yellow filter so that the amount of red for the corresponding printing plate is reduced in all areas where the colour "primary blue" was not present in the original and that therefore the unbalanced nature of the printing colours can be adjusted. Consequently there is no reason to assume that the skilled person would be led by the examples in a direction away from a solution to the problem stated in the patent.

- 3.3 In summary, the Board follows the conclusion arrived at in the decision under appeal in that the essential features to realize the subject-matter of the patent as specified in claim 1 can be carried out without undue burden by the skilled person and that therefore the appellant's objection based on Article 100(b) EPC must be rejected.

4. *The late cited document D17*

- 4.1 It was not in dispute that the excerpts of the textbook D17 disclosed that it was known in the colour printing art to provide an optical image for creating a plate for one printing colour by exposing the negative or mask through two filters in succession in which one of the exposures was small when compared to the other. In view of the respective percentages of 95% and 5% such known exposure would fall within the definition of the exposure defined in the characterising part of claim 1 of the patent in suit.

- 4.2 The respondent considered that although the characterising features of claim 1 were known in

themselves from D17 this was not sufficient to conclude its relevance. Since D17 related to the four colour process whereas the present patent concerned two colour printing, there was no suggestion that the process of multiple exposure disclosed in D17 could be used to solve the underlying problem of the patent in suit.

The Board draws attention to the fact that in the paragraph "background of this invention" also the patent in suit extensively discusses the particularities of the four colour process including the "fine tuning" or adjustment of the intensities of the various colours by selecting exposure times and development times. Obviously, the skilled person will consider the known adjustment concerning the intensity of colours in the four colour separation process when intensities of the printing plates in the two colour process are in need of such "fine tuning". In this respect nothing indicates that the two colour separation process is principally different from the four colour process, on the contrary, as will be clear from the patent in suit and the prior art disclosed in D17, only smaller adaptations and some experimentation are necessary for achieving a realistic reproduction of an image in the two-colour interpretation.

Therefore, the Board is of the opinion that D17 is relevant when deciding the ground of opposition under Article 100(a) EPC, in particular as concerns the issue of inventive step of the subject-matter of claim 1.

- 4.3 The Board follows the appellant in that the introduction of D17 merely concerns evidence about the common knowledge of the skilled person to support

submissions already presented in the opposition proceedings so as to fill a gap in this initial line of argumentation of the opponent. Moreover, the citing of D17 cannot be considered to constitute an abuse of proceedings because it took place at the earliest possible moment (together with the statement of grounds of appeal) and does also not introduce a totally new line of attack.

Under such circumstances a document filed after the 9-month period of Article 99 EPC may be allowed into the proceedings if it is sufficiently relevant (see for example T 29/96).

The late filing of document D17 does not constitute a reason of equity (Article 104(1) EPC), which would demand that costs be apportioned.

- 4.4 In accordance with the case law of the boards of appeal, if a new citation is filed during the opposition appeal proceedings and is relevant enough to be taken into account, the case should as a rule be remitted under Article 111(1) EPC to the department of first instance so that the document can be examined at two levels of jurisdiction and the patent proprietor is not deprived of the possibility of subsequent review (see for example T 326/87, OJ 1992, 522).

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

A. Townend

A. Burkhart