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**D E C I S I O N**  
**of 8 November 2001**

**Case Number:** T 0333/98 - 3.2.5

**Application Number:** 92250156.4

**Publication Number:** 0520594

**IPC:** B41F 27/12

**Language of the proceedings:** EN

**Title of invention:**

Plate exchange apparatus for printing press

**Patentee:**

Komori Corporation

**Opponent:**

Heidelberger Druckmaschinen AG

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 54, 56

**Keyword:**

"Novelty, main request, auxiliary request (yes)"  
"Inventive step, main request, auxiliary request (no)"  
"Public prior use (approved)"  
"Different apportionment of costs (no)"

**Decisions cited:**

-

**Catchword:**

-



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Boards of Appeal

Chambres de recours

**Case Number:** T 0333/98 - 3.2.5

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.5**  
**of 8 November 2001**

**Appellant:** Heidelberg Druckmaschinen AG  
(Opponent) Kurfürsten-Anlage 52-60  
D-69115 Heidelberg (DE)

**Representative:** -

**Respondent:** Komori Corporation  
(Proprietor of the patent) 11-1, Azumabashi 3-chome  
Sumida-Ku  
Tokyo (JP)

**Representative:** Patentanwälte Wenzel & Kalkoff  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 2 February 1998  
rejecting the opposition filed against European  
patent No. 0 520 594 pursuant to Article 102(2)  
EPC.

**Composition of the Board:**

**Chairman:** W. Moser  
**Members:** W. R. Zellhuber  
P. E. Michel

## Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal against the decision of the Opposition Division rejecting the opposition against the European patent No. 0 520 594.
- II. On 6 December 1996, an opposition was filed against the patent as a whole and based on Article 100(a) (lack of novelty, Article 54 EPC, and lack of inventive step, Article 56 EPC).

The following document was cited in the notice of opposition:

E1: EP-A 0 431 575.

On 30 October 1997, after having received the summons to attend oral proceedings before the Opposition Division, scheduled for 12 December 1997, the appellant made mention of a public prior use for the first time, and filed one page of a visit report and a sheet comprising copies of photographs and explanatory notes. Hearing of Mr. Filsinger as a witness was offered. In a communication dated 8 December 1997, the Opposition Division requested the submission of a statutory declaration by Mr. Filsinger. The declaration was filed on 10 December 1997.

At the end of the oral proceedings held on 12 December 1997, the Opposition Division announced the decision to reject the opposition. It held that the grounds for opposition cited in the Article 100(a) EPC did not prejudice the maintenance of the patent having regard to document E1. It further found that the allegation of public prior use was belatedly filed and disregarded it

irrespective of its relevance, exercising the discretion conferred upon it by Article 114(2) EPC.

III. In the course of the appeal procedure, the appellant referred in addition to the following documents:

E2: Heidelberg, Visit Report, "Plattenwechselsysteme", dated 16 January 1991, pages 1 to 5;

E3: Sheet carrying colour photographs 14, 15 and 16 and explanatory notes; photograph 15 carrying the indicium "28 11'90";

E4: Statutory declaration by Mr. Filsinger of 8 December 1997.

The offer of hearing of Mr. Filsinger as a witness was maintained.

IV. Oral proceedings were held before the Board of Appeal on 8 November 2001.

(i) The appellant requested that the decision under appeal be set aside and the European patent No. 0 520 594 be revoked.

He further requested a different apportionment of costs.

(ii) The respondent (patentee) requested, as a main request, that the appeal be dismissed. As an auxiliary request, he requested that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 to 3 filed on 5 October 2001.

He further requested a different apportionment of costs.

V. Claim 1 of the patent in suit as granted (main request of the respondent) reads as follows:

"1. A plate exchange apparatus for a printing press, comprising:

a plate holding unit (15) supported on frames (1) such that a distal end thereof is movable between an operative position where said distal end comes close to plate lockup devices (3, 4) disposed in a gap of a plate cylinder (2) and a storing position where said distal end is retracted from said operative position; characterized by

positioning members (60) provided at said distal end of said plate holding unit and brought into contact with a member on said plate cylinder when said plate holding unit is located at said operative position."

Claim 1 according to the auxiliary request comprises in addition to the features of claim 1 as granted the following feature:

"..., said member with which said positioning members (60) are in contact being a pair of disk-shaped bearers (2a) provided at two end portions of said plate cylinder (2), and said plate holding unit being stopped at said operative position while said positioning members are urged against circumferential surfaces of said bearers."

VI. In the written and oral procedure, the appellant argued essentially as follows:

Document E1 disclosed a plate exchange apparatus according to the preamble of claim 1 of the patent in suit as granted. Furthermore, Figures 9 and 10 of document E1 showed a positioning roll located at the distal end of the plate exchange apparatus. In the operating position, which was shown in Figure 9, that roll came into contact with a bearer ring 34 ("Schmitzring"), the latter was shown in Figure 1 of document E1. Although the description of document E1 was silent about that roll, a person skilled in the art inevitably would consider that that roll had the function of a positioning member for the plate holding unit.

Therefore, the subject-matter of claim 1 of the patent in suit as granted (main request of the respondent) was not novel.

Furthermore, documents E2, E3 and E4 showed that a printing machine of the type Komori Lithrone 40 Nr. L440-772 comprising a plate exchange apparatus had been made available to the public before the priority date of the patent in suit. Document E3, in particular, photograph 15 and the appended text, the latter having been added at the time the visit report E2 had been drafted, disclosed a plate exchange apparatus comprising a positioning roll which, in the operative position, came into contact with the bearer ring ("Schmitzring").

Therefore, the subject-matter of claim 1 according to the main request of the respondent, at least, did not

involve an inventive step in view of the disclosure of document E1 and the documents relating to the alleged public prior use.

The same applied to the subject-matter of claim 1 according to the first auxiliary request of the respondent. A person skilled in the art would provide a pair of positioning elements in order to avoid any curling of the plate holding unit. Moreover, Figure 9 of document E1 showed the front view of a positioning roll located at one end of the plate holding unit and Figure 10 showed the back view of a positioning roll located at the opposite end of the plate holding unit. Thus, document E1 already disclosed a plate holding unit comprising a pair of positioning elements.

The public prior use concerned a printing machine delivered by the respondent and not by the appellant. Although the respondent had thus had the relevant documents with regard to the alleged public prior use at his disposal, he had considered neither requesting revocation of the patent in suit nor contributing to the resolution of the matter. This behaviour of the respondent had caused additional costs, and the request of a different apportionment of costs should thus be allowed.

VII. In the written and oral procedure, the respondent argued essentially as follows:

There was no disclosure of positioning members in document E1. The "element" which, according to the appellant, represented a positioning element, was only shown in the drawings. Neither the structure nor the purpose of that "element" was disclosed. The

description was completely silent about it. Moreover, in Figures 9 and 10, that "element" was illustrated differently. The features of the characterising portion of claim 1 of the patent in suit as granted were thus disclosed neither implicitly nor explicitly in document E1.

The claim of public prior use lacked sufficient substantiation. As regards the statutory declaration (document E4), it seemed highly doubtful that somebody should be able to give an account of a certain machine with such detailed knowledge after seven years, particularly since the visit report (document E2) did not reveal any details. As far as document E3 was concerned, photograph 15 was the only one on which a date was provided. Moreover, it showed a very limited section of a machine. It was not even evident whether this was a machine according to claim 1 of the patent in suit as granted. Photograph 15 showed nothing but the end of a plate holding unit on which a cylindrical element was arranged. The picture did not reveal whether this was a fixed or a rotating element, nor could the function of the shown section be taken from the picture.

The subject-matter of claim 1 of the patent in suit as granted (main request of the respondent) was thus novel.

In document E1, positioning of the plate holding unit was not mentioned at all, and nothing in document E1 could lead the skilled person to suspect that the illustrated element was intended to serve as a positioning element. The illustrated element might have various functions. Furthermore, neither document E2 nor



the photograph 15 of document E3 indicated positioning elements contacting, in the operative position, a member of the plate cylinder. Such an assertion was based on pure hindsight.

The subject-matter of claim 1 of the patent in suit as granted (main request of the respondent) thus involved an inventive step.

Claim 1 according to the auxiliary request of the respondent concerned a concrete embodiment which was suggested neither by document E1 nor by the documents pertaining to the alleged prior use. In particular, none of these documents suggested means for stopping the plate holding unit while positioning elements were urged against circumferential surfaces of disk-shaped bearers.

When filing the opposition on 6 December 1996, the appellant already had at his disposal all documents concerning the alleged public prior use. Nevertheless, the documents had belatedly been filed, and piece by piece. This "policy of small steps" constituted an obvious procedural abuse. The alleged public prior use should therefore be disregarded. Due to the fact that the documents had been filed belatedly, and, in particular, due to the procedural abuse referred to above, it was justified to impose a different apportionment of costs on the appellant.

## **Reasons for the Decision**

1. *Alleged public prior use*

Document E2 relates to a report dated 16 January 1991, according to which Mr. Filsinger and the editor of the report visited several printing firms in Japan equipped, among others, with printing machines comprising automatic plate exchange devices. On 28 November 1990, they visited the firm Kato Photo Printing and inspected a printing machine "Komori Lithrone 40 no. L 440-772". The respective statements in the statutory declaration of Mr. Filsinger (document E4) are thus confirmed by document E2. The photograph 15 of document E3, which shows a portion of the plate exchange device of that machine, carries the indicium "28 11'90" thus indicating the date of 28 November 1990, which coincides with the date of the visit to the firm Kato Photo Printing.

Accordingly, in the Board's judgement, in view of the written evidence on file, ie the documents E2 and E4 and the photograph No. 15 of document E3, it has been proved beyond any reasonable doubt that:

- (i) Mr Filsinger visited the firm Kato Photo Printing on 28 November 1990;
- (ii) a printing machine "Komori Lithrone 40 No. L 440-772" was installed in the premises of that firm on 28 November 1990;
- (iii) that printing machine was inspected by Mr Filsinger;
- (iv) there was no imposed secrecy;
- (v) photograph No. 15 of document E3 represents a picture taken of a plate holding unit of the

plate exchanging apparatus of that printing machine on 28 November 1990.

Document E2 does not disclose any details of that machine. The contribution of the alleged prior use to the relevant state of the art is thus strictly limited to the objective disclosure of photograph No. 15, which shows a plate holding unit of the plate exchanging apparatus of the above mentioned printing machine "Komori Lithrone 40 No. L 440-772". Indeed, to the extent that the text appended to photograph No. 15 and the statutory declaration (document E4) give rise to the mentioning of elements or features which are not recognisable in photograph No. 15, these elements or features have to be disregarded for lack of proof beyond any reasonable doubt, because, as far as the text appended to photograph No. 15 is concerned, it does not bear any date, and, as far as the statutory declaration is concerned, it is very doubtful whether a person is capable of recalling exactly what he or she saw several years ago.

The latter is also the reason why the Board did not consider hearing Mr Filsinger as a witness.

2. *Main request*

2.1 Novelty

Document E1 discloses a plate exchange apparatus for a printing press, comprising a plate holding unit 83 supported on frames such that a distal end thereof is movable between an operative position (cf. Figures 9 and 11, dashed lines), where that distal end comes close to plate lockup devices 5, 30 disposed in a gap

of a plate cylinder 1, and a storing position (cf. Figure 11, full line) where that distal end is retracted from said operative position. According to Figures 9 and 10 of document E1, at that distal end, the plate holding unit 83 comprises an unnumbered element comprising a circumferential outer surface. In the two-dimensional illustration of Figure 9, that element contacts a line indicating the outer circumferential surface of the plate cylinder, when the plate holding unit is in the operative position.

The description of document E1 is silent about that element and its purpose. The drawings do not show whether, in the operative position, that element is actually brought into contact with a member on the plate cylinder. Accordingly, it is neither directly and unambiguously derivable from the disclosure of document E1 that that element is in contact with a member on a plate cylinder nor that that element has the function of a positioning element.

Photograph 15 of document E3 shows a portion of a plate holding unit comprising a roll-like element located at an outer end of that unit. Photograph 15 does not show the plate holding unit together with the plate cylinder. Accordingly, the photograph does not disclose a plate holding unit movable between an operative and a retracted position. Neither does it indicate whether or not that roll-like element, in an operative position, contacts a member of the plate cylinder.

The subject-matter of claim 1 according to the main request is therefore novel with regard to the cited prior art.

## 2.2 Inventive step

### 2.2.1 Closest prior art

Document E1, which represents the closest prior art, relates to a plate exchange apparatus according to the preamble of claim 1. The apparatus comprises a plate holding unit which, in the operative position, receives an old printing plate 89 taken off the plate cylinder, and delivers a new plate to be wound around the plate cylinder. The old plate 89 is inserted into a receiving chamber of the plate holding unit formed by guide plates 88, cf. column 10, lines 51 to 57 and Figure 9. The new plate 105 is moved from the plate holding unit towards a lockup device 5 of the plate cylinder comprising gripping means, cf. Figures 3 and 9.

### 2.2.2 Problem - Solution

In order to assure a correct functioning of the plate exchange apparatus as disclosed in document E1, the plate holding unit has to be brought in a position which allows entering of the old plate into the chamber of the plate holding unit provided therefor, and insertion of the new plate into the gap formed by the opened gripping means of the lockup device 5.

The problem underlying the patent in suit may therefore be seen in providing a plate exchange apparatus wherein the plate holding unit can be brought into a position allowing the old plate to be received and a new plate to be delivered.

The patent in suit suggests a plate exchange apparatus wherein positioning elements are provided at the distal

ends of the plate holding unit, which, in the operative position, are brought into contact with a member of the plate cylinder.

A person skilled in the art would consider providing means for positioning the plate holding unit in the operative position with respect to the plate cylinder in order to assure the correct functioning of the apparatus, and, in view of the prior art as disclosed in document E1 and the photograph 15 of document E3, he would consider the solution suggested by the patent in suit.

Photograph 15 of document E3 shows the lower portion of the plate holding unit, which is very similar to the lower portion of the plate holding unit shown in document E1. The plate holding unit shown in photograph 15 comprises a roll-like element located at the bottom and at an outer side edge of the plate holding unit. A person skilled in the art would thus recognize that that cylindrical roll-like element corresponds to the element having an outer circumferential surface illustrated in Figure 9 of document E1.

Accordingly, photograph 15 of document E3 indicates, in more detail, the structure and the location of that element depicted in Figure 9 of document E1.

With an arrangement of the roll-like element on the plate holding unit as shown in photograph 15, the element corresponding to it and shown in the apparatus according to document E1, in the operative position, comes close to the disk-shaped bearer 34, shown in Figure 1 of document E1. The bearer 34 is a member of

the plate cylinder, cf. Figure 1 and description, column 7, lines 54 and 55 of document E1. Without the necessity of applying an inventive step, a person skilled in the art would thus recognize that that roll-like element and the disk-shaped bearer constitute means suitable for positioning the plate holding unit with respect to the plate cylinder, in that that element is brought into contact with the bearer.

Therefore, the subject-matter of claim 1 according to the main request does not involve an inventive step within the meaning of Article 56 EPC.

### 3. *Auxiliary request*

#### 3.1 Amendments

Claim 1 represents a combination of the features of claims 1 and 3 of the patent in suit as granted and is based on claims 1 and 3 of the application as filed. Therefore, the amended claim 1 does not contravene Article 123 (2) and (3) EPC.

#### 3.2 Novelty

Since claim 1 comprises all the features of claim 1 as granted which has been found to be novel with regard to the cited prior art, cf. paragraph 2.1 above, the subject-matter of claim 1 according to the auxiliary request also meets the requirement of novelty (Article 54 EPC).

#### 3.3 Inventive step

According to claim 1, in the operative position, the

positioning members are in contact with a pair of disk-shaped bearers provided at two end portions of the plate cylinder. Furthermore, the plate holding unit is stopped at the operative position while the positioning members are urged against circumferential surfaces of the bearers.

Document E1, however, already discloses a plate cylinder provided with a pair of disk-shaped bearers 34 located at two end portions of the plate cylinder, cf. column 7, lines 54 and 55 of the description and Figure 1. Accordingly, a person skilled in the art would similarly provide a pair of positioning members contacting that pair of bearers thus avoiding any curling of the plate holding unit.

Furthermore, in order to maintain a predetermined position of an element in contact with another member, it belongs to the common general knowledge of a person skilled in the art, to provide means for stopping that element and urging it against its counterpart. A person skilled in the art would use that generally known principle also in connection with a plate exchange apparatus as disclosed in document E1 without the necessity of applying an inventive step.

The subject-matter of claim 1 according to the auxiliary request thus does not involve an inventive step within the meaning of Article 56 EPC.

4. Consequently, neither the main request nor the auxiliary request of the respondent are allowable.



5. *Requests for different apportionment of costs*

5.1 In the present case, the appellant requested the revocation of the patent in suit. Thus, the burden of proof of any non-patentability is with the appellant. The respondent is not obliged either to submit any facts or, as patent proprietor, to request revocation of his patent.

Therefore, the appellant's request for apportionment of costs is refused.

5.2 The allegation of prior use was filed by the appellant in response to a communication of the Opposition Division announcing its provisional opinion that the prior art on file on that date did not prejudice the maintenance of the patent in suit. Since the Opposition Division did not share the appellant's view of the relevance of the cited document, it is the legal right of the appellant to undertake steps he finds suitable in order to improve his position. Since, later on, he also was adversely affected by the decision of the Opposition Division, this applies also to the appeal procedure.

Furthermore, the allegation of prior use and written evidence were filed in the course of opposition procedure and before the final date of 12 November 1997 set in accordance with Rule 71a EPC by the Opposition Division. Admittedly, the statutory declaration E4 was filed after that final date, however, this was made in compliance with a respective request of the Opposition Division dispatched two days before.

Therefore, the Board concludes that there is no abuse

of the procedure by the appellant.

Consequently, the respondent's request that the documents concerning the alleged prior use be rejected because of their belated filing as well as the respondent's request for a different apportionment of costs are refused.

## **Order**

### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The requests for apportionment of costs are refused.

The Registrar:

The Chairman:

M. Dainese

W. Moser