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D E C I S I O N
of 20 December 1999

Case Number: T 1139/98 - 3.5.1

Application Number: 93201115.8

Publication Number: 0620674

IPC: H04N 1/40

Language of the proceedings: EN

Title of invention:

Method for making a lithographic printing plate

Patentee:

Agfa-Gevaert N.V.

Opponent:

Heidelberger Druckermaschinen AG

Headword:

-

Relevant legal provisions:

EPC Art. 56, 100(a), 114

Keyword:

"Fresh grounds for opposition"

Decisions cited:

G 0009/91, G 0010/91, G 0001/95, G 0007/95

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 1139/98 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 20 December 1999

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

Representative: -

Respondent: Agfa-Gevaert N.V.
(Proprietor of patent) Septestraat 27
2640 Mortsel (BE)

Representative: -

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 13 October 1998
rejecting the opposition filed against the
European patent No. 0 620 674 pursuant to
Article 102(2) EPC.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: A. S. Clelland
M. J. Vogel

Summary of Facts and Submissions

I. European patent No. 620 674 was opposed by the present appellant on the ground that the subject-matter of claim 1 lacked novelty having regard to the disclosure of each of two documents:

D1: EP-B-74 422

D2: DE-C-3 634 939

II. In the course of the opposition proceedings and after expiry of the 9-month opposition period the opponent raised as a ground of opposition a lack of inventive step and cited two further documents:

D3: DE-C-2 107 738

D4: DE-A-3 804 941

III. In its decision the Opposition Division found that the subject-matter of claim 1 was novel. Documents D3 and D4, and the ground of lack of inventive step, were not admitted to the proceedings.

IV. The appellant has appealed against this decision and requests revocation of the patent. In the statement of grounds of appeal it is argued that the Opposition Division was in error in basing its decision exclusively on the issue of novelty. Although the notice of opposition only referred explicitly to novelty, it was evident that inventive step was in fact meant. There had merely been a use of incorrect terminology. It had never been argued that all features

of claim 1 were known from either D1 or D2 alone. The implication rather was that the features of the preamble of claim 1 were known from the state of the art and the characterising feature was known from both D1 and D2. Thus, although inventive step was nowhere explicitly mentioned it was clear that this was *de facto* what was meant.

IV. The patentee in response argued that only the ground of novelty had been admitted to the opposition proceedings and referred to the decision of the Enlarged Board of Appeal G 10/91, OJ EPO 1993, 420, which stated that only those grounds for opposition already cited at the opposition stage could be considered on appeal unless the patentee consented. The response included the statement that "the patent proprietor does not consent with the ground for opposition under A 100(a) in conjunction with A 56 EPC".

V. Claim 1 of the patent reads as follows:

"1. A method for making a lithographic printing plate from an original containing continuous tones comprising the steps of

- screening said original to obtain screened data
- scan-wise exposing a lithographic printing plate precursor according to said screened data, said lithographic printing plate precursor having a surface capable of being differentiated in ink accepting and ink repellent areas upon said scan-wise exposure and an optional development step and

- optionally developing a thus obtained scan-wise exposed lithographic printing plate precursor characterized in that said screening is a frequency modulation screening."

Reasons for the Decision

1. The primary issue before the Board is whether the ground of inventive step can be discussed in the present proceedings.
2. In decisions G 1/95 and G 7/95, OJ EPO 1996, 615 and 626, the Enlarged Board of Appeal held that the expression "grounds for opposition" under Article 100 EPC must be interpreted as meaning an individual legal basis for objection to the maintenance of a patent. Article 100(a) EPC was therefore held to contain a collection of different legal objections, or different grounds for opposition, so that novelty and inventive step were to be considered as different legal objections having a different legal basis.
3. It follows that the late introduction into opposition proceedings of the ground of inventive step constitutes the introduction of a fresh ground of opposition, even if an objection based on lack of novelty was initially made. Although in accordance with the principal of *volenti non fit injuria* a fresh ground of opposition may be introduced into appeal proceedings with the agreement of the patentee, in the response to the statement of grounds of appeal the patentee explicitly withholds his consent.

4. In the present case, inventive step could therefore only be raised if it was implicitly present in the originally filed notice of opposition or if the Opposition Division permitted the ground to be introduced. The appellant has drawn attention to various passages in the notice of opposition which it is asserted show that objection of lack of inventive step was always intended. The appellant asserts that the informed reader would understand that when read as a whole the opposition documents contain an inventive step argument.

5. The argumentation in the notice of opposition starts by citing documents D1 and D2 and reciting the features of claim 1. It then asserts that various features of the claim preamble would be understood by the skilled person as implicit whenever reference is made to a lithographic printing plate. It summarises the remaining features of the preamble and the characterising feature as "the direct exposure of a printing plate with screening data, whereby the screening is a frequency modulated screening" (Board's translation). The difference between amplitude and frequency modulated screening is described. D1 and D2 are then individually discussed and the summarised disclosure of the claim is said to be known from each of these documents. The discussion of D1 and D2 ends with the respective phrases "this feature of claim 1 is therefore not new" and "this feature of claim 1 of the patent in suit is therefore also anticipated by this document and not new" (Board's translations).

6. The argument is thus that all practical lithographic printing plates will have most of the features of the claim preamble; D1 and D2 show such printing plates and also disclose the remaining features of the preamble and the characterising feature as summarised above. This is a novelty argument.

7. This conclusion on the substance of the opposition agrees with that from the formal documents. The pre-printed notice of opposition form, EPO form 2300, includes at point VI a section "grounds of opposition" and a series of boxes to be crossed to indicate on which grounds the opposition is supported. Only the box for novelty was crossed.

8. In a submission from the opponent after the end of the 9-month opposition period the issue of inventive step was raised for the first time. Two further documents, D3 and D4, were cited to show specific features asserted by the patentee not to be present in either D1 or D2. This submission includes the statements that "in the opponent's view the use of known processes on special printing plates which do not have any particular new properties is not an invention" and "... the features of claim 1 ... have no inventive height" (Board's translations).

9. The Board understands these somewhat unclear statements to be references to inventive step. In the invitation to the oral proceedings the Opposition Division stated that "The opponent has provided no clear arguments against the inventive step of the claimed method but has merely shown that the individual steps of the claimed method were known in themselves" and concluded

- that the claimed method involved an inventive step.
10. The minutes of the oral proceedings state that the opponent requested revocation "on the ground of lack of novelty and lack of inventive step" but then add that the Opposition Division refused in accordance with Article 114(2) EPC to admit either the ground of lack of inventive step or late-filed documents D3 and D4. A verbal decision was given at the end of the oral proceedings to the effect that claim 1 satisfied the requirements of the EPC with respect to novelty and that the ground of lack of inventive step was disregarded. In the written decision, paragraph 8, the Opposition Division states that "the only ground of opposition mentioned in the notice of opposition is lack of novelty, and only this ground was discussed in depth during the oral proceedings". It is then stated that the ground of lack of inventive step "mentioned by the opponent during the oral proceedings was dismissed with reference to decision no. G10/91...".

 11. As set forth in decisions G 9/91 and G 10/91, OJ EPO 1993, 408 and 420, there are circumstances in which an Opposition Division may, in application of Article 114(1) EPC, admit to the proceedings a ground for opposition not covered by the statement pursuant to Rule 55(c) EPC. The Enlarged Board stated however, see point 16 of both decisions, that the consideration of grounds not properly covered by the statement pursuant to Rule 55(c) EPC should only take place in cases where, prima facie, there are clear reasons to believe that such grounds are relevant and would in whole or in part prejudice the maintenance of the European patent.

12. On the facts of the present case the Board is satisfied that the Opposition Division correctly exercised its discretion not to admit the new ground because it considered the ground insufficiently relevant.

13. There remains the question of whether, despite refusing the Opponent permission to do so, the Opposition Division *de facto* introduced the ground of lack of inventive step by discussing it in the written decision. The various references to inventive step by the Opposition Division are however not understood by the Board as the introduction of a new ground in accordance with Article 114(1) EPC. The comments in the invitation to oral proceedings could be interpreted as inviting the opponent to raise the ground but, as is clear from the minutes, permission was subsequently refused. The brief comments in the decision appear on the one hand to be an explanation of why the ground was not admitted and on the other hand a non-binding opinion as to why the claimed method *prima facie* involves an inventive step. Given that the decision refers at point 8 to decision G 10/91 (see point 11 above) and given the Enlarged Board's comment that the application of Article 114(1) EPC should only take place where there are clear reasons to believe that such grounds are relevant and would in whole or in part prejudice the maintenance of the European patent, the Board concludes that the ground was not introduced into the proceedings by the Opposition Division.

14. Finally, the Board notes that the subject-matter of claim 1 is novel with respect to the disclosure of each of D1 and D2; neither of these documents clearly and unambiguously discloses a lithographic printing plate

precursor.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg