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**D E C I S I O N**  
**of 18 February 2004**

**Case Number:** T 0035/00 - 3.2.5

**Application Number:** 92500136.4

**Publication Number:** 0540455

**IPC:** B42D 15/10

**Language of the proceedings:** EN

**Title of invention:**

A process for preparing printed sheets with optical effects

**Patentee:**

Grifoll Casanova, Juan

**Opponent:**

GIESECKE & DEVRIENT GmbH

**Headword:**

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**Relevant legal provisions:**

EPC Art. 56, 111(1), 122(2), 123(3)

**Keyword:**

"Restitutio in integrum (no)"

"Remittal to first instance (no)"

"Inventive step (main and first auxiliary request, no)"

"Extension of protection (second auxiliary request, yes)"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0035/00 - 3.2.5

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.5  
of 18 February 2004

**Appellant:** Grifoll Casanova, Juan  
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**Representative:** Pastells Teixido, Manuel  
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**Respondent:** GIESECKE & DEVRIENT GmbH  
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**Representative:** Klunker, Schmitt-Nilson, Hirsch  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 19 November 1999  
revoking European patent No. 0540455 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

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

## Summary of Facts and Submissions

- I. The appellant (patentee) lodged an appeal against the decision of the Opposition Division revoking European Patent No. 0 540 455.

The Opposition Division held that the subject-matter of claim 1 as granted lacked an inventive step.

- II. The appellant requested remittal of the matter to the first instance or maintenance of the patent in suit,
- (i) as main request, on the basis of claim 1 filed as main request on 8 February 2000;
  - (ii) as first auxiliary request, on the basis of claim 1 filed as second auxiliary request on 8 February 2000; and
  - (iii) as second auxiliary request, on the basis of claims 1 to 3 filed as "proposal of amended claims" on 8 February 2000.

The respondent (opponent) requested that the appeal be dismissed. As an auxiliary request, the respondent requested that oral proceedings be held.

- III. The following documents are referred to in the present decision:

D2: US-A-4,294,782

D4: DE-A-33 08 831

IV. Claim 1 of the main request of the appellant reads as follows:

"A process for obtaining printed sheets with optical effects, said sheets comprising a ply of plastic material worked as a lens through which motifs provided behind said ply are viewed, at least one of the surfaces of said sheets (2) by means of any conventional system (3) being printed with the pertinent motifs and illustrations; a transparent resin (6), is applied on the surface to be printed thereby wholly or partially impregnating the sheet (2) surface, after which the engraving (7-8) is performed by pressure and heat in the impregnated area which will produce said optical effects;

characterized in that:

- the transparent resin (6') used in this process is polymerizable by ultraviolet rays;
- the engraving on the resin-coated surface of the sheets (2) is performed at the same time with pertinent means, as ultraviolet rays are emitted on said sheets (2) to polymerize the resin (6');
- the resin (6') is applied on the sheet (2), adjacent the point of the calender (18) where the press roller (12) is acting, i.e. where the engraving of the resin-coated sheet is being effected by incidence of the ultraviolet rays, so that said resin (6') is applied practically at the same time as said sheet (2) is delivered to said calender (18)."

Claim 1 of the first auxiliary request corresponds to claim 1 of the main request, with two of the features of the characterising clause transferred to the preamble.

Claim 1 of the second auxiliary request of the appellant reads as follows:

"A process for obtaining printed sheets with optical effects, the pertinent motifs and illustrations being printed on said sheets (2) and a resin (6) wholly or partially impregnating them is applied on the surface, this resin is subsequently engraved for obtaining the optical effects and is polymerized by ultraviolet rays, the engraving of the resin-coated face of the sheets (2) being performed at the same time that with the pertinent means, as ultraviolet rays are emitted on said sheets (2) to polimerize the resin (6) **characterized in that** the resin (6') is applied on the sheet (2) adjacent to the point of the calender (18) where the press roller (12) is acting, i.e. where the engraving of the resin-coated sheet is being effected and its polimerization by incidence of the ultraviolet rays."

V. The appellant has argued substantially as follows:

A letter had been filed in the procedure before the Opposition Division, containing claims forming the basis of auxiliary requests, which was not taken into account. An opportunity should therefore be given for the Opposition Division to consider these claims.

Claim 1 of the main request is distinguished over the disclosure of D2 in that it is specified that the resin is applied to the sheet adjacent to the point of the calender where the press roller is acting.

This feature is not suggested by the cited prior art and involves an inventive step.

VI. The respondent has argued substantially as follows:

The request for restitutio in integrum was filed out of time.

It does not involve an inventive step to alter slightly the time and place at which the resin is applied to the sheet, since this does not have any effect upon the engraving and polymerisation of the resin. There are only three possibilities for applying the resin. That is, directly on the substrate, to the calender, or at the point at which the substrate meets the calender. The choice of one of these three possibilities does not solve any problem and does not involve an inventive step.

Claim 1 of the second auxiliary request does not comply with the requirements of Articles 84 and 123(3) EPC.

VII. A communication setting out the provisional opinion of the Board was issued on 26 February 2003, inviting observations from the parties within a period of four months. A further communication of the Board was issued on 29 August 2003, inviting observations from the parties within a period of two months. No reply to either communication was received from the appellant.

## Reasons for the Decision

### 1. *Procedural Matters*

1.1 The appellant has requested re-establishment of rights on the grounds that a fax sent on 10 March 1999 and a confirmation letter sent on 11 March 1999 at least did not reach the file and were consequently not taken into account by the Opposition Division. At this stage in the proceedings, the Opposition Division had issued a communication on 27 November 1998 inviting the appellant to file a response within a period of four months.

1.2 According to Article 122(2) EPC, an application for restitutio in integrum must be filed in writing within two months of the removal of the cause of non-compliance with the time limit. According to the case law of the Boards of Appeal, the removal of the cause of non-compliance occurs on the date on which the person responsible is made aware of the fact that a time limit has not been observed. In the present case, the representative acting on behalf of the appellant became aware of the fact that his fax and letter had not been taken into account upon receipt of the decision of the Opposition Division issued on 9 November 1999. The request for remittal to the first instance was, however, only made with the statement setting out the grounds of appeal, received on 8 February 2000. The request, insofar as the request is regarded as being for restitutio in integrum, thus cannot be allowed.

- 1.3 The occurrence of a substantial procedural violation within the meaning of Rule 67 EPC has not been sufficiently substantiated. In the first place, there is no evidence on file to the effect that the facsimile alleged to have been sent to the EPO on 10 March 1999 was in fact effectively sent to the EPO. Furthermore, it is not clear whether the registration receipt of the Spanish Post Office, annexed to the statement setting out the grounds of appeal, actually refers to the present case. Finally, it is noted that the letter of reply constituting the facsimile is not dated. When given an opportunity to respond to these points in a communication of the Board issued on 29 August 2003, no reply was received from the appellant.
- 1.4 The request of the appellant could also be regarded as being for remittal to the first instance as provided for in Article 111(1) EPC. This is not, however, appropriate in the present case. Claim 1 under consideration in the present main and first auxiliary requests constitutes a combination of claims 1 and 4 as granted. This combination was considered by the Opposition Division not to involve an inventive step (see paragraph 4.1 of the decision of the Opposition Division). The issues have thus already been considered by the department of first instance.
- 1.5 The request for remittal to the first instance, whether or not it is regarded as being a request for restitutio in integrum, thus cannot be allowed.



*Main request*

2. *Inventive step*

2.1 The closest prior art is represented by document D2, and, in particular, the process described with reference to Figure 2 of the drawings. In addition to the features of the preamble of claim 1, this document discloses a process in which:

- (i) the transparent resin (24) is polymerizable by ultraviolet rays (see column 6, lines 9 and 10);  
and
- (ii) the engraving on the resin-coated surface of the sheets is performed at the same time as ultraviolet rays are emitted on said sheets to polymerize the resin (engraving is carried out by means of moulds (42) at the same time as ultraviolet rays are emitted by the source (32)).

2.2 However, in the process of document D2, the resin (24) is applied to the sheet (12) at a point spaced from the point of the calender where the press roller is acting. The subject-matter of claim 1 is thus distinguished over the disclosure of document D2 in that the resin is applied on the sheet adjacent the point of the calender where the press roller is acting, i.e. where the engraving of the resin-coated sheet is being effected, so that said resin is applied practically at the same time as said sheet is delivered to said calender.

2.3 Figure 9 of document D4 shows a process for forming a hologram on a laminated structure by means of a cylinder (21). Transparent material (25) is supplied from a nozzle (24) onto the surface of the cylinder. Thus, the resin is applied to the sheet, i.e. first makes contact with the sheet, adjacent the point of the cylinder where a press roller (26) is acting, so that said resin is applied to the sheet practically at the same time as said sheet is delivered to said calender.

2.4 The only possibilities for applying the transparent resin to the substrate are to apply the resin:

(i) to the sheet upstream of the point at which the sheet passes between the calender and the press roller as in the process of document D2,

(ii) to the calender upstream of the point at which the sheet passes between the calender and the press roller as in the process of document D4, or

(iii) directly at the point at which the sheet passes between the calender and the press roller.

2.5 The choice of any of these possibilities so as to arrive at the subject-matter of claim 1 does not solve any technical problem and therefore does not involve an inventive step. In particular, the advantages suggested in the patent in suit at column 5, lines 13 to 19, that is, a reduction in the size of plant and in the engraving process time, would not be obtained merely as a result of altering the location at which the resin is applied to the sheet.

*First auxiliary request*

3. Claim 1 of the first auxiliary request contains the same features as claim 1 of the main request. The reasons for considering that the subject-matter of claim 1 of the main request does not involve an inventive step thus also apply to claim 1 of the first auxiliary request.

*Second auxiliary request*

4. In claim 1 of the second auxiliary request of the appellant, the following features contained in claim 1 as granted have been omitted:

(i) the resin is transparent;

(ii) the sheets comprise a ply of plastics material worked as a lens through which motifs provided therebehind are viewed; and

(iii) the engraving is performed by pressure and heat.

5. The claim has thus been amended so as to extend the protection conferred. The amendments to the claim accordingly do not comply with the requirements of Article 123(3) EPC.
6. In view of the above, none of the requests of the appellant are allowable.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

P. Cremona

W. Moser