

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [] To Chairmen
(D) [X] No distribution

D E C I S I O N
of 28 February 2003

Case Number: T 0220/01 - 3.2.5

Application Number: 96108494.4

Publication Number: 0737595

IPC: B42D 15/10

Language of the proceedings: EN

Title of invention:
Security document

Applicant:
MINNESOTA MINING AND MANUFACTURING COMPANY

Opponent:

-

Headword:

-

Relevant legal provisions:
EPC Art. 76(1)

Keyword:
"Extension beyond the content of the earlier application as
filed (yes)"

Decisions cited:
T 0331/87

Catchword:

-



Case Number: T 0220/01 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 28 February 2003

Appellant: MINNESOTA MINING AND MANUFACTURING COMPANY
(Applicant) 3M Center
Saint Paul, Minnesota 55133-3427 (US)

Representative: Voortmans, Gilbert J.L.
3M Europe S.A./N.V.
OIPC
Hermeslaan 7
B-1831 Diegem (BE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 23 October 2000
refusing European patent application
No. 96 108 494.4 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: W. Moser
Members: W. Widmeier
H. M. Schram

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the Examining Division refusing European patent application No. 96 108 494.4 (publication number EP-A-0 737 595), which is a divisional application of European patent application No. 90 906 739.9 (publication number WO 90/12694).

The Examining Division held in its decision, which was a decision according to the state of the file referring to three communications, that the application did not meet the requirements of Article 76(1) EPC since it went beyond the content of the earlier application as filed.

- II. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of

(a) claims 1 to 9 filed as main request on 3 February 2001; or

(b) claims 1 to 9 filed as auxiliary request on 3 February 2001.

In case the Board would not be prepared to accept the main request, oral proceedings were requested.

- III. On 5 November 2002, summons to attend oral proceedings were sent to the appellant, together with a communication. In the communication the Board explained why, according to its provisional opinion, the method claims 7 of the main request and the auxiliary request contravened Article 76(1) EPC.

On 15 November 2002 the appellant withdrew its request for oral proceedings.

IV. Independent claim 7 according to the main request reads as follows:

"7. A method of producing an image-bearing component for a security laminate comprising the steps of:

- (a) providing a sheet (10,20) of transparent medium having on a face thereof a layer (11) of a high temperature glue; and
- (b) producing an image (12) on the glue layer (11) using carbon or a compound which does not flow when applied to the glue layer (11) and which is absorptive of visible or near infra-red radiation; and, if necessary, allowing or causing the compound to set."

In independent claim 7 according to the auxiliary request the following feature is added at the end of claim 7 of the main request:

"the image-bearing component thus obtained being capable of forming said security laminate upon heat bonding said glue layer (11) to a substrate and said image (12) not being destroyed thereby."

V. The appellant argued essentially as follows:

The subject-matter of the divisional application can directly and unambiguously be derived from the earlier application as filed. Although the earlier application was directed to a method of producing an image within a laminate, which comprises an image-bearing component, it is clear for a person skilled in the art that

protection may be sought for the image-bearing component as such. It can be derived from the content of the earlier application as filed that the objective of the invention, i.e. to provide a security laminate having an image, is realized through the properties of the image-bearing component. Although, for achieving the final security laminate, it is necessary to bond the image-bearing component to a substrate, the essential contribution to the art lies in the image-bearing component. The bonding process is well-known in the art, and the feature that the image-bearing component is not destroyed when bonded to the substrate is the result of the image-bearing component. Thus, the bonding process is not an essential technical feature, and it is possible to claim only the intermediate product, i.e. the image-bearing component. Consequently, the divisional application does not go beyond the content of the earlier application as filed and is therefore in accordance with Article 76(1) EPC.

The additional feature of claim 7 of the auxiliary request is an inherent feature of the image-bearing component and serves to clarify the scope of the claim. Thus, also claim 7 of the auxiliary request meets the requirements of Article 76(1) EPC.

Reasons for the Decision

Main request

1. Independent claim 1 of the earlier application as filed is directed to a method of producing an image within a laminate. The method comprises the following steps:

- (i) coating one side of a sheet of transparent medium with a layer of high temperature glue;
- (ii) producing an image on the glue layer using carbon or carbon-containing or other radiation absorbent compound which does not flow when applied to the glue layer and, if necessary, allowing or causing the image-producing compound to set;
- (iii) applying a substrate to the high temperature glue layer on which the image has been produced; and
- (iv) bonding the transparent medium to the substrate using a known high temperature thermal bonding process, thus producing a laminate of the transparent material and the substrate.

Independent claim 2 of the earlier application as filed uses a slightly different wording for steps (i) and (ii), but is technically identical to claim 1.

Step (a) of claim 7 according to the main request corresponds to step (i) of claim 1 of the earlier application as filed and has the same technical meaning.

Step (b) of claim 7 according to the main request is identical to step (ii) of claim 1 of the earlier application as filed.

Thus, the method of claim 7 according to the main request omits steps (iii) and (iv) of the method of earlier application as filed, claiming only a method of

producing an intermediate product, called "image-bearing component for a security laminate", of the method of the earlier application as filed.

The question to be answered is whether the appellant is entitled to claim only that part of the method of the earlier application as filed which relates to this intermediate component.

2. The description of the earlier application as filed states on page 3, lines 4 to 23, that it was a surprising discovery that the "image is not destroyed, if the toner or other carbon-containing material used to create the image has set, when the glue layer is heated to create a bond". In other words, the surprising effect consists of two parts: an image is produced on a layer of high temperature glue **and** the image is not destroyed when the substrate is bonded to the glue layer. So, even as a well-known process, the step of bonding the transparent medium to the substrate constitutes an indispensable step of the method of the earlier application as filed. The skilled reader of the earlier application as filed is taught that the object of the invention is to provide a method for creating an image **within** a laminate which satisfies the requirements for the production of more secure security documents (cf. page 2, line 26 to page 3, line 3). It is not the object of the invention of the earlier application as filed to provide a method for the production of an image-bearing component suitable for a security laminate. Also, the expression "image-bearing component" is nowhere used in the earlier application as filed. Thus, the skilled reader would not infer a reduced method as specified in claim 7 according to the main request as a separate invention from the content

of the earlier application as filed.

In accordance with decision T 331/87 (OJ EPO 1990, 213), the omission of a feature is only allowable under Article 76(1) EPC when a skilled person would directly and unambiguously recognise that (1) the omitted feature was not explained as essential in the original disclosure, (2) it was not, as such, indispensable for the function of the invention in the light of the technical problem it served to solve, and (3) the removal required no real modification of other features. Requirements (1) and (2) are not fulfilled in respect of claim 7 according to the main request because, in the earlier application as filed steps (iii) and (iv) are described as essential steps of the method, and as indispensable for the function of the invention which consists in preventing the image on the glue layer to be destroyed when the glue layer is bonded to the substrate.

The Board therefore concludes that the omission in claim 7 of the main request of features (iii) and (iv) of the method disclosed in the earlier application as filed infringes Article 76(1) EPC.

Auxiliary request

3. Claim 7 of the auxiliary request is supplemented by the feature that the image-bearing component is capable of forming a security laminate by heat bonding the glue layer to a substrate without destroying the image. Thus, this claim mentions a property of the image which it shows only when the image-bearing component is bonded to the substrate. In the judgement of the Board, this amendment cannot overcome the fundamental

deficiency pointed out under point 1 above. The substrate and the bonding step, respectively, are missing also in claim 7 of the auxiliary request. For the same reasons as stated under point 2 above, also claim 7 according to the auxiliary request is not in accordance with Article 76(1) EPC.

4. Under these circumstances, it was not necessary to consider claim 1 of the main request and the auxiliary request, which is directed to an image-bearing component for making a security laminate.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

E. Görgmaier

W. Moser