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**Datasheet for the decision
of 22 October 2009**

Case Number: T 1265/07 - 3.2.05

Application Number: 97942714.3

Publication Number: 0930979

IPC: B41M 3/14

Language of the proceedings: EN

Title of invention:
Self-verifying security documents

Patentee:
Securency International Pty Ltd

Opponents:
GIESECKE & DEVRIENT GmbH
Leonhard Kurz Stiftung & Co. KG
DE LA RUE INTERNATIONAL LIMITED

Headword:

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Relevant legal provisions:
EPC Art. 54, 111(1), 123(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Extension beyond the content of the application as filed
(main request, auxiliary requests 1-3, yes; auxiliary
request 5, no)"
"Novelty (auxiliary request 5, yes)"
"Remittal (yes)"

Decisions cited:
T 0611/90, T 0473/98

Catchword:

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Case Number: T 1265/07 - 3.2.05

D E C I S I O N
of the Technical Board of Appeal 3.2.05
of 22 October 2009

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 29 May 2007
revoking European patent No. 0930979 pursuant
to Article 102(1) EPC.**

Composition of the Board:

Chairman: W. Zellhuber
Members: P. Michel
 M. J. Vogel

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division revoking European Patent No. 0 930 979.
- II. The patent in suit was revoked by the Opposition Division on the grounds of Articles 54 and 123(2) EPC.
- III. Oral proceedings were held before the Board of Appeal on 22 October 2009.

The appellant requested that the decision under appeal be set aside and that the patent in suit be maintained on the basis of claims 1 - 23 (main request), or, as an auxiliary measure, on the basis of one of the auxiliary requests 1 - 3 and 5 - 8, filed on 22 September 2009, or on the basis of one of the auxiliary requests 9 - 14, filed on 6 October 2009. Auxiliary request 4, filed on 22 September 2009, was withdrawn.

Respondents I and II (opponents 01 and 02) requested that the appeal be dismissed. Respondents I and II also requested that the case not be remitted to the first instance for further prosecution. Although not present at the oral proceedings, respondent III (opponent 03) also requested that the appeal be dismissed.

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

"1. A security document (1; 20;) including a security device (10; 22;) and verification means (11; 21;) for verifying or inspecting the security device (10; 22;),

said security document (1; 20;) being formed from a substrate (2) bearing indicia (3), wherein the security document is a banknote which comprises a single flexible sheet (2), the verification means comprises self-verification means (11; 21;) provided at a first transparent portion (5) of the single flexible sheet (2), wherein the first portion (5) is of transparent plastics material providing a window (5), characterised in that the single flexible sheet is formed from a transparent plastics substrate to which at least one opacifying layer is applied on both sides of the substrate to cover the surfaces of the substrate except in the area of the first portion and the security device (10; 22;) is provided at a second portion (4) of the single flexible sheet (2) spaced laterally from the first portion (5) so that the self-verification means (11; 21;) can be used to verify or inspect the security device (10; 22;) when the single flexible sheet (2) is bent, folded or twisted to bring the first and second portions (5,4) into register."

Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that the words "on an outer surface of one of said opacifying layers (3) at" are introduced after the word "provided".

Claim 1 of auxiliary request 2 differs from claim 1 of the main request in that the words "to cover the surfaces of the substrate" are omitted.

Claim 1 of auxiliary request 3 differs from claim 1 of auxiliary request 2 in that the words "on an outer surface of one of said opacifying layers (3) at" are introduced after the word "provided".

Claims 1 and 9 of auxiliary request 5 read as follows:

"1. A security document (1) including a security device (10) and verification means (11) for verifying or inspecting the security device (10) said security document (1) being formed from a substrate (2) bearing indicia (3), wherein the security document comprises a single flexible sheet (2), such as a banknote, the verification means comprises self-verification means (11) provided at a first transparent portion (5) of the single flexible sheet (2), wherein the first portion (5) is of transparent plastics material, and the security device (10) is provided at a second portion (4) of the single flexible sheet (2) spaced laterally from the first portion (5) so that the self-verification means (11) can be used to verify or inspect the security device (10) when the single flexible sheet (2) is bent, folded or twisted to bring the first and second portions (5,4) into register, characterised in that the self-verification means of the first portion (5) comprises an optical lens (11) and the security device provided at the second portion (4) comprises a feature (10) which can be inspected, enhanced or optically varied by the optical lens when the first and second portions (5,4) are brought into register."

"9. A security document (20) including a security device (22) and verification means (21) for verifying or inspecting the security device (22), said security document (20) being formed from a substrate (2) bearing indicia (3), wherein the security document comprises a single flexible sheet (2), such as a banknote, the verification means comprises self-verification means

(21) provided at a first transparent portion (5) of the single flexible sheet (2), wherein the first portion (5) is of transparent plastics material, and the security device (22) is provided at a second portion (4) of the single flexible sheet (2) spaced laterally from the first portion (5) so that the self-verification means (21) can be used to verify or inspect the security device (22) when the single flexible sheet (2) is bent, folded or twisted to bring the first and second portions (5,4) into register, characterised in that the security device comprises an area (22) of the sheet printed with metamerics inks, and the self-verification means comprises an optical filter (21) for viewing the area (22) printed with metamerics inks."

V. The following document is referred to in the present decision:

G1: EP-A-0 256 176

VI. The appellant argued substantially as follows in the written and oral procedure:

The amendments to claim 1 according to the main request and auxiliary requests 1 to 3 are disclosed in the application as filed (published version) at page 3, lines 2 to 7, as well as page 8, lines 13, 14 and 21 to 25, which corresponds fully to the passage at page 3.

As regards the feature of claim 1 that the surfaces of the substrate are covered except in the area of the first portion, the use of the term "opacifying" requires that the transparent substrate be covered.

Whilst reference is made to an "area or areas", the embodiment in which more than one such area is provided was deleted, and the claims are directed solely to the use of a single area. The use of the term "except" is exclusive and makes it clear that the entire surface of the substrate is covered except for the area which provides a window. Whilst the passage at page 8, lines 13 and 14 and 21 to 25, may be regarded as not explicitly disclosing covering the entire substrate apart from the window, the description does not contradict this interpretation of the passage at page 3, lines 2 to 7.

The term "window" as used in the claims must refer to a transparent, indicia-free portion of the security document.

For technical reasons, for example, the application of the security device by printing, the security device could not be in or under the opacifying layer, and must therefore be provided on the outer surface of the opacifying layer.

The amendments to claim 1 according to the main request and auxiliary requests 1 to 3 thus comply with the requirement of Article 123(2) EPC.

Document G1 does not disclose a security document comprising a single flexible sheet of flexible material, a verification means in the form of an optical lens, or a security device which can be inspected, enhanced or optically varied by an optical lens.

The passage at column 1, lines 23 to 29 of document G1 relates to the prior art and does not concern the security document disclosed in document G1. The arguments of the respondents concerning lack of novelty of claim 1 of auxiliary request 5 rely on picking out features from unrelated parts of document G1.

The subject-matter of claims 1 and 9 of auxiliary request 5 is thus new.

It would be appropriate to remit the case to the first instance for consideration of the question of inventive step in order to give the appellant the opportunity of arguing the matter at two instances.

VII. The respondents argued substantially as follows in the written and oral procedure:

As regards the feature of claim 1 that the surfaces of the substrate are covered except in the area of the first portion, the passage in the application as filed at page 3, lines 2 to 7, does not use the term "cover". This passage merely discloses that the at least one opacifying layer is not applied to an area or areas of the substrate.

The passage in the application as filed at page 3, lines 2 to 7, is solely concerned with the provision of an essentially indicia-free portion or window.

Claim 1 of the main request and auxiliary requests 1 to 3 is not restricted to the use of a security device produced by printing. It is entirely feasible that the

device could be included in or under an opacifying layer.

The amendments to claim 1 according to the main request and auxiliary requests 1 to 3 thus do not comply with the requirement of Article 123(2) EPC.

In the first to third and fifth paragraphs of document G1, there is disclosed a security document, such as a bank pass book. As the first paragraph makes clear, the disclosure is not restricted to documents in book form. In addition, Figures 17 and 18 show an embodiment of a front and back cover of a pass book, separated by a fold line, which together form a single flexible sheet.

It is implicit that the transparent strip on which the verification means is provided is a plastics substrate, since it is not feasible to use glass. In addition, the strip is bonded to the cover and thus forms a single sheet therewith. A lenticular screen constitutes an optical lens through which the security device can be inspected and is optically varied.

Whilst the fifth paragraph of document G1 is introduced by the words "various prior suggestions", this paragraph, together with the two following paragraphs, discloses one alternative for the means to be used to read the scrambled indicia of the security device. The reference at column 4, line 34 to "other methods (discussed above)" refers back to the fifth paragraph of document G1.

The subject-matter of claim 1 of auxiliary request 5 is thus not new.

It would not be appropriate to remit the case to the first instance for consideration of the question of inventive step in view of the excessive delay which this would cause, particularly in view of the age of the patent in suit. Reference is made to decisions T 611/90 and T 473/98.

Reasons for the Decision

1. *Main Request*

Amendments

- 1.1 In claim 1, it is specified that "at least one opacifying layer is applied on both sides of the substrate to cover the surfaces of the substrate except in the area of the first portion". This is construed to mean that at least one opacifying layer is applied on each side of the substrate to cover the entire surface of the substrate except in the area of the first, transparent portion.

It is disclosed in the application as filed at page 3, lines 2 to 7, that "the security document is preferably formed from a sheet-like substrate of transparent plastics material to which at least one opacifying layer or coating is applied on one side or both sides of the substrate except in the area or areas where it is desired to provide a transparent, essentially indicia-free portion or "window" in the security document. The at least one opacifying layer therefore

only partially covers the surface of the substrate to leave said first portion essentially indicia-free."

In addition, in connection with the embodiment illustrated in Figures 1 and 2, it is disclosed at page 8, lines 13 and 14, that "the substrate 2 is covered over most of its upper and lower surfaces by opacifying layers" and at page 8, lines 21 to 23, that "the opacifying layers of indicia are not applied over the entire surfaces of the sheet-like substrate 2 and thus leave a transparent portion 5 of the substrate which is at least partially not covered by the opacifying layers".

Thus, whilst there is a disclosure that the security document is provided with a transparent portion which is not covered by the opacifying layers on either side of the substrate, there is not an unambiguous disclosure that the remainder of the substrate is entirely covered on both sides by the opacifying layers. In particular, whilst the appellant placed particular reliance on the passage at page 3, lines 2 to 7, it is noted that this passage does not use the term "cover", but merely states that an opacifying layer or coating is applied on one side or both sides of the substrate. The use of the term "opacifying" in itself does not imply that the layers on each side of the substrate each entirely covers the substrate apart from a transparent window.

- 1.2 In addition, the passage at page 3, lines 2 to 7, cited under point 1.1 above, relates to the provision of a transparent, essentially indicia-free portion or "window" in the security document. There is, however,

nothing in claim 1 to indicate that the transparent portion is essentially indicia-free. The presence of indicia within the window would not prevent the transparent portion from functioning as a window through which a security device can be viewed.

- 1.3 For the reasons set out under both points 1.1 and 1.2 above, the amendments to claim 1 do not comply with the requirement of Article 123(2) EPC.

2. *Auxiliary Request 1*

Amendments

- 2.1 Claim 1 includes the feature that the security device is provided on an outer surface of one of the opacifying layers.

This feature is not disclosed in the application as filed either explicitly or implicitly. It is not excluded that the security device could form part of an opacifying layer. Whilst it may well be more convenient, when forming the security device by printing, to print on a continuous opaque layer, the claim is not restricted to a security device formed by printing. In addition, an opaque security device could be applied to the substrate as part of or under an opacifying layer.

- 2.2 In addition, claim 1 includes the features discussed under points 1.1 and 1.2 above in respect of the main request.
- 2.3 The amendments to claim 1 thus do not comply with the requirement of Article 123(2) EPC.

3. *Auxiliary Request 2*

Amendments

- 3.1 Claim 1 includes the feature discussed under point 1.2 above in respect of the main request. The amendments to claim 1 thus do not comply with the requirement of Article 123(2) EPC.

4. *Auxiliary Request 3*

Amendments

- 4.1 Claim 1 includes the features discussed under point 1.2 and 2.1 above in respect of the main request and auxiliary request 1. The amendments to claim 1 thus do not comply with the requirement of Article 123(2) EPC.

5. *Auxiliary Request 5*

Amendments

Independent claims 1 and 9 do not contain the features discussed above which do not comply with the requirement of Article 123(2) EPC. Claim 1 is directed to a security document in which the verification means comprises an optical lens, as disclosed in claims 1 and 9 of the application as filed and in the embodiment of the invention described with reference to Figures 1 and 2. Claim 9 is directed to a security document in which the security device is printed with metamerics inks, as disclosed in claims 1 and 17 of the application as

filed and in the embodiment of the invention described with reference to Figures 3 and 4.

Novelty

- 5.1 As set out in column 1, lines 1 to 14, document G1 relates to a security document, such as a bank pass book, having printed on one portion thereof an area of scrambled indicia and having on another portion thereof a transparent area configured as a reading screen for unscrambling the indicia. Column 1, lines 23 to 39 describe prior suggestions for printing scrambled indicia and notes that, if the indicia are scrambled by being photographed through a lenticular screen, the reading screen should also be in the form of a lenticular screen.

At column 4, lines 18 to 33, there is described, with reference to Figures 17 and 18, a preferred embodiment of a bank pass book having a cover, to one marginal edge of which is attached a transparent screen (111) on which is printed a reading screen (112) consisting of opaque straight lines. Scrambled indicia (113) are printed either inside the back cover or on a page of the book.

Figure 17 shows the back cover or page as being separated from the front cover by a single line. There is not, however any indication in document G1 as to whether this line represents a fold in a single sheet or whether the front and back covers are formed from two separate sheets. There is also no indication that the covers are flexible.

Whilst the respondents regard the sentence at column 4, lines 34 and 35 of document G1 as being a direct reference to the fifth paragraph of the document, this reference could refer rather to the passage at column 2, lines 8 to 33.

Document G1 thus does not disclose a security document which comprises a single flexible sheet having verification means provided at a first portion of the sheet and a security device provided at a second portion of the sheet spaced laterally from the first portion.

The subject-matter of claim 1 is therefore new.

- 5.2 Claim 9 relates to a security document in which the security device is printed in metameric inks. There is no suggestion in document G1 of such a security device. The subject-matter of claim 9 is therefore also new.

Claims 2 to 8 and 10 to 20 are directly or indirectly appendant to claims 1 and 9 respectively and relate to preferred features of the security document. The subject-matter of these claims is therefore similarly new.

6. *Remittal*

In T 611/90, OJ 1993, 50, it is indicated that, if a document is relied upon for the first time in an appeal proceedings and is admitted into the proceedings as being relevant, the case should normally be remitted to the department of first instance. In T 473/98, OJ 2001, 231, it is noted that the presence of appropriate

obiter dicta in a decision of an opposition division could obviate a remittal. These cases are thus not relevant to the present case.

The opposition division has not had the opportunity of considering the issue of inventive step. In order to enable this issue to be considered at two instances, the Board considers it to be appropriate to exercise their discretion to remit the case to the first instance for further prosecution in accordance with Article 111(1) EPC.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

D. Meyfarth

W. Zellhuber