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**Datasheet for the decision
of 3 February 2015**

Case Number: T 0013/11 - 3.3.01

Application Number: 03775147.6

Publication Number: 1546272

IPC: C09D11/00, B41M3/14, G07D7/12

Language of the proceedings: EN

Title of invention:
METHOD AND INK SETS FOR MARKING AND AUTHENTICATING ARTICLES

Patent Proprietor:
SICPA HOLDING SA

Opponent:
Bundesdruckerei GmbH

Headword:
Security ink/SICPA

Relevant legal provisions:
EPC Art. 100(c), 123(2)
RPBA Art. 12(4), 13(1)

Keyword:
Main request - added subject-matter (yes)
Auxiliary request -
request could have been filed in first instance proceedings
(yes)

Decisions cited:
T 0936/09, T 0361/08, T 1732/10

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 0013/11 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 3 February 2015

Appellant:
(Patent Proprietor)

SICPA HOLDING SA
Avenue de Florissant 41
1008 Prilly (CH)

Representative:

Hoffmann Eitle
Patent- und Rechtsanwälte PartmbB
Arabellastraße 30
81925 München (DE)

Respondent:
(Opponent)

Bundesdruckerei GmbH
Oranienstr. 91
10958 Berlin (DE)

Representative:

Jungblut, Bernhard Jakob
Jungblut & Seuss
Patentanwälte
Max-Dohrn-Strasse 10
10589 Berlin (DE)

Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 11 October 2010
revoking European patent No. 1546272 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman A. Lindner
Members: C. M. Radke
L. Bühler

Summary of Facts and Submissions

- I. An opposition was filed against the grant of European patent No. 1 546 272. The opposition sought the revocation of the patent as a whole and was based on grounds under Article 100(a) (alleged lack of novelty and inventive step), (b) and (c) EPC.
- II. The appeal of the patent proprietor is directed against the decision of the opposition division to revoke the patent.

In particular, the opposition division decided that grounds under Article 100(c) prejudiced the maintenance of the patent as granted (main request) and that claims 1 and 21 of the auxiliary request then on file contravened the requirements of Article 123(2) EPC.

- III. The present claims are
- claims 1 to 25 as granted and
 - claims 1 to 25 of the auxiliary request filed under cover of a letter dated 5 December 2014.
- a) Claim 1 of the main request (i. e. of the patent as granted) reads as follows:

"1. Printing ink, comprising

- (a) at least one dye or pigment having at least one absorption maximum in the visible range of the electromagnetic spectrum which is substantially different from the absorption maxima of the base colors of the CIEXYZ system, and
- (b) at least one other dye or pigment having an absorption band in the visible range of the electromagnetic spectrum whose band width at half intensity is narrower than 2400 cm^{-1} , and

(c) at least one other dye or pigment having at least one absorption maximum in the ultraviolet or in the infrared region of the electromagnetic spectrum."

- b) Claim 1 of the auxiliary request differs from that of the main request as follows (wherein the board marked deletions by striking through and insertions in bold):

"1. Printing ink, comprising

~~(a) at least~~ **more than** one dye or pigment having at least one absorption maximum in the visible range of the electromagnetic spectrum which is substantially different from the absorption maxima of the base colors of the CIEXYZ system, and
~~(b) at least one other dye or pigment~~ having an absorption band in the visible range of the electromagnetic spectrum whose band width at half intensity is narrower than 2400 cm^{-1} , and
~~(c)~~ at least one other dye or pigment having at least one absorption maximum in the ultraviolet or in the infrared region of the electromagnetic spectrum."

IV. In the following,

- the feature "at least one absorption maximum in the visible range of the electromagnetic spectrum which is substantially different from the absorption maxima of the base colors of the CIEXYZ system" will be denoted as "property A",
- the feature "an absorption band in the visible range of the electromagnetic spectrum whose band width at half intensity is narrower than 2400 cm^{-1} " as "property B" and

- the feature "at least one absorption maximum in the ultraviolet or in the infrared region of the electromagnetic spectrum" as "property C".

V. The arguments of the appellant, as far as relevant for this decision, may be summarised as follows:

Main Request

Claim 1 is based on original claims 1 and 2 and page 4, lines 4 ff., in particular page 4, lines 11-18, of the application as filed.

Original claim 1 allows for the presence of more than one dye or pigment having the properties A and/or B. That directly discloses at least one dye or pigment having the property A and at least one other dye or pigment having the property B. Page 4 of the application as filed shows that the properties A and B may be isolated and divided.

The fact that properties A and B may be present in respect of different dyes or pigments is evident from claims 1 and 2 and page 4 as originally filed.

To have at least one dye or pigment having the property A and at least one different dye or pigment having the property B is a selection of four possibilities out of six covered by original claim 1 and cannot be considered novel when the novelty test is applied.

Pages 5 and 19 disclose that features A and B have different effects and advantages that both contribute to the solution of the problem posed.

Moreover, example 4 comprises four dyes including

Macroflex Yellow 6G having the property A,
Rhodamine B base which has the property B and
Absorber dye IR P303 which has an absorption maximum
in the infrared region.

Although present claim 1 is no generalisation of
example 4, said example is a pointer to the subject-
matter claimed that cannot be ignored.

Auxiliary Request

The auxiliary request should be admitted into the
proceedings. It was filed two months prior to the oral
proceedings in reply to the board's communication. It
only comprises simple amendments which restrict the
scope of the claims and can be discussed without
delaying the procedure.

The auxiliary request filed in the opposition
proceedings resulted from a combination of granted
claims 1 and 3 and was intended to address the
objections. It is related to the present auxiliary
request, the latter being just more suitable to
overcome the objection under Article 123(2) EPC.

- VI. The respondent's arguments, as far as relevant for this
decision, may be summarised as follows:

Main Request

Claim 1 as originally filed only defines a dye or
pigment which either has property A or B or
both properties A and B. There is no basis in the
application as filed for the combination of one dye or
pigment having property A with a different dye or
pigment having property B. Page 4 of the application as
filed only provides a basis for original claim 1. The

ink of example 4 contains four different specific dyes, is completely silent on property B and is not suitable for generalisation.

The novelty test applied by the appellant proceeds from the wrong assumption that at least three different dyes/pigments must be present.

Auxiliary Request

The claims of the auxiliary request were late-filed and should not be admitted into the proceedings. Up to the oral proceedings before the opposition division only one auxiliary request was filed which obviously was not intended to overcome the objections under Article 123(2) EPC. The patent proprietor could and should have filed the claims of the present auxiliary request during the opposition proceedings (see decision T 0939/09).

VII. In its communication posted on 6 August 2014, the board gave reasons why it was of the preliminary opinion that grounds under Article 100(c) EPC prejudiced the maintenance of the patent on the basis of the main request.

VIII. The appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance on the basis of the claims as granted (main request) or of the claims of the first auxiliary request filed with letter of 5 December 2014 in case one of these requests is found allowable under Articles 100(c) and 123(2) EPC.

The respondent requested that the appeal be dismissed. It requested further that the auxiliary request filed

with letter dated 5 December 2014 not be admitted into the appeal proceedings.

IX. The chairman announced the decision of the board at the end of the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

2. Main request

2.1 This request comprises the claims as granted (see point III a) above). It was disputed whether grounds under Article 100(c) EPC prejudiced the maintenance of the patent as granted, in particular in view of the amendments in claim 1.

2.2 In particular, it was disputed whether or not the feature

(a) **at least one dye or pigment** having property A
and

(b) **at least one other dye or pigment** having property B

in claim 1 as granted has a basis in the application as originally filed (where properties A and B are as defined under point IV above).

2.3 The appellant indicated original claims 1 and 2, example 4 and pages 4, 5 and 19 of the description as originally filed as a basis for amended claim 1 as granted (see point V above).

2.4 Whereas original claim 2 is silent on properties A and B, original claim 1 requires that **at least one dye or pigment having property A and/or B** is present in the ink.

Original claim 1 thus leaves open whether the same or different dyes or pigments show properties A and B. Hence, the combination of original claims 1 and 2 is not sufficient as a basis for claim 1 as granted.

2.5 The appellant also relied on page 4, line 4 ff, in particular on lines 11-18, of the application as filed as a basis for the amendments. The passage on page 4, lines 11-18, reads as follows: "The marking on a value document or article according to the present invention comprises i) visible colors which are not used in ordinary color reproduction or printing, ii) narrow-band absorbers which do only yield pastel shade color, and iii) invisible 'colors' which correspond to absorption outside the visible range (400 to 700 nm) of the electromagnetic spectrum, either in the ultraviolet (below 400 nm) or in the infrared region (above 700 nm)".

This sentence does, however, not directly and unambiguously disclose that the feature i) (which corresponds to property A) and feature ii) (which corresponds to property B) may belong to different dyes or pigments.

This is confirmed in the following paragraph on page 4 ("Thus, the present invention is related to ...") which is related to inks containing at least one dye or pigment having property A or C and/or B, and thus is even less specific than original claim 1.

2.6 Whether or not pages 5 and 19 of the application as filed disclose that features A and B have different effects and advantages and both contribute to the solution of the problem posed is not relevant for the current issue as neither of these pages discloses that at least one dye or pigment is to have the property A and at least one **different** dye or pigment is to have property B.

2.7 The view that the amendment was only a selection of four out of six possible combinations covered by original claim 1 was raised on pages 6 and 7 of the statement setting out the grounds of appeal.

As the board pointed out in section 3.8 of its communication, the analysis of the appellant only covers the cases where two different dyes or pigments absorbing in the visible region are used in addition to the one absorbing IR- or UV-radiation. It does not take into account the cases covered by original claim 1 where only one "visible" dye or pigment is used.

The appellant provided no arguments as to why it deemed that the combination of

- (a) the selection of at least two dyes or pigments absorbing visible light from "at least one" such dye or pigment with
- (b) the selection of one dye or pigment having property A and a different dye or pigment having property B from dyes or pigments having properties A and/or B

was directly and unambiguously disclosed in original claim 1.

2.8 Finally, the appellant relied on example 4 as originally filed. This example relates to an ink

prepared by mixing Ink 1, Ink 2, Ink 3 and Ink 4 of formulation 3 (see page 25, lines 5-8, of the application as filed). Each of these Inks contains one specific dye or pigment. These dyes or pigments have absorption maxima at 550 nm (Ink 1), 610 and 680 nm (Ink 2), 440 nm (Ink 3) and 800 nm (Ink 4) (see pages 23 and 24 as originally filed). Only the absorption maximum of 800 nm of Ink 4 is outside the visible region (it absorbs in the infrared). Hence, the product of example 4 contains three specific dyes or pigments having a total of four absorption maxima in the visible region.

Whereas the appellant argued that this example fell under the scope of claim 1 and thus was a pointer to this claim, the respondent considered claim 1 to be an undue generalisation of this example.

First of all, the appellant pointed out that he never had argued that claim 1 was a generalisation of example 4 (see the statement dated 21 February 2011 setting out the grounds of appeal, the second complete sentence on page 4). Therefore, the board does not need to give reasons why it concurs with the respondent that such a generalisation would not be permissible under Article 100(c) EPC.

Secondly, as pointed out by the respondent, example 4 is silent on property B and the appellant did not provide any evidence that any of the dyes or pigments used in this example had this property (see respondent's letter dated 29 June 2011, the last complete paragraph on page 4). For this reason alone, example 4 cannot be a "pointer" to the subject-matter claimed.

2.9 For these reasons, grounds under Article 100(c) EPC prejudice the maintenance of the patent on the basis of the claims as granted. Therefore, the main request was refused.

3. Auxiliary request

3.1 The claims of this auxiliary request were filed under cover of a letter dated 5 December 2014 i. e.

- after the statement setting out the grounds of appeal dated 21 February 2011,
- after the board issued a communication and summoned the parties to oral proceedings on 4 August 2014 and
- prior to the oral proceedings before the board which took place on 3 February 2015.

This new auxiliary request replaced the one filed with the statement setting out the grounds of appeal, the claims of which being identical to those of the auxiliary request filed on 8 July 2010 which was decided upon in the decision under appeal.

3.2 According to decision T 936/09 of 1 March 2012, headnote, "the patent proprietor is not free to present or complete his case at any time that he wishes during the opposition or opposition appeal proceedings, depending, for example, on his procedural strategy or his financial situation. In view of the judicial nature and purpose of inter partes appeal proceedings (...) and in the interests of an efficient and fair procedure, the board considers it necessary that all parties to opposition proceedings complete their submissions during the first-instance proceedings in so far as this is possible. If a patent proprietor (...) chooses not to complete his submissions at the stage of

the first-instance proceedings, but rather presents or completes his case only in the notice of appeal or the statement setting out the grounds of appeal, then he will need to face the prospect of being held to account for such conduct by the board when, for example, exercising its discretion under Article 12(4) RPBA. (...)."

- 3.3 The board concurs with these principles. In the board's judgment, the above considerations, which were applied in the exercise of the discretion under Article 12(4) RPBA, can also be applied by the board when exercising its discretion under Article 13(1) RPBA. Otherwise it would be easily possible for the appellant to circumvent the provisions of Article 12(4) RPBA (T 361/08 of 3 December 2009, point 13 of the Reasons).

The board therefore considers, in agreement with the respondent, that admission of the present auxiliary request hinges on the question whether or not the appellant could have presented this auxiliary request during the opposition proceedings.

- 3.3.1 In its opposition brief, the respondent *inter alia* based its opposition on grounds under Article 100(c) EPC (see the letter dated 2 March 2009, section 2 on page 4). In particular, it was argued that there was no basis in the application as filed for the requirement in claim 1 as granted for the feature that at least one dye or pigment had property A whereas a different dye or pigment had property B.

In its communication dated 29 April 2010 annexed to the summons to oral proceedings, the opposition division gave a reasoned preliminary opinion why it concurred

with the opponent in that respect (see point 1.3 of the communication).

The patent proprietor filed claims forming the base of an auxiliary request on 8 July 2010. These claims differed from the ones as granted in that granted claims 1 and 2 were combined (see section 2 on page 5 of the respective letter). Neither did this amendment modify or replace the feature objected to by the opponent and the opposition division, nor did the patent proprietor give any reasons in said letter why the combination of granted claims 1 and 2 were to overcome said objection.

No further auxiliary request was submitted during the opposition proceedings.

- 3.3.2 Consequently, the patent proprietor and present appellant **could** have filed claims which were likely to overcome the objection under Article 100(c) or 123(2) EPC in response to the communication of the opposition division at the latest.

The appellant's argument that the auxiliary request resulted from consideration of the board's preliminary opinion in the annex to the summons to oral proceedings does not justify the admittance of the late filed request. First, the board's preliminary opinion did not introduce any new issues, facts, or arguments which would justify the appellant's auxiliary request. Second, parties to appeal proceedings are not entitled to wait for the board's preliminary opinion before dealing in substance with an issue or argument raised by the other party (T 1732/10 of 19 December 2013, points 1.3 and 1.4 of the Reasons). For a complete reply to the objections raised by the opponent under

Article 100(c) EPC, the appellant should therefore have filed an appropriate set of amended claims during the opposition proceedings. In doing so, the present situation could have been avoided where the admission of the auxiliary request would have either required consideration by the board of grounds for opposition on which the opposition division had not taken a decision, or remittal to the department of first instance for further prosecution.

3.3.3 For these reasons, the board exercised its discretion under Article 13(1) RPBA by not admitting the auxiliary request into the proceedings.

4. As mentioned above, grounds under Article 100(c) EPC prejudice the maintenance of the patent based on the main request of the appellant. The sole auxiliary request of the appellant was not admitted into the proceedings. Consequently, the appeal was dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Schalow

A. Lindner

Decision electronically authenticated