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**Datasheet for the decision  
of 12 September 2012**

**Case Number:** T 1496/11 - 3.2.05

**Application Number:** 97942714.3

**Publication Number:** 930979

**IPC:** B41M3/14

**Language of the proceedings:** EN

**Title of invention:**

Self-verifying security documents

**Patentee:**

Securrency International Pty Ltd

**Opponents:**

Giesecke & Devrient GmbH  
Leonhard Kurz Stiftung & Co. KG  
De La Rue International Limited

**Headword:**

**Relevant legal provisions:**

EPC 1973 Art. 87, 54(3), 56  
EPC R. 103(1)

**Keyword:**

Priority - identity of invention - main request (no)  
Admissibility of late filed documents (yes)  
Remittal (no)  
Novelty - main request (no)  
Inventive step - auxiliary request 1 (yes)  
Reimbursement of appeal fee (no)

**Decisions cited:**

T 0378/88, T 0027/94, T 1265/07

**Catchword:**



**Beschwerdekammern  
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Case Number: T 1496/11 - 3.2.05

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.05**  
**of 12 September 2012**

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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted 25  
May 2011 concerning maintenance of the European  
Patent No. 930979 in amended form.**

**Composition of the Board:**

**Chairman:** M. Poock  
**Members:** S. Bridge  
M. J. Vogel



## Summary of Facts and Submissions

I. Three oppositions were filed against European patent No. 0 930 979 as a whole based on Article 100(a) EPC (lack of novelty, Article 54 EPC, and lack of inventive step, Article 56 EPC).

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

priority document: PCT/AU97/00675

G1: EP-A-0 256 176

G2: "*Optical interference coatings for inhibiting of counterfeiting*", J.A.Dobrowolski et al, *Optica Acta*, 1973, vol. 20, no. 12, pages 925 to 937

G3: EP-A-0 290 875

G5: GB-A-1 512 018

G19: WO-A-94/27254

G25: EP-A-1 147 912, a divisional application of the patent in suit

G26: Script "*New standards for Banknote Security-Polymer Banknotes*" ("*Exhibit PZ-3*") presented at the "*9th International Conference on Currency Counterfeiting and 3rd International Conference on Fraudulent Travel Documents*" in Helsinki from 9 to 13 June 1997; including a "*Statutory Declaration*"; "*Draft Agenda*", "*Draft list of Delegates*" ("*Exhibit PZ-2*") and "*Slides plus comments*" ("*Exhibit PZ-4*")

III. On a first appeal against the opposition division's decision to revoke the patent, the board decided in decision T 1265/07 - inter alia - that the independent claims of auxiliary request 5 did not contain those features which were objected to under Article 123(2) EPC and that the subject-matter of claims 1 and 9 was

new with regard to document G1. For the consideration of the inventive step requirement, the case was remitted to the first instance.

- IV. The present appeal is against the interlocutory decision of the opposition division of 25 May 2011 on the basis of which the patent could have been maintained in amended form. Opponent O1 lodged this appeal on 27 June 2011 and paid the appeal fee on the same day. The statement setting out the grounds of appeal was received on 22 September 2011.
  
- V. Oral proceedings were held before the board of appeal on 12 September 2012 in the absence of the party as of right (opponent O3), whose representatives had previously informed the board that they would not attend.
  
- VI. The appellant (opponent O1) requested that the decision under appeal be set aside, that the patent in suit be revoked and that the appeal fee be reimbursed.

The respondent (patent proprietor) requested that the appeal be dismissed (main request) or that the decision under appeal be set aside and that the patent in suit be maintained on the basis of the sets of claims, filed as auxiliary request 1 during the oral proceedings, or the sets of claims filed on 10 February 2012 (auxiliary requests 2 to 9).

Opponent O2 withdrew its opposition on 2 February 2011 and is therefore no longer a party to these appeal proceedings.

The party as of right (opponent O3) did not file any requests.

VII. Independent claims 1, 9 and 20 of the patent in suit as maintained by the opposition division (now main request, formerly 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 bank note, 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 bank note, 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 metameric inks, and the self-verification means comprises an optical filter (21) for viewing the area (22) printed with metameric inks."*

*"20. A method of verifying a security document in accordance with any one of the preceding claims, characterised in that the method comprises the step of bending, folding or twisting the flexible sheet to bring the first portion of the sheet including the self-verification means into register with the security device provided at the second portion of the sheet."*

VIII. Claim 1 according to auxiliary request 1 differs from claim 1 according to the main request in that the expression "*comprises a feature (10)*" is replaced by "*comprises a printed or embossed feature (10)*". Independent claims 9 and 20 according to auxiliary request 1 are identical to those of the main request.

IX. The arguments of the appellant in the written and oral proceedings can be summarised as follows:



The embodiment of the invention in which the self-verification means comprises an optical lens was only disclosed in the priority document in combination with a security device which comprises a printed or embossed feature (priority document, page 4, lines 12 to page 5, line 1). In claim 1 (main request), which is based on this embodiment, this limitation has been omitted so that the subject-matter of claim 1 has been generalised to security devices produced by other means such a hot stamping or photo-lithographic processes.

Similarly, the feature that the transparent portion of the substrate is "*essentially indicia free*", which is systematically disclosed in the priority document, has been omitted from the subject-matter of claims 1 and 9 (main request).

Conversely, the alternative that the single flexible sheet is "*bent*", present in the subject-matter of claims 1 and 9 (main request), is not disclosed in the priority document. A similar objection to the term "*twisted*" was withdrawn in view of its disclosure in the first paragraph of page 15 of the priority document.

Therefore, claims 1 and 9 (main request) are not entitled to the claimed priority.

In consequence, the divisional application G25 of the patent in suit and document G26 are *prima facie* relevant for novelty and should be introduced into the proceedings. The issue of novelty with respect to these documents was not treated in earlier decision T 1265/07 so that there is no case of *res judicata* in view of these new facts. The description of the embodiments in the divisional application G25 is identical to that in

the priority document. The divisional application G25 is thus validly entitled to the claimed priority and thereby constitutes novelty destroying prior art under Article 54(3) EPC for the subject-matter of claim 1 (main request).

The admissibility of the auxiliary request 1 as filed during the oral proceedings of 12 September 2012 was not contested.

The subject-matter of claim 1 (auxiliary request 1) only differs from the closest prior art document G1 in that the front and rear cover of the bank pass book comprises a "*single flexible sheet*". The objective problem thus concerns the manufacture of such a cover. Booklets such as passports whose cover comprises a single flexible sheet are generally known. The subject-matter of claim 1 (auxiliary request 1) is thus arrived at immediately without an inventive step.

As set out in its introduction, document G1 is not limited to the example of bank pass books but also concerns security documents in general (see also document G1, claim 10). A reference to security documents is generally understood to include banknotes. The person skilled in the development of security features will always seek to apply such security features to different kinds of security documents and would therefore consider applying the invention of document G1 to banknotes. As banknotes consist of a single flexible sheet, the subject-matter of claim 1 (auxiliary request 1) is arrived at immediately without an inventive step.

The reference in document G1 to security documents in general (column 1, lines 1 to 14, claim 10) also leads

the skilled person to consider banknotes, in particular, because self-verification means which are also applicable to banknotes are known from documents G2 and G3. The person skilled in the art of developing security features would thus infer from the self-verification inventions of documents G2 and G3 that the invention set out in document G1 can be immediately applied to banknotes without requiring an inventive step.

Furthermore, the use of a lens as reading screen is suggested in document G1 (column 1, lines 23 to 29) by the reference to a "*lenticular screen*" which inevitably comprises lenses.

Document G19 (page 12, lines 11 to 21, figure 1) discloses a printed array of microimages as a security feature to be verified by viewing it through spherical microlenses. The microlenses may be positioned above the microimages and integrated into documents whose substrate is made of plastic (page 21, lines 9 to 20, figure 5). The subject-matter of claim 1 (auxiliary request 1) differs from this state of the art in that the verification means are spaced laterally from the microimages such that the security document has to be folded when inspecting or verifying the document. Starting from document G19 as the closest prior art, the objective problem is thus to provide a further alternative for combining the lenses with the microimages for self-verification of a security document.

Document G1 solves this problem of providing a security document with means to enable its authenticity to be readily checked (column 1, lines 3 to 5) and mentions explicitly a security system with a lenticular screen

(column 1, lines 23 to 29). Thus applying the general teaching from document G1 to the security document according to document G19 immediately leads the skilled person to the subject-matter of claim 1 (auxiliary request 1) without performing an inventive step.

A further solution disclosed in document G19 involves the use of a separate verification device incorporating the microlenses (page 26, figure 6). Document G2 discloses, as an alternative to such separate verification devices, a solution in which the self verification means and the security device are spaced apart on the same document, so that by folding one can test one with the other (page 931, last paragraph, figure 11). Similarly, document G3 proposes, as an alternative, to separate testing devices (column 1, lines 22 to 27 and 34 to 36), providing the security document with two apertures with polarising films and folding the security document so as to bring these two apertures together for self-verification. Thus applying the teaching from either document G2 or G3 to the security document according to document G19 immediately leads the skilled person to the subject-matter of claim 1 (auxiliary request 1) without performing an inventive step.

Document G5 discloses the use of metameric inks for inhibiting forgery (page 1, lines 10 to 29 and 59 to 62). In the embodiment, the filter is separate from the security document (page 2, lines 66 to 78). The subject-matter of claim 9 differs from the invention of document G5 in that the filter is part of the security document. The objective problem is thus to configure the security document so as to avoid such external verification means. This problem is addressed in any one of documents G1 (column 1, lines 3 to 14) and G3

(column 1, lines 22 to 27). The skilled person is thus led by document G1 or G3 to include the filter in the security document and thereby immediately arrive at the subject-matter of claim 9 without an inventive step.

Conversely, the skilled person starting from any one of documents G1, G2 or G3 would be led by the invention of document D5 to use metameric inks and a filter as self-verification elements.

Thus the subject-matter of claim 9 lacks an inventive step.

After the Chairman's announcement of the board's conclusions concerning the inventive step deliberations, the reimbursement of the appeal fee was requested, because the opposition division's decision was deemed not to have been sufficiently reasoned.

- X. The arguments of the respondent in the written and oral proceedings can be summarised as follows:

The omission from the subject-matter of claim 1 of the "*printed or embossed feature*" of the security device has as basis in the priority document both the general presentation of the invention (priority document, page 3, lines 21 to 29) and the alternative embodiment in which a "*distorting lens may be used to distort a security device, ...*" (page 4, line 28 to page 5, line 1). Furthermore, both this feature and the "*essentially indicia-free*" nature of the transparent portion are not essential features of the invention and may thus be omitted without resulting in a previously undisclosed generalisation. The addition of the term "*bend*" merely constitutes an explanation of the *verification process* without adding subject-matter to

the *device* claims 1 and 9. Claims 1 and 9 (main request) are thus entitled to the claimed priority.

Late filed documents G25 and G26 should not be introduced into the proceedings, because they are not *prima facie* relevant. If they are nevertheless introduced, then the case should be remitted to the first instance to provide the respondent with two instances for the novelty discussions based on these documents. Otherwise, there are no comments concerning the question of novelty of the subject-matter of claim 1 with respect to documents G25 and G26.

Late filed auxiliary request 1 should be admitted into the proceedings, because it aims to overcome the specific cause of lack of entitlement to the claimed priority as identified during the oral proceedings before the board.

Document G1 discloses a bank pass book with a scrambled representation of a signature as only example of a security document. The subject-matter of claim 1 (auxiliary request 1) differs therefrom in that the security document comprises a single flexible sheet, the self-verification means comprises an optical lens and the security device comprises a feature which can be inspected, enhanced or optically varied by the optical lens.

Paragraph 5 (column 1, lines 23 to 29) of document G1 only refers to prior art and cannot be understood as forming part of the invention disclosed in document G1. The term "*lenticular screen*" is merely used without further explanations in this paragraph and it is not clear that such a "*lenticular screen*" comprises any lens: in the context of document G1 the reading screen

of the embodiment does not comprise any lens and only consists of a transparent strip with printed opaque straight lines (column 4, lines 21 to 23).

The skilled person is not motivated to change the security documents respectively disclosed in documents G2 and G3 both of whose self-verification processes are based on the principle of extinguishing light and thus different from the claimed arrangement with a lens. It is thus not possible to arrive at the subject-matter of claim 1 (auxiliary request 1) from any combination of documents G1, G2 or G3. The skilled person has no reason to deviate from the respective solutions of documents G1, G2 or G3 or seek to combine their teachings.

The security document set out in figure 5 of document G19 does not require a verification process, because the lenses are fixed in the thick plastic substrate at the appropriate focusing distance above the microimages (page 21, lines 13 to 20). The subject-matter of claim 1 (auxiliary request 1) differs therefrom in that the security document has to be folded for the verification process and thus constitutes a different solution. Documents G2 and G3 teach self-verification by testing for the extinction of light when overlaying two multilayer or polarising filters. In the absence of any indication of particular advantages, there is no motivation for the skilled person to modify any of these solutions or to attempt to re-combine their features in any particular way.

The use of metamerick ink (document G5) is not necessarily suitable for scrambling a signature in a bank pass book (document G1). Furthermore, the filter for use with the metamerick inks is not necessarily

suitable for incorporating into a single flexible sheet.

The subject-matter of claims 1 and 9 according to auxiliary request 1 therefore involves an inventive step.

XI. The party as of right did not present any arguments.

### **Reasons for the Decision**

1. The appeal is admissible.
2. Priority right, Article 87 EPC 1973
  - 2.1 The general presentation of the invention on page 3, lines 21 to 29 of the priority document does not constitute a basis for omitting the "*printed or embossed feature*" from the security device disclosed in the context of the embodiment in which the self-verification means comprises an optical lens (priority document, page 4, line 13 to page 5, line 1) and on which the subject-matter of claim 1 is based, because this would constitute an intermediate generalisation in which said feature, which was only disclosed in combination with those of the embodiment, would have been arbitrarily omitted from the context of that combination.

Similarly, the alternative "*distorting lens*" merely constitutes "*another form of optical lens*" (priority document, page 4, lines 28 to page 5, line 1) and thus has to be understood in the overall context of the



embodiment with the "*optical lens*" taken as a whole (priority document, page 4, line 13 to page 5, line 1) so that this does not form a basis for the omission of the "*printed or embossed feature*".

Thus the security device according to claim 1 (main request) has been generalised to include features produced by other means such as, for example, hot stamping or photo-lithography. The subject-matter of claim 1 (main request) thus does not constitute the same invention as that set out in the priority document (Article 87(1) EPC 1973).

- 2.2 Although the transparent portion is systematically described as "*essentially indicia free*" throughout the priority document, when understood in the context of the priority document taken as a whole, the requirement "*essentially indicia free*" does not go beyond the condition that the transparent portion in the security document has to be usable as a means for verifying, enhancing or optically varying a security device elsewhere on the document (priority document, page 3, lines 18 to 20) even when indicia are present in the transparent portion. The possible presence of translucent indicia in the transparent portion, as raised by the appellant, is not explicitly discussed in the priority document but would, in any case, still be subject to this condition.

Thus, the absence of an explicit statement in claims 1 and 9 to the effect that the transparent portion has to be "*essentially indicia free*" in itself does not make the subject-matter of claims 1 and 9 a different invention with respect to the one disclosed in the priority document, because these claims contain the

limitation "*that the self-verification means (11) can be used to verify or inspect the security device (10)*".

- 2.3 The addition in claims 1 and 9 (main request) that the single flexible sheet may be "*bent*" instead of "*folded*" does give rise to an invention different from that disclosed in the priority document for the following reason: *Folding* the single flexible sheet to bring the first and second portions into register so that the self-verification means can be used to verify or inspect the security device necessarily involves *bending* the single flexible sheet. Conversely, *bending* the single flexible sheet to bring the first and second portions into register so that the self-verification means can be used to verify or inspect the security device is a process which can also be described as "*folding*". The addition of the term "*bent*" to the wording of claims 1 and 9 does not add any new possibilities which were not immediately and unambiguously derivable from the disclosure of the prior art document.

The appellant's argument that the covers of a bank pass book, which, for the sake of this argument, are to be assumed rigid and thus may be folded but not generally bent, cannot be accepted by the board, because the security document claimed in claims 1 and 9 (main request) comprises a single flexible sheet. The embodiments of the invention concern (flexible) banknotes and there is no support elsewhere in the patent in suit of a limitation to a security document with rigid covers joined to the single flexible sheet so as to only permit folding about a hinge-like region connecting these rigid covers but which is otherwise prevented from bending by the rigidity of the covers.

Thus, the addition of the term "*bent*" to the wording of claims 1 and 9 in itself does not make the subject-matter of claims 1 and 9 a different invention with respect to the one disclosed in the priority document.

2.4 The addition in claims 1 and 9 (main request) that the single flexible sheet may be "*twisted*" instead of or in addition to being "*folded*" was no longer contested and has a basis in the first paragraph of page 15 of the priority document.

2.5 The subject-matter of claim 9 (main request) thus constitutes the same invention as that set out in the priority document (Article 87(1) EPC 1973).

3. Late filed document G25; *res judicata*; request for remittal and novelty

In view of the foregoing, the subject-matter of claim 1 (main request) is only entitled to the filing date of 08 October 1997.

The divisional application G25 of the patent in suit discloses an embodiment in which a flexible banknote may be folded upon itself and a self-verification means in form of an optical lens used to view an area of microprinting which constitutes the security device (column 8, lines 21 to 34 and figures 1 and 2). The description of this embodiment is identical to that provided in the priority document (page 9, lines 19 to 27 and figures 1 and 2). This embodiment of the divisional application G25 is therefore entitled to the claimed priority date of 10 October 1996 and thereby anticipates the subject-matter of claim 1 (main request) which is only entitled to the filing date of 08 October 1997. These new facts were not addressed in

the earlier decision T 1265/07 so that, according to established case law (e.g. T 27/94, item 2; T 378/88, item 4) there is no case of res judicata.

For these reasons, the divisional application G25 is prima facie relevant and the board exercised its discretion to introduce it into the proceedings.

The board considered that, in the absence of an absolute right to have an issue decided upon by two instances, the question of novelty with respect to the divisional application G25 did not warrant a remittal at this advanced stage of the proceedings. The board thus exercised its discretion to refuse the respondent's request for remittal to the first instance.

The lack of novelty of the subject-matter of claim 1 (main request) with respect to the divisional application G25 under Article 54(3) EPC was subsequently not contested by the respondent.

Hence, the subject-matter of claim 1 (main request) lacks novelty with respect to the divisional application G25 under Article 54(3) EPC.

4. Auxiliary request 1

Claim 1 according to the auxiliary request 1 specifies that the security device "*comprises a printed or embossed feature*" and is thus the same invention as that disclosed in the priority document.

5. Inventive step, Article 56 EPC (auxiliary request 1)

5.1 Claim 1

5.1.1 The subject-matter of claim 1 (auxiliary request 1) differs from the invention disclosed in document G1 in that the claimed security document comprises a single flexible sheet with an optical lens for inspecting, enhancing or optically varying the security device. Such a security document has a different structure from that of a booklet used for bank pass books (document G1) or passports.

Document G1 does not disclose the cover as a single flexible sheet nor does it teach disposing the reading screen and the scrambled indicia laterally spaced on a single flexible sheet. Document G1 mentions the prior art possibility of a security feature involving a lenticular screen (column 1, lines 23 to 29) in a conditional manner ("*If this system were used ...*"). It thus remains indeterminate, whether this possibility forms part of the teaching of document G1 or not. However, according to document G1, the preferred method of scrambling the indicia involves a different arrangement with a regularly lined image disposed on a regularly lined background together with an overall random pattern (column 1, line 40 to column 2, line 33) and is used in the embodiment of document G1.

Even though the term "*security document*" may generally be understood to refer to items such as passports, security passes, identity cards, banknotes, credit and identity cards (see page 12 of the grounds of appeal), it is not clear that this term would necessarily encompass all of these types of security documents in the context of document G1, because not all security

documents are in book form. Security documents not in book form include some typically inherently rigid security documents, such as credit or identification cards, while others such as banknotes are usually in form of a single flexible sheet. There are no indications in document G1 as to whether or how the invention may be applied to security documents not in book form. Since the invention of document G1 is only disclosed with the example of a bank pass book, the reference to security documents in general thus does not immediately extend the invention of document G1 in any obvious way to security documents not in book form. Thus, it cannot be deemed obvious to the skilled person that security documents which are not in book form may also be suitable for the invention of document G1 without having been motivated to investigate such matters.

Even if, as advanced by the appellant, the person skilled in the development of security features were to consider applying the invention of document G1 to banknotes, he would arrive at a banknote incorporating a method of scrambling the indicia which involves the arrangement with the regularly lined image disposed on a regularly lined background together with an overall random pattern (column 1, line 40 to column 2, line 33). There is no motivation in document G1 to cause the skilled person to deviate from the preferred embodiment and instead, as an additional measure, seek to investigate the possibility of configuring part of a banknote as a lenticular screen in accordance with the passage column 1, lines 23 to 29 of document G1.

Although documents G1, G2 and G3 each disclose an invention in which two elements of a security device are brought into register for the purpose of

verification, this only occurs in the context of the particular security device respectively disclosed in each of these documents. None of these documents teach that the process of folding and bringing into registry a self-verification element and a security device is a general principle in which the nature of the self-verification element and security device may be arbitrarily varied. A multiple step process in which a skilled person first has to consult several documents, such as documents G1, G2 and G3, in order to infer a general teaching of folding a transparent verification feature of a single flexible sheet onto a security feature laterally spaced on the same single flexible sheet for the purpose of self-verification before then selecting an alternative security device and verification means such as spherical microlenses and microimages (document G19) demonstrates a lack of obviousness rather than the contrary, because there is no motivation for the skilled person to carry out such an investigation, other than hindsight.

- 5.1.2 Document G19 discloses a security document in which an array of micro-lenses is fixed in the thick plastic substrate above the microimages (page 21, lines 9 to 20, figure 5). If document G19 is considered to form the closest prior art, the subject-matter of claim 1 (auxiliary request) differs from the embodiment of figure 5 in that the lens and the printed feature are spaced laterally on the single flexible sheet and thus require folding the lens onto the printed feature for inspecting or verifying the security document. The verification process is thus not as immediate as with the security document of document G19 which only requires looking at the security feature. The kind of security documents considered in document G19 are "*banknotes, credit cards and the like*" (page 1, lines 5

to 9). It is not clear what would motivate a skilled person to consult a document concerned with a bank pass book such as document G1 when concerned with "*banknotes, credit cards and the like*". Nevertheless, in order to arrive at the subject-matter of claim 1, the skilled person, in combining the teachings of documents G19 and G1, would have to selectively choose to retain the plastic substrate, the microlenses and microimages from the invention of document G19, discard the book, the printed reading screen and scrambled indicia of the invention disclosed in document G1, while laterally spacing the microlenses from the microimages on a same single flexible sheet. In particular, placing self-verification means spaced laterally from the security device on a "*single flexible sheet*" is not derivable from either document and there is, thus, no motivation for the skilled person to do so, other than hindsight.

- 5.1.3 A further solution disclosed in document G19 involves the use of a separate verification device incorporating the microlenses (page 26, figure 6). Document G2 discloses, as an alternative to a separate testing device, a security document in which the two multilayer coatings are filters which, when placed in series, would not transmit any light and which are affixed to the security document, so that by folding, one coating can be tested against the other using any white light source (page 931, last paragraph, figure 11). Similarly, document G3 proposes as an alternative to separate testing devices (column 1, lines 22 to 27 and 34 to 36), a security document with two apertures with polarising films such that the axes of polarisation are mutually at right angles when the security document is folded so as to bring these two apertures together.



In order to arrive at the subject-matter of claim 1 by combining the teachings of document G19 and either one of documents G2 and G3, the skilled person would have to selectively choose to retain the plastic substrate, the microlenses and microimages from the invention of document G19, discard the multilayer films or polarising films of the inventions disclosed in documents G2 and G3 but laterally space the microlenses from the microimages on a same single flexible sheet. There is no motivation for the skilled person to select this particular combination of features. Furthermore, the embodiment shown in figure 5 of document G19 already avoids the need for a separate testing device by incorporating the lenticular screen above the printed image. Thus, there is no motivation for the skilled person to selectively isolate such a particular combination of features from document G2 or G3, other than hindsight.

5.1.4 Therefore, the subject-matter of claim 1 (auxiliary request 1) is based on an inventive step (Article 56 EPC 1973).

5.2 Claim 9

5.2.1 The subject-matter of claim 9 (auxiliary request 1) differs from the invention set out in document G1 in that the claimed security document comprises a single flexible sheet printed with metamerics inks and an optical filter for viewing the thus printed area.

5.2.2 Document G5 discloses the use of metamerics inks for inhibiting forgery of thus printed matter and involves the use of a separate filter for verification (page 1, lines 10 to 29 and 59 to 62; page 2, lines 66 to 78). The subject-matter of claim 9 (auxiliary request 1)

differs from the invention set out in document G5 in that the claimed security document further includes the optical filter for viewing the area printed with metamerics inks when folded so as to bring the filter into register with the printed area.

5.2.3 There is no indication in either document G1 or document G5 that the security device and the self-verification means are to be spaced apart on a single flexible sheet. In addition, there is no indication in document G5 that the filter is suitable for integration into a security document. The combination of the teachings of documents G1 and G5 thus, at best, leads to a bank pass book with a security device printed with metamerics ink and a reading screen including the filter. Thus, starting from either document G1 or document G5, in combination with the other one of documents G1 and G5, does not lead the skilled person to the subject-matter of claim 9, even if he were motivated to make such a combination.

5.2.4 Document G3 mentions invisible markings on valuable documents such as bank notes and identifies the problem of avoiding the inconvenience that these require separate verification equipment (column 1, lines 10 to 27). Document G3 discloses the use of areas of polarisation with polarisation axes mutually at right angles when folding the security document brings together these polarising areas (column 1, lines 47 to column 2, line 11, figures 1 to 9). Thereby document G3 solves the problem of avoiding additional equipment for verification.

The subject-matter of claim 9 differs from the inventions disclosed in documents G3 (or in document G2) by the use of metamerics inks for the

security device and of an optical filter as self-verification means.

It is not clear why the skilled person would be motivated to replace the polarising filters of document G3 or the multilayer filters of document G2 by other means. There is also no indication in either document G3, G2 or G5 that the kind of optical filter for verifying the metameric inks is immediately suitable for integration into a single flexible sheet. Therefore, the skilled person starting from document G5 is not directed towards a single flexible sheet with a security device printed with metameric ink laterally spaced from a filter for these metameric inks forming the self verification means.

5.2.5 The subject-matter of claim 9 (auxiliary request 1) is based on an inventive step (Article 56 EPC 1973).

5.2.6 Verification method claim 20 is carried by the independent device claims 1 and 9 and is thus also based on an inventive step (Article 56 EPC 1973).

6. Request for reimbursement of the appeal fee

A requirement for reimbursement of the appeal fee under Rule 103(1)(a) EPC is that the appeal itself be deemed allowable. As this requirement has not been met, the reimbursement of the appeal fee cannot be allowed (Rule 103(1)(a) EPC).

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to maintain the patent on the basis of the following documents:
  - Claims 1 to 20, filed as auxiliary request 1 during the oral proceedings;
  - Description, columns 1 to 12 and drawings, figures 1 to 4, as filed during the oral proceedings before the opposition division on 9 December 2010.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated