

Internal distribution code:

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

**Datasheet for the decision
of 12 July 2016**

Case Number: T 2203/12 - 3.2.05

Application Number: 03727109.5

Publication Number: 1509396

IPC: B41C1/05, B41M3/14, B23K26/00

Language of the proceedings: EN

Title of invention:
Method of manufacturing an engraved plate

Patent Proprietor:
KBA-NotaSys SA

Opponent:
Giesecke & Devrient GmbH

Relevant legal provisions:
EPC 1973 Art. 100(b)
RPBA Art. 12(4), 13(3)

Keyword:
Sufficiency of disclosure (yes)
Admission of late-filed documents (yes)
Remittal to the department of first instance (yes)



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 2203/12 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 12 July 2016

Appellant: Giesecke & Devrient GmbH
(Opponent) Patent und Lizenzen
Prinzregentenstrasse 159
81677 München (DE)

Respondent: KBA-NotaSys SA
(Patent Proprietor) Avenue du Grey 55
Case Postale 347
1000 Lausanne 22 (CH)

Representative: Cyril Ganguillet
ABREMA
Agence Brevets & Marques Ganguillet
Avenue du Théâtre 16
P.O. Box 5027
1002 Lausanne (CH)

Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 25 September 2012 rejecting the opposition filed against European patent No. 1509396 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman M. Poock
Members: O. Randl
J. Geschwind

Summary of Facts and Submissions

- I. The appellant (opponent) filed an appeal against the decision of the opposition division rejecting the opposition against European patent No. 1 266 768.
- II. The opposition division has in particular considered the following documents:

D1: WO 97/48555 A1;
D2: DE 100 44 403 A1;
D3: WO 00/20216 A1;
D4: WO 00/20217 A1;
D8: Helmut Kipphan, Handbuch der
Printmedien, Springer Verlag, 2000,
pages III and IV as well as 437-449.

Together with its statement of grounds for appeal, the appellant filed the following documents:

D12: JP 2002-137353 A;
D12': machine translation of D12;
D13: DE 198 05 179 B4;
D14: Helmut Kipphan, Handbuch der
Printmedien, Springer Verlag, 2000,
pages III and IV as well as 49-53, 373-379,
437-444, 604-608, 623-653, and 1163.

About six weeks before the oral proceedings the appellant filed document D13' (DE 198 05 179 A1), i.e. the patent application corresponding to patent D13.

- III. The oral proceedings before the board took place on 12 July 2016.

IV. The appellant (opponent) requested that the decision under appeal be set aside and the patent revoked.

The respondent (patent proprietor) requested that the appeal be dismissed or that the decision under appeal be set aside and the patent be maintained on the basis of the claims filed by letter of 9 June 2016 as auxiliary requests 1 to 11.

V. Independent claim 1 of the patent as granted reads:

"A method of manufacturing an engraved plate for intaglio printing of sheets of security papers, wherein a non engraved plate is submitted to a programmed engraving process by a computer controlled engraving tool, characterised in that said programmed engraving process engraves said non engraved plate according to the three-dimensional guiding pixel data (X, Y, Z) of a master depth-map of one said sheet, wherein said master depth-map is generated by at least one computer stored original depth-map, said original depth-map consisting of a three-dimensional raster image of at least a part of one said security paper, and wherein an elementary engraving step is associated to each three-dimensional pixel data."

VI. The appellant (opponent) argued as follows:

(a) Sufficiency of disclosure

The expression "elementary engraving step" is not a commonly used expression but rather a linguistic creation of the patent proprietor. When trying to carry out the invention, the skilled person would have to rely on speculation and assumptions in respect of this feature.

(b) Admissibility of documents D12 to D14

(i) D12, D12' and D13

The filing of documents D12, D12' and D13 is a reaction to the - erroneous - finding of the opposition division according to which the subject-matter of claim 1 concerned the manufacturing of an engraved plate for intaglio printing of a plurality of sheets. The appellant has discovered them via a fresh search carried out by an external search company. The documents are highly relevant and should be admitted.

D12' is the machine translation of document D12. As can be seen from the abstract and Fig. 1, this document is highly relevant. It discloses the claimed method, with the exception of its use for banknotes.

(ii) D13'

Document D13 was published after the priority date of the opposed patent but as the indication of its *Offenlegungstag* shows, its content has been made available to the public well before the priority date. D13' is the corresponding publication; a comparison shows that there have been no substantial amendments. Thus document D13' is nothing but the proof of what had been published, i.e. the very content of document D13. It is true that document D13' was only filed a few weeks before the oral proceedings but its content is the same as the content of document D13, which had been filed before. The patent proprietor, therefore, cannot be surprised by the content of document D13'.

D13' is highly relevant because it discloses every step of claim 1, the only exception being that it does not mention banknotes.

(iii) D14

Documents D8 and D14 both are extracts from a textbook. The opponent cannot be expected to file the whole book (1212 pages), which expresses the common general knowledge of the skilled person in the year 2000. The opponent could not foresee how the opposition division would use document D8; it is admissible to react to the division's findings by filing a more extensive extract.

(iv) Fresh case?

Document D8 was already on file before the opposition division. Documents D1 to D3, which had been used in the original opposition, disclose methods in which the elementary engraving step is a line rather than a pixel. Therefore, D8 in combination with documents D12, D13 and D14 is more relevant.

Incidentally, point V of the statement of grounds of appeal indicates that the prior attacks are maintained.

(c) Remittal to the first instance

The appellant does not object to a remittal, in particular because the patent proprietor should have the opportunity to consider document D13'.

VII. The respondent (patent proprietor) argued as follows:

(a) Sufficiency of disclosure

The respondent endorsed the reasoning of the opposition division and also referred to its written submissions of 26 July 2010.

In response to a question raised by the appellant, the opponent referred to paragraph [0039] of the opposed patent and declared that each "elementary engraving step" corresponded to one pixel.

(b) Admissibility of documents D12 to D14:

(i) D12, D12' and D13

These documents have been filed belatedly and have never been used before the opposition division. By filing these documents, the introduction of which was not justified, the opponent has attempted to build a new opposition case, which qualifies as an abuse of procedure. Moreover, document D13 is not part of the state of the art.

Document D12 is a Japanese patent document. The translation D12' supplied by the appellant is an incomprehensible machine translation. The appellant has not filed a correct translation although the respondent has asked for such a translation.

The provisional opinion of the board expressed in its communication - according to which the question of relevance not decisive under Article 12(4) RPBA - contradicts decisions such as T 1738/11 or T 1380/04. Documents D12 and D13 should be excluded as clearly not

prima facie relevant. As a matter of fact, both documents belong to the field of rotogravure (*Rastertiefdruck*), which is never used for the printing of banknotes, precisely because it is used for printing mass products. Banknotes are printed by intaglio printing techniques. In this context the respondent referred to paragraphs [0003] and [0004] of document D2, which distinguish the methods of rotogravure ("konventioneller Rastertiefdruck") and intaglio printing ("Stichtiefdruck").

(ii) D14

The late filing of document D14 amounts to yet another abuse of procedure. The opponent was aware of this document but had only filed an extract (15 pages) during the opposition proceedings. Together with the statement of grounds of appeal, the opponent filed a more extensive extract (59 pages), which could and should have been filed earlier. The filing of the shorter extract shows that the opponent clearly had considered the 44 additional pages not to be relevant. Moreover, the appellant had tried to create the - false - impression that D14 was the same document as D8. Thus document D14 should not be admitted to the proceedings.

(iii) Fresh case?

Document 14 cannot be equated to document D8. The appeal was based on attacks based on a combination of document D14 with documents D12 and D13, respectively. This constitutes a fresh case because none of these documents was filed before the opposition division. The opponent has used the appeal proceedings to file a new opposition. Appeal proceedings are intended to review

first instance decisions and not to offer the opportunity to file a fresh case.

(c) Remittal to the first instance

Subsequent to the declaration of the board that it intended to admit documents D12, D13' and D14 into the proceedings, the respondent requested that the case be remitted to the first instance.

Reasons for the Decision

1. Applicable law

The patent application on which the opposed patent is based was filed on 3 June 2003. According to Article 7 of the Act revising the EPC of 29 November 2000 (OJ EPO 2007, Special edition No. 4, 217) and the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC of 29 November 2000 (OJ EPO 2007, Special edition No. 4, 219), Article 100 EPC 1973 applies in the present case.

2. Claim interpretation

Claim 1 is directed to a method for engraving a plate that is then to be used for intaglio printing of sheets of security papers. The engraving is carried out by means of a computer controlled tool.

First, a 3D raster image of (at least part of) a security paper is established and stored on a computer. This image is referred to as "original depth-map" (ODM). At least one ODM is then used to generate a

so-called master depth-map (MDM). For instance, such a sheet may comprise engraving information for a set of banknotes, each of which has the same ODM.

The MDM is said to contain "3D guiding pixel data (X, Y, Z) for one sheet". This is understood to mean that the MDM contains, for each pixel of the sheet - characterised by its position X and Y - the corresponding depth Z of the plate used to print the sheet. The set (X, Y, Z) thus corresponds to information allowing to operate or guide the engraving tool such that at the pixel of position (X, Y) the engraving has depth Z.

The feature according to which "an elementary engraving step is associated to each three-dimensional pixel data" is somewhat unclear because of the expression "elementary engraving step". In order to understand the meaning of this expression, the skilled person would consider the meaning of the terms as such, as well as the context in which they are used in the patent.

The patent specification does not define the expression "elementary engraving step", which occurs twice: in claim 1 as well as in the part of the description that recites the subject-matter of that claim (paragraph [0013]). Moreover, an "elementary laser engraving step" is mentioned in paragraph [0015]; in each occurrence, the elementary step is said to be associated to pixel data.

The adjective "elementary" is commonly used to designate something that relates to, or constitutes, the basic, essential or fundamental part or aspect of an object. Therefore, the board has reached the conclusion that the skilled person trying to understand

the concept of an "elementary engraving step" would understand that this has to be an engraving step which constitutes a basic unit or building block for the engraving pattern; in other words, the engraving pattern to be obtained is composed of a series of such elementary engraving steps.

Paragraph [0039] of the opposed patent ("The master depth-map is used by the engraving tool, which engraves the plate pixel by pixel.") is also relevant in this context because it provides further evidence that each elementary engraving step corresponds to one pixel.

This understanding is in line with the disclosure that in the case of laser engraving, the elementary engraving step is associated to each pixel of the raster image. This is also the interpretation put forth by the patent proprietor.

Thus the board reaches the conclusion that the feature according to which "an elementary engraving step is associated to each three-dimensional pixel data" means that the engraving is carried out as a series of elementary steps, each step corresponding to the engraving of a pixel of the MDM.

3. Sufficiency of disclosure

A European patent has to disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

The only objection related to sufficiency of disclosure concerns the feature according to which "an elementary engraving step is associated to each three-dimensional pixel data".

The board is unable to see why this feature would hinder the skilled person from carrying out the invention. As explained above (see point 2.) the skilled person would understand that the engraving was to be carried out pixel by pixel. The skilled person knows how to engrave accordingly. Thus the alleged vagueness of the feature "elementary" appears not to constitute an unsurmountable obstacle for carrying out the invention.

Consequently, the board has reached the conclusion that this objection is unfounded: Article 100(b) EPC 1973 does not prejudice the maintenance of the patent as granted.

4. Admissibility of documents D12 to D14

The admission of documents D12, D12', D13 and D14 lies within the discretion of the board under Article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA) of the EPO (OJ EPO 1/2016, Supplementary publication, page 41 et seq.); the admission of document D13' is governed by Article 13(3) RPBA.

The decision of the opposition division has made it clear to the appellant that its understanding of the prior art cited during the opposition proceedings was found unpersuasive. In such a situation it is not unusual to carry out a complementary search for prior art and to file new documents together with the statement of grounds of appeal. Article 12(4) RPBA empowers the boards not to admit such documents, but unless there is good reason to dismiss the belated submission (in particular, procedural behaviour that has to be qualified as abusive), the boards very often

do not make use of that power. In any case, the mere fact that new documents are filed together with the statement of grounds of appeal cannot establish an abuse of procedure. If this were the case, it would not make sense to give the boards the discretion to admit such documents, because this would be tantamount to allowing an abuse of procedure.

4.1 Documents D12, D12' and D13'

These documents disclose many features of claim 1 and appear not to be irrelevant for the assessment of inventive step. The argument that these documents concern printing techniques that are never used for printing security papers will have to be considered when inventive step is examined, but even if this argument is followed, it appears not to *a priori* disqualify documents D12 and D13' as documents that could lead the skilled person to the subject-matter of claim 1. It is at least imaginable that the skilled person would consider applying features of rotogravure techniques to intaglio printing techniques used for security papers. Whether this is the case or not is a question that belongs to the substantive examination and cannot be decided in the context of the admissibility of the documents under consideration.

Document D12' is a machine translation and, as such, to be handled with caution. However, the mere fact that it is a machine translation does not deprive it of any usefulness. The respondent has only made general assertions as to the quality of the translation but has not established concrete deficiencies. Under these circumstances, the board has no good reasons not to admit the document.

The board considers that the admission of document D13' does not conflict with the requirements of Article 13(3) RPBA, in particular in view of its decision to remit the case to the department of first instance (see point 5. below).

Thus the board has decided to admit documents D12, D12' and D13' to the proceedings.

4.2 Document D13

This document was published on 10 March 2005. As a consequence, this document cannot constitute prior art under Article 54(2) EPC 1973 for an application filed on 3 June 2003 and claiming a priority of 5 June 2002. Thus document D13 cannot be used for the assessment of novelty or inventive step and the board has decided not to admit it to the proceedings.

4.3 Document D14

Documents D8 (filed with the notice of opposition) and D14 (filed with the statement of grounds of appeal) are overlapping extracts from the same textbook. The fact that the appellant introduced document D14 as document D8 is admittedly confusing to some extent. However, the board does not find it to constitute an abuse of procedure. The appellant-opponent consistently used the reference D8 for the textbook as such. As it did not want to file a complete copy of a textbook containing more than 1200 pages, it only filed the pages which it held to be most relevant at the respective stages of the proceedings. The board cannot see how this would amount to a malicious and deliberate misuse of the procedure. Moreover, the textbook from which both extracts were taken is to be considered a

representation of the common general knowledge of the skilled person. Evidence for this knowledge should not normally be held inadmissible. Therefore, the board has decided to admit document D14.

5. Remittal to the first instance

According to point 11 of the decision under appeal, "[i]n the written procedure, the opponent argue[d] that the subject-matter of claim 1 is not inventive over the combination of documents D1 and D3 and of documents D1 and D4. This line of argument was not maintained during the oral proceedings where the opponent stated that his sole objection of lack of inventive activity was based on the combination of the documents D1+D8."

Consequently, the appellant has based all its first instance inventive step attacks on document D1 as closest prior art. Document D8 was cited, but not considered as promising starting point.

The inventive step attacks substantiated in the statement of grounds of appeal are all based on document D14 as closest prior art. The sweeping reference to first-instance submissions in point V. of the statement of ground cannot be considered as a substantiation of further attacks that are to be maintained. If a party wishes the board to take account of arguments put forth during first instance proceedings, it has to explicitly present and substantiate them in its statement of grounds of appeal or its response, as the case may be.

Considering the above, the board has reached the conclusion that, notwithstanding the fact that

documents D8 and D14 have some overlap, the appellant has presented a fresh case when filing the appeal.

The board does not agree with the respondent that this finding necessarily has to lead to a dismissal of the appeal. However, in view of the concurring views of the respondent and the appellant on this issue, it appears appropriate to remit the case to the opposition division for further prosecution, so that this case can be examined by two instances. This way of proceeding also offers the respondent the opportunity of having the very late filed and so far unsubstantiated auxiliary requests 1 to 11 considered.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated