

Internal distribution code:

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

**Datasheet for the decision
of 14 November 2017**

Case Number: T 1145/13 - 3.2.05

Application Number: 04761881.4

Publication Number: 1805042

IPC: B42D15/10

Language of the proceedings: EN

Title of invention:

Security document with a volume hologram forming a partial motif

Patent Proprietor:

KXO AG

Opponent:

Bundesdruckerei GmbH

Relevant legal provisions:

EPC 1973 Art. 56

EPC Art. 123(2), 123(3)

RPBA Art. 12(4), 13(1), 13(3)

Keyword:

Admittance of document that was not admitted by the first instance - yes

Admittance of a request filed with the reply to the appeal but substantiated at a later time - yes

Added matter - no

Extension of the scope of protection - no

Inventive step - yes



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1145/13 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 14 November 2017

Appellant: Bundesdruckerei GmbH
(Opponent) Oranienstr. 91
10958 Berlin (DE)

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

Respondent: KXO AG
(Patent Proprietor) Zählerweg 12
c/o OVD Kinegram AG
6301 Zug (CH)

Representative: Kurt Sutter
E. Blum & Co. AG
Vorderberg 11
8044 Zürich (CH)

Decision under appeal: **Decision of the opposition division of the
European Patent Office posted on 14 March 2013
rejecting the opposition filed against European
patent No. 1805042 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman M. Poock
Members: H. Schram
D. Rogers

Summary of Facts and Submissions

I. On 13 May 2013 the appellant (opponent) lodged an appeal against the decision of the opposition division, posted on 14 March 2013, by which its opposition against European patent No. 1 805 042 was rejected. The statement of grounds was filed on 24 July 2013.

The opposition had been filed against the patent as a whole on the basis of Article 100(a) EPC (lack of novelty, Article 54 EPC, lack of inventive step, Article 56 EPC).

II. Oral proceedings were held before the board of appeal on 14 November 2017.

III. The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained upon the basis of claims 1 - 12 of the main request submitted at the oral proceedings before the board on 14 November 2017.

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

„An anti-counterfeit security object comprising
a substrate (1),
a volume hologram (8) arranged on or in the
substrate (1),
a first motif (6) stored in said volume hologram
(8) and visible under a given viewing condition only,
and a second motif (7) stored outside said volume

hologram (8) and arranged in alignment with said first motif (6),

wherein, under said viewing condition, said first and said second motif (7) combine to a third motif (6, 7),

characterized in that said second motif (7) is at least partially formed by an optically variable device (12, 13; 15; 18; 20, 21), and wherein said second motif (7) is at least partially formed by holes (20, 21) extending through said substrate (1)."

V. The documents referred to in the appeal proceedings included the following:

E6 DE 199 24 385 A1.

VI. The arguments of the appellant, in writing and during the oral proceedings, can be summarized as follows:

Admittance of document E6

The opposition division held that the late-filed document E6 was not relevant and did not admit it into the opposition proceedings. In particular, the opposition division held that volume holograms were only disclosed as being part of prior art, see column 1, lines 28 to 33 and column 2, lines 19 to 22, and that the latter passage („Grundsätzlich ist Darüber hinaus ... ") had to be interpreted as a referral back to the prior art described in column 1. This interpretation was wrong. Since document E6 was novelty destroying for the granted claim 1 it was very relevant and should be admitted into the appeal proceedings.

Admittance of the main request

The main request was filed for the first time in the appeal proceedings as auxiliary request 1 and was late-filed. This request should not be admitted into the appeal proceedings, since it should have been filed in the opposition proceedings.

Admissibility of the amendments, Articles 123(2) and (3) EPC

Claim 1 of the main request was a combination of claims 1 and 11 as granted, albeit with the deletion of the term „microscopic“ in claim 11 as granted. The scope of protection of claim 1 of the main request was thus extended with respect to the combination of claims 1 and 11 as granted, contrary to Article 123(3) EPC. The deletion of the term „microscopic“ in claim 1 of the main request introduced subject-matter extending beyond the content of the application as filed, Article 123(2) EPC.

Novelty

The subject-matter of claim 1 of the main request lacked novelty with respect to document E6, since the additional feature of claim 11 as granted, ie „wherein said second motif (7) is at least partially formed by holes (20, 21) extending through said substrate (1)“ was already known from said document, see column 6, lines 10 to 16, in particular the term „perforation“.

VII. The arguments of the respondent, in writing and during the oral proceedings, can be summarized as follows:

Admittance of document E6

The only passage in document E6, wherein volume holograms are mentioned was the passage in column 2, lines 19 to 22. This passage referred to the prior art, not to the invention according to document E6, since in

the remainder of that document only the combination of a transmission hologram and a reflection hologram was mentioned. Document E6 did not destroy the novelty of claim 1 as granted. The opposition division therefore correctly held that the late-filed document E6 was not relevant and did not admit it into the opposition proceedings.

Admittance of the main request

The main request was filed as auxiliary request 1 with the reply to the appeal. Claim 1 was a combination of claims 1 and 11 as granted. In point 6 of its notice of opposition the appellant had merely alleged that the subject-matters of the dependent claims were at least partly known from, or at least obvious in view of documents E1 to E3, without giving substantiation (see also the paragraph bridging pages 3 and 4 of respondent's letter dated 21 March 2012, mentioned in the reply to the appeal). This request was substantiated in the respondent's letter dated 13 October 2017 and should be admitted into the appeal proceedings.

Admissibility of the amendments, Articles 123(2) and (3) EPC

Claim 1 of the main request clearly met the requirements of Article 123(2) and (3) EPC.

Novelty and inventive step

The subject-matter of claim 1 of the main request was novel and involved an inventive step, since the additional feature of claim 11 as granted, ie „wherein said second motif (7) is at least partially formed by holes (20, 21) extending through said substrate (1)“ was not known from the cited prior art.

Reasons for the Decision

1. The appeal is admissible.

PROCEDURAL ISSUES

2. *Admittance of document E6*

- 2.1 The opposition division did not admit document E6. In point 2.2.1, first paragraph, of the decision under appeal, it is stated:

"For a document to conform with the requirements of Art. 114(2) EPC, the EPO generally uses the condition of "prima facie" relevance. When it is directly clear e.g. that the document is novelty destroying, it meets the condition. Prima facie relevance can however, in some cases, also be regarded as present in the case of lack of inventive step."

As is apparent from 2.2.1 of the decision under appeal, document E6 was thoroughly discussed well beyond a "prima facie" examination. However, the opposition division held that the subject-matter of claim 1 of the patent was new over document E6, that this document was not more relevant than the prior art on file and in fact taught away from volume holograms, see 2nd to 4th paragraphs from the bottom of page 4 of the decision under appeal.

- 2.2 While it lies in the discretion of the board to refuse evidence which was not admitted in the first instance proceedings, the board has its own discretion for admitting late filed documents, cf Article 12(4) RPBA.

2.3 After an in-depth discussion of the content of document E6 in the oral proceedings before the board, the board considered document E6 relevant. Therefore, the board used its discretion and admitted document E6 into the appeal proceedings.

3. *Admittance of the main request*

3.1 During the oral proceedings the respondent withdrew its former main request (to dismiss the appeal and hence to maintain the patent as granted), and re-submitted auxiliary request 1 filed with its reply to the appeal as its new main request.

3.2 Since a substantiation of the reasons why it was requested that the decision under appeal be amended (cf Article 12(2) RPBA) was filed only with letter of 13 October 2017, the former auxiliary request 1 (hereinafter referred to as „main request“) is deemed to have been filed on said date.

The main request is thus considered as an amendment to the respondent's case which falls under the ambit of Article 13 RPBA.

Since claim 1 of the main request is in substance a combination of claims 1 and 11 as granted, the board is of the opinion that the appellant can be expected to deal with this amendment.

3.3 Consequently, the main request was admitted into the appeal proceedings, Article 13(1), (3) RPBA.

MAIN REQUEST

4. *Admissibility of the amendments, Article 123(2) and (3) EPC*

4.1 Claim 1 of the main request differs from claim 1 as granted in that the expression „and wherein said second motif (7) is at least partially formed by holes (20, 21) extending through said substrate (1)“ has been added at the end of the claim.

4.2 A basis for this amendment is claim 12 as originally filed.

It follows that the amendment does not introduce subject-matter extending beyond the content of the application as filed, Article 123(2) EPC.

4.3 Since the inclusion of subject-matter from claim 12 as originally filed into granted claim 1 results in a narrower scope of protection, the subject-matter of claim 1 of the main request also meets the requirements of Article 123(3) EPC.

5. *Ground for opposition under Article 100 (a) EPC 1973 in combination with Articles 54 and 56 EPC 1973*

5.1 Document E6 represents the closest state of the art. This document concerns an information carrier, in which information is contained in the form of a hologram, see column 1, lines 3 und 4.

In column 1, lines 17 to 20, it is stated (translation of cited passages in this section by the board):

„Frequently, information is stored either in the form of a transmission hologram or in the form of a reflection hologram, on pieces of foil that are in

turn glued onto products for purposes of protection against copying".

In the last sentence of the passage in column 1, lines 17 to 33, it is stated:

„A copying of film holograms or volume holograms, which have stored the information in a high-resolution photo layer, can basically be accomplished only with expensive laser equipment, which can supply the coherent light that is necessary and sufficient for copying".

The object of the invention according to document E6 is to create an information carrier of the type named initially with increased copy protection and/or an additional easily recognizable security feature, column 1, lines 37 to 40. The invention solves this object with the information carrier of claim 1, wherein the hologram is the combination of a transmission hologram and a reflection hologram, see also column 1, lines 48 to 51.

In column 2, lines 19 to 24, it is stated:

„Basically, holographically stored information of film or volume holograms is meaningfully protected from copying, since coherent light sources must be used for such copying. In addition, the combination of both hologram types into one hologram according to the invention offers the following additional advantages: ..." (emphasis by the board).

In the first sentence an advantage of film or volume holograms is mentioned: „holographically stored information is meaningfully protected from copying".

While the board is of the opinion that the wording „both hologram types“ in the second sentence (in German: Darüber hinaus bietet die erfindungsgemäße Kombination beider Hologrammtypen in einem Hologramm noch folgende Vorteile: ...) refers to transmission holograms and reflection holograms rather than to film holograms and volume holograms, this is not to say that the transmission holograms and reflection holograms cannot be „film or volume holograms“. On the contrary: since said sentence starts with „In addition ...“, the person skilled in the art will readily understand that the transmission hologram and the reflection hologram are film or volume holograms, and that the combination of a transmission hologram and a reflection hologram offers additional advantages with respect to film or volume holograms. If this were not the case, the wording „In addition“ and „additional“ would be superfluous.

In column 2, lines 24 to 30, it is stated:

„: Depending on the lighting (from the front or from the back ...) either one or the other or both holograms appear each time“.

The two types of holograms can be clearly differentiated from one another on the basis of their characteristic apparent images („motifs“), see column 2, lines 30 to 35. The information carrier is comprised of a carrier layer 2, onto which light-reflecting layer 3 is glued or otherwise introduced, see column 4, lines 57 to 62. According to the first embodiment of the invention, first and second hologram layers 4, 5 are provided, wherein a first type of hologram (transmission or reflection hologram) and a second type of hologram are recorded, respectively.

Summarising, document E6 discloses (the corresponding features of claim 1 of the main request are put in brackets) an information carrier protected from copying („an anti-counterfeit security object“) comprising a carrier layer 2 and a reflecting layer 3 („substrate“), a first (film or volume) hologram layer 4 arranged on said layers 2, 3 („a volume hologram (8) arranged on or in the substrate (1)“) having a first motif stored in said first hologram layer 4 and visible under a given viewing condition only, and a second motif stored in a second hologram layer 5 („and a second motif (7) stored outside said volume hologram (8)“).

According to said first embodiment, the transmission hologram and the reflection hologram are contained in two separate hologram layers arranged one on top of the other, and at least one hologram layer is transparent and both types of hologram appear simultaneously, as long as the upper layer of the hologram lying closer to the readout side of the information carrier is transparent, see column 2, lines 49 to 58. In the judgment of the board, in this case it can be said, since they are simultaneously visible, that the first and second motifs are „arranged in alignment with“ each other and that they combine to a third motif.

It follows that document E6 discloses all the features of the preamble of claim 1 of the main request. Since the second hologram layer 5 is an optically variable device, document E6 also discloses the first characterising feature of claim 1 of the main request.

5.2 The subject-matter of claim 1 of the main request differs from the information carrier known from document E6 in that

- (i) wherein said second motif (7) is at least partially formed by holes (20, 21) extending through said substrate (1).

This distinguishing feature has the advantage that the second motif at least partially formed by holes looks different under different angles. The claimed anti-counterfeit security object provides for a very distinctive behaviour of the motifs that makes them easy to detect, cf paragraph [0014] of the patent in suit.

The appellant has submitted that document E6 disclosed said feature, see column 6, lines 10 to 16, and that the subject-matter of claim 1 of the main request was not novel over document E6.

This cannot be accepted by the board. The passage cited by the appellant reads:

„The individual layers 2 to 6 may thus be glued together so that if an attempt is made to strip off individual layers, the layer that is stripped off is at least partially disrupted. For example, for this purpose, a perforation can be introduced into individual layers 2 to 6, which breaks this layer up into smaller segments when it is stripped off” (emphasis added by the board).

The purpose of the perforation is thus to prevent a counterfeiter from tampering with the individual layers. Document E6 does not disclose that the „second motif is at least partially formed by holes”.

5.3 Since appellant did not raise objections under Article 56 EPC 1973 against claim 1 of the main request in the appeal proceedings, the board concludes that the distinguishing feature is not known from, or suggested by, the cited prior art. It follows that the subject-matter of claim 1 of the main request is not obvious to the person skilled in the art, and hence involves an inventive step, Article 56 EPC 1973.

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 with the order to maintain the patent as amended in the following version:

Description:

Pages 2, 3 and 4 received during the oral proceedings of 14 November 2017;

Claims:

No 1 -12 of the main request received during the oral proceedings of 14 November 2017;

Drawings:

Figures 1 to 9 of the patent specification.

The Registrar:

The Chairman:



N. Schneider

M. Poock

Decision electronically authenticated