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**Datasheet for the decision
of 11 November 2016**

Case Number: T 1202/13 - 3.2.05

Application Number: 05738147.7

Publication Number: 1742806

IPC: B42D15/00

Language of the proceedings: EN

Title of invention:

Improvements in Substrates Incorporating Security Devices

Patent Proprietor:

De La Rue International Limited

Opponent:

Leonhard Kurz Stiftung & Co. KG

Relevant legal provisions:

EPC 1973 Art. 100(a), 54(2)

RPBA Art. 13(1)

Keyword:

Novelty - Main request and auxiliary requests 1, 2 and 4 (no)
Late-filed auxiliary request 5 - request clearly allowable (no)



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Case Number: T 1202/13 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 11 November 2016

Appellant: Leonhard Kurz Stiftung & Co. KG
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
25 March 2013 concerning maintenance of the
European Patent No. 1 742 806 in amended form.

Composition of the Board:

Chairman M. Poock
Members: S. Bridge
D. Rogers

Summary of Facts and Submissions

- I. An opposition was filed against European patent No. 1 742 806 as a whole based on Article 100(a) EPC 1973 (lack of novelty and lack of inventive step) and Article 100(b) EPC 1973.
- II. The opposition division held that independent claim 2 of the main request lacked novelty over document E1, but that the patent, as amended according to the first auxiliary request, met the requirements of the EPC.
- III. The appeal was lodged against this interlocutory decision by the opponent.
- IV. Oral proceedings were held before the board of appeal on 11 November 2016.
- V. The requests of the appellant (opponent) were to set aside the decision under appeal and to revoke the patent.
- VI. The requests of the respondent (patent proprietor) were, as a main request to dismiss the appeal. Alternatively, the respondent requested to set aside the decision under appeal and to maintain the patent in amended form upon the basis of one of auxiliary requests 1, 2 or 4, filed under cover of a letter dated 6 October 2016, or upon the basis of auxiliary request 5, filed at the oral proceedings before the board.
- VII. Claims 1 and 2 according to the main request read as follows:

"1. A security substrate comprising at least one elongate security device (10, 15), in which the security

device is partially embedded within a substrate, which security device has a series of first regions exposed at a series of windows formed in at least a first surface of the substrate and a series of second regions covered by the substrate at bridges formed between the windows in the first surface of the substrate, wherein each of the first regions comprises a first optically variable security feature (16) which varies upon change of viewing angle without the need for additional external stimulus and which has substantially the same appearance in each region and is visible in each window when the first surface of the substrate is viewed in reflected light and the second regions comprise a second security feature (17) which has substantially the same appearance in each second region but is different from the first security feature and is not visible when the first surface of the substrate is viewed in reflected light, but is visible when the first surface of the substrate is viewed in transmitted light."

"2. A security substrate comprising at least one security device, in which the security device is a discrete patch or an elongate element, which security device has a first region exposed at a window or aperture formed in at least a first surface of the substrate, and a second region covered by the substrate which is therefore not visible at the first surface of the substrate, in which the security device is substantially wholly exposed at a second surface of the substrate, wherein the first region comprises a first security feature which is visible when the first surface of the substrate is viewed in reflective light and the second region comprises a second security feature which is different from the first security feature and is not visible when the first surface of

the substrate is viewed in reflective light, but is visible when the first surface of the substrate is viewed in transmitted light, wherein the first security feature incorporates parts of a phrase or pattern which interplay with other parts of a phrase or pattern forming the second security feature so that when the substrate is viewed as a whole in transmitted light they combine to provide a full continuous design or repeating phrase."

- VIII. Claim 1 according to auxiliary request 1 differs from claim 1 of the main request in that the following additional feature is introduced at the end of the claim:
- "wherein the second security features (17) are interspersed between the first security features (16)".
- IX. Claim 1 according to auxiliary request 2 differs from claim 1 of the main request in that the following additional feature is introduced after "the second regions comprise a second security feature (17)":
- "in the form of demetallised indicia".
- X. Auxiliary request 4 corresponds to the main request with claim 1 deleted and the remaining claims suitably renumbered such that claim 2 of the main request is claim 1 of auxiliary request 4.
- XI. Claim 1 according to auxiliary request 5 differs from claim 1 of auxiliary request 4 in that the alternative "full continuous design or" and both instances of "or pattern" have been deleted.
- XII. The following documents are referred to in the present decision:

E3: US-A-6,030,691;
E5: EP-B-0 723 501;
E7: DE 694 10 241 T2.

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

Main request

Since the preliminary opinion of the opposition division seemed favourable to the opponent, they had no reason to file further objections at that stage. The additional novelty objection based on document E7 is a reaction to the decision of the opposition division. Since the product of the manufacturing method disclosed in document E7 is *prima facie* relevant to assessing the novelty of the subject-matter of claim 1, document E7 should be admitted into the proceedings.

The continuous security substrate manufactured by the method of figures 4 and 5 anticipates the subject-matter of claim 1. Therefore, the subject-matter of claim 1 is not new with respect to document E7.

Auxiliary request 1

The continuous security substrate with successive regions 7 on tape 6, manufactured by the method of figures 4 and 5 of document E7, is such that at least parts of the successive star shaped regions 4 of the security features 7 are necessarily interspersed between the successive windows 3 of the same successive security features 7 on tape 6. The patent in suit discloses similar arrangements, for example, in figure

21a. Therefore, the subject-matter of claim 1 is not new with respect to document E7.

Auxiliary request 2

The subject-matter of claim 1 lacks novelty with respect to the embodiment of figure 11 of document E3, where interference layers are used to form the first and second security features, where the first security features are the series of wide areas 15 with the relatively larger demetallised indicia "PL" and the second security features are the series of narrow areas 16 with the relatively smaller demetallised indicia "PL PL".

Auxiliary request 4

Figure 1 of document E5 discloses a banknote 1. When viewing this banknote from the back instead of from the front, security feature 12 is visible in reflected light due to the metal layer on the diffractive structures 20 but security feature 13 is not visible in reflected light, because it is hidden from view by the paper substrate 2. In addition, it is implicit for the skilled person that security feature 13 is visible in transmitted light, firstly because the substrate 2 is paper (page 5, lines 12 to 19 - paper substrate such as for banknotes), because the diffracting structure 21 of security feature 13 is coated with a metal layer. The visibility of a metallic coating layer through a paper substrate is a well-known effect known from banknotes. The configuration disclosed in document E5 is thus the same as that in the patent in suit. When viewed in transmitted light, the metal layer of security features 12 and 13 appears in a pattern-like manner as shown in figures 1 and 3 (respectively as lozenge and oval

shapes) and results in an overall "*continuous design*" made of both the lozenge and oval patterns.

The subject-matter of claim 1 thus lacks novelty with respect to document E5.

Auxiliary request 5

The subject-matter of claim 1 has been limited such that the first and second security features combine to form a *repeating phrase*. This does not imply a need for additional registration, because a *repeating phrase* can also be recognised by the viewer when its parts are slightly offset from one another. There is also no technical effect implied by the required *repeating phrase* since it is the human mind which has to interpret a linguistic information content. Thus the amendment made in claim 1 only concerns the esthetic design of the first and second security features and does not introduce any additional technical features of the claimed security substrate: Claim 1 is not suited to overcoming the outstanding novelty objection. Therefore, auxiliary request 5 should not be admitted into the proceedings.

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

Main request

Late filed document E7 should have been filed earlier, for example during the opposition period.

Document E7 only discloses a single security feature 7 which is partially embedded in the substrate and thus differs from the subject-matter of claim 1 which

requires two different security features which do not interfere with each other (WO-publication of the patent in suit, page 3, lines 19 to 32) and which are formed by different processes. The manufacturing method as disclosed in document E7 creates a single security feature 7 manufactured by a single process and, furthermore, is silent about whether the resulting series of *characters* ("Zeichen") 7 have substantially the same appearance. The description of the manufacturing method does not repeat the features of the embodiment of figures 1 and 2 so that there is no series of windows which have a series of first security features all being the same as each other and there is no second security feature. The subject-matter of claim 1 is therefore new with respect to document E7.

Document E7 is thus not *prima facie* relevant to assessing the novelty of the subject-matter of claim 1, and should not be admitted into the proceedings.

Auxiliary request 1

The manufacturing method as disclosed in document E7 creates a series of single security features 7, which cannot be interspersed between themselves. The additional feature of claim 1 thus establishes novelty with respect to document E7.

Auxiliary request 2

Both security features of the embodiment of figure 11 of document E3 involve demetallised indicia. The subject-matter of claim 1 differs therefrom in that two different security features - formed by different processes - are required.

In addition, the passage in column 3, lines 55 to 61 does not apply to the embodiment of figure 11, whereas the passage in document E3, starting at column 6, line 16 refers explicitly to the embodiment of figure 11 ("*These thread variants ...*") but does not mention interference layers thereby excluding this possibility for making the security features: Thus, no optically variable first security feature is disclosed. The subject-matter of claim 1 is new with respect to document E3.

Auxiliary request 4

Document E5 does not disclose that security feature 13 is visible in transmitted light when viewing security feature 12 from the side to which aperture 4 is open (i.e. from the bottom in figure 2). Furthermore, document E5 discloses that security features 12 and 13 are different security features which are remote from each other (figure 1) and therefore not continuous. There is no suggestion of any form of linkage between them so that they interplay to form a continuous design.

In consequence, the subject-matter of claim 1 is new with respect to document E5.

Auxiliary request 5

The amendment limits the subject-matter of claim 1, because the first and second security feature must combine to form a *repeating phrase*, thereby restoring novelty over document E5 which only discloses a abstract design. This amendment constitutes an implicit technical feature, because the parts of the phrase from the first and second security features must line up, thus requiring registration between the first and

second security features. Therefore, auxiliary request 5 should be admitted into the proceedings.

Reasons for the Decision

1. Main request

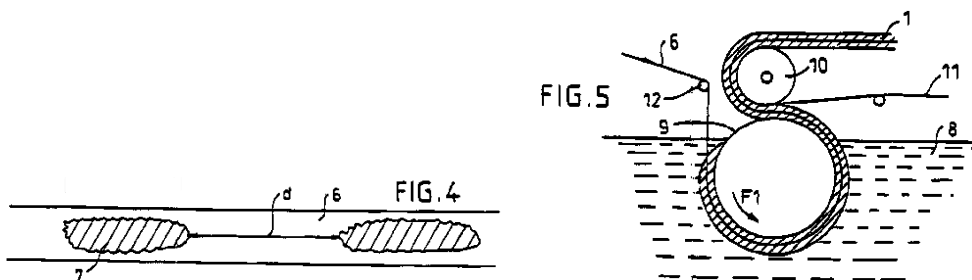
1.1 Admissibility of document E7

The ground of opposition of lack of novelty and lack of inventive step (Articles 54 and 56 EPC 1973 in combination with Article 100(a) EPC 1973) was already introduced with the notice of opposition. With the grounds of appeal, the appellant provided an additional novelty argument based on newly filed document E7 in support of this ground. Since the preliminary opinion of the opposition division (as annexed to the summons dated 2 July 2012) appeared to be favourable to the appellant, then opponent, the appellant had no reason to file further objections at that stage (cf Article 12(4) RPBA).

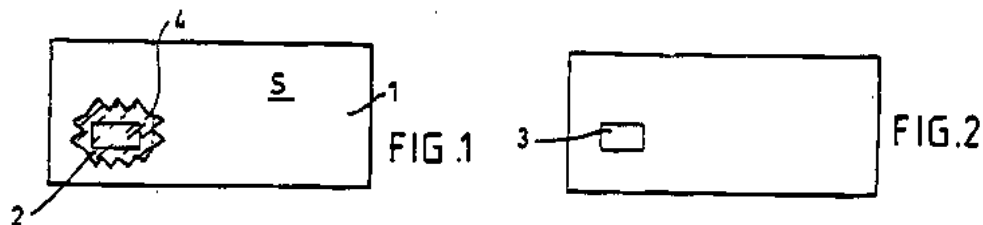
The board considers that the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy do not stand in the way of admitting this new novelty argument based on new document E7 (cf Article 13(1) RPBA). Since document E7 is relevant to the question of novelty of the subject-matter of claim 1 according to the main request (see next point), it is admitted into the proceedings.

1.2 Novelty in view of document E7

1.2.1 Document E7 discloses a continuous manufacturing process (page 5, line 4 to page 6, line 17, figures 4 and 5, claim 6) in which the strip 6 with security features 7 according to figure 4 (page 4, lines 1 to 3) is partially embedded in the paper substrate produced by the paper-making machine of figure 5.



1.2.2 The security substrate produced by the method according to document E7 thus comprises plural windows 3 (figures 1 and 2) in registry with the security features 7 on the strip 6 of figure 4.



1.2.3 The product of the manufacturing process is a security substrate comprising at least one elongate security device (the sequence of security features 7 as disposed on the dissolving PVA strip 6 of figure 4), in which the security device is partially embedded within a substrate, which security device has a series of first regions 3 exposed at a series of windows 3 formed in at least a first surface of the substrate 1 and a series of second regions 4 covered by the substrate at bridges (figure 4, d) formed between the windows 3 in the first surface of the substrate 1, wherein each of the first regions 3 comprises a first optically variable security feature (2, 7 which may be diffractive or a hologram -

see page 5, lines 24 and 25, claims 2 and 3) which varies upon change of viewing angle without the need for additional external stimulus (a property which is implicit for diffractive or hologram based security features) and which has substantially the same appearance in each region (implicit in that the purpose of the manufacturing method of figure 4 is to produce security substrates according to the invention - page 4, lines 1 to 3) and is visible in each window 3 when the first surface of the substrate is viewed in reflected light and the second regions 4 comprise a second security feature (this is composed of those parts 4 of the preceding and following security feature 7 which extend beyond their respective window 3 in direction of the bridge d formed between successive windows 3) which has substantially the same appearance in each second region 4 but is different from the first security feature 3 and is not visible when the first surface of the substrate is viewed in reflected light, but is visible when the first surface of the substrate is viewed in transmitted light.

1.2.4 That the first and second security features have the respective same appearance in each respective first and second region implicitly follows from the fact that the security features 7 (as disposed on strip 6) each correspond to one of the security sheets of figures 1 and 2 (document E7, page 4, lines 1 to 3 and page 5, lines 14 to 19). The respondent's argument to the contrary is based on an isolated view of the manufacturing method which ignores the invention set out in document E7 when read as a whole where the purpose of the manufacturing method is to produce the security substrate of figures 1 and 2 in a continuous manner. Therefore this argument of the respondent cannot be followed by the board.

- 1.2.5 The first and second security features differ, because the optically variable effect is only visible in the first region (rectangle 3 in figure 2) in reflective light while those parts 4 (of the preceding and following star shape 4 of security feature 7 which extend beyond their respective rectangular window 3 in direction of the bridge d formed between successive windows 3) can only be viewed in transmitted light. This is as required by the subject-matter of claim 1. In addition, the shapes of the first and second security features differ in that one is rectangular 3 while the other comprises two parts of a star shape 4.
- 1.2.6 The respondent's argument, that the first and second security features do not differ merely because they are formed on tape 6 by a same process, cannot be followed, for the following reasons: The wording of claim 1 is absolute ("*... is different from ...*") and is thereby not limited only to particular differences such as having to be formed by different processes as advanced by the respondent. In addition, claim 1 does not contain an explicit requirement for different manufacturing methods.
- 1.2.7 Furthermore, the subject-matter of claim 1 does not require that the second security feature in the second region be uninterrupted by a gap d (see figure 4 of document E7).
- 1.2.8 It was further argued on behalf of the respondent that the *characters* 7 ("*Zeichen*") might constitute a continuous text or phrase and thus differ along the tape 6. As was also pointed out by the appellant, the German term "*Zeichen*" is broader than the English term "*characters*" and includes signs such as the star shape

of the embodiment of figure 1. In addition, there is no disclosure in document E7 that the successive signs 7 ("Zeichen") on the tape 6 constitute a continuous text or phrase.

1.2.9 Although there is no explicit additional generic requirement in claim 1 that the first and second security features are not to interfere with one another - as advanced by the respondent. The complementary regions 4 and 3 of the security device 2, 7 of document E7 do not interfere with one another anyway, because one 3 is only visible in reflected light and the other 4 in transmitted light.

1.2.10 In consequence, the subject-matter of claim 1 according to the main request lacks novelty with respect to the security substrate produced by the manufacturing method disclosed in document E7 (Article 54(2) EPC 1973).

2. Auxiliary request 1

Claim 1 according to auxiliary request 1 has one additional feature with respect to claim 1 of the main request, namely "*wherein the second security features (17) are interspersed between the first security features (16)*".

In document E7, the successive arrangement of security features 7 on tape 6 (figure 4, see sections 1.2.5 and 1.2.7 above) is such that at least parts of the successive star shaped regions 4 of the security features 7 are necessarily interspersed between the successive windows 3 of the same successive security features 7: Thus, the second security features 4 are interspersed between the first security features 3 in the sense of the patent in suit, in particular, when

considering embodiments such as that of figure 21a where second security features (small stars) are similarly interspersed between first security features (large stars 16).

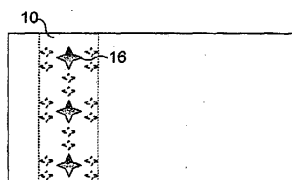


FIG. 21a

Therefore, the above additional feature does not distinguish the subject-matter of claim 1 from the prior art: the subject-matter of claim 1 according to auxiliary request 1 lacks novelty with respect to the security substrate produced by the manufacturing method disclosed in document E7 (Article 54(2) EPC 1973).

3. Auxiliary request 2

3.1 The subject-matter of claim 1 according to auxiliary request 2 differs from claim 1 of the main request in that the second security feature (17) is *"in the form of demetallised indicia"*.

3.2 Document E3 discloses a security thread whose special protective effect results from the combination of negative writing (which cannot be copied due to the incident light/transmitted light effect) with further information which is easy to recognize in particular in incident light (column 3, lines 33 to 38). Column 3, lines 55 to 61 further discloses: *"Suitable opaque coating materials include not only metal layers but also other non-metallic layers contrasting with the surroundings in terms of color and/or gray tone when viewed in transmitted light, e.g. opaque, preferably white, color layers, metallicly lustrous layers such as titanium nitride or **interference layers** as are known*

for example from U.S. Pat. No. 3,858,977" (emphasis added by the board).

The implication here is that "*interference layers*" constitute an "*optically variable security feature which varies upon change of viewing angle without the need for additional external stimulus*" in the sense of claim 1. This implication was no longer contested during the oral proceedings before the board (U.S. Pat. No. 3,858,977 discloses this effect in column 2, line 28 to column 3, line 23).

- 3.3 The respondent contests that the general disclosure of column 3, lines 55 to 61 of document E3 applies to the embodiment of figure 11, on the basis that the passage starting on column 6, line 16 is to be understood as part of the disclosure of the embodiment of figure 11, because "*these thread variants*" (meaning at least those of the embodiment of figure 11) are explicitly referenced. However, the washing process and other demetallisation methods mentioned in the passage starting in column 6, line 16 are not incompatible with the use of an interference layer as the opaque coating material. The same applies to the further possibility of printing *on* the negative writing with bronze inks or metallicly lustrous inks (as opposed to printing the background surrounding the demetallised indicia with such inks). Therefore, contrary to what was advanced on behalf of the respondent, the fact that the passage starting at column 6, line 16 does not mention interference layers does not exclude this possibility for making the first security features of the embodiment of figure 11.

In consequence, the skilled person considering document E3 as a whole learns that the demetallised indicia of

the first security features may be formed in an interference layer. Such a first security feature is necessarily an *"optically variable security feature which varies upon change of viewing angle without the need for additional external stimulus"*.

3.4 In the embodiment according to figure 11, narrower bar areas 16 alternate with widened areas 15. The bar areas 16 are preferably embedded in the document material and thus ensure the necessary anchoring in the document (column 6, lines 6 to 15).

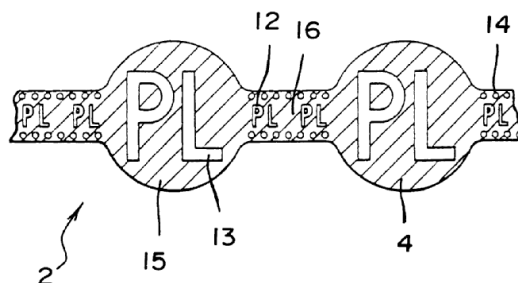


FIG. 11

This implies that the small writing 12 found in the narrower bar areas 16 is hidden from view in reflected light. This was not contested by the parties.

3.5 The embodiment of figure 11 discloses a security substrate comprising at least one elongate security device 2, in which the security device 2 is partially embedded within a substrate (embedding of narrower bar areas 16), which security device 2 has a series of first regions 15 exposed at a series of windows formed in at least a first surface of the substrate and a series of second regions 16 covered by the substrate at bridges formed between the windows in the first surface of the substrate, wherein each of the first regions 15 comprises a first optically variable security feature (interference layers with relatively larger demetallised indicia "PL") which varies upon change of viewing angle without the need for additional external stimulus

(implicit in the use of interference layers) and which has substantially the same appearance in each region 15 and is visible in each window when the first surface of the substrate is viewed in reflected light and the second regions 16 comprise a second security feature in the form of demetallised indicia (relatively smaller demetallised indicia "PL PL") which has substantially the same appearance in each second region 16 but is different from the first security feature (relatively larger demetallised indicia "PL" surrounded by interference layers) and is not visible when the first surface of the substrate is viewed in reflected light (because narrower bar areas 16 are embedded in the substrate), but is visible when the first surface of the substrate is viewed in transmitted light.

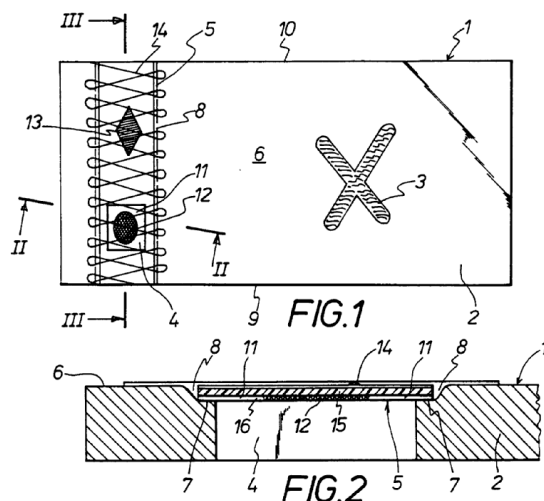
3.6 Contrary to the respondent's position, the board cannot accept that a security feature consisting of cut out relatively larger lettering "PL" surrounded by interference layers and viewable in reflected light should be the same as (i.e. not different from) one consisting of embedded cut out relatively smaller lettering "PL PL" and which can only be seen in transmitted light. The fact that cut out letters PL, albeit of different sizes, occur in both security features does not appear to be sufficient to make them identical. Even the different sizes of the respective cut out letters PL are already sufficient to make the two security features "*different*", because the wording of claim 1 is absolute ("*...is different...*") and is thereby not limited only to particular differences such as having to be formed by different processes as advanced by the respondent.

3.7 In consequence, the subject-matter of claim 1 according to auxiliary request 2 lacks novelty with respect to

the embodiment of figure 11 disclosed in document E7 (Article 54(2) EPC 1973).

4. Auxiliary request 4

4.1 Document E5 discloses (page 5, line 12 to page 6, line 30, figures 1 to 3) a security document 1 such as a banknote comprising at least one window-like aperture 4 being provided in a substrate 2 and closed by means of a translucent covering film 5 which projects on all sides beyond the aperture 4 and is fastened over its entire area on a surface 6 of the substrate 2. The covering film 5 is provided with a security feature 12 formed by a diffracting structure 21 and/or thin-layer arrangement which is optically active in refraction and/or diffraction arranged in the area of the aperture 4 and a second security feature 13, preferably based on optical effects 20, 22 outside of the area of the aperture 4.



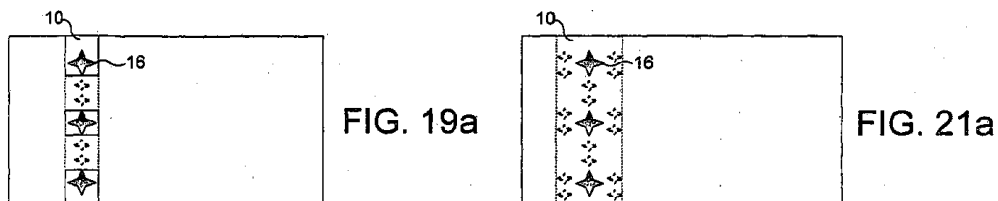
4.2 As advanced on behalf of the appellant, even though document E5 makes no statements to this effect, it is nevertheless implicit for the skilled person that the reflective metallic coating 22 of security feature 13 is visible as a dark patch in transmitted light since this is usual for a security feature with a metallic

coating on the kind of paper substrate 2 used for banknotes (page 5, lines 12 to 19).

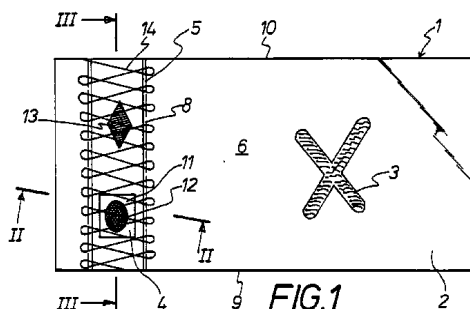
The respondent considered that this is not necessarily the case, because the following passage suggested the possibility of a continuous metal layer other than in the window region 4: "*Die Figur 1 zeigt, dass die Abdeckfolie 5 nur in einem Teilbereich der fensterartigen Durchbrechung 4, nämlich dem äußeren Bereich 11, transparent ist, während im inneren Bereich der Durchbrechung 4 ein zusätzliches, z.B. auf optischen Effekten beruhendes Sicherheitsmerkmal 12, z.B. in Form einer bei Transmission wirksamen Diffraktionsstruktur, vorgesehen ist. Das zusätzliche Sicherheitsmerkmal 12 in der fensterartigen Durchbrechung 4 kann aber nicht nur von einer brechungs und/oder beugungsoptisch wirksamen Diffraktionsstruktur, beispielsweise einem Hologramm, Pixelgram etc., gebildet werden. Es wäre auch denkbar, als zusätzliches Sicherheitsmerkmal 12 beispielsweise eine reflektierende Fläche, einen besonderen Mikrodruck, eine Dünnschichtanordnung oder eine sonstige Gestaltung, die nur schwer nachzuahmen ist, zu wählen.*" (page 5, lines 44 to 51). However, this passage only discusses the transparency remaining in the window region due to the presence of the security feature 12 (wholly contained in window region 4) and goes on to disclose various alternatives for making security feature 12 (for example, a diffraction structure, a hologram, a pixelgram, a reflective area, etc.). Contrary to what was advanced on behalf of the respondent, this passage thus does not suggest a continuous metal layer.

In consequence, the board cannot see any reason to disagree with the argument of the appellant.

4.3 In the patent in suit, the feature "they [i.e. the first and second security features] combine to provide a full continuous design" is not further defined either in the claims or in the description. However, some of the embodiments disclose spaced discrete stars of different sizes as the first and second security features, for example, see figures 19a, 21a, etc.



In the embodiment of figure 1 of document E5, security features 12 and 13 are respectively shown as an oval and a lozenge spaced from one another along direction III - III. Otherwise, document E5 is silent concerning designs to be used for security features 12 and 13.



As was advanced on behalf of the appellant, when viewed as a whole in transmitted light, the metal layer of security features 12 and 13 can be seen as a combined pattern made up of both the lozenge 13 and the oval 12 shown in figure 1 which thereby form a "continuous design" made up of discrete elements as in the patent in suit. This argument was not countered by the respondent and the board cannot see any reason to disagree.

4.4 Document E5 discloses a security substrate 1 (page 5, line 12 to page 6, line 30, figures 1 to 3) comprising at least one security device 5, 12, 13 in which the

security device 5, 12, 13 is a discrete patch or an elongate element 5 (figures 1 and 2), which security device has a first region (oval 12) exposed at a window or aperture 4 formed in at least a first surface of the substrate 2 (bottom in figure 2), and a second region (lozenge 13) covered by the substrate 2 which is therefore not visible at the first surface of the substrate 2 (bottom in figure 2), in which the security device (oval 12) is substantially wholly exposed at a second surface of the substrate 2 (top in figure 2), wherein the first region (oval 12) comprises a first security feature (oval 12) which is visible when the first surface of the substrate 2 (bottom in figure 2) is viewed in reflective light and the second region (lozenge 13) comprises a second security feature (lozenge 13) which is different from the first security feature (oval 12) and is not visible when the first surface of the substrate 2 (bottom in figure 2) is viewed in reflective light, but is visible when the first surface of the substrate 2 (bottom in figure 2) is viewed in transmitted light, wherein the first security feature (oval 12) incorporates parts of a phrase or pattern (oval 12 and lozenge 13 in combination) which interplay with other parts of a phrase or pattern forming the second security feature (lozenge 13) so that when the substrate 2 is viewed as a whole in transmitted light they combine to provide a full continuous design (oval 12 and lozenge 13 in combination) or repeating phrase.

In consequence, the subject-matter of claim 1 according to auxiliary request 4 is not new with respect to document E5 (Article 100(a) and 54(2) EPC 1973).

5. Auxiliary request 5

5.1 According to Article 13(1) RPBA, any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. In addition, the criterion of whether or not the amendments and submissions are relevant to a resolution of the issues being discussed at the oral proceedings may be taken into account for the exercise of this discretion.

5.2 By eliminating the alternative of providing a "*full continuous design*", the amendment to claim 1 limits its subject-matter, because the respective parts provided by the first and second security features must combine to form a "*repeating phrase*".

5.3 It was argued on behalf of the respondent that this amendment implicitly introduces a technical feature concerning the registration of the first and second security features, because the parts of the phrase from the first and second security features must line up to provide the "*repeating phrase*".

It is implicit to the skilled person that a certain amount of registration is needed for the required interplay of the parts when the parts from the first and second security features combine to provide a "*repeating phrase*" or a "*full continuous design*". However, there is no support in the patent in suit of a greater need for registration when the parts from the first and second security features combine to provide a

"*repeating phrase*" instead of a "*full continuous design*" nor has any been advanced by the respondent.

The board thus concurs with the appellant, in that there is no evidence for a necessity for improved registration.

- 5.4 The board also agrees with the appellant in that there is also no technical effect implied by the required "*repeating phrase*" itself, because this feature requires a human mind to interpret a linguistic information content of the first and second security features, while the security features themselves still have the same technical constitution.

In consequence, the amendment made in claim 1 only concerns the esthetic design of the first and second security features and does not introduce any additional technical features to the claimed security substrate. Such a non-technical amendment is not *prima facie* suitable for restoring novelty over the prior art.

- 5.5 Therefore, the board exercises its discretion under Article 13(1) RPBA to not admit auxiliary request 5 into the proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated