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**Datasheet for the decision
of 9 May 2016**

Case Number: T 1524/14 - 3.2.05

Application Number: 06700276.6

Publication Number: 1928670

IPC: B42D15/10

Language of the proceedings: EN

Title of invention:

Document and method of manufacturing same

Applicant:

3M Innovative Properties Company

Relevant legal provisions:

EPC 1973 Art. 54
EPC 1973 R. 29(2)
RPBA Art. 12(4)

Keyword:

More than one independent claim in the same category - no
(main request)
Novelty - no (auxiliary request 1)
Pursuing abandoned claims in the examination appeal
proceedings - no (auxiliary request 2)



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Case Number: T 1524/14 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 9 May 2016

Appellant: 3M Innovative Properties Company
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Decision under appeal: **Decision of the examining division of the European Patent Office posted on 28 January 2014 refusing European patent application No. 06700276.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman M. Poock
Members: H. Schram
J. Geschwind

Summary of Facts and Submissions

I. The appellant (applicant) filed a notice of appeal on 31 March 2014 against the decision of the examining division, posted on 28 January 2014, by which European patent application No. 06 700 276.6 was refused on the grounds that the subject-matters of claims 1 and 8 of the main request filed on 21 November 2012 were not new, Article 54 EPC 1973, and that the subject-matter of claim 1 of the auxiliary request filed on 19 August 2013 was not new and did not involve an inventive step, Articles 54 and 56 EPC 1973. The statement setting out the grounds of appeal was filed on 6 June 2014.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of any one of the sets of claims filed as main request and auxiliary requests 1 and 2 with the statement setting out the grounds of appeal.

II. The documents referred to in the appeal proceedings include the following:

D3 EP-A 1 516 749;

D8 DE 10 2004 008 840.

III. Claims 1 and 8 of the main request read as follows:

"1. An authentication or validation document incorporating a page for holding data relating to the intended holder of the document, said page incorporating an inlay (1) provided with a microchip, the chip (7) being adapted to be encoded with data in electronic form, a sheet (3) of material capable of being provided with data in visually legible form, and

plastics layers (11, 12) between which the inlay (1) and sheet (3) are laminated so as to embed the inlay (1) and sheet (3) of material within said page, wherein the page has a nominal binding line along which pages of the document are secured together, the plastics layers (11, 12) between which the inlay (1) and the sheet (3) are laminated extending across said nominal binding line of the page."

"8. An authentication or validation document incorporating a page for holding data relating to the intended holder of the authentication or validation document, said page incorporating an inlay (1) provided with a microchip (7), the chip (7) being adapted to be encoded with data in electronic form, a sheet (3) of material capable of being provided with data in visually legible form, and plastics layers (11, 12) between which the inlay (1) and sheet (3) are laminated so as to embed the inlay (1) and sheet (3) of material within said page, wherein the page is formed along one edge to provide a hinge for binding purposes, with a projecting tab which extends (substantially) the full length of the edge and is formed from said plastics layers (11, 12) between which the inlay (1) and sheet (3) are laminated."

Claim 1 of auxiliary request 1 differs from claim 8 of the main request in that the brackets around the word "substantially" have been deleted and in that the expression "wherein the tab (11A, 12A) is formed only from said plastics layers (11, 12)" has been added at the end of the claim.

IV. In support of his request, the appellant submitted the following:

Main request

It was still believed that the subject-matter of the main request was novel and involved an inventive step. Reference was made to the letter of August 19, 2013 (see, in particular, sections 2.1 - 2.2). In more detail, claim 1 of the main request related to an authentication or validation document incorporating a page for holding data relating to the intended holder of the document. The page incorporated an inlay provided with a microchip, a sheet of material capable of being provided with data in visually legible form, and plastic layers. The microchip was adapted to be encoded with data in electronic form. The inlay and the sheet were laminated between the plastic layers so as to embed the inlay and sheet within said page. The page had a nominal binding line along which pages of the document were secured together. The plastic layers between which the inlay and the sheet were laminated extended across said nominal binding line. It was not believed that document D3 disclosed or suggested all of the above features of claim 1 of the main request.

In the communication dated 21 May 2013, the examining division had associated the reference sign 2 in document D3 to both the notions "page for holding data" and "sheet (3) of material" mentioned in claim 1, and argued that "page (2)", ie "sheet (2) of material" of document D3, did not incorporate an inlay with a microchip as required by claim 1 of the main request. In this context, it was explicitly pointed out that claim 1 required that "said page incorporating an inlay provided with a microchip". The "Personalisierbogen 2" of document D3, however, did not incorporate an inlay provided with a microchip. Accordingly, the subject-matter of claim 1 of the main request was novel and

inventive over document D3. The same argumentation applied mutatis mutandis to independent claim 8 which also required "said page incorporating an inlay provided with a microchip".

Auxiliary request 1

Independent claim 1 of auxiliary request 1 was rejected as lacking novelty over document D8. However, this document did not clearly and unambiguously disclose that the "inlay provided with a microchip" and "the sheet of material capable of being provided with data in visually legible form" were two separate layers. In contrast thereto, document D8 clearly taught the opposite in paragraph [0011], namely a single layer. Based on said opposite teaching, it was still believed that claim 1 of auxiliary request 1 was not only novel but also based on an inventive step vis-à-vis document D8.

Auxiliary request 2

Document D8 did neither disclose nor suggest that visually legible data should be printed on a sheet of material ("Personalisierseite 16") and afterwards laminated with the inlay as required by new independent method claim 1 of auxiliary request 2. Accordingly, it was believed that the subject-matter of claim 1 of auxiliary request 2 was not only novel but also based on an inventive step vis-à-vis document D8.

- V. In a communication dated 18 February 2016 annexed to the summons to attend oral proceedings scheduled for 9 May 2016 the board expressed *inter alia* its provisional opinion that the exception to the rule that a patent application may only contain one independent claim in

the same category did not seem to apply in the present case for the main request(see point 5 of said communication), that the subject-matter of independent claims 1 and 8 of the main request did not seem to be new with respect to document D3 or document D8 (see point 6 of said communication), and that the subject-matter of claim 1 of auxiliary request 1 did not seem to involve an inventive step with respect to a combination of documents D3 and D8 (see point 8 of said communication).

The board further stated that, since the claim fees in respect of (original) claims 51 to 132 were not paid within the time limit, said claims were deemed to have been abandoned, see the *Noting of loss of rights pursuant to Rule 112(1) EPC* dated 31 July 2008 and the communication dated 17 December 2008. Claim 1 of auxiliary request 2, which is directed to a method of producing an authentication or validation document, and which seemed to correspond to claim 88 of the application as filed, could therefore not be pursued in the examination appeal proceedings (see point 9 of said communication) and that for the aforesaid reasons the appeal was likely to be dismissed (see point 10 of said communication).

VI. The appellant informed the board on 2 May 2016 that it will not attend the oral proceedings. Subsequently, the scheduled oral proceedings were cancelled by the board.

Reasons for the Decision

1. The appeal is admissible.

2. Since no substantive reply to the communication of the board dated 18 February 2016 (see point V above) was received from the appellant, the board sees no reason to depart from it and adopts its provisional findings contained therein as its final judgment, see points 3 to 5 below.

3. *Main request - allowability of more than one independent claim in the same category*
 - 3.1 In its communication the board wrote (see point 5.3) that it would appear that "the only difference between the authentication or validation document according to claim 1 or claim 8 of the main request is that in the document according to claim 8 of the main request the pages of said document are not necessarily secured together, whereas in the authentication or validation document according to claim 1 of the main request the pages are secured together". Since these findings were not contested by the appellant, the board has no reason to deviate from them.

 - 3.2 Rule 29(2)(c) EPC 1973 stipulates that a European patent application may contain more than one independent claim in the same category if the subject-matter of the application involves one of the following: "(a) ..., (b) ..., (c) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim".

 - 3.3 The appellant has submitted (see letter of 21 November 2012, point 1.3) that the independent claims of the main request referred to alternative solutions in the meaning of Rule 43(2)(c) EPC: while claim 1 suggested a nominal binding line along which pages of the document

were secured, claim 8 referred to a hinge for bonding purposes with a projecting tab.

In view of point 3.1 above however, the board is of the opinion that - apart from the feature in claim 1 "wherein the page has a nominal binding line along which pages of the document are secured together" - claims 1 and 8 of the main request substantially claim the same subject-matter, albeit in a different wording.

It would therefore have been appropriate to cover said subject-matter by a single independent claim.

3.4 It follows that the main request is not allowable (cf Rule 29(2)(c) EPC 1973).

4. *Auxiliary request 1 - novelty, Article 54 EPC 1973*

4.1 In its communication dated 18 February 2016 the board wrote (see point 8.1) that it would seem that the subject-matter of claims 1 and 8 of auxiliary request 1 was not new with respect to document D8.

Since these findings were not contested, the board has no reason to deviate from them.

4.2 It follows that auxiliary request 1 is not allowable (cf Article 54 EPC 1973).

5. *Pursuing abandoned claims in the examination appeal proceedings*

Claim 1 of auxiliary request 2 corresponds to claim 88 of the application as filed. Since the claim fee in respect of claim 88 as filed was not paid within the time limit, this claim is deemed to have been abandoned

and cannot be pursued in the examination appeal proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated