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**Datasheet for the decision
of 23 March 2023**

Case Number: T 0951/17 - 3.4.01

Application Number: 11182173.2

Publication Number: 2434437

IPC: G06K19/077, G06K19/02

Language of the proceedings: EN

Title of invention:

Anti-counterfeiting tags and related manufacturing method

Patent Proprietor:

Istituto Poligrafico e Zecca dello Stato S.p.A.

Opponent:

Giesecke+Devrient Mobile Security GmbH

Headword:

Method of manufacturing anticounterfeiting labels / Istituto
Poligrafico e Zecca dello Stato

Relevant legal provisions:

EPC Art. 123(2), 100(b), 54(1), 54(2), 56

RPBA Art. 12(4)

RPBA 2020 Art. 12(2), 25(1), 25(2)

Keyword:

Main request - Amendments - undisclosed disclaimer
Inventive step - first auxiliary request (no)
Second auxiliary request - late-filed request - request
withdrawn before the opposition division
Second auxiliary request - primary object of appeal
proceedings to review decision - appeal case directed to
requests on which decision was based (no)
Grounds for opposition - fresh ground for opposition in appeal
proceedings (yes) - no consent of proprietor
Novelty, Inventive step - third auxiliary request (yes)

Decisions cited:

G 0001/16, G 0001/03, G 0002/10, T 1689/12, G 0010/91,
G 0009/91, G 0001/95



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Case Number: T 0951/17 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 23 March 2023

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
7 February 2017 concerning maintenance of the
European Patent No. 2434437 in amended form.**

Composition of the Board:

Chairman B. Noll
Members: T. Zinke
C. Almberg

Summary of Facts and Submissions

- I. In an interlocutory decision, the Opposition Division decided that, account being taken of the amendments made by the proprietor during the opposition proceedings according to the then third auxiliary request, the patent and the invention to which it related met the requirements of the EPC. The Opposition Division decided not to admit the then main request and further held that claim 1 of the then first auxiliary request lacked clarity (Article 84 EPC) and did not comply with Article 123(2) EPC, and that claim 1 of the then second auxiliary request lacked an inventive step in view of document D9 (EP-A-1 516 749).
- II. Both the opponent and the proprietor appealed against that decision.
- III. Following an exchange of statements of grounds of appeal and replies thereto, the opponent filed a rejoinder dated 4 December 2017 in which it, *inter alia*, for the first time raised insufficient disclosure as a ground of opposition (see below, point 37).
- IV. The Board issued a summons to oral proceedings with an accompanying preliminary opinion.
- V. The opponent, but not the proprietor, responded to the Board's preliminary opinion.
- VI. At oral proceedings held on 23 March 2023, the parties confirmed that their final requests are as follows:

The opponent requests that the appealed decision be set aside and that the patent be revoked.

The proprietor requests that the appealed decision be set aside, and that the patent be maintained as amended according to the claims of one of

- the main request in appeal, filed on 14 October 2016, subject of the appealed decision (then labelled "first auxiliary request"), and re-filed with the statement of grounds of appeal,
- the first auxiliary request in appeal, filed on 14 October 2016, subject of the appealed decision (then labelled "second auxiliary request"), and re-filed with the statement of grounds of appeal, and
- the second auxiliary request in appeal, filed on 14 October 2016 (then labelled "fourth auxiliary request"), and re-filed with the statement of grounds of appeal.

In the alternative, the proprietor requests that the patent be maintained as amended according to the claims of the third auxiliary request in appeal, filed (then labelled "substitute third auxiliary request") and found allowable at oral proceedings before the Opposition Division.

VII. Independent claim 1 of the main request in appeal reads:

*An anti-counterfeiting label (1), comprising:
- a multilayer main body (11) embedding a data storage device (4) suitable for wireless transmission, which main body (11) in its turn comprises a first (21) and a second (22) layer of a rigid plastic material between which an intermediate layer (3) of a flexible material is interposed; and*

- a flexible extension (12) of said main body (11), anchorable onto a product or support and made by a portion of said intermediate layer (3) protruding beyond said main body (11), provided that said label is not a data page of a booklet document.

Independent claim 11 of the main request in appeal is identical to claim 11 as granted and reads:

A method of manufacturing anti-counterfeiting labels (1), each having a multilayer main body (11) embedding a data storage device (4) suitable for wireless transmission and an extension (12) of a material flexible and anchorable onto a product or support, which method provides the steps of:
(a) pre-punching a first (210) and a second (220) sheet of rigid plastic material, which are to form the main bodies (11) of the labels, at areas intended to form the flexible extensions (12); and
(b) coupling the first (210) and the second (220) sheet of plastic material with an intermediate layer (30) of flexible material, which intermediate layer (30) forms the flexible extensions (12) of the labels.

VIII. In the claim set of the first auxiliary request in appeal the device claims defining an anti-counterfeiting label were removed and only the method claims remained. Independent claim 1 of the first auxiliary request is identical to claim 11 of the patent as granted therefore also identical to claim 11 of the main request.

- IX. Independent claim 1 of the second auxiliary request in appeal is amended as compared to claim 1 of the first auxiliary request in appeal in that, at the end, a feature is added, which reads:

... wherein said first (210) and second (220) sheet of rigid plastic material are made of a material having a rigidity greater than 40 mN.

- X. Independent claim 1 of the third auxiliary request in appeal is amended as compared to independent claim 1 of the first auxiliary request in appeal by the introduction of two features at the end, which read:

... which method comprises, prior to said step (a), a step of coupling the first (210) and the second (220) plastic sheet with a respective protecting coating (310, 320), preferably transparent, and wherein said step (a) provides for the first (210) or the second (220) sheet of plastic material to be punched already coupled with the data storage devices (4).

Reasons for the Decision

Main request in appeal - added subject-matter

1. At oral proceedings, on this topic, the proprietor referred to its written case, whereas the opponent entirely agreed with the Board's negative preliminary opinion, from which the Board has no reason to deviate.
2. The proprietor's main request is identical to the first auxiliary request subject of the appealed decision.

3. In claim 1 of the main request the proprietor introduced a negative feature, which reads *provided that said label is not a data page of a booklet document*. This amendment extends beyond the content as originally filed (Article 123(2) EPC).

4. In G 1/16 (OJ 2018, A70, point 43; see also CLBA, section II.E.1.7.2) the Enlarged Board considered

that the choice of the proper test for assessing the allowability of any disclaimer is determined by the fundamental distinction, in terms of their legal nature, between disclosed disclaimers and undisclosed disclaimers. That distinction necessitates providing for each of the two classes of disclaimer a single specific test for assessing whether the introduction of a given disclaimer is in compliance with Art. 123(2) EPC. For undisclosed disclaimers the proper test is whether the criteria of G 1/03 [(OJ 2004, 413)] are fulfilled, and for disclosed disclaimers the proper test is the gold standard disclosure test of G 2/10 [(OJ 2012, 376)].

5. G 1/16 also specifies the difference between disclosed and undisclosed disclaimers (points 14 and 15):

The term "undisclosed disclaimer" relates to the situation in which neither the disclaimer itself nor the subject-matter excluded by it have been disclosed in the application as filed.

The term "disclosed disclaimer" relates to the situation in which the disclaimer itself might not have been disclosed in the application as filed, but the subject-matter excluded by it has a basis in the application as filed, e.g. in an embodiment.

6. The wording of the passage of the description, on which the disclaimer is based, is different from the disclaimer itself. It reads *Moreover, the label of the invention may also have the format of the data page of booklet documents and be bound thereinside [...]* (originally filed description, page 7, lines 1 and 2, identical in paragraph [0042] of the B1-document). Hence, this passage only describes the "format" of the data page and not the data page itself. Also, the part "and be bound thereinside" is missing.
7. The proprietor argued (statement of grounds of appeal, page 4, paragraphs 4 to 5 and during oral proceedings) that the wording "may also have the format of" means "may be embodied as". As evidence for this allegation, the proprietor provides a definition and synonyms of the term "format" from an online dictionary.
8. However, even according to the cited definitions and synonyms it is evident that "format of a data page" relates to particular features of a data page, but not to a data page *per se*.
9. Hence, for a disclaimer *provided that said label is not a data page of a booklet document*, there is no unambiguous and direct disclosure in the application as filed.
10. Thus, the disclaimer belongs to the "undisclosed disclaimers".
11. With regard to undisclosed disclaimers, the Enlarged Board in G 1/03 considered that the following criteria were to be applied for assessing the allowability of a

disclaimer which was not disclosed in the application as filed (order, section 2.1):

A disclaimer may be allowable in order to:

- *restore novelty by delimiting a claim against state of the art under Article 54(3) and (4) EPC;*
- *restore novelty by delimiting a claim against an accidental anticipation under Article 54(2) EPC; an anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention; and*
- *disclaim subject-matter which, under Articles 52 to 57 EPC, is excluded from patentability for non-technical reasons.*

None of the criteria for an allowable undisclosed disclaimer are fulfilled in the present case.

12. Consequently, the proprietor's main request is not allowable, since it does not comply with the requirements of Article 123(2) EPC.

First auxiliary request in appeal - novelty

13. Since, at the end of oral proceedings, the parties abandoned all procedural requests, no reasons are required in respect of the continued presence of document D9 in these proceedings.
14. The proprietor's first auxiliary request is identical to the second auxiliary request subject of the appealed decision.

15. In the appealed decision, the Opposition Division held that this auxiliary request lacked an inventive step in view of document D9. The Opposition Division identified as a distinguishing feature over D9 that the material of the external layers is more rigid than the layer that forms the flexible extension. This was based on an interpretation of the relative terms "flexible material" and "rigid plastic material" in claim 1 of the then second auxiliary request (reasons, section 20, middle of page 8).
16. With the reply to the proprietor's statement of grounds and during oral proceedings, the opponent argued that the subject-matter of claim 1 is not novel over D9 (section 2.1.1), whereas the proprietor in its statement of ground and during oral proceedings saw further differences between the claimed subject-matter and D9 than that identified by the Opposition Division.
17. The parties are in dispute about
- (a) whether the personalization sheet ("Personalisierungsbogen") in D9 is a label as defined in claim 1,
 - (b) whether rigid layer sheets are disclosed in D9, and
 - (c) whether a pre-punching of the rigid layers is disclosed in D9.
18. In the patent specification (paragraph [0010]) a broad understanding of the term "label" is given:

In the present context, the term "label" is to be understood in a broad sense to include any element, such as e.g. tags, cards or tickets, applicable onto a product for its identification, authentication and/or traceability.

In paragraph [0042] of the patent specification it is even stated:

Moreover, the label of the invention may also have the format of the data page of booklet documents and be bound thereinside, as well as be used to record environmental parameters in case of plant maintenance booklets.

19. With the first auxiliary request, the proprietor, however, requests the removal of paragraph [0042] from the patent specification (cf. annexes to the statement setting out the grounds of appeal).
20. The proprietor argued that the skilled person would not understand the term "label" to encompass a data page or a personalization page, because such a page is a part of the product, but not "applicable onto" it. Paragraph [0042] would enlarge the skilled person's understanding beyond its normal meaning. Removing the paragraph would result in a skilled person's understanding of the term "label" not including a page of a book.
21. This is not persuasive. First, paragraph [0042] does not mention that the application of labels described therein is something particular, that goes beyond a skilled person's understanding. Second, the "product" as mentioned in paragraph [0010] is not defined at all, so that it is not clear, what limitations are implied by "applicable onto" such a product. A passport - as disclosed in D9 - is a product that is intended to be identified, authenticated and/or traced - even without the "personalization page", because of e.g. visa stamped onto the paper pages of a passport. Hence, the personalization page is a "label" in the sense of the

patent, applicable onto the rest of the passport, for its identification, authentication and/or traceability.

22. With regard to the question, whether rigid layer sheets are disclosed in document D9, the Board concurs with the assessment of the Opposition Division that more rigid outer layers as compared to the flexible intermediate layer are not disclosed in a direct and unambiguous way in D9. Whereas the materials used for the overlay sheets are disclosed to include "PC", i.e. polycarbonate, HDPE, PTPE or oPP (D9, paragraph [0038]) and, thus, include the same materials as disclosed for the rigid layers in the patent specification (PVC, PC, PET, PETG, B1-document, paragraph [0017]), the rigidity is not only a question of the material, but, for instance, also of the thickness of the layer. If a layer stack of several layers is more rigid than a single layer, this does not allow conclusions about the rigidity of a single layer in the layer stack.
23. With regard to the question of pre-punching, the passages in D9 dealing with the fabrication of the data page (paragraphs [0060] to [0071], corresponding figures 8 and 9) do not disclose at what step during the fabrication the punches 17 (*Ausstanzungen* 17) in the outer layers are realized. However, from originally filed claims 9 and 11 it can be derived that the overlay sheets 8 and 15 have the punches 17 already before coupling them to the personalization sheet. Hence, D9 discloses pre-punching of outer overlay sheets before coupling them with an intermediate flexible layer.
24. Hence, the subject-matter of claim 1 of the first auxiliary request is novel over document D9, since D9 does not disclose sheets of plastic material that are

more rigid than an intermediate flexible layer (Article 54(1), (2) EPC).

First auxiliary request in appeal - inventive step

25. The distinguishing feature, i.e. the rigid plastic materials, enhance the stability of the anti-counterfeiting labels. Hence, the objective technical problems is to find more stable labels.
26. The Board concurs with the Opposition Division's conclusion (reasons, section 20, middle of page 8) that adjusting the rigidity of the outer layers (e.g. by adjusting their thickness) was an obvious choice for the skilled person depending on the needs for a label. Whereas paragraph [0070] of D9 particularly refers to very thin and easily bendable overlay sheets in "replacement" (*ersatzweise sehr dünne und leicht biegbare Overlayfolien (8,15)*) this "replacement" indicates that - when not replaced - these overlay sheets can also be more rigid.
27. Consequently, the first auxiliary request lacks an inventive step in view of document D9 (Article 56 EPC).

Second auxiliary request in appeal - admission

28. The second auxiliary request, re-filed with the statement of grounds of appeal in 2017, is identical to the fourth auxiliary request first filed on 14 October 2016 and withdrawn during oral proceedings before the Opposition Division (minutes, point 6, page 5).

29. On the question of the admission of the second auxiliary request, the parties argued *inter alia* as follows.
30. The proprietor argued that Article 12(4) RPBA 2007 applies. As opposed to in the revised RPBA, the presumption was that everything presented with the statement of grounds of appeal was taken into account, unless there was a reason not to. In the section of the CLBA referred to in the preliminary opinion, i.e. V.A. 5.11.3(i), the resubmission of a request previously withdrawn was to be admitted under two special conditions, namely that there was no procedural abuse in the sense that the withdrawal was not made to avoid a decision on a critical issue, and that the other party was not surprised. In the present case, the withdrawal was prompted by the admission of D9 into the proceedings, not by any abusive intentions, and the opponent was familiar with the claim request at issue after it had been widely discussed in the first instance.
31. The opponent argued that the appeal proceedings were about reviewing the appealed decision. The claim request was not subject of that decision. Therefore, it had no place in these proceedings.
32. The admission of the second auxiliary request is at the discretion of the Board under Article 12(4) RPBA 2007 (applicable under Article 25(2) RPBA 2020). Moreover, Article 12(2) RPBA 2020 should be considered (applicable under Article 25(1) RPBA 2020).
33. Under Article 12(4) RPBA 2007, the Board has the power to hold inadmissible requests *which could have been presented [...] in the first instance proceedings*. The

second auxiliary request, that indeed was in the first instance proceedings, demonstrably *could* have been presented there.

34. Under Article 12(2) RPBA 2020, the primary object of the appeal proceedings is to review the appealed decision in a judicial manner. Therefore, a party's appeal case shall be directed to the requests on which the appealed decision was based. Such a review of the second auxiliary request is not possible, as the proprietor actively closed that door by withdrawing the request before the Opposition Division could decide on it.
35. The proprietor's withdrawal of its request was a serious procedural declaration with consequence. This Board is not convinced that in the present case the proprietor should be free to backtrack on it in the sense of re-submitting the request at will on the basis that the withdrawal was not made in abuse and that the substance of the request was familiar. In the Board's view, that would not only conflict with the role of the appeal proceedings but also unreasonably undermine the expectations raised by the act of withdrawal.
36. Therefore, the second auxiliary request is not admitted into the appeal proceedings (Article 12(4) RPBA 2007, Article 12(2) RPBA 2020, T 1689/12, Reasons 1.2).

Third auxiliary request in appeal - insufficiency of disclosure

37. With the submission of 4 December 2017 (section 2.1.1), the opponent raised an objection of insufficient disclosure ("Mangelnde Ausführbarkeit") against the third auxiliary request. This objection against a claim

that was granted - as an explicitly formulated alternative in claim 14 with back-references to claims 13 and 11 - amounts to raising a fresh ground of opposition under Article 100(b) EPC. According to the jurisprudence in opposition appeal proceedings fresh grounds of opposition may be considered only with the proprietor's consent (G 10/91, G 9/91, G 1/95).

38. During written proceedings the proprietor did not give its consent, and it confirmed the non-consent during oral proceedings.
39. Since the proprietor did not give its consent to the late-introduction of the new ground of opposition under Article 100(b) EPC, the objections with regard to insufficiency of disclosure are not considered.

Third auxiliary request in appeal - novelty

40. In the decision under appeal, the Opposition Division held that D9 does not disclose the following features of claim 1 of the proprietor's third auxiliary request (reasons, section 24, page 12 to page 13, second paragraph):
- before the pre-punching, the first and second layers are coupled with a protective coating and
 - are already foreseen with the data storage device and
 - that the first and second sheets are made of rigid plastic material,
 - and that there is applied any coating upon the layers 15 and 9 in Figure 4b.
41. With the statement of grounds, the opponent argued against this analysis (statement of grounds, section

2.1) and stated that the skilled person would find all features of claim 1 in D9. Also in the reply to the preliminary opinion and during oral proceedings, the opponent further elaborated about their interpretation of D9.

42. In particular, with regard to the question of rigid plastic material it was referred to paragraphs [0013], [0014] and [0036] to [0039], and to Figures 3 and 4, in which rigid plastic materials were disclosed. Further, it was referred to the common general knowledge of the skilled person who knew about rigid pages of a passport and about non-plastified joint ("Naht") regions (statement of grounds, section 2.1, page 4 to page 5, second complete paragraph; reply to preliminary opinion, section II.2).
43. With regard to the data storage device, the opponent referred to paragraph [0060] and in particular to a pre-laminated ("vorlaminiert") element with an IC and an antenna, that is laminated together with the other layers in a following step (statement of grounds, page 5, third complete paragraph, reply to preliminary opinion, section II.4).
44. Concerning the protective coatings, the opponent referred to the overlay sheets "Overlayfolien" in D9 that were used to protect the passport page against physical impacts (statement of grounds, page 5, last paragraph).
45. The opponent also referred (statement of grounds, page 5, third paragraph; page 6, second paragraph; reply to preliminary opinion, section II.3), to punches ("Ausstanzungen") that are punched before lamination (paragraphs [0066] and [0067]). It was also argued that

the order of the steps (coupling of layers, punching of layers, lamination of layers) is arbitrary and known to the skilled person. In D9, for instance, an overlay sheet was laminated and a punching could occur prior to a lamination (D9, paragraph [0067]) or already laminated sheets can be punched (D9, paragraph [0052]).

46. The Board is not persuaded.
47. As already discussed above with regard to the first auxiliary request, the question of rigidity is not only a question of material, but also of the layer thickness. Whereas the materials mentioned in D9 (polycarbonat (PC), PETP) are - in principle - suited to manufacture rigid layers (i.e. more rigid than the flexible intermediate layer), in D9 it is always the combination of a stack of layers that makes the passport page more rigid than the flexible region, where only the flexible intermediate layer is present. From that it is not possible to imply any level of rigidity to the single layers alone.
48. Second, in the interpretation of D9 used by the opponent with regard to lack of novelty, the layers 8 and 15 of D9 (the overlay sheets, "Overlayfolien") are the rigid layers. In D9 these layers are the outermost layers. An - additional - protecting layer on top of these overlay sheets is not foreseen.
49. Third, as already discussed above with regard to the first auxiliary request, document D9 does not disclose - with regard to the embodiment in Figure 9 - at what time in the manufacturing process the punching step is performed, in particular that the pre-punching of the first and second layers - here already coupled with the protective coating and with the data storage device -

takes place before coupling these layers with the flexible intermediate layer. In particular, in paragraph [0069] a punch 17 is disclosed as being continuous ("durchgehend"). It is not disclosed, however, in which direction the punch 17 is continuous (i.e. whether in a vertical direction through the layer stack or in a lateral direction in a single layer). And even when interpreted as meaning continuous in a vertical direction, this does not mean that the punch is punched together for a plurality of layers. It might also be possible to punch each layer separately at the same location before one layer is coupled on top of the other.

50. Hence, claim 1 of the third auxiliary request is novel over D9 (Article 54(1), (2) EPC).
51. With the statement of grounds, the opponent also raised a lack of novelty objection over document D3 (WO-A-2006/097276).
52. As already stated in the preliminary opinion, there is no disclosure in D3 of a pre-punching step of an outer layer coupled with a protection layer prior to laminating these layers onto a flexible layer. No counter-argument was provided by the opponent.
53. Hence, claim 1 of the third auxiliary request is novel over D3 (Article 54(1), (2) EPC).

Third auxiliary request in appeal - inventive step

54. In the decision under appeal, as well as in the opponent's statement of grounds and in the preliminary opinion, document D9 was considered as representing the

closest prior art. The proprietor did not question the choice of D9 as closest prior art.

55. In opposition proceedings and at the start of the appeal proceedings the opponent used a first interpretation of document D9, wherein the overlay sheets 8, 15 of D9 were interpreted as the first and second sheet of rigid plastic material as defined in claim 1 of the third auxiliary request. With the reply to the preliminary opinion (section IV), the opponent introduced a second, additional, interpretation of D9, wherein the overlay sheets 8, 15 were interpreted as the protective coatings defined in claim 1. In the following both interpretations and their implications on the analysis of inventive step are discussed.
56. The first interpretation is the same that was used when discussing novelty above. As explained in detail above, the following distinguishing features lack in D9:
- before the pre-punching, the first and second layers are coupled with a protective coating (in D9 there is no coating at all above the overlay sheets 8, 15) and
 - are already foreseen with the data storage device and
 - that the first and second sheets are made of rigid plastic material.
57. The distinguishing features have different technical effects: the protective coatings protect the layers against external damages, e.g. mechanical destruction; the rigid plastic materials enhance the stability of the label, the coupling of the layers with their respective coatings and with the data storage device and the following pre-punching before coupling these

layer stacks with the intermediate layers results in a better alignment of the layers.

58. According to the different technical effects, different partial problems are solved: increasing the stability, protection against damages, easier handling of the layers during the manufacturing process.
59. As discussed above with regard to the first auxiliary request in appeal, the skilled person may derive information from D9 to increase the thickness of the overlay sheets and thereby their rigidity.
60. D9 does not explicitly disclose a particular function for the overlay sheet 8, 15. However, since the personalization, the laser printing, the IC are located in other, inner, sheets, and since the overlay sheets 8, 15 are the outermost layers (see figures 4a, 4b, 5a, 5c) it is implicit that they are protecting the inner layers. Hence, it is highly doubtful that the skilled person would have used an additional protective coating on top of such a protecting overlayer. For that reason, also a protective overlay on both sides of security printing as disclosed in D7 (US-A-2005/0202249, paragraph [0026], Figure 1) would not have prompted a skilled person to add two further protective coatings on top of already existing protecting overlay sheets.
61. And neither in D9, nor in any of the other prior art documents, there is any hint that the handling of the layers in a manufacturing process could be improved by first coupling some of the layers and pre-punching them together, before actually coupling the pre-coupled and pre-punched layer stack with the intermediate flexible layer.

62. In particular, document D9 discloses punching the separate sheets separately (see, for instance claims 9 and 11) and not pre-coupling them and only then pre-punching them and then coupling them with the flexible layer.
63. D3 discloses a punching only at the end of the manufacturing process (page 16, lines 11 to 12).
64. D4 (WO-A-2008/135285) discloses a punching ("Stanzung") at the end of the manufacturing process (page 2, first and second paragraph; page 8, first full paragraph) and punchings ("Stanzungen") for a core sheet stack ("Kernfolienpaket 22", page 5, second paragraph) that can be pre-laminated. But for the core sheet stack no details are given as to when the steps of punching and laminations are performed.
65. D6 (EP-B-1 663 667) also discloses a punching ("ausgestanzt") only at the end of the manufacturing process (D6, column 4, lines 13 to 19, claim 13).
66. Hence, according to the first interpretation of D9, the subject-matter of claim 1 of the third auxiliary request in appeal is based on an inventive step.
67. According to the second interpretation of D9, the layer 5 in D9 is considered as the layer that is supposed to be the rigid first (or second) layer of the claimed subject-matter.
68. According to this second interpretation the overlay sheet 8 of D9 is the protective coating and the overlay sheet 15 is supposed to be another protective coating.

69. With this second interpretation, the following features are not disclosed in D9:

- there is no first sheet of rigid plastic material, since layer 5 is not disclosed to be rigid
- there is no second sheet of rigid plastic material at all, which, thus, can neither be pre-punched, nor pre-coupled with its protective coating before pre-punching, it can also not be coupled with the intermediate flexible layer
- there is no pre-punching of a rigid plastic material already coupled with a data storage device

70. Different technical effects result from these distinguishing features. Under the assumption that the second sheet has similar features as the first sheet, the second sheet could be used for additional security items via e.g. laser imprinting. Using rigid first and second sheets increases the stability of the label. Pre-coupling and pre-punching of layers increase the alignment of different layers during manufacturing.

71. These different technical effects are used to solve different partial problems, i.e. enhancing security, increasing stability and increasing ease of handling during a manufacturing process.

72. Whereas in the first interpretation, the skilled person would have been prompted by D9 to increase the stability of the label by increasing the thickness of the overlay sheets, in the second interpretation the first layer should be made rigid. Since already the overlay sheets could be made rigid, it is doubtful that the skilled person would then - in addition - also have made the first layer rigid, without any hint from D9 that also the rigidity of the first layer is an issue.

73. Further, in D9 the security items foreseen are printed in the layer 5, there seems to have been no incentive for a skilled person to add a further "security" layer.
74. In addition, the very same partial objective technical problem that was present in the first interpretation, i.e. that the ease of handling should be improved, still exists even under the second interpretation. And - as discussed above - neither D9 nor any other document cited in that regard (D3, D4, D6) provides the skilled person with any hint towards the solution defined in claim 1, namely pre-coupling and pre-punching of layers before coupling these with the intermediate flexible layer.
75. Hence, even under the second interpretation of D9, the subject-matter of claim 1 of the third auxiliary request is based on an inventive step (Article 56 EPC).
76. Consequently, the proprietor's third auxiliary request in appeal, i.e. the patent as maintained by the Opposition Division, is allowable.

Conclusion

77. Since the main request in appeal is not allowable under Article 123(2) EPC, the first auxiliary request in appeal is not inventive, the second auxiliary request in appeal is not admitted into the proceedings, and since the claim set found allowable by the Opposition Division, i.e. the third auxiliary request in appeal, is allowable, the appeals of both parties have to be dismissed.

Order

For these reasons it is decided that:

The appeals are dismissed.

The Registrar:

The Chair:



D. Meyfarth

B. Noll

Decision electronically authenticated