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**Datasheet for the decision
of 23 March 2022**

Case Number: T 1441/17 - 3.2.05

Application Number: 01918709.5

Publication Number: 1285402

IPC: B42D15/10

Language of the proceedings: EN

Title of invention:

Method of making a foil faced financial transaction card
having graphics printed thereon and card made thereby

Patent Proprietor:

VALID USA, Inc.

Opponent:

Giesecke+Devrient Currency Technology GmbH

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

Reformatio in peius (yes: main request and aux. requ. 1, 4, 5)
Added subject-matter (yes: auxiliary requests 2 and 3)

Decisions cited:

G 0009/92



Beschwerdekammern

Boards of Appeal

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Case Number: T 1441/17 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 23 March 2022

Respondent: VALID USA, Inc.
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Decision under appeal: **Interlocutory decision of the Opposition**
Division of the European Patent Office posted on
28 April 2017 concerning maintenance of the
European Patent No. 1285402 in amended form.

Composition of the Board:

Chairman P. Lanz
Members: O. Randl
C. Brandt

Summary of Facts and Submissions

- I. Both the patent proprietor and the opponent appealed against the opposition division's decision to maintain European patent No. 1 285 402 ("the patent") in amended form.

The opposition division was of the opinion that the ground for opposition under Article 100(c) EPC prejudiced the maintenance of the patent as granted but that auxiliary request 1 (filed during the oral proceedings before the opposition division) complied with the requirements of the EPC. Consequently, the opposition division did not examine auxiliary requests 2 (also filed during the oral proceedings), 3 and 4 (filed as auxiliary requests 1 and 2 on 7 February 2017, see point 8 of the summary of facts and submissions of the decision under appeal).

- II. The patent expired on 16 March 2021. On 21 May 2021, the board issued a communication pursuant to Rule 100(2) EPC inviting the parties to consider if they wished the proceedings to be continued in view of the provisions of Rule 84(1) EPC.
- III. In a letter dated 17 June 2021, the opponent requested that the proceedings be continued.
- IV. The patent proprietor did not file such a request and withdrew its appeal in a letter dated 2 July 2021.
- V. Consequently, the appeal proceedings were continued with the opponent as the sole appellant and the principle of prohibition of *reformatio in peius* applying.

VI. The appellant (opponent) 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 in its granted form (main request) or on the basis of one of auxiliary requests 1 to 5.

VII. In a letter dated 18 January 2022, the respondent informed the board that it would not be represented at the oral proceedings scheduled for 24 January 2022. In view of this declaration, the board cancelled the oral proceedings and decided to issue the decision in writing.

VIII. The independent claims of the patent as granted (main request) read (for claim 1, the feature references used by the board are in square brackets):

"1. [C0] A foil faced financial transaction card having graphics printed thereon, said card comprising:
[C1] a rigid plastic sheet substrate layer;
[C2] a metal containing foil layer adhesively bonded on its back surface to a surface of said substrate layer,
[C3] a front surface of said foil layer having a printable layer thereon;
[C4] an adhesive layer bonded to the printable top coat layer on the metal containing layer;
[C5] printed ink graphics on a front surface of the adhesive layer;
[C6] a clear protective overlay adhesively bonded on the surface of the card over said graphics thereon, wherein [C7] the component layers of material that form the foil faced card are bonded to one another to the extent that any layer possesses a minimum peel strength

of 5.95 N/cm (3.4 lbf/in) to resist delamination of said card."

"15. A method of making a foil faced financial transaction card having graphics printed thereon, said method comprising:
providing a rigid plastic sheet substrate layer and a metal containing foil layer having a front surface with a printable layer thereon;
mounting said metal containing foil layer by way of its adhesive back surface on a surface of said substrate layer;
applying an adhesive layer on the front surface of the metal containing layer mounted on the substrate layer;
printing ink graphics on a front surface of the adhesive layer;
providing a clear protective overlay on said printed ink graphics on a front surface of said adhesive layer on top of the metal containing foil layer;
wherein the component layers of material that form the foil faced card are bonded to one another to the extent that: any layer possesses a minimum peel strength of 5.95 N/cm (3.4 lbf/in) to resist delamination said card."

Claims 1 and 15 of new auxiliary request 1 differ from claims 1 and 15 of the main request by the addition of the feature "[C2a] wherein said foil layer is bonded to said substrate layer by a heat-activated adhesive" after the words "of said substrate layer".

Claims 1 and 14 of auxiliary request 2 - which corresponds to auxiliary request 1 filed during the oral proceedings before the opposition division and which the opposition division considered to comply with the requirements of the EPC - differ from claims 1 and

15 of auxiliary request 1 by the addition of the features "[C5a] wherein said printed ink graphics are formed of ink applied using an offset litho press and/or a silkscreen printing process" and "wherein said ink graphics are printed using offset litho and/or silkscreen printing", respectively, after the words "of the adhesive layer".

Claims 1 and 13 of auxiliary request 3 - which corresponds to auxiliary request 2 filed during the oral proceedings before the opposition division - differ from claims 1 and 14 of auxiliary request 2 by the addition of feature "[C2b] using a roll laminating process" after the words "heat-activated adhesive".

Claim 1 of auxiliary request 4 - which corresponds to auxiliary request 1 filed on 7 February 2017 - differs from claim 1 of the main request by the insertion of the feature "wherein said adhesive layer is applied to said topcoat layer by a silkscreen operation" after the words "metal containing layer".

Claim 15 of auxiliary request 4 differs from claim 15 of the main request by the insertion of the feature "by a silkscreen operation" after the words "on the substrate layer".

Claims 1 and 15 of auxiliary request 5 - which corresponds to auxiliary request 2 filed in a letter dated 7 February 2017 - differ from claims 1 and 15 of auxiliary request 4 by the insertion of the features "to provide an adhesive layer having a thickness in the order of 50 microns (μm)" and "said adhesive layer having a thickness in the order of 50 microns (μm)", respectively, after the words "silkscreen operation".

IX. The relevant submissions of the parties regarding the compliance of amendment M4 ("rigid plastic sheet substrate layer") with the requirements of Article 123(2) EPC may be summarised as follows.

(a) Appellant (opponent)

While the originally filed claim 14 required the foil to have a "plastic substrate layer", claim 1 requires it to have a "rigid plastic sheet substrate layer". The alleged basis (**page 3, line 9: "rigid solid layer"**) is inappropriate because this layer is not only rigid but also solid. The feature of a solid layer was not included in claim 1 because it lacks clarity. Moreover, the corresponding layer is said to consist of PVC. However, "plastic" comprises a large group of compositions and is in no way to be equated with PVC. A certain thickness is also assumed in this context, as well as other structural features (see page 3, lines 10 and 11 of the original description). Thus, the respondent has picked out a single feature in a mosaic-like manner. The cited reference can in no way provide a basis for the amendments. Furthermore, page 3 is to be interpreted in the context of Figs. 1 to 3. According to page 3, line 2, it is mandatory that the card be shaped according to the ANSI/ISO standard. Consequently, the embodiment as a whole is not suitable for disclosing the feature under consideration. Moreover, reference is made to **Fig. 4**, which, however, again represents a different embodiment. Thus, **Figs. 1 to 3**, which are described on page 3 to 4, line 5, show structural features of the smart card, and Fig. 4, in the synopsis with the description starting from page 4, line 6, shows process steps carried out by a subcontractor. The different embodiments of Figs. 1 to 3 cannot be combined with Fig. 4. There is no direct

and unambiguous disclosure for a combination of the various embodiments. Rather, there is a separation between structural features and procedural steps. In particular, it is also shown with reference to Fig. 4 that the cards comply in a particularly advantageous manner with the ANSI/ISO standard (see the originally filed application document, page 4, line 29). Thus, it is clear that elements were arbitrarily isolated and used in a different combination when claim 1 was amended. Fig. 4 comprises a multitude of features that have not found expression in the claims (e.g. foil sheet trimming, processing steps for Visa or Mastercard, lamination, reduction to card size, etc.). Furthermore, reference was also made to **original claim 21**. However, this embodiment comprises two rigid sheets. **Page 4, line 4** refers to a distinct embodiment which comprises PVC substrates. Furthermore, line 5 provides that the corresponding substrate must be white. Moreover, a size specification is given in this context. Again, the disclosure of a single layer was isolated from its context. Such an amendment disregards the requirements of Article 123(2) EPC.

(b) Respondent (patent proprietor)

Amendment M4 was rightly held to be in compliance with Article 123(2) EPC by the opposition division. **Original claim 21** depends on original claim 14 on which both claim 1 as granted and claim 1 as maintained in amended form by the opposition division are based. It clearly defines for the card plastic substrate layer to comprise two rigid sheets of plastic material laminated to one another. **Page 4, lines 4 and 5** of the original description clearly and unambiguously discloses that, instead of the two laminated plastic sheets, a single plastic sheet can be employed. Even though this

disclosure is made in the context of a certain embodiment as shown in original **Figs. 1 to 3**, the general applicability of this statement to the claimed features is manifest to the skilled person. The fact that the feature of original claim 21 is not tied to further features of the embodiment of original Figs. 1 to 3 supports this view. Thus, amendment M4 complies with the requirements of Article 123(2) EPC. Considering that the original description underlying the opposed patent explicitly states that the flow diagram of **Fig. 4** shows "the method of making the financial transaction card according to the invention" (see page 2, last paragraph of the original description), it is not apparent why the skilled person should understand the technical features of the financial transaction card to be structurally separated from the manufacturing steps described for making this card. Rather, in view of the above paragraph and in line with the last paragraph on page 2 of the original description, the term "rigid plastic sheet substrate layer" as used in the independent method claim 15 as granted as well as maintained in amended form by the opposition division as claim 14 is also in line with the requirements of Article 123(2).

Reasons for the Decision

1. Requests on file

The following table lists the various requests on file before the opposition division and the board and the date of their first filing ("MR" is short for "main request" and "ARn" stands for "auxiliary request n").

Final requests before the opposition division	Date of first filing	Requests before the board
MR	granted patent	MR
-	06.09.2017	AR1
AR1	07.03.2017	AR2
AR2	07.03.2017	AR3
AR3	07.02.2017	AR4
AR4	07.02.2017	AR5

2. Consequence of the prohibition of *reformatio in peius*

As a consequence of the withdrawal of its appeal, the patent proprietor is limited to defending the patent in the version that the opposition division found to be allowable (i.e. current auxiliary request 2) and claims for further limitations of that request (i.e. current auxiliary request 3), see decision G 9/92, Order 2.

The current main request and auxiliary request 1 have a broader scope of protection than current auxiliary request 2. Consequently, the amendments proposed in these requests are neither appropriate nor necessary for defending the patent in the version found allowable by the opposition division. The maintenance of the patent on the basis of these requests would thus contravene the prohibition of *reformatio in peius*.

The same applies to current auxiliary requests 4 and 5, whose scope of protection extends beyond the scope of protection of current auxiliary request 2.

Thus, in view of the prohibition of *reformatio in peius*, the main request and auxiliary requests 1, 4 and 5 have to be rejected as inadmissible and it is therefore not possible to maintain the patent on the basis of these requests. Consequently, the board considers only auxiliary requests 2 and 3 in the following.

3. Auxiliary request 2

3.1 Interpretation of feature C1

Original claim 14 required that the card comprise a plastic substrate layer. Feature C1 now requires the presence of a rigid plastic sheet substrate layer.

The original wording "plastic substrate layer" designates a layer of the card made of a plastic material and acting as a substrate onto which other materials are applied. The adjective "rigid" might qualify the plastic or the layer, but in the original application it always qualifies the layer. The meaning of the insertion of the word "sheet" is less straightforward. According to the Oxford English Dictionary, the term "sheet" may designate "a broad expanse or stretch of something lying out flat ... forming a relatively thin covering or layer". In view of this, two possible interpretations come to mind. Either the term "sheet" means "layer" and is redundant, or the whole expression is to be understood as a product-by-process feature meaning "a substrate layer made from a rigid plastic sheet". The latter interpretation would be in line with the process shown in Fig. 4, but this process involves the use of more than one sheet. Original claim 21 reads:

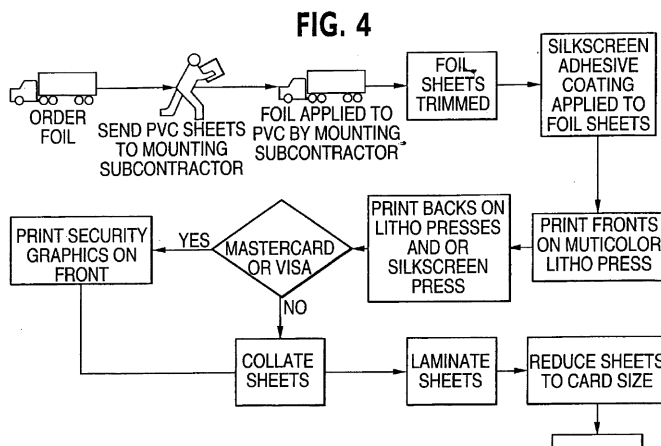
"21. The card according to claim 14, wherein said substrate comprises two rigid sheets of plastic material laminated to one another."

As the substrate layer comprises at least two sheets, the "sheet ... layer" language makes better sense and does not have to be understood as a reference to the process. This passage appears to favour the first interpretation, which the board adopts.

3.2 Compliance with Article 123(2) EPC

Original claim 14 required that the card comprise a plastic substrate layer. Feature C1 now requires the presence of a rigid plastic sheet substrate layer. For the board's interpretation of this feature, see point 3.1 above. The opposition division found this amendment - identified as amendment M4 in point 2.1 of the Reasons for the decision under appeal - to comply with the requirements of Article 123(2) EPC. This conclusion is explained in point 2.1.4 of the Reasons for the decision under appeal. The opposition division noted that:

- the word "rigid" is disclosed on page 3, line 9 of the original application ("... The method of making the foil faced financial transaction card 20 comprises providing a plastic substrate layer, for example, a rigid solid layer of polyvinyl chloride having a thickness of 26 mil ...", underlining by the board)
- the word "sheet" is disclosed in Fig. 4



Detail of Fig. 4

- original claim 21 discloses that the substrate comprises "two rigid sheets of plastic material laminated to one another". According to the opposition division, this also discloses the more general "rigid plastic sheet substrate layer", especially in light of the use of the word "single" on page 4, line 4 of the original description

The board cannot endorse this reasoning. The original description always associates the rigidity of the layer with PVC material (see page 3, line 9 and page 4, lines 3, 5 and 10). Fig. 4, which also discloses the use of PVC sheets, does not mention the rigidity of the sheets at all. Original claim 21 is more relevant. To make it support the amendment, the opposition division referred to a sentence found on page 4, lines 4 and 5:

"As noted above, a single 26 mil white rigid PVC substrate could also be employed." (Underlining by the board.)

Again, only a single layer made from PVC material is envisaged.

Consequently, amendment M4 adds subject-matter extending beyond the content of the original application and infringes Article 123(2) EPC.

Therefore, it is not possible to maintain the patent in amended form on the basis of auxiliary request 2.

In view of this conclusion, it is not necessary to examine the other objections raised by the appellant against auxiliary request 2.

4. Auxiliary request 3

The independent claims of auxiliary request 3 differ from those of auxiliary request 2 by the addition of feature C2b, according to which the bonding is carried out using a roll laminating process.

Claim 1 of auxiliary request 3 comprises feature C1, which the board found to infringe Article 123(2) EPC (see point 3.2 above). The addition of feature C2b is not suitable for overcoming the objection.

Therefore, it is not possible to maintain the patent in amended form on the basis of auxiliary request 3.

5. Conclusion

As none of the requests on file is allowable, the patent must be revoked.

6. Cancellation of the oral proceedings

In their notices of appeal, both parties requested an oral procedure in case the board did not grant their requests. By letter dated 18 January 2022, the

respondent announced that it would not participate in the oral proceedings scheduled for 24 January 2022. This is interpreted as a withdrawal of the request for oral proceedings. As the board grants the appellant's main request by revoking the patent, there is no need to hold oral proceedings. Therefore, the board cancelled the oral proceedings and decided to issue its decision in writing.

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:



N. Schneider

P. Lanz

Decision electronically authenticated