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**Datasheet for the decision
of 31 May 2023**

Case Number: T 1569/19 - 3.4.03

Application Number: 13199415.4

Publication Number: 2774775

IPC: B42D25/00, G06K19/077

Language of the proceedings: EN

Title of invention:

A method of manufacturing an electronic identity document

Patent Proprietor:

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

Opponent:

Bundesdruckerei GmbH

Headword:

Relevant legal provisions:

EPC Art. 100 (a), 100 (b), 54 (1), 56, 83
RPBA Art. 12 (4)

Keyword:

Ground for opposition: Insufficiency of disclosure - patent as granted sufficiently disclosed

Ground for opposition: Lack of novelty - patent as granted new

Ground for opposition: Lack of inventive step - patent as granted inventive

Objection filed first time in appeal - not admitted, could have been filed in opposition

Decisions cited:

T 0001/81, T 0131/01, T 1914/12, T 0603/14, T 2238/15,

T 0482/18

Catchword:



Beschwerdekammern

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Case Number: T 1569/19 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 31 May 2023

Appellant: Bundesdruckerei GmbH
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 29 March 2019
rejecting the opposition filed against European
patent No. 2774775 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman T. Häusser
Members: M. Papastefanou
G. Decker

Summary of Facts and Submissions

I. The appeal of the opponent was against the decision of the opposition division rejecting its opposition against the European patent No. 2 774 775 B1.

The opposition was based on the grounds for opposition of lack of novelty and inventive step (Article 100(a) EPC in combination with Articles 52(1), 54(1) and 56 EPC) and lack of sufficient disclosure (Article 100(b) EPC in combination with Article 83 EPC).

II. Reference is made to the following documents, cited during the opposition procedure:

D1: US 2012/155700 A1
D6: US 2005/0129281 A1
D7: GB 2 033 299 A
D8: US 2010/0179680 A1
D9: WO 96/27498 A1

III. In the impugned decision, the opposition division held *inter alia* that:

- the invention was sufficiently disclosed in the patent within the meaning of Article 83 EPC
- claim 1 as granted was new over D6
- claim 1 as granted involved an inventive step in view of a combination of D1 as closest prior art with any of D8, D9, D6, and a combination of D7 as closest prior art with the skilled person's common general knowledge

IV. The parties' final requests were:

The appellant ("opponent") requested that the decision under appeal be set aside and the patent be revoked in

its entirety.

The respondent ("proprietor") requested as its main request that the appeal be dismissed (i.e. that the patent be maintained as granted). As an auxiliary measure, the proprietor requested that the decision under appeal be set aside and that the patent be maintained in amended form according to one of the first to fourth auxiliary requests filed with its reply to the grounds of appeal (letter dated 29 November 2019).

The proprietor also requested that the opponent's objections of lack of inventive step starting with D6 as closest prior art not be admitted into the proceedings.

- V. The wording of claim 1 as granted (main request), including the feature numbering used by the parties and the opposition division in square brackets, is as follows:

A method of manufacturing an electronic document, the latter of the type comprising

- [1.1] a physical medium bearing identification data in a physical form, in particular graphic form, and*
- [1.2] storage means bearing the same and/or further identification data in electronic format,*
- [1.3] which method comprises the steps of:*
 - (a) providing separately a physical medium and storage means, both to be customized with identification data;*
 - (b) providing identification data to be associated with a same document;*
 - (c) providing simultaneously said identification data to first means for writing said identification data*

in physical form upon said medium and to second means for writing said identification data in electronic format on said storage means;

(d) performing said data writing upon said physical medium and on said storage means; and

(e) assembling said medium bearing identification data in physical form with said storage means bearing identification data in electronic format.

VI. The wording of the claims of the auxiliary requests is not relevant for this decision.

VII. The parties' arguments can be summarised as follows:

- On sufficiency of disclosure

The **opponent** argued that the term "simultaneously" in feature [1.3](c) was to be understood so broadly that it had no particular meaning for the skilled person who would thus not have known how to implement it. If "simultaneously" was to be understood narrowly, the patent did not provide sufficient information about how the data could be provided to the first and second means for writing simultaneously. The claim did not provide any limitations to the localisation of the first and second means for writing; they could thus be installed remotely from each other. The patent did not provide sufficient information to the skilled person about how the steps [1.3](c) and [1.3](e) were to be carried out in such circumstances.

According to **the proprietor**, the term "simultaneously" was to be understood in its common meaning, i.e. "at the same time". That the patent did not give specific information about certain steps of the claimed method did not automatically mean that the skilled person

would not be able to carry them out.

- *On novelty*

In the opinion of the **opponent**, D6 disclosed all features of claim 1. In particular, Figure 1 of D6 showed an embodiment of the described invention and it was clear that feature [1.3](c) was disclosed; D6 also disclosed an embodiment in which steps [1.3](d) and [1.3](e) were carried out in the same order as in claim 1. Claim 1 was thus not new over D6.

The **proprietor** was of the opinion that Figure 1 of D6 did not show an embodiment of the invention of D6 but only a concept. The embodiments of the described method were presented in Figures 24 and 29 which made clear that feature [1.3](c) was not disclosed and that the steps [1.3](d) and [1.3](e) were carried out in inverse order with respect to claim 1 of the patent. Claim 1 was thus new over D6.

- *On inventive step starting from D1*

According to the **opponent**, D1 disclosed all features of claim 1 except that the steps [1.3](d) and [1.3](e) were carried out in the inverse order of the one in claim 1 of the patent. The skilled person would find it obvious to combine D1 with any of the teachings of D8, D9 or D6 and arrive at the claimed method in an obvious manner. The subject-matter of claim 1 was thus not inventive.

The **proprietor**, although it agreed with the opponent's analysis of the disclosure of D1, argued that there was no reason for the skilled person to consider D8, D9 or D6. Moreover, there was nothing in the disclosure of

those documents that would incite the skilled person to invert the order of the steps [1.3](d) and [1.3](e) in D1 without using inventive skills. The subject-matter of claim 1 was not obvious when D1 was taken as closest prior art.

- On inventive step starting from D6

The **proprietor** pointed out that D6 had been extensively discussed with respect to novelty during the opposition procedure but the opponent had never raised any objection of lack of inventive step starting from it. Moreover, the opponent had agreed with the examining division during the oral proceedings that D6 was not an appropriate starting point. The objection of lack of inventive step starting from D6 submitted for the first time during the appeal proceedings could and should have been submitted during the opposition procedure and should not be admitted into the appeal proceedings.

According to the **opponent**, since D6 had been extensively discussed during the opposition procedure, no new facts were submitted by the objection of lack of inventive step starting from D6 as closest state of the art. New arguments were always to be admitted into the appeal according to Article 12(4) RPBA 2007.

Reasons for the Decision

1. The invention
- 1.1 The invention relates to manufacturing of electronic identity documents such as passports, identity cards, etc. Such electronic documents comprise a physical medium (e.g. a booklet) with an incorporated electronic

storage means. Identification information of the user is both printed on the physical medium and stored into the storage means (see e.g. paragraph [0001] of the patent specification).

- 1.2 Such electronic documents are conventionally manufactured by first assembling the physical medium and the electronic storage means together and then writing the identification information onto each of them. In such circumstances there are two problems. First, when the electronic document is assembled, there is a point where there is a complete, anonymised identity document available (e.g. an empty passport). Such a document could be lost, stolen, etc., and malicious users could use it to create false/counterfeit identity documents. Second, when the document has to be personalised (i.e. the user's identification data written on the physical medium and into the storage means), it has to be made sure that the identification data to be printed on the physical medium match those intended to be stored into the storage means (see paragraphs [0003] to [0008]).

- 1.3 The claimed method solves these problems by providing the physical medium and the storage means separately, and providing the identification data simultaneously to first and second means for writing the data on the physical medium and into the storage means. The physical medium and the storage means are then assembled together, after being personalised, to produce the electronic document.

In this way, there is no moment where an assembled but still not personalised electronic document exists. Moreover, since the identification data are provided simultaneously to be written on the physical medium and

the storage means, there is no problem related to their matching (see paragraphs [0019] to [0021] of the patent specification).

Main request (patent as granted)

2. Sufficiency of disclosure (Articles 100(b) and 83 EPC)

2.1 The term "simultaneously" in feature [1.3](c) of claim 1

2.1.1 The opponent argued at first that, if "simultaneously" was to be understood as "at the same time", there was no detailed specification of the time in the patent, i.e. whether it should be *the same second or the same minute*, so that the skilled person was not in a position to know how accurate the simultaneous provision of the identification data to the first and second means for writing (feature [1.3](c)) was supposed to be (see first paragraph on page 3 of the statement of the grounds of appeal).

2.1.2 In addition, the opponent pointed to paragraph [0031] of the patent specification, which stated that the identification data were carried to the first and second means for writing "*simultaneously - or however in almost such logic sequence*". A similar expression was also used in paragraph [0048]. According to the opponent, the term "such logic sequence" was an indication that it was not necessary for the identification data to be provided "at the same time" to the first and second means for writing. The skilled person, therefore, did not get unambiguous information about how the data were to be provided to the first and second means for writing.

2.1.3 The opponent also referred to the board's interpretation in its preliminary opinion, according to which the skilled person reading the patent as a whole would have understood that the purpose of feature [1.3](c) was to provide the data to the first and second means for writing so that the writing on the physical medium and the storage means could be carried out simultaneously or "in parallel" (see point 4.1.1 of the board's communication under Rule 15(1) RPBA 2020). In the opponent's view, this definition led to a very broad interpretation, since it only meant that the data had to be available at the first and second writing means at the same time, but said nothing about the timing of their transmission (provision) to those means for writing, which could have taken place even years apart.

The opponent's conclusion was that the term "simultaneously" in feature [1.3](c) was so broad that it had no clear meaning in the context of the present patent, and the skilled person would not be able to carry it out, at least not in its whole scope.

2.1.4 The board sees no reason to give the term "simultaneously" any other meaning than the ordinary and commonly used one, i.e. "at the same time".

The fact that there is no detailed specification whether it should be at the same minute or same second is not a problem. As the opponent pointed out, the board's preliminary opinion was that the skilled person would understand that the main point was that the identification data are provided to the first and second means for writing at the same time so that the following steps of writing the identification data on the physical medium and the storage means could be

carried out at the same time, or in parallel. The board is still of this opinion.

2.1.5 The opponent's interpretation that the identification data can be provided to the first and second means for writing even years apart ignores that the claim defines that the data has to be provided to the first and second writing means simultaneously, i.e. at the same time. Any interpretation of the term "simultaneously" cannot ignore this aspect. The board's interpretation relates rather to the fact that, in a data transmission from one device to others (or from one part of a device to other parts), it cannot in general be guaranteed that the data will always arrive exactly at the same time at their destinations. The skilled person knows that there must be some tolerance in the notion of "at the same time". The important aspect is that the subsequent writing steps to the physical medium and the storage means can be executed in parallel, i.e. also at the same time. Although this latter aspect is not claimed, it is the only way of carrying out the invention described in the description.

2.1.6 The board also shares the proprietor's argument that the fact that a term in the claim may be interpreted broadly does not automatically render it insufficiently disclosed. At most the broad interpretation may give rise to problems relating to lack of clarity, which is not a ground for opposition and has not been argued by the opponent.

2.2 Features [1.3](c) and [1.3](e) of claim 1

2.2.1 The opponent argued that the patent as a whole did not provide any details regarding the location of the first and second means for writing. Since this question was

left practically open, the first and second means for writing could be located at different locations, even in different countries. The steps of the simultaneous provision of the identification data to these first and second means for writing (feature [1.3](c)) and the assembly of the physical medium with the storage means (feature [1.3](e)) would have thus not be straightforward for the skilled person to carry out.

According to the opponent, the provision of the identification data to the first and second means for writing would have involved problems related to the transmission of the data to different locations, possibly through firewalls. Even delivery of the data by hand could not be excluded. The patent contained no relevant information on these matters. Similarly, assembling the physical medium with the storage means would have also involved problems relating to the matching together of the identification data written (stored) on each of them, since it had to be made sure that they both related to the same person. Again, the patent did not give any information so that the skilled person would not have been able to carry out those steps without undue burden.

- 2.2.2 The board does not find these arguments convincing. The skilled person would not consider interpretations of the claims which are not supported by the content of the patent as a whole. As stated previously, the purpose of the claimed invention relates to minimising the risk of having partially completed elements of the electronic documents circulating before the electronic document is finalised. It also relates to minimising the risk of "mismatching" between data on the physical medium and those on the storage means when they are assembled together. Having the first and second means

for writing installed at different locations goes against this purpose, since the physical medium and the storage means, both containing the identification data of the user, would have to be brought together for assembly. This means that at least one of the physical medium and storage means would have to be physically transported to a different location for the assembly to take place. This would increase the risk of the medium/means being stolen/intercepted/lost during transportation. Moreover, since the physical medium and the storage means would be brought together from different locations, they would have to be matched in order to make sure that the electronic document would contain the same identification data in the physical medium and in the storage means. These aspects, however, correspond to the problems of the state of the art the invention is trying to solve, i.e. it is against the stated purpose of the invention (see e.g. paragraph [0010] of the patent).

- 2.2.3 In the board's understanding, the claimed method, by providing the identification data to the first and second means for writing simultaneously, allows for a simultaneous (or parallel) writing of the data on the physical medium and the storage means so that they can be assembled together as soon as possible after the data have been written on them. Therefore, in the board's opinion, the skilled person would not contemplate embodiments including the positioning of the first and second means for writing at locations remote from each other.
- 2.2.4 Moreover, even if the opponent's interpretation were to be followed, the board's view is that the skilled person would be able to carry out the two objected steps on the basis of the patent disclosure and common

general knowledge. In essence, step [1.3](c) defines the provision (transmission) of data from one point to two other points (the first and second means for writing). There is nothing in the patent indicating that there is something particular in this data provision (transmission), so that the skilled person would be able to carry it out on the basis of common general knowledge alone. Moreover, taking into account the ordinary meaning of the term "simultaneously", the board's opinion is that the skilled person would be in a position to arrange the method so that the data are provided (transmitted) to the two means for writing at the same time on the basis of the information in the patent and common general knowledge.

Similar considerations are also valid regarding feature [1.3](e). Even if the physical medium and the storage means had to be transported from one location to another, there is nothing particular in bringing them together and assembling the one with the other. Their matching does not involve any particularities, so the skilled person can carry it out on the basis of their common general knowledge alone. Moreover, the board notes that the patent acknowledges that such a matching was known in the state of the art (see e.g. paragraphs [0004] to [0008] of the patent specification).

2.3 The board's conclusion is, therefore, that the patent discloses the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art and the ground for opposition under Article 100(b) EPC does not prejudice the maintenance of the patent as granted.

3. Novelty (Articles 100(a), 52(1) and 54 EPC)

- 3.1 The opponent argued that claim 1 as granted lacked novelty over document D6.
- 3.2 In the decision under appeal, the opposition division came to the conclusion that D6 did not disclose the simultaneous provision of the data to the two means for writing (feature [1.3](c)) and that in D6 the steps of writing the identification data to the physical medium and the storage means (feature [1.3](d)) and the assembly of the one with the other (feature [1.3](e)) were carried out in inverse order compared to the order of the steps in claim 1.
- 3.3 It was common ground that D6 disclosed all features of claim 1 as granted except [1.3](c) and the order of steps [1.3](d) and [1.3](e). Regarding feature [1.3](c) (the simultaneous provision of the identification data to the first and second means for writing), the discussion focused on Figure 1 of D6 and the corresponding disclosure in the description and, in particular, on the questions whether Figure 1 represented an embodiment of the invention of D6 and what it exactly disclosed regarding the transmission of the looks data (L1) from the photographic unit (10).
- 3.4 According to the opponent, Figure 1 of D6 represented an embodiment of the system of the invention of D6. The opponent argued that the three arrows pointing to the image server (40), the 2-D photo-printing unit (30) and the holographic stereo manufacturing unit (20) at the upper part of Figure 1 indicated that the looks image data (L1) (corresponding to the identification data of claim 1) obtained by the photographic unit (10) were provided to those three units simultaneously. According to the opponent, the patent also indicated the simultaneous provision of the data to the first and

second writing means by arrows (see e.g. Figures 1 and 2 of the patent) and so the skilled person would have reached the same conclusion in the context of Figure 1 of D6 (i.e. that the data were provided simultaneously to the corresponding units).

In addition, as D6 disclosed, the system of Figure 1 could also be implemented as an "integrated single apparatus" (see paragraph [0090]). The skilled person knew that in such an apparatus the various steps (corresponding to the various functions of the different units included in the apparatus) had to be executed "as parallel as possible". It was thus implicit that the skilled person would understand that the look data (L1) were provided to the three units represented in Figure 1 simultaneously.

- 3.5 The board, although it agrees with the opponent that Figure 1 presents an embodiment of the invention of D6, notes that Figure 1 represents a system (see D6, paragraph [0049]) which, although it may illustrate how data flow from one element/unit to another, does not provide any information regarding the timing or the order of the execution of the various operations. The description referring to Figure 1 (starting at paragraph [0089]) describes each unit represented in Figure 1 and the corresponding operation it carries out. Paragraph [0146] makes clear that this part of the description (i.e. paragraphs [0089] to [0146]) refers to the system: "Such a certification system is able to make a certification card CC ...". The board thus agrees with the proprietor that Figure 1 is not a flow chart in the sense that it does not show an order/timing of the execution of the various operations. The arrows in Figure 1 indicate from which unit to which unit(s) of the system the data are transmitted but do

not provide any information about any timing/sequence of these transmissions. It cannot thus be concluded from Figure 1 that the data are transmitted simultaneously to the three units. In contrast to D6, the patent, apart from the arrows in the figures (flow charts), describes explicitly that the data are provided simultaneously to the first and second means for writing (see e.g. paragraph [0031] of the patent specification). The skilled person would thus get the information about the simultaneous transmission not from the figures of the patent but from the detailed description.

3.6 The same conclusion is also valid for the embodiment of the system of Figure 1 of D6 as an integrated apparatus. There is no indication in D6 that any of the functions of the apparatus are executed in parallel/at the same time. The board does not consider common general knowledge or common practice that in such an apparatus the different operations have to be carried out "as parallel as possible". In the board's view, the order and the timing of the various operations within an apparatus depend on the specific implementation, application, circumstances and requirements. It is thus not accepted that the skilled person would always strive for a parallel/simultaneous execution of the various operations.

3.7 The board is thus of the opinion that Figure 1 of D6 does not disclose directly and unambiguously that the looks image data (L1) are provided to the three units 20, 30, and 40 simultaneously.

Moreover, it is observed that the image server (40) does not correspond to any of the first and second means for writing of claim 1 as granted. Rather, it is

the information recording unit (50) which writes the data into the recording medium (RM) and should thus be seen as the corresponding (second) means for writing of claim 1 as granted. Hence, even if it were to be accepted that the three arrows in Figure 1 indicated a simultaneous data transmission, the data would still not be provided to the first and second means for writing, as in claim 1.

3.8 The board's conclusion is therefore that D6 does not disclose feature [1.3](c) of claim 1 as granted. At least for this reason, claim 1 is new over D6 and the ground for opposition of lack of novelty (Articles 100(a), 52(1) and 54 EPC) does not prejudice the maintenance of the patent as granted.

4. Inventive step (Articles 100(a), 52(1) and 56 EPC).

4.1 Starting from D1

4.1.1 D1 describes the creation of "intelligent" documents, i.e. documents in sheet form, which contain both electronic and visible versions of information (paragraph [0001]). D1 uses "document blanks", i.e. sheets of paper with embedded/integrated electronic storage means such as RFID tags (see Figure 1 and paragraph [0037]). The same information is written on the sheet, i.e. the physical medium, and the electronic storage means (paragraph 0040]). The information can be provided to the means for writing on the physical medium and to the means for writing into the electronic storage means simultaneously (see paragraph [0044]).

It was common ground that the only difference between claim 1 as granted and D1 was that the steps [1.3](d) and [1.3](e) were carried out in inverse order in D1,

i.e. first the physical medium and the storage means were assembled together and then identification data were written on them.

- 4.1.2 The opponent's first argument was that the different order of the two method steps was not sufficient to render the claimed method inventive over D1. Making reference to the decision T 1/81 ,OJ EPO 1981, 439, the opponent argued that the order in which the two steps of the method were carried out did not constitute a difference that could support the presence of an inventive step.

The board does not agree with this argument. The patent provides specific reasons as to why in the claimed method the information is first written separately on each of the physical medium and the storage means and then these two elements are assembled together (see e.g. paragraphs [0019] to [0021] of the patent specification). The order of these steps in the claimed method is therefore not an arbitrary choice, but one which solves a specific technical problem. The cited decision T 1/81 relates to a method of making a transversely ribbed thermoplastics pipe by thermoplastic molding. The deciding board concluded, among others, that *[i]n the absence of other features that from a technical point of view would contribute to patentability, the sequence in which the socket and pipe connection is made therefore does not suffice to impart inventive step to the method claimed* (Reasons 11, first paragraph). In the board's opinion, this conclusion relates to the specific context of that case and does not allow general conclusions to be drawn as to the lack of inventive contribution by the order of the steps in any claimed method. As indicated below and in contrast to that decision, in the present case

the claimed order of the steps has specific technical advantages.

- 4.1.3 In a different line of argumentation, the opponent considered that the objective technical problem solved by the features distinguishing claim 1 as granted from D1 (i.e. the different order of steps [1.3](d) and [1.3](e)) was how to increase the security of the claimed method, in particular how to avoid that assembled documents (i.e. comprising both the physical medium and the electronic storage means) without any information on them could be lost/stolen, facilitating the production of counterfeit security documents. This was in line with the prior art problems indicated in the patent (see paragraph [0019] of the patent specification). The proprietor agreed with this formulation of the technical problem.
- 4.1.4 According to the opponent, the skilled person faced with the formulated technical problem would have considered any of the documents D8, D9 or D6 and reached the claimed invention in an obvious manner.
- 4.1.5 D8 relates to an apparatus for the distribution of cards on paper carriers. A card (calling card, smart card, credit card, etc.) comprising electronic storage means (e.g. chip, magnetic stripe) is coupled with a sheet of paper (glued on it) and then folded into an envelope to be posted. The described apparatus receives manufactured cards with information stored in the chip or a magnetic stripe and also printed/embossed on the card. It reads user identification information from the card and prints it on a paper carrier (sheet). At a subsequent step, the card is coupled with the paper carrier. The printing of the information on the paper carrier can be carried out before or after the coupling

with the card (see D8, paragraph [0035]).

According to the opponent, the combination of the card (including electronic storage means) and the paper sheet on which it was affixed corresponded to the electronic document of the patent. There was a physical medium (the sheet of paper) and an electronic storage means (the chip of the card) which contained the same identification information. According to the main embodiment of D8, the information was first stored in the storage means, then it was printed on the sheet of paper (physical medium) and then the electronic document was assembled, by gluing the card on the paper sheet (see paragraphs [0025] to [0035]). The skilled person would understand from document D8 that by assembling the electronic document after the information had been printed on the physical medium and stored in the electronic storage means, the identified technical problem would be solved. They would thus adapt the method of D1 accordingly, by inverting the order of the steps of printing/storing the information and assembling the electronic document. The subject-matter of claim 1 as granted was thus obvious in view of a combination of D1 with D8.

- 4.1.6 The board does not find this argument of the opponent convincing.

It is first noted that the proprietor contested the opponent's interpretation regarding the electronic document in D8. For the skilled person it was evident that the electronic document of the patent would correspond to the card of D8, which included a physical medium (the plastic substrate) and electronic storage means (the chip/magnetic stripe). According to the proprietor, the skilled person would never think of the

paper sheet with the card glued on it as an electronic document in the present context.

Leaving aside the question of whether or not the paper sheet carrier with the card affixed on it can be considered an electronic document in the sense of the patent, the board notes that D8 is not concerned with the formulated technical problem. The board has thus doubts whether the skilled person would even consider document D8 at all. Moreover, D8 does not contain any indication that a specific order of the steps of writing the data on the paper carrier and coupling the card with the paper carrier plays any role in the method described therein. On the contrary, the skilled person reading D8 would rather understand that the order of the specific steps is not important and can be implemented either way (see paragraph [0035], cited also above). The board thus takes the view that the skilled person would not consider D8 at all and even if they did, they would find no indication that the order of the execution of the steps of writing on the paper sheet/carrier and affixing the card on it might be relevant for solving any technical problem.

- 4.1.7 Moreover, the board notes that if the opponent's interpretation of electronic document in D8 were to be accepted, the identified problem of avoiding the circulation of assembled electronic documents without any identification information stored on them would not arise. In D8, there is a card, comprising an electronic storage means with information both embossed on the card and stored in the storage means. At no point is there a card without any information in/on it, as the manufacturing of the card is not part of the disclosure of D8. The sheet of paper onto which the card is glued, which according to the opponent corresponded to the

physical medium of the electronic document of the claimed invention, had no information on it in the beginning and then the information read from the card's chip was printed on it. Hence, before writing the information on the paper sheet, there would be a customised card with identification information printed on it and stored in its storage means, glued on an empty sheet of paper. The board considers that even if such an "electronic document", consisting of an empty sheet of paper and a customised card, were to be lost or stolen there would be no risk of producing any counterfeits, since the identification information was already stored in/on the card. The skilled person would thus have no reason to take into consideration D8 at all when faced with the identified technical problem.

- 4.1.8 Similar considerations are valid with regard to D9 which describes a device and a method for combining (affixing, coupling) a smart card with a paper carrier, like the ones described in D8. D9 is concerned with the protection of the data recorded on the card and the matching of the card and the corresponding paper carrier. The card does not contain any user information but only an identification number, which - when read by a reading device - leads to a connection to a database where the user data are stored. At the same time, the information printed on the paper carrier is also read (e.g. by video). The information is sent to a processing device, which compares the information retrieved from a database with the information read from the paper carrier. If they match, then the card is coupled with the paper carrier (see D9, Figure 1).

The board notes that D9 does not describe any writing of data on the card or the paper carrier, as the described method starts with the data already recorded/

written on the respective medium. There is no question in D9 as to whether the coupling of the card with the paper carrier should/could be done before or after the information is written on them. Nor is there any indication that coupling the card with the paper carrier after the data has been written on them solves any particular technical problem. Hence, the board takes the view that the skilled person would not consider D9 when seeking to solve the identified technical problem.

- 4.1.9 Regarding D6, the parties disagreed whether or not D6 disclosed the same order of execution of steps [1.3](d) and [1.3](e) as in claim 1 as granted.

While it was uncontested that in the detailed description of the method in D6, the physical medium and the electronic storage means were assembled before the information was written on them (see e.g. Figures 24 and 29; paragraphs [0267] and [0295]), the parties were of different opinions regarding the embodiment of the system of Figure 1. The opponent made reference to paragraphs [0037] to [0040] and to claims 20 and 22 of D6 and argued that Figure 1 represented an embodiment which was different from the ones of Figures 24 and 29. In this embodiment, the information was first written on the physical medium and the storage means ("recording medium") and then the two were assembled together as an electronic document. According to the opponent, the skilled person seeking to solve the identified technical problem would consider D6 and would recognise in that first embodiment (Figure 1) that first writing the data on the physical medium and the storage means and then assembling the two together would solve it. They would thus combine these two teachings and arrive at the claimed invention in an

obvious manner.

- 4.1.10 The board is not convinced by this argument of the opponent, either. As with D8 and D9, there is no indication in D6 that the order of the steps of writing the data and assembling the electronic document plays any role in solving any technical problem and in particular the one identified above. Hence, the skilled person would have no reason to consider D6 at all.

Moreover, accepting that D6 discloses an embodiment where the steps [1.3](d) and [1.3](e) are carried out in the same order as in claim 1 of the patent, the skilled person reading D6 would be faced with different embodiments specifying different orders of the two steps. In one embodiment (Figure 1) the steps were carried out in the same order as in claim 1, but in other embodiments (Figures 24 and 29) the steps were carried out in inverse order. In the absence of any mention of which order would be preferable or even why the order is not the same in all embodiments, the skilled person would not find any indication in D6 to consider the one and not the other. In the board's opinion, therefore, even if the skilled person had considered D6, they would not have found any reason to conclude that the order of the steps as carried out in the embodiment of Figure 1 was to be preferred to the order in the embodiments of Figures 24 and/or 29.

- 4.1.11 As a final comment, the board notes that D1 does not describe at all the manufacture of the electronic document (the "document blank"). The description in D1 starts with such a document already available and provides details related to the writing of the information on it. In the board's view, therefore, even if the skilled person were to have received from the

teachings of D8, D9 or D6 the incentive to change the order of writing/printing the identification data on the physical medium and the storage means and assembling of the electronic document in D1, they would find no information on how to do it, since D1 does not describe the assembling/manufacturing of the electronic document at all.

The general mention in paragraph [0038] of how such electronic documents may be manufactured is not considered sufficient for the skilled person to modify the method of D1 (see e.g. Figure 5) so that it would comprise a step of assembling the RFID tag and the paper sheet *after* the data were written on them. Such modifications would go beyond what can be considered obvious for the skilled person.

4.1.12 The board's conclusion is thus that the subject-matter of claim 1 is not obvious to the skilled person starting from D1 as closest state of the art.

4.2 Starting from D6

4.2.1 The opponent had not presented any objections of lack of inventive step with D6 as closest state of the art during the first instance opposition procedure. The first time such objections were put forward was in the statement of the grounds of the present appeal.

4.2.2 The proprietor objected to the admission of these objections of the opponent. It argued that such an objection had never been discussed during the opposition procedure, despite the fact that the opponent had used D6 in other objections related to lack of novelty. Moreover, the proprietor pointed out that the opponent had agreed with the opposition

division that D6 was not suitable as closest state of the art (see the middle of page 13 of the reasons for the impugned decision: *"The opponent agreed that D6 cannot be seen as closest prior art since it does not disclose (at least) the simultaneity in step (1.3) (c)"*). The opponent had thus deliberately chosen not to present such an objection for the opposition division to decide upon, despite the fact that it had been given the explicit opportunity to do so. The objection should thus not be admitted into the appeal proceedings because it could and should have been presented during the opposition procedure.

- 4.2.3 The opponent did not present any arguments in relation to the proprietor's argument that it could and should have filed this objection during the first-instance opposition proceedings. Neither did it contest that it had agreed during these proceedings that D6 was not suitable as closest prior art. The opponent mainly argued that this new objection did not constitute any new fact but merely a new argument, which the board had no discretion not to admit into the appeal proceedings.

According to the proprietor, D6 had been discussed in detail during the first-instance opposition proceedings in the context of novelty and the proprietor was thus familiar with its content. The new objection of lack of inventive step starting from D6 did not, therefore, present any new subject-matter that the opponent was not aware of.

Making reference to decisions T 131/01, OJ EPO 2003, 115, (Reason 3.1, fifth paragraph and Reason 3.2, second paragraph) and T 2238/15 (Reason 4, first and second paragraphs), the opponent argued that, since D6 had previously been discussed in relation to

lack of novelty, its objection of lack of inventive step with D6 as closest prior art did not constitute a new ground for opposition nor a new fact, but merely a new argument. The statement of the grounds of appeal was filed before the new version of the Rules of Procedure of the Boards of Appeal (RPBA 2020) entered into force and the admission of this objection had to be judged under the older version, namely Article 12(4) RPBA 2007, which mentioned only facts, evidence and requests, but no arguments, which could have been presented in the first instance proceedings. The objections of lack of inventive step starting from D6 should thus be admitted.

- 4.2.4 According to Article 12(4) RPBA 2007, the Board has the power to hold inadmissible "facts, evidence, or requests" which could have been presented in the first instance proceedings.

Since the opponent did not contest that it could have presented the objection of lack of inventive step with D6 as starting point in the opposition proceedings, the only remaining question is whether these objections are to be considered new facts or new arguments. The board agrees with the opponent that Article 12(4) RPBA 2007 does not relate to arguments.

- 4.2.5 The board also agrees with the opponent that these objections do not constitute a new ground for opposition, since lack of inventive step was raised and substantiated from the beginning of the opposition procedure, albeit with different prior art documents as starting points.

- 4.2.6 In the decision T 131/01 there was question of whether the ground for opposition related to lack of inventive

step had been properly substantiated. The opponent had presented in its notice of opposition a fully substantiated attack in relation to lack of novelty and a simple mention that should the claim be considered novel, then it would not have been inventive based on the same prior art document. In the passages cited by the opponent, the deciding board concluded that *in a case where a patent has been opposed under Article 100(a) EPC on the grounds of lack of novelty having regard to a prior art document and lack of inventive step having regard to the same prior art and the ground of lack of novelty has been substantiated pursuant to Rule 55(c) EPC, a specific substantiation of the ground of lack of inventive step is neither necessary - given that novelty is a prerequisite for determining whether an invention involves an inventive step and such prerequisite is allegedly not satisfied - nor generally possible without contradicting the reasoning presented in support of lack of novelty. In such a case, the objection of lack of inventive step is not a fresh ground for opposition and can consequently be examined in the appeal proceedings without the agreement of the patentee (see also Headnote). The board does not see how this aspect is relevant in the present context, since there has been no question that the ground for opposition related to lack of inventive step had been properly substantiated from the beginning of the opposition procedure.*

In a different passage of the same decision (Reasons 4; not referred to by the opponent), the deciding board concluded that a late-filed objection of lack of inventive step based on a document previously used for an objection of lack of novelty did not constitute a new fact but only a new argument. The deciding board did not provide many details but only stated that "[a]s

is apparent from the minutes of the oral proceedings, no new facts and evidence were submitted. Document DE was cited and analysed in the notice of opposition, so that its content does not constitute new facts" (see last lines in point 4.1 of the Reasons).

The present board notes that in the referred notice of opposition, there is also mention that claim 1 as granted was not inventive in view of document "DE" (see bottom of page 4) and that there were also other objections of lack of inventive step starting from this document against other claims (see e.g. pages 5 to 7).

Hence, it is not correct that no objection of lack of inventive step based on the specific document had been presented during the opposition procedure, contrary to the present case, where it is uncontested that no objection of lack of inventive step starting from D6 was presented during the opposition procedure.

4.2.7 In T 2238/15 there was discussion whether an objection of lack of inventive step starting from a document previously used only in objections related to lack of novelty and which was presented for the first time during the oral proceedings before the opposition division, was indeed late-filed and whether it constituted a new fact or a new argument.

The opponent in that case had argued lack of novelty of granted claim 1 based on document MB3 and lack of inventive step starting from document MB8. After the proprietor had filed an auxiliary request during the written procedure, the opponent presented an objection of lack of inventive step against claim 1 of the auxiliary request starting from MB3 in combination with MB8. During the oral proceedings, the opposition

division considered this objection to be a late-filed fact and did not admit it into the proceedings because it considered that it was not prima facie relevant.

The deciding board first questioned whether this objection should be considered late-filed because it was submitted as a reaction to the proprietor's filing of auxiliary requests only one month before the oral proceedings. In fact, the board considered that it was not late-filed and that the opposition division had committed a substantial procedural violation by not admitting it.

The deciding board then went on to analyse the opponent's arguments regarding the content of MB3 and MB8 with respect to the claimed features considered important in the discussion and concluded that all the relevant aspects of these two documents in relation to the claimed features had been discussed among the parties so that the new objection based on MB3 in combination with MB8 was not to be considered a new fact, but rather a new argument. As Article 114(2) EPC made reference only to late-filed facts and evidence (but not arguments), the opposition division was not correct in not admitting this new argument into the opposition proceedings.

It is noted that T 2238/15 made reference to T 131/01, Reasons 4 as support for its conclusions.

The present board notes that, as in T 131/01, the deciding board in T 2238/15 did not conclude that a new objection based on documents already on file should always be considered a new argument and not a new fact. The deciding board referred to the discussions among the parties in the context of previous objections based

on the same documents and concluded that all the relevant aspects had been discussed so that no new facts were presented. The present board reaches a different conclusion regarding the present case, as it notes that the opponent had always argued that D6 disclosed all the features of claim 1 as granted and no possible combined disclosure of those features in relation to any combination with other teachings had been put forward during the opposition procedure.

- 4.2.8 The board takes the view that the content of the disclosure of D6 (or any prior art document in general) is generally to be considered a fact. D6 as a prior art document constitutes evidence but which parts of D6 disclose which features of claim 1 as granted constitute facts (see e.g. T 1914/12, Reasons 7.1 and in particular 7.1.4, T 603/14, Reasons 7.3, T 482/18, Reasons 1.2.5, also referring to T 1914/12).

The opponent had always argued during the opposition procedure that D6 disclosed all the features of claim 1 of the patent. In appeal, it presented a new objection based on the fact that D6 did not disclose feature [1.3](c). This is a new fact and not merely a new argument. A new argument would relate e.g. to the technical effects provided by this distinguishing feature, whether the skilled person would consider other documents, if it would be obvious to combine them with D6, etc. All these arguments would, however, be based on the new fact regarding the disclosure of D6.

- 4.2.9 Summarising, the board considers that the opponent's objection of lack of inventive step starting from D6 relates to new facts presented for the first time in appeal that could and should have been presented in the first instance opposition proceedings. Exercising the

power under Article 12(4) RPBA 2007, the board does not admit this objection into the appeal proceedings.

4.3 The board's conclusion is hence that the subject-matter of claim 1 as granted is not obvious for the skilled person and therefore the ground for opposition of lack of inventive step does not prejudice the maintenance of the patent as granted (Articles 100(a), 52(1) and 56 EPC).

5. Since none of the grounds for opposition raised by the opponent prejudices the maintenance of the patent as granted, the appeal must fail.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



B. Atienza Vivancos

T. Häusser

Decision electronically authenticated