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**Datasheet for the decision
of 10 May 2022**

Case Number: T 2196/19 - 3.4.02

Application Number: 10761121.2

Publication Number: 2417489

IPC: G02B27/22, B41M3/14, B42D15/00,
G06K5/00, G06K19/00, G07D7/00,
B42D25/00

Language of the proceedings: EN

Title of invention:
METHOD OF MANUFACTURING A SECURITY DOCUMENT OR DEVICE WITH AN
OPTICALLY VARIABLE IMAGE

Patent Proprietor:
Reserve Bank of Australia

Opponent:
Giesecke+Devrient Currency Technology GmbH

Headword:

Relevant legal provisions:
EPC Art. 123(3), 54
RPBA Art. 12(4), 12(2)

Keyword:

Main request - Amendments - broadening of claim (yes)

Main request - Novelty - (no)

Auxiliary requests - Reply to the statement of grounds of appeal - party's complete case (no)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 2196/19 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 10 May 2022

Appellant: Giesecke+Devrient Currency Technology GmbH
(Opponent) Patente und Lizenzen
Prinzregentenstraße 159
81677 München (DE)

Representative: Giesecke + Devrient IP
Prinzregentenstraße 159
81677 München (DE)

Respondent: Reserve Bank of Australia
(Patent Proprietor) 65 Martin Place
Sydney, NSW 2000 (AU)

Representative: Lincoln IP
4 Rubislaw Place
Aberdeen AB10 1XN (GB)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
31 May 2019 concerning maintenance of the
European Patent No. 2417489 in amended form.**

Composition of the Board:

Chairman R. Bekkering
Members: C. Kallinger
T. Karamanli

Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal against the interlocutory decision of the opposition division that the patent as amended according to the then main request met the requirements of the EPC and requested that the decision be set aside and that the patent be revoked in its entirety.
- II. In its reply to the appellant's statement of grounds of appeal, the respondent (patent proprietor) requested as its main request that the appeal be dismissed and that the patent be maintained in amended form according to the main request on which the contested decision is based, i.e. claims 1 to 3 as filed in electronic form on 30 April 2018. As auxiliary requests, the respondent further requested that the decision under appeal be set aside and that the patent be maintained
- according to the First Auxiliary Request filed during the first-instance opposition procedure, i.e. as granted,
 - as amended according to the Second or Third Auxiliary Request filed during the first-instance opposition procedure.
- As a further auxiliary measure, the respondent requested oral proceedings.
- III. A summons to oral proceedings was issued on 28 October 2021. In a communication pursuant to Article 15(1) RPBA 2020 (OJ EPO 2020, Supplementary publication 1, 42), which was attached to the summons, the board set out its preliminary, non-binding views on certain aspects of the case.

IV. With a letter dated 28 April 2022, the respondent withdrew its request for oral proceedings and announced that it would not be represented at the oral proceedings.

V. The oral proceedings appointed for 12 May 2022 were cancelled by the board.

VI. The following documents will be referred to in this decision:

D1 EP 0 118 222 A1

D2 EP 0 171 252 A2

VII. Claim 1 of the main request reads as follows

1. *A method of manufacturing a security document or device (2) including:
providing a substantially transparent material (6) having a first side and a second side;
arranging an ablative layer (8), which is at least partially reflective or opaque, on the second side of the material (6) to be an outermost reflective or opaque layer;
forming an array of microlenses (4) on the first side of the material (6), the array of microlenses (4) arranged to at least partially focus light towards the ablative layer (8); and
exposing the ablative layer (8) to incident laser light (42), resulting in the removal of the ablative layer (8) on the second side of the material (6) in a plurality of areas to create a plurality of patterns (12, 16),
characterised in that
each pattern (12, 16) is viewable only at a particular viewing angle or range of angles to form a*

'flipping image' viewable in transmission from both sides, wherein two said patterns are created and the ablative layer (8) is exposed to the incident laser light (42) through the array of microlenses (4) at equal and opposite angles from an axis perpendicular to the first side of the substantially transparent material (6).

VIII. None of the parties has responded in substance to the board's communication under Article 15(1) RPBA 2020.

Reasons for the Decision

1. Decision in written proceedings

In reply to the summons to oral proceedings and the board's communication under Article 15(1) RPBA 2020, the respondent withdrew its request for oral proceedings and informed the board that it would not be attending any oral proceedings that might be held. Since the appellant requested oral proceedings on an auxiliary basis and the board does not consider holding oral proceedings to be expedient or necessary under Article 116(1) EPC, the oral proceedings were cancelled. As the case at hand is ready for decision, and the requirements of Articles 113(1) and 116(1) EPC are complied with, the board issues the decision in written proceedings pursuant to Article 12(8) RPBA 2020.

2. General references to first-instance opposition proceedings - Article 12 RPBA 2007

In the present case, the appellant's statement of grounds of appeal was filed before the date on which the revised version of the Rules of Procedure of the Boards of Appeal (RPBA 2020) entered into force, i.e. 1 January 2020 (see Article 24(1) RPBA 2020). Thus, in accordance with Article 25(2) RPBA 2020, Article 12(4) to (6) RPBA 2020 does not apply to the statement of grounds of appeal and the reply to it filed in due time. Instead, Article 12(4) of the Rules of Procedure of the Boards of Appeal in the version of 2007 (RPBA 2007 - see OJ EPO 2007, 536) continues to apply.

In their submissions, both the appellant (see e.g. section VII) and the respondent (see pages 1 and 2) referred in general to their submissions made during the opposition proceedings.

However, merely referring generally to submissions made during first-instance opposition proceedings cannot be seen as meeting the requirement of Article 12(2), second sentence, RPBA 2007 (which in its relevant parts corresponds to Article 12(3) RPBA 2020) that the statement of grounds of appeal and the reply have to set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld and should specify expressly all the facts, arguments and evidence relied on.

The board therefore does not take into account, pursuant to Article 12(4) RPBA 2007, the parties' submissions made during the opposition proceedings and referred to only in the appeal proceedings.

As a consequence, this decision considers only the documents expressly referred to, the requests sufficiently substantiated, and the arguments expressly brought forward in the statement setting out the grounds of appeal or the reply thereto.

3. Main request - Amendments - Article 123(3) EPC

3.1 The patent relates to a method for manufacturing a security document or device. Claim 1 of the patent as granted inter alia defined the step of

"arranging an ablative layer (8), which is at least partially reflective or opaque, on the second side of the material (6) to be an outermost reflective opaque layer".

During the first-instance opposition proceedings this feature has been amended as follows (emphasis added by the board):

"arranging an ablative layer (8), which is at least partially reflective or opaque, on the second side of the material (6) to be an outermost reflective or opaque layer".

3.2 The opposition division found that claim 1 as granted defined that the ablative layer was either reflective, opaque or both. As amended claim 1 of the current request was restricted to an ablative layer which was either reflective or opaque, but no longer reflective and opaque, the scope of protection was not extended.

3.3 The appellant argued that the patent as granted was restricted to an ablative outermost layer which was reflective and opaque, whereas the patent in amended form no longer contained this restriction.

3.4 The board agrees with the appellant's interpretation of claim 1 as granted. This claim defines in a first place that the ablative layer is at least partially reflective or opaque. These two properties are not exclusive and according to this expression, the ablative layer is required to possess one of the two. The further requirement that the ablative layer is a "*reflective opaque layer*" restricted the subject-matter of granted claim 1 to ablative layers which are reflective and opaque.

As claim 1 as amended no longer contains this restriction but defines that the ablative outermost layer is reflective or opaque, the scope of protection of the patent is extended. Therefore, the requirements of Article 123(3) EPC are not met.

4. Main request - Novelty - Article 54 EPC

The features of claim 1 of the main request will be referred to as follows:

- 1.1 A method of manufacturing a security document or device (2) including:
- 1.2 providing a substantially transparent material (6) having a first side and a second side;
- 1.3 arranging an ablative layer (8), which is at least partially reflective or opaque, on the second side of the material (6) to be an outermost reflective or opaque layer;
- 1.4 forming an array of microlenses (4) on the first side of the material (6), the array of microlenses (4) arranged to at least partially focus light towards the ablative layer (8); and

- 1.5 exposing the ablative layer (8) to incident laser light (42), resulting in the removal of the ablative layer (8) on the second side of the material (6) in a plurality of areas to create a plurality of patterns (12, 16), characterized in that
- 1.6 each pattern (12, 16) is viewable only at a particular viewing angle or range of angles to form a 'flipping image' viewable in transmission from both sides,
- 1.7 wherein two said patterns are created and
- 1.8 the ablative layer (8) is exposed to the incident laser light (42) through the array of microlenses (4) at equal and opposite angles from an axis perpendicular to the first side of the substantially transparent material (6).

4.1 Document D1

4.1.1 It is undisputed that D1 discloses the method steps defined in features 1.1 to 1.5 and 1.7.

4.1.2 The opposition division concluded that document D1 failed to disclose that

- each pattern is viewable only at a particular viewing angle or range of angles to form a "flipping image" viewable in transmission from the second or opposite side (part of feature 1.6),
- the ablative layer is exposed to the incident laser light through the array of lenses at equal and opposite angles from an axis perpendicular to the first side of the substantially transparent material (feature 1.8).

The opposition division argued in particular that there was no connection between example 3 and Figure 4 of

document D1 and that D1 disclosed a flipping image only after all process steps have been carried out but not at the stage of an intermediate embodiment which corresponded to the claimed embodiment.

4.1.3 With respect to the differentiating features as identified by the opposition division, the board agrees with the appellant's line of argument and is of the following opinion:

(a) Feature 1.8

D1 discloses in the general part of the description (see page 4, lines 7 to 14) that the specular reflective layer is exposed to the incident laser light through the array of microlenses. D1 further discloses an embodiment in which two openings are formed in the reflective layer at equal and opposite angles from an axis perpendicular to the first side of the substantially transparent material (see page 8, line 35 to page 9, line 9 and Figure 4: angles 33 and 34 together with the symmetric placing of openings 31 with respect to individual microlenses). Example 3, which is related to example 1 and has the same basic layered structure as the embodiment shown in Figures 1 and 4, uses explicitly disclosed angles of $\pm 30^\circ$ from an axis perpendicular to the substrate (see page 13, line 29 to page 14, line 6). Therefore, D1 discloses feature 1.8 in conjunction with the other features of claim 1.

(b) Feature 1.6

Feature 1.6 relates to the appearance of the manufactured security device rather than to the steps of its manufacture. As discussed above, D1 (see in particular page 3, lines 1 to 21) discloses all the

manufacturing steps as claimed. The board is of the opinion that the security device resulting from the manufacturing process disclosed in D1 necessarily must have the same properties as defined in feature 1.6 of claim 1.

This is in particular the case for the intermediate security device described in Example 3 in which the specular reflective layer is the outermost layer as required by feature 1.3 (see page 11, lines 11 to 19 and page 13, lines 30 to 32: as no adhesive layer is present). In this embodiment, the pattern is viewable only at a particular viewing angle to form a "flipping image" viewable in transmission from one side, namely the side of the microlenses (see page 14, lines 6 to 10). As the manufacturing steps for this device are identical to the claimed steps, the board is of the opinion that also in the security device of Example 3 of D1 the "flipping image" is necessarily also viewable from the other side and that therefore feature 1.6 is disclosed in D1.

The board is therefore of the opinion that D1 discloses feature 1.6 of claim 1, in particular also in connection with the requirement of feature 1.3, i.e. that the reflective layer is the outermost layer.

- 4.1.4 In conclusion, the board is convinced by the appellant's arguments and is therefore of the opinion that the subject-matter of claim 1 lacks novelty with respect to the disclosure of document D1.

4.2 Document D2

4.2.1 It is undisputed that D2 discloses the method steps defined in features 1.1, 1.2, 1.4, 1.5 and 1.7.

4.2.2 The opposition division concluded that document D2 failed to disclose that

- each pattern is viewable only at a particular viewing angle or range of angles to form a "flipping image" viewable in transmission from the second or opposite side (part of feature 1.6),
- the ablative layer is exposed to the incident laser light through the array of lenses at equal and opposite angles from an axis perpendicular to the first side of the substantially transparent material (feature 1.8),
- the ablative layer is the outermost reflective layer (part of feature 1.3).

The opposition division argued in particular that even in the intermediate product of D2, in which the reflective layer was the outermost layer, the "flipping image" was not viewable from the side of the reflective layer.

4.2.3 With respect to the differentiating features as identified by the opposition division, the board is of the following opinion:

(a) Feature 1.3

The board agrees with the appellant's line of argument that, with the completion of manufacturing step (1) (see page 3, line 17 to page 4, line 7), a security device as claimed is realized. Such a security device is shown in Figure 1 of D2, which illustrates a

"transparent authentication sheet of the invention" (see page 8, lines 1 to 5). In this device, the reflective layer is the outermost layer. Therefore, feature 1.3 is disclosed in D2.

(b) Feature 1.8

The board also agrees with the appellant's line of argument that D2 discloses that the ablative layer is exposed to the incident laser light through the array of lenses (see Figure 1, page 4, lines 3 to 7 and page 8, line 37 to page 9, line 4) at equal and opposite angles from an axis perpendicular to the first side of the substantially transparent material (see page 5, lines 13 to 18 and Example 2 on page 11, lines 11 to 14). Therefore, feature 1.8 is disclosed in D2.

(c) Feature 1.6

It is undisputed that D2 (see Example 2, page 11 and page 5, lines 13 to 18) discloses that each pattern is viewable only at a particular viewing angle or range of angles to form a "flipping image" viewable in transmission from one side, namely the side of the microlenses.

As already discussed above with respect to document D1 (see point 3.1), feature 1.6 relates to the appearance of the manufactured security device rather than to the steps of its manufacture. D2 discloses for the manufacturing of the security device the same process steps as claim 1. Therefore, the resulting security device necessarily must also have the same properties as defined in feature 1.6 of claim 1. The board cannot see any step in the claimed method which could justify a difference in the appearance of the resulting

security device. Therefore, feature 1.6 is also disclosed in D2.

- 4.2.4 In conclusion, the board is convinced by the appellant's arguments and is therefore of the opinion that the subject-matter of claim 1 lacks novelty with respect to the disclosure of document D2.

5. Auxiliary Requests

The respondent had filed the First, Second and Third Auxiliary Requests during the first-instance opposition proceedings and upheld them in the appeal proceedings. As indicated above (see point 1), the respondent referred only in general to its submissions made during the opposition proceedings with regard to these requests.

In view of the above, the board is of the opinion that the First, Second and Third Auxiliary Request have not been properly substantiated in the reply to the statement setting out the grounds of appeal, contrary to the requirements of Article 12(2) RPBA 2007. As a consequence, the board does not take into account the First, Second and Third Auxiliary Requests according to Article 12(4) RPBA 2007 (see also Case Law of the Boards of Appeal, 9th edition 2019, V.A.4.12.5).

6. Since none of the respondent's requests is allowable, the patent must be revoked (Article 101(2) and (3) EPC).

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:



H. Jenney

R. Bekkering

Decision electronically authenticated