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**Datasheet for the decision
of 16 July 2024**

Case Number: T 0704/20 - 3.4.03

Application Number: 14753322.8

Publication Number: 3038839

IPC: B42D15/00

Language of the proceedings: EN

Title of invention:

IDENTIFICATION ASSEMBLY FOR AN IDENTITY DOCUMENT

Patent Proprietor:

Morpho B.V.

Opponent:

Bundesdruckerei GmbH

Relevant legal provisions:

EPC Art. 52(1), 56, 100(a)
EPC R. 139

Keyword:

Inventive step - (no) - obvious combination of known features

Decisions cited:

G 0003/89



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Case Number: T 0704/20 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 16 July 2024

Appellant: Bundesdruckerei GmbH
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 9 January 2020
rejecting the opposition filed against European
patent No. 3 038 839 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman T. Häusser
Members: J. Thomas
T. Bokor

Summary of Facts and Submissions

- I. The appellant-opponent (hereinafter "the appellant") appealed against the decision of the opposition division to reject the opposition against European patent No. 3 038 839.
- II. The opposition had been filed against the patent as a whole based on the grounds for opposition under Article 100(a) and (b) EPC.
- III. The appellant requested that the decision under appeal be set aside and that the patent be revoked in its entirety. It further requested oral proceedings.
- IV. The respondent (patent proprietor) requested that the appeal be dismissed and that the patent be maintained as granted. It further requested, as a first auxiliary request, that the correction of an obvious error in claim 14 be allowed and, as a second auxiliary request, that the patent be maintained based on a set of claims identical to the granted claims except for claims 14 to 16, which were to be deleted. The respondent also requested oral proceedings as an auxiliary measure.
- V. The board summoned to oral proceedings and issued a communication under Article 15(1) RPBA expressing its preliminary opinion that the opponent's appeal was likely to succeed.
- VI. With letter of 29 February 2024, the respondent informed the board that it would not be represented at the oral proceedings. Thereafter the board cancelled the oral proceedings.

VII. The following documents are referred to in this decision:

E1: WO 2015/030575 A1 (the international application corresponding to the impugned patent)

E2: FR 2 918 311 A1

E3: GB 2 376 209 A

VIII. Claim 1 of the main request reads as follows (labelling in bold added by the board):

*"**F1** An identification assembly for an identity document (10), the assembly comprising*

***F2.1** a substrate (12) with a substantially planar configuration, and*

***F2.2** an adjacent surface (13, 14) hingeably attached to the substrate (12) and provided adjacent to the substrate (12),*

***F3.1** wherein the substrate (12) comprises at least two image areas (18, 20),*

***F3.2** the first image area (18) having a first image (19),*

***F3.3** the second image area (20) comprising a second laser produced image (21), and*

***F3.4** a third image (22) corresponding to the second image (21) is provided onto the adjacent surface (13, 14),*

***F3.5** the third image (22) being visible for a user by hinging the substrate away from the adjacent surface (14),*

***F3.6** and wherein the second image area (20) is transparent, characterised in that*

***F4** the third image is provided through the second image area onto the adjacent surface and*

***F5** in that the first image area is opaque."*

IX. Claim 14 of the main request reads as follows
(labelling in bold added by the board):

*"**M1** A method for producing an identification assembly of any of the preceding claims, wherein the method comprises the following steps:*

***M2** - providing a substrate (12) comprising at least two image areas (18, 20),*

***M3** - providing an adjacent surface (13, 14) to said substrate (12),*

***M4** - attaching the substrate (12) to the adjacent surface (13, 14) in a hinging manner,*

***M5** - laser producing a first image (19) in a first image area (18) without laser energy being transferred to the adjacent surface (13, 14),*

***M6** - laser producing a second image (21) onto a second image area (20) while allowing part of the laser energy to penetrate through the substrate (12) and to form an image (22) in the adjacent surface (13, 14),*

***M7** being the second image area (20) opaque and the second image area (20) transparent."*

X. Claim 14 of the first auxiliary request is amended as follows compared to claim 14 of the main request (underlined features are added, struck out features are deleted):

*"**M6** - laser producing a second image (21) onto a second image area (20) while allowing part of the laser energy to penetrate through the substrate (12) and to form an image (22) in the adjacent surface (13, 14),*

***M7** being the ~~second~~ first image area (~~20~~, 18) being opaque and the second image area (20) being transparent"*

XI. The second auxiliary request was amended compared to the main request as follows:

- claims 1 to 13 remained unchanged,
- claims 14 to 16 were deleted.

Hence, this request has only one independent claim, which is identical to claim 1 of the main request.

XII. The appellant's arguments relevant for the present decision are summarised as follows:

Main request: The subject-matter of claim 1 did not involve an inventive step, because it was rendered obvious when combining the prior art as disclosed in the patent itself (presented as prior art in document E1) in combination with the teaching of document E3.

First auxiliary request: The appellant did not make further submissions following the respondent's reply to the grounds of appeal. However, already in the grounds of appeal they argued (within the framework of their arguments on insufficiency, Article 83 EPC, in respect of the main request) that an expected correction of an error in claim 14 under Rule 139 EPC was not possible following G 3/89.

Another possible amendment to partially opaque and partially transparent image areas, in order to eliminate the error, would constitute an unallowable amendment (Article 123(2) EPC) which in its view was not originally disclosed. Deleting the erroneous feature by replacing it with another feature was also not possible (Article 123(3) EPC).

Second auxiliary request: The appellant did not expressly argue in respect of this request, as no

submissions were made subsequent to the statement setting out the grounds of appeal.

XIII. The respondent's arguments relevant for the present decision are summarised as follows:

Main request: The subject-matter of claim 1 involved an inventive step because it was not obvious to combine the closest prior art, i.e. the Swedish passport discussed in the patent itself, with the teaching of document E3. This document did not deal with security documents and was from a remote technical field so that the skilled person would not consider its teaching.

First auxiliary request: The error in claim 14 was evident and a correction of the error should therefore be allowed under Rule 139 EPC.

Second auxiliary request: The same arguments as for the main request applied, since claim 1 was not amended.

Reasons for the Decision

1. Procedural matters

1.1 In response to the board's communication under Article 15(1) RPBA the respondent informed the board that no one would attend the oral proceedings in order to represent the respondent.

1.2 The Boards of Appeal usually interpret a declaration of no representation of a party at the oral proceedings as a withdrawal of the request for oral proceedings (*Case Law of the Boards of Appeal of the EPO*, 10th Edition, 2022, III.C.4.3.2). This is also considered to be applicable in the case at hand. Therefore, the board

considers that the respondent's original auxiliary request for oral proceedings is no longer maintained.

1.3 In its communication under Article 15(1) RPBA, the board indicated its preliminary opinion that the board was minded to consider the appeal allowable (see points 9.4.3, 10.4, and 11.2 of the communication).

1.4 Therefore, the board considers the case to be ready for a final decision, since it was minded to decide in favour of the only party requesting oral proceedings as an auxiliary measure. Under these circumstances the board decided to cancel the summoned oral proceedings and to issue the present decision in writing according to Article 12(8) RPBA.

2. Main request - inventive step

2.1 Closest prior art

The appellant and the respondent considered the prior art mentioned in the introductory part of the patent itself (see paragraph [0004]), i.e. the prior art which had already been mentioned in the international patent application E1 corresponding to the patent, as an appropriate starting point for the assessment of inventive step. The board agrees.

In the patent, paragraph [0004], corresponding to page 1, line 27 to page 2, line 4 of document E1, the Swedish passport is discussed as prior art. As indicated in these passages it exhibits all features defined in the preamble of claim 1. This was not disputed by the parties. The board also agrees with this analysis.

2.2 Differentiating features

Therefore, the subject-matter defined in claim 1 of the main request differs from the Swedish passport by

- the third image being provided through the second image area onto the adjacent surface and
- the first image area being opaque.

This was not disputed by the parties, either, and the board also agrees.

2.3 Technical effect - objective technical problem to be solved

These differentiating features solve the following technical problem: Increasing the security of the identity document against counterfeiting by rendering the replacement of one of the two consecutive principal pages of the document difficult and by rendering the verification of the authenticity of these two pages easy. The verification of the two document pages is thus simple but secure. The second and third images are exactly superimposed due to the way how they were manufactured. The combined second and third image can then be easily compared to a first image visible only on the first page near the combined image due to its opaqueness.

2.4 Obviousness

The respondent was of the opinion that the skilled person when looking for a solution to the above mentioned problem and starting from the Swedish passport would not combine the teaching of the Swedish passport with the teaching of document E3, contrary to the appellant's opinion. In the respondent's view, document E3 was from a technical field remote from the

field of the security of identity documents, so that the skilled person would not consider document E3 when looking for the solution of the above problem and starting from the disclosure of the Swedish passport.

The board is however of the opinion that, in order to solve the problem mentioned above, the person skilled in the art would be looking for an instruction on how to mark two consecutive pages such that they are difficult to counterfeit. The problem to be solved therefore concerns instructions on how to mark two separate but related pages as belonging together, which simply concern two separate parts, here the pages, of a device, here the identity document. The skilled person would thus be looking for any information relating to the marking of separate parts belonging to the same device. This topic is dealt with and shown in document E3, where two parts are provided with the same numbers by producing these numbers in both separate parts (the bush and the sleeve) in a single production step (laser marking in a single step) so that the fact that they belong together can be controlled when superposing these numbers. In addition, document E3 also discloses the idea that the provision of the same number on the pin and the bush ensures that both units belong together (the number of the sleeve being exactly superposed on the number on the bush). The person skilled in the art would also understand from document E3 that the correctly superimposed images of the second and third image areas (on the bush and the sleeve) are reproduced a second time on the first opaque image area (on the pin) for easy comparison. Therefore, the idea of the security markings as shown in document E3 may be exactly transferred to the two pages of the Swedish passport, thereby arriving at the subject-matter of claim 1 as granted.

The board does not share the respondent's opinion that document E3 is not combinable with the closest prior art due to the allegedly remote technical field of document E3. As the appellant has pointed out (see grounds of appeal, point VIII.A.1.5, last paragraph), document E3 relates to "*security markings*" in general "*so that their source may be verified*" (document E3, page 1, lines 3 to 5). Document E3 is not limited to the specific embodiment of a security bolt comprising a pin and a bush but is directed to a particular marking technique. Therefore, the skilled person is taught in document E3 the information on the specific laser marking of two separate but related units of the device, in particular the pin on the one hand and the bush and sleeve on the other hand. This may be directly applied to the combination of different image areas on two consecutive pages in the security document of the closest state of the art. In both assemblies the superposed images can be produced by a single manufacturing step, providing markings on the two units which are absolutely identical. Taking only this information from document E3 and applying it to the corresponding second and third image areas known from the Swedish passport, the device as defined in claim 1 is directly obtained.

The board agrees that in document E3 the rotatable sleeve with the bush has no reference point for automatically superposing the two identical markings on the bush and the sleeve once they are realised. This is however of no relevance because the automatic superposition derives from the features already known and present in the closest prior art in which the two consecutive pages are already pivotably arranged due to the binding of the pages in book form.

It is this arrangement of the two consecutive pages by pivotably connecting them which allows for the exact superposition.

The board sees no reasons why the lens function is relevant or important when considering and implementing the teaching of document E3 in the Swedish passport, either. Whether or not the function of the lens is preserved seems irrelevant to the discussion at hand.

Therefore, the board concludes that the skilled person would consider document E3 as it relates to "*security markings*". The skilled person would realise that the teaching of document E3 implemented in the Swedish passport allows to solve the above mentioned problem easily and obviously.

2.5 Hence, the subject-matter defined in claim 1 as granted lacks an inventive step (Article 100(a) EPC in combination with Articles 52(1) and 56 EPC) when starting from the Swedish passport discussed as prior art in the impugned patent and document E1 and combining it with the teaching of document E3.

3. First and second auxiliary requests

3.1 The sets of claims of the first and second auxiliary requests have been amended compared to the one of the main request by correcting an allegedly obvious error in claim 14 (first auxiliary request) and by deleting the method claims 14 to 16 (second auxiliary request).

3.2 Respective claim 1 of the first and second auxiliary requests is consequently identical to claim 1 of the main request which the board found to lack inventive

step. Therefore, the outcome with regard to claim 1 of the main request applies *mutatis mutandis* to respective claim 1 of the first and second auxiliary requests, which consequently do not fulfil the requirements of Articles 52(1) and 56 EPC, either.

4. Since respective claim 1 of the main request and the first and second auxiliary requests lacks inventive step (Article 52 and 56 EPC), none of the requests is allowable. Consequently, the patent must be revoked.

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:



S. Sánchez Chiquero

T. Häusser

Decision electronically authenticated