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**Datasheet for the decision
of 19 September 2024**

Case Number: T 1757/22 - 3.4.02

Application Number: 16859840.7

Publication Number: 3370095

IPC: G02B5/18, B42D25/328,
B42D25/40, G03H1/02, G09F3/02,
B42D25/351

Language of the proceedings: EN

Title of invention:
DISPLAY BODY

Patent Proprietor:
Toppan Printing Co., Ltd.

Opponent:
Giesecke+Devrient Currency Technology GmbH

Relevant legal provisions:
EPC Art. 54(1), 100(a), 100(b), 111(1)
RPBA 2020 Art. 11, 12(2), 12(4)

Keyword:
Sufficiency of disclosure (yes)
Novelty (main request: no)
Remittal for further prosecution (yes)

Decisions cited:

T 0439/22



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Case Number: T 1757/22 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 19 September 2024

Appellant: Giesecke+Devrient Currency Technology GmbH
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 19 May 2022
rejecting the opposition filed against European
patent No. 3370095 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman R. Bekkering
Members: F. J. Narganes-Quijano
B. Müller

Summary of Facts and Submissions

- I. The opponent (appellant) lodged an appeal against the decision of the opposition division rejecting the opposition filed against European patent No. 3370095.

The opposition filed by the appellant against the patent as a whole was based on the grounds for opposition of insufficiency of disclosure (Article 100 (b) EPC) and of lack of novelty and of inventive step (Article 100 (a) together with Articles 52 (1), 54 (1) and 56 EPC).

- II. During the appeal proceedings the parties referred *inter alia* to the following document already considered during the first-instance proceedings:

D1: EP 2 790 042 A1.

In the decision under appeal the opposition division found that none of the grounds for opposition under Articles 100 (a) and (b) EPC prejudiced the maintenance of the patent as granted. In particular, the opposition division held in respect of the claims as granted that the claimed invention was sufficiently disclosed in the patent specification and that the subject-matter of independent claims 1 and 15 was new over document D1 and involved an inventive step, in particular over document D1.

- III. In a communication pursuant to Article 15 (1) RPBA annexed to summons to oral proceedings the board gave a preliminary assessment of the case.

IV. By letter dated 13 August 2024 the respondent submitted claims according to auxiliary request 1A and the following documents:

X1: "Concise Oxford English Dictionary", 12th edition 2011, Oxford University Press; two bibliographic pages and pages 628, 629, 1236 and 1237

X2: Extract from *en.wikipedia.org*, entry "Groove", one page.

V. By letter dated 19 August the appellant submitted the following documents:

X3: Extract from *spektrum.de*, entry "Kreuzgitter", Lexika, Lexikon der Optik; two pages

X4: Extract from *spektrum.de*, entry "Kreuzgitter", Lexika, Lexikon der Physik; two pages.

VI. Oral proceedings were held on 19 September 2024.

The appellant requested that the decision under appeal be set aside and the patent be revoked.

The respondent requested that the appeal be dismissed (main request) or that the decision under appeal be set aside and the patent be maintained in amended form on the basis of the claims of

- auxiliary request 1 filed with a letter of 14 October 2020 or

- auxiliary request 1A filed with a letter of 13 August 2024 or

- auxiliary request 2 filed with a letter of 14 October 2020.

At the end of the oral proceedings the chairman announced the decision of the board.

VII. Claim 1 as granted (main request) reads - with the feature labelling "M1" to "M1.5" in square brackets used during the proceedings being inserted therein by the board - as follows:

"[M1] A display member (10) comprising:

[M1.1] a light transmission layer (11) which has a principal surface on which a plurality of pixels (PX) are two-dimensionally arranged; and

[M1.2] a metal layer (12) which partially covers the principal surface,

[M1.3] each of the plurality of pixels (PX) including one or more selected from the group consisting of:

[M1.3.1] a first region (R1) which has a plurality of first grooves (G1) or ridges each of which extends in a longitudinal direction in a first angle range of -10° to $+10^{\circ}$ with respect to a first direction (D1) which is parallel to the principal surface;

[M1.3.2] a second region (R2) which has a plurality of second grooves (G2) or ridges each of which extends in a longitudinal direction in a second angle range of -65° to $+65^{\circ}$ with respect to a second direction (D2) which is parallel to the principal surface and is perpendicular to the first direction (D1), the plurality of second grooves (G2) or ridges forming a diffraction structure on an interface between the light transmission layer (11) and the metal layer (12) or on a surface of the metal layer (12);

[M1.3.3] a third region (R3) which is flat; and

[M1.3.4] a fourth region (R4) which has a plurality of third grooves (G3) or ridges each of

which extends in a longitudinal direction in the second angle range, the plurality of third grooves (G3) or ridges forming an anisotropic light-scattering structure on the interface between the light transmission layer (11) and the metal layer (12) or on the surface of the metal layer (12),

[M1.4.1] one or more of the plurality of pixels (PX) including the first region (R1),

[M1.4.2] one or more of the plurality of pixels (PX) including the second region (R2),

[M1.2.1] the metal layer (12) not covering at least part of the first region (R1) and covering the second region (R2), and also covering the third region (R3) and the fourth region (R4) when the third region (R3) and the fourth region (R4) are present,

[M1.5] the display member (10) being configured to display a first image corresponding to a distribution of the first region when the display member (10) is illuminated with white light and transmitted light is observed and display a second image when the display member is illuminated with white light and diffracted light which exits the diffraction structure is observed."

The patent as granted also includes claims 13 and 14 respectively directed to a transfer foil and to a labelled article comprising the display member defined in claim 1, and a method claim 15 reading as follows:

"A method for producing a display member (10), the method comprising the steps of:

preparing a light transmission layer which has a principal surface on which a plurality of pixels (PX) are two-dimensionally arranged, each of the plurality of pixels (PX) including one or more selected from the group consisting of:

a first region (R1) which has a plurality of first grooves (G1) or ridges each of which extends in a longitudinal direction in a first angle range of -10° to $+10^{\circ}$ with respect to a first direction (D1) which is parallel to the principal surface;

a second region (R2) which has a plurality of second grooves (G2) or ridges each of which extends in a longitudinal direction in a second angle range of -65° to $+65^{\circ}$ with respect to a second direction (D2) which is parallel to the principal surface and is perpendicular to the first direction (D1), the plurality of second grooves or ridges being arranged to form a diffraction structure;

a third region (R3) which is flat; and

a fourth region (R4) which has a plurality of third grooves (G3) or ridges each of which extends in a longitudinal direction in the second angle range, the plurality of third grooves (G3) or ridges being arranged to form an anisotropic light-scattering structure,

one or more of the plurality of pixels (PX) including the first region (R1), one or more of the plurality of pixels (PX) including the second region (R2);

forming a first layer as a metal layer (12) on the principal surface;

forming a second layer by depositing a material which is different from a material of the first layer on the first layer by a vapor phase deposition method while conveying the light transmission layer in the first direction (D1), permeability to an etching agent in a position of the first region (R1) being higher than permeability to the etching agent in the second to fourth regions (R2, R3, R4); and

selectively removing at least part of a portion of a lamination structure which is composed of the first layer and the second layer, by bringing the etching

agent into contact with the second layer, the portion being located on the first region."

Claim 1 of auxiliary request 1 differs from claim 1 as granted in that feature M1.3.1 further reads as follows:

", and which has no grooves or ridges which extend in a longitudinal direction outside the first angle range".

The corresponding feature of independent claim 15 of auxiliary request 1 was also amended as indicated in respect of claim 1.

Reasons for the Decision

1. The appeal is admissible.
2. *Patent as granted (main request) - Claims 1 and 13 to 15 - Sufficiency of disclosure (Article 100 (b) EPC)*

The appellant contested the opposition division's view that the ground for opposition under Article 100 (b) EPC did not prejudice the maintenance of the patent as granted and also submitted that the opposition division omitted consideration of one of three objections raised under Article 100 (b) EPC during the first-instance proceedings.

- 2.1 According to a first objection raised by the appellant, the method of manufacture disclosed in the patent specification (paragraphs [0015] to [0025]) would not

enable the skilled person to manufacture the display member of granted claim 1 satisfying feature M1.2.1 in the whole range of angles defined in the claimed features M1.3.1 and M1.3.2. In particular, the range of angles defined in claim 1 was such that the longitudinal directions of the first and the second grooves could form a relatively small angle of +/- 10° with the conveying direction considered in the method of manufacture, and in these circumstances no difference in the degree of porosity required by the mentioned method could be achieved. This objection also applied to the transfer foil and to the labelled articles respectively defined in claims 13 and 14 as granted.

- 2.1.1 The board first notes that it follows from features M1.3.1 and M1.3.2 of claim 1 that the value of the (non-obtuse) angle between the first longitudinal direction along which the grooves or ridges of the first region extends and the second longitudinal direction along which the grooves or ridges of the second region extends is between a maximum value of 90° and - as submitted by the respondent - a minimum value of 15°. In the specific case in which the angle has the extreme value of 15°, it is possible to select during the manufacture of the display member according to the method disclosed in paragraphs [0015] to [0025] of the patent specification a conveying direction forming, as submitted by the appellant, an angle within the range of +/- 10° to each of the first and the second longitudinal directions. In addition, this specific conveying direction is such that it would not be possible to form the second layer (for instance, of silicon oxide, see paragraph [0019]) on the first metal layer (see paragraph [0012]) by oblique vapor deposition (paragraphs [0018] and [0019]) with a

different porosity on the first and second regions as required by the mentioned method (paragraphs [0023] and [0024]) and, consequently, it would not be possible to subsequently carry out the selective etching of the first metal layer underlying the second layer (paragraphs [0018] and [0025]) required by the method and resulting in the metal layer not covering at least a part of the first region and covering the second layer as required by the claimed feature M1.2.1 (paragraph [0016]).

However, the description discloses that

- the degree of porosity of the second layer formed on the first region and the degree of non-porosity of the second layer formed on the second region directly depend, respectively, on the degree of parallelism (see "almost parallel" in paragraph [0024]) of the grooves of the first region and on the degree of non-parallelism (see "intersect at a large angle" in paragraph [0023]) of the grooves of the second region with the conveying direction to be used during manufacture, and

- the degree of porosity and of non-porosity of the first and the second regions determines the degree of selective etching of the metal layer in the regions (paragraph [0025]; see also Fig. 5A to 5E, together with the corresponding description in paragraphs [0141] to [0147]), and therefore it determines the degree to which the respective regions of the display member are covered by the metal layer.

In addition, claim 1 requires that the metal layer does not cover at least in part the first region and covers the second region (feature M1.2.1), thus requiring that, while the selective (non-etching and etching) mechanism of the metal layer underlying the aforementioned method is to be performed with a

relatively high non-etching efficiency for the second region, it is not required to be conducted with a high etching efficiency for the first region.

In view of these considerations and the degrees of tolerance implied by them, the skilled person would understand that in the case in which the angle between the first and the second longitudinal directions is only of 15° the conveying direction would have to be selected as being coincident with the first longitudinal direction or possibly as forming a relatively small angle with this direction in the sense opposite to the second longitudinal direction so that the conveying direction is at an angle equal to 15° or sufficiently greater than 15° with respect to the second longitudinal direction to ensure that, as required by the disclosed method, the second longitudinal direction "intersect[s] at a large angle with [the] conveying direction" for obtaining a non-porous layer in the second region (paragraph [0023]), while the first longitudinal direction is still "almost parallel to the conveying direction" for obtaining a substantially porous layer in the first region (paragraph [0024]) such that the metal layer is subsequently etched from at least a part of the first region but substantially not etched in the second region (feature M1.2.1).

In addition, in the specific case in which the angle between the first and the second longitudinal directions has the extreme value of 90° (see for instance the embodiments of Fig. 1 to 3, together with Fig. 5A to 5E, and Fig. 12 together with Fig. 15A to 15D), it would be sufficient to select the conveying direction - as disclosed in paragraphs [0131], [0144] and [0167] - as being parallel to the first

longitudinal direction - and therefore orthogonal to the second longitudinal direction - to carry out the method disclosed in the description with high efficiency on both the first and the second regions and to obtain a display member satisfying feature M1.2.1.

Therefore, in the board's view the description of the patent specification contains sufficient information and guidance to enable the skilled person to select the different parameters (in particular, the conveyance direction) used in the method of manufacture so as to result in the display member defined in claim 1, and in particular in a display member satisfying the combination of features M1.3.1, M1.3.2 and M1.2.1. In any case, there is no technical evidence in support of the appellant's submission that the mentioned claimed combination of features would not be reproducible following the disclosed method when the angle between the first and the second longitudinal directions would be relatively small, and in particular of the order of 15°, and the appellant's submissions are not sufficient to shift the burden of proof on the respondent.

- 2.1.2 The same considerations apply to the transfer foil and to the labelled article respectively defined in claims 13 and 14 and each comprising the display member of claim 1.
- 2.1.3 Therefore, in the board's opinion the appellant's submissions in respect of this first objection do not call into question the sufficiency of disclosure of the invention defined in claims 1, 13 and 14.
- 2.2 According to a second objection raised by the appellant, claims 1, 13, 14 and 15 left open the material for the second layer and therefore also the

material for the etching agent, and the patent specification disclosed only one example of material (silicon oxide) for the second layer and examples of etching agents for this material. Sufficiency of disclosure for other materials, in particular for materials that did not grow in a columnar shape, could not be derived from the patent specification.

2.2.1 Independent claim 15 defines a method of manufacture resulting in a display member as that defined in claim 1, and claims 13 and 14 are respectively directed to a transfer foil and to a labelled article comprising the display member of claim 1. The appellant's arguments are only directed to the method of manufacture as such and, therefore, it is sufficient to consider the appellant's objection in respect of the method defined in independent claim 15.

2.2.2 As submitted by the respondent, according to the established case law an invention is in principle sufficiently disclosed if at least one way is clearly indicated enabling the skilled person to carry out the invention ("Case Law of the Boards of Appeal", EPO, 10th edition 2022, section II.C.5.2). It is undisputed by the appellant that the patent specification already discloses one way enabling the skilled person to carry out the method defined in independent claim 15, the mentioned way involving the use of silicon dioxide growing to form columns for the formation of the second layer (paragraphs [0144] and [0167], together with paragraph [0019]) and the use of one among a plurality of appropriate etching agents (paragraphs [0107], [0108] and [0200]). Therefore, the patent specification discloses at least one way enabling the skilled person to carry out the claimed method.

In addition, the method defined in independent claim 15 is not restricted to the second layer being made of a material which grows to form columns when deposited by vapor phase deposition, and the same applies to the description which discloses in the context of the formation of a layer having different degrees of permeability to an etching agent as required by independent claim 15 (see paragraph [0018]) that "[o]blique vapor deposition is used for forming an oriented film of a liquid crystal" (paragraph [0019], first sentence), the use of a material growing to form columns being subsequently disclosed only as an example (see paragraph [0019], second sentence). In this context, the skilled person is informed that other materials, in particular materials used for forming oriented films of a liquid crystal, can also be used for carrying out the method of independent claim 15, without the materials growing necessarily to form columns as disclosed in the case of silicon oxide.

2.2.3 Therefore, the patent discloses more than one way of carrying out the claimed method - and therefore also of manufacturing the devices defined in claims 1, 13 and 14 - and, for this reason, the appellant's objection is not convincing. In any case, and as submitted by the respondent, the appellant's submissions are insufficient to justify shifting the burden of proof on the respondent.

2.3 The appellant submitted as a third objection that, on the one hand, the method of independent claim 15 was based on vapor phase deposition which was identified as vacuum deposition in paragraph [0199] of the description of the patent in suit and that, on the other hand, the method disclosed in the description involved laminar and turbulent flows. However, in

vacuum there were no such laminar and turbulent flows. Therefore, there was a contradiction in the disclosure of the method, and there was no information in the patent specification as to how the turbulent flow could be reached. In addition, this contradiction was raised during the first-instance oral proceedings and it was not dealt with by the opposition division in the decision under appeal.

The respondent submitted that this objection was neither submitted in writing during the first-instance proceedings nor shown in the minutes of the first-instance oral proceedings. In addition, no request for correction of the minutes had been filed by the appellant. Therefore, this objection was raised for the first time in the statement of grounds of appeal and it should not be admitted into the appeal proceedings pursuant to Article 12 (4) RPBA.

- 2.3.1 The board notes that the mentioned objection was - contrary to the appellant's submissions - at least implicitly addressed in the decision under appeal in the reasoning given by the opposition division in support of its view on the issue of sufficiency of disclosure and according to which "The argument about a vapor phase deposition method [...] being exclusively functioning in a vacuum atmosphere is not supported by any proof." (reasons, point 2.2.3, second sentence). At least for this reason the appellant's submissions in this respect are - contrary to the respondent's contention - to be considered in appeal pursuant to Article 12 (4), together with Article 12 (2) RPBA, either as an objection already raised during the first-instance oral proceedings - a fact that was not disputed by the respondent - and subsequently dealt with in the decision under appeal or, in any case, at

least as a counter-argument submitted by the appellant in response to the reasons given by the opposition division in point 2.2.3 of the reasons of the decision under appeal.

2.3.2 In addition, the board is not convinced by the appellant's objection. The contradiction alleged by the appellant and based on the use of vacuum deposition in a specific example of the patent specification (Example 1, paragraph [0199]) would, at the most, amount to an objection that independent claim 15 is not supported by the description within the meaning of Article 84 EPC, which does not constitute a ground for opposition under Article 100 EPC. In any case, in the board's opinion the contradiction submitted by the appellant is not persuasive. The board notes in this respect that the appellant mentions laminar flows, but that the description of the patent in suit is silent as to the formation of laminar flows, at least of laminar flows within the strict meaning of the term. Furthermore, as submitted by the respondent, the characterization "vacuum" refers to vacuum deposition performed at a very low air pressure and, in addition, there is vapor of the material to be deposited present in the chamber. The board also notes that, in any case, the formation of the second layer in the specific example of paragraph [0199] is carried out in vacuum, but in other examples of the description deposition in vacuum is only disclosed as being preferred when forming the second layer by vapor phase deposition (paragraphs [0144] and [0167]).

2.3.3 For these reasons, the appellant's submissions relating to a contradiction in the disclosure of the method that would prejudice sufficiency of disclosure are not convincing.

2.4 In view of the above considerations, the board concludes that the ground for opposition of insufficiency of disclosure (Article 100 (b) EPC) does not prejudice the maintenance of the patent as granted.

3. *Patent as granted (main request) - Claim 1 - Novelty (Article 100 (a), in conjunction with Articles 52 (1) and 54 (1) EPC)*

3.1 In its decision the opposition division held that the display member defined in claim 1 was new over document D1 in the combination of features M1.3.1 and M1.3.2. In particular, the opposition division considered in respect of the structure disclosed in document D1 by reference to Fig. 9 that the patent specification made it clear that the structure represented in Fig. 21 of the patent - identical to that of Fig. 9 of document D1 - was "a structure which is adoptable for the second region" of claim 1 (paragraphs [0186] and [0187]).

The appellant contested the opposition division's view that the structure of Fig. 9 of document D1 came in consideration only for the second region of the claimed display member. The appellant essentially submitted that claim 1 was to be considered as such, without reference to the description.

3.2 The board first notes that claim 1 defines a display member comprising

- at least one pixel (see feature M1.4.1) including a region comprising the features of the "first region" defined in feature M1.3.1, at least part of the region not being covered by the metal layer (feature M1.2.1), and

- at least one pixel (see feature M1.4.2) including a region comprising the features of the "second region" defined in feature M1.3.2, the region being covered by the metal layer (feature M1.2.1).

The display member disclosed in document D1 by reference to Fig. 1 and 2 comprises a plurality of pixels "PE" (Fig. 2), each of the pixels having the structure shown in Fig. 3 and 4. Each of the pixels comprises

- a region (called in document D1 a "first region") constituted by sub-regions SR1, SR2 and SR3 (Fig. 3 and 4), each of these sub-regions being covered by a reflective metal layer 120' (Fig. 4 and paragraphs [0088] to [0091]) and comprising the features of the "second region" defined in feature M1.3.2 of claim 1 as granted, in particular comprising a plurality of grooves or ridges extending in a direction perpendicular to the plane of Fig. 4 and forming a diffraction structure (Fig. 4 and paragraph [0027]), and

- an additional region (called in document D1 a "second region") constituted by region R2 (Fig. 3 and 4), this region not being covered by the metal layer 120' (Fig. 4 and paragraphs [0088] to [0091]).

In addition, document D1 discloses that region R2 has an arrangement of a plurality of grooves or ridges (Fig. 4 and paragraph [0032]) which according to paragraphs [0114] to [0116] can adopt the form of the structure represented in Fig. 9 constituted by a two-dimensional distribution of grooves or ridges, and in particular by a two-dimensional square distribution of recesses or projections having a quadrangular square prism shape (paragraphs [0114] to [0116] and [0126] to [0128]), the structure being non-metallized (paragraph

[0116], second sentence). This region R2 having the structure represented in Fig. 9 has a plurality of grooves or ridges each extending in a longitudinal direction parallel to the principal surface of the pixel layer and perpendicular to the plane of Fig. 4, and also a plurality of grooves or ridges each extending in a longitudinal direction parallel to the principal surface of the pixel layer and parallel to the plane of Fig. 4 as required by the features of the "first region" defined in feature M1.3.1 of claim 1 as granted.

Therefore, the display member disclosed in document D1 by reference to Fig. 1 to 5 in combination with Fig. 9 satisfies the combination of features M1.3.1 and M1.3.2.

- 3.2.1 According to the reasons given by the opposition division in its decision and the respondent's submissions, claim 1 would implicitly exclude that the first region of the claimed display member had the structure of Fig. 9 of document D1 which was identical to Fig. 21 of the patent specification. In particular, the respondent concurred with the opposition division that the structure shown in Fig. 21 of the patent was disclosed in the patent specification as an example of the second region (paragraphs [0186] and [0187]) and that this structure was only adapted for the second region. The respondent referred in this respect to the "own dictionary" approach for the interpretation of the claims mentioned in the referral decision T 439/22 (point 3 of the reasons).

However, in the board's view the mere fact that the two mentioned figures are identical but are disclosed for a different use in the display bodies of document D1 and

of the description of the patent specification (i.e. as constituting in document D1 the non-metallized region R2, see paragraphs [0116] and [0126], and in the patent specification the metallized region) is irrelevant for the issue under consideration. In particular, the subject-matter of claim 1 does not exclude that the claimed first region has the structure shown in Fig. 9 of document D1, and neither the fact that the description discloses that the second region may have the structure shown in Fig. 21 identical to Fig. 9 of document D1, nor the possible difficulties mentioned by the respondent in manufacturing the first region having the mentioned structure following the specific manufacture process disclosed in the patent specification (see point 2.1.1 above, and paragraphs [0022] and [0023] of the description) justify construing claim 1 in a restrictive manner as implicitly excluding structuring the first region as shown in Fig. 9 of document D1. More particularly, claim 1 is directed to a display member having the claimed structural and functional features, and the claim contains no reference to the manufacture of the display member, and consequently the novelty of the claimed display member is to be assessed on the basis of the claimed features, irrespective of the specific method disclosed in the patent for the manufacture of the display member and, more particularly, irrespective of whether the mentioned particular embodiment of document D1 falling within the terms of claim 1 as granted and therefore encompassed by this claim is obtainable by the particular method disclosed in the patent.

The board also notes that the description of the patent only mentions that the structure of Fig. 21 "is adoptable for the second region" (paragraph [0186]),

without excluding its use for the first region, and that - as submitted by the appellant - the description mentions that the first region of the display member having the plurality of first grooves or ridges "optionally [has] a groove or ridge which intersects with the plurality of first grooves or ridges" (paragraph [0007]). Therefore, the description of the patent does not exclude that the first region of the claimed display member may have the structure represented in Fig. 9 of document D1 and, consequently, claim 1 is not new over document D1 under the "own dictionary" approach mentioned by the respondent.

3.2.2 The respondent also submitted that, under an interpretation of claim 1 without reference to the description - i.e. following the "primacy of the claims" approach considered in the mentioned decision T 439/22 -, the terms of the claim excluded the use of the structure of Fig. 9 of document D1 for the first region because the "grooves" mentioned in feature M1.3.1 would be understood by the skilled person as referring to long, narrow indentations that allowed another material to move within the grooves (see definition of "groove" in document X1, page 628, and in document X2) and the claimed "ridges" would be understood as referring to the corresponding edges or elevations (see definition of "ridge" in document X1, page 1237). Therefore, the skilled person would not identify the structure of Fig. 9 of document D1 as having grooves or ridges as claimed, in particular because document D1 referred to recesses or projections (paragraph [0114]).

The board, however, is not persuaded by this argument. The structure of Fig. 9 of document D1 can be considered to be formed, as submitted by the appellant

by reference to the concept of cross-grid (see definition of "Kreuzgitter" in documents X3 and X4), by a first arrangement of parallel grooves or ridges and a second arrangement of parallel grooves or ridges that is orthogonal to the first arrangement, and claim 1 does not exclude the presence in the first region (see feature M1.3.1) of a second plurality of parallel grooves or ridges orthogonal to the plurality of grooves or ridges defined in feature M1.3.1. In addition, the respondent's submissions in this respect are at variance with the fact that according to the description of the patent the structure represented in Fig. 21 - identical to that of Fig. 9 of document D1 - can be used for the second region defined in claim 1 in a similar manner as the first region, i.e. as a region having a plurality of grooves or ridges extending in a longitudinal direction (feature M1.3.2).

3.3 In view of these considerations, the board concludes that the display member defined in claim 1 as granted is not new in view of document D1 (Articles 52 (1) and 54 (1) EPC) and that, therefore, the ground for opposition under Article 100 (a) EPC prejudices the maintenance of the patent as granted.

4. *Auxiliary request 1 - Further prosecution*

4.1 The opposition was, by virtue of the decision under appeal, rejected. In view of the conclusion in point 3 above, the opposed patent cannot be maintained as granted and, therefore, the decision under appeal cannot stand and must be set aside. The appeal is thus allowable within the meaning of Article 111 (1), first sentence, EPC. The question therefore arises whether the patent can be maintained in amended form on the basis of auxiliary request 1, in particular in view of

the appellant's substantive submissions on both novelty and inventive step of the amended claim 1. According to Article 111 (2), second sentence, EPC the board may either examine this question or remit the case to the opposition division.

- 4.2 During the oral proceedings the respondent submitted that Article 11 RPBA had an exceptional character and that a remittal would not be justified because claim 1 amended according to auxiliary request 1 corresponded to claim 1 as granted as construed by the opposition division in its decision (see point 3.1 above, first paragraph). Therefore, in the present circumstances a remittal would not meet the requirements of Article 11 RPBA.

The board notes, however, that the opposition division's decision on the issue of novelty of claim 1 as granted was not based on a substantive comparison of the display member of claim 1 as granted and the embodiment of document D1 involving the structure of Fig. 9, but only on an interpretation of claim 1 that excluded consideration of the structure of Fig. 9 of document D1 (see point 3.1 above) and which the board considers unjustified (see point 3.2.1 above). Therefore, no substantive assessment was carried out by the opposition division on the issues of novelty and inventive step over the mentioned embodiment of document D1. In this context, addressing this question with respect to claim 1 amended according to auxiliary request 1 on appeal would require the board going beyond the primary object of the appeal proceedings to review the appealed decision in a judicial manner (Article 12 (2) RPBA). In the board's view, and as confirmed by the established case law (see "Case Law of the Boards of Appeal", *supra*, section V.A.9, in

particular sub-sections V.A.9.3.2-a), b) and d)), this constitutes a special reason within the meaning of Article 11 RPBA that - contrary to the respondent's view - justifies the remittal of the case to the opposition division for further prosecution.

- 4.3 For these reasons the board, in the light of the specific circumstances of the case, considers it appropriate exercising its discretion under Article 111 (1), second sentence, EPC, together with Article 11 RPBA to remit the case to the opposition division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



L. Gabor

R. Bekkering

Decision electronically authenticated