

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 3 May 2024**

Case Number: T 1901/22 - 3.2.05

Application Number: 16770591.2

Publication Number: 3341216

IPC: B42D25/00

Language of the proceedings: EN

Title of invention:

Single or dual transfer process for preparing and transferring sharply defined single elements to objects to be protected

Patent Proprietors:

Crane Security Technologies, Inc.
Visual Physics, LLC

Opponents:

Giesecke+Devrient Currency Technology GmbH
Leonhard Kurz Stiftung & Co. KG

Relevant legal provisions:

EPC Art. 54, 84, 100(a), 111(1), 111(2)
EPC R. 111(2)
RPBA 2020 Art. 11, 12(3), 12(5), 12(6)

Keyword:

Ground for opposition - lack of novelty (yes)

Statement of grounds of appeal - reasons set out clearly and concisely (no) - auxiliary requests 1, 6, 7, 8 and 9 admitted (no)

Appealed decision - auxiliary requests 2, 3, 4, 5, 10, 11 and 12 - sufficiently reasoned (no)

Appealed decision - auxiliary requests 10, 11 and 12 - error in the use of discretion (yes)

Late-filed auxiliary requests 2, 3, 4, 5, 10, 11 and 12 - admitted in first-instance proceedings (no) - admitted (yes)

Claims - auxiliary requests 2, 3, 4 and 5 - clarity after amendment (no)

Remittal - fundamental deficiency in first-instance proceedings (yes) - remittal to the department of first instance (yes)

Reimbursement of appeal fee - equitable by reason of a substantial procedural violation (no)

Decisions cited:

J 0007/83



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 1901/22 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 3 May 2024

Appellants: Crane Security Technologies, Inc.
(Patent Proprietors) One Cellu Drive
Nashua, NH 03063 (US)

Visual Physics, LLC
1245 Old Alpharetta Road
Alpharetta, GA 30005 (US)

Representative: Grünecker Patent- und Rechtsanwälte
PartG mbB
Leopoldstraße 4
80802 München (DE)

Respondent I: Giesecke+Devrient Currency Technology GmbH
(Opponent 1) Prinzregentenstraße 159
81677 München (DE)

Representative: Giesecke+Devrient IP
Prinzregentenstraße 161
81677 München (DE)

Respondent II: Leonhard Kurz Stiftung & Co. KG
(Opponent 2) Schwabacher Strasse 482
90763 Fürth (DE)

Representative: Louis Pöhlau Lohrentz
Patentanwälte
Postfach 30 55
90014 Nürnberg (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 25 May 2022
revoking European patent No. 3341216 pursuant to
Articles 101(2) and 101(3)(b) EPC.**

Composition of the Board:

Chairman P. Lanz
Members: M. Holz
 F. Blumer

Summary of Facts and Submissions

- I. The patent proprietors (appellants) filed an appeal against the decision of the opposition division revoking European patent No. 3 341 216 (the patent).

According to the reasons for the decision under appeal, the opposition division concluded, *inter alia*, that the subject-matter of claim 1 as granted lacked novelty in view of document D6 (WO 2010/072339 A2), in particular, in view of the embodiment shown in Figures 5 and 6. In its view, feature D2 was disclosed on page 16, lines 6 to 13 of document D6. The opposition division also concluded that the claims of auxiliary requests 1, 6, 7, 8 and 9 did not comply with Article 84 EPC since the definition that the separation layer had a relief structure was redundantly present in claims 1 and 5 and since feature F (and feature F') was not clear. In its opinion, claim 1 of auxiliary requests 2, 3, 4 and 5 did not meet the requirements of Article 84 EPC in view of feature G. The opposition division further decided not to admit auxiliary requests III to V filed during the oral proceedings before it at 15.13 hrs (renumbered as auxiliary requests 10 to 12 in appeal, see below).

- II. Opponent 1 (respondent I) and opponent 2 (respondent II) replied to the appellants' statement of grounds of appeal.

In a further letter dated 24 August 2023, the appellants made additional submissions.

On 8 March 2024, the board issued a communication under Article 15(1) RPBA and provided its preliminary

opinion, namely that the subject-matter of claim 1 of the main request was not new in view of document D6, auxiliary requests 1 and 6 to 9 should not be admitted into the proceedings under Article 12(3) and (5) RPBA, auxiliary requests 2 to 5 should be admitted but were not allowable for lack of clarity, auxiliary requests 10 to 12 could form the basis for a remittal of the case to the opposition division, and a reimbursement of the appeal fee was not equitable.

In a further letter dated 15 April 2024, the appellants filed additional submissions.

III. On 3 May 2024, oral proceedings before the board were held as requested.

The appellants requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, as an auxiliary measure:

- that the patent be maintained as amended according to the claims of:
 - auxiliary request 1 filed as auxiliary request I with the statement of grounds of appeal
 - or one of auxiliary requests 2 to 5 filed as auxiliary requests II to V (first new set) with the statement of grounds of appeal
 - or one of auxiliary requests 6 to 9 filed as auxiliary requests II to V with the statement of grounds of appeal
- or that the case be remitted to the opposition division for further prosecution
- or that the patent be maintained as amended according to the claims of one of auxiliary requests 10 to 12 filed as auxiliary requests III to V (second new set) with the statement of grounds of appeal

The appellants also requested a reimbursement of the appeal fee.

Respondents I and II requested that the appeal be dismissed.

IV. **Claim versions**

Claim 1 as granted (corresponding to the appellants' main request) reads (the feature references employed by the board are included in square brackets):

"**[A]** A pre-patch transfer sheet (10) comprising:
[B] a carrier substrate (12); and
[C] a pre-patch transfer assembly (14,16,18) that is affixed along a first side of the carrier substrate and comprising:
[C1] at least one isolated element (22) for transfer having **[D]** (i) a micro-optic film material assembly (16) **[D1]** that produces an image, **[C3]** and (ii) an adhesive layer (18) affixed along a first side of the micro-optic film material assembly opposite the carrier substrate; and **[C21]** a background area from which material has been removed that is adjacent to or surrounds the at least one isolated element for transfer,
characterised in that **[D2]** the image is a synthetic image, wherein the image is synthetized by the united performance of a multiplicity of individual focusing element/image icon systems, wherein each focusing element magnifies a dot/very small space of the image below the focusing element, the dots are then combined and projected, thus leading to a magnified image, which is a synthetic image."

Claim 1 of auxiliary request 1 differs from claim 1 as granted in that the word "characterised" in feature C21 is replaced by "characterized" and in that the following features E and F are included at the end of the claim:

"[E] wherein a separation layer is disposed between the carrier substrate and the pre-patch transfer assembly, [F] wherein the separation layer has a relief structure on one surface that mates or conforms to an exposed lens layer of the micro-optic film material."

Claim 5 of auxiliary request 1 reads:

"The pre-patch transfer sheet of claim 1, wherein the separation layer comprises a relief structure."

Claim 1 of auxiliary request 2 differs from claim 1 as granted in that the word "characterised" in feature C21 is replaced by "characterized" and in that feature E and the following feature G are included at the end of the claim:

"[G] wherein the separation layer only covers a discontinuous area that is 0.1mm to 0.4mm larger or 0.2mm smaller than the isolated elements for transfer."

Claim 1 of auxiliary request 3 differs from claim 1 of auxiliary request 2 in that the following feature H is included at the end of the claim:

"[H] wherein the pre-patch transfer assembly further comprises a series of spaced die cut lines placed in the isolated elements at locations where a lead edge and optionally also a rear edge of a stamping die will contact the isolated elements during transfer from a

transfer sheet to a continuous sheet of security documents."

Claim 1 of auxiliary request 4 differs from claim 1 of auxiliary request 3 in that the following feature I is included between features D1 and C3:

"[I] the micro-optic film material assembly being a non-tearable or tear resistant film material or resin structure,"

Claim 1 of auxiliary request 5 differs from claim 1 of auxiliary request 4 in that the following feature J is included at the end of the claim:

"[J] wherein the die cut lines do not reach the carrier substrate."

Claim 1 of auxiliary request 6 differs from claim 1 as granted in that the word "characterised" in feature C21 is replaced by "characterized" and in that feature E and the following features F' and G' are included at the end of the claim:

"[F'] wherein the separation layer has a relief structure that on one surface that mates or conforms to an exposed lens layer of the micro-optic film material; [G'] wherein the separation layer only covers areas corresponding to the isolated elements for transfer or a discontinuous area slightly larger, for example 0.1mm to 0.4mm, or slightly smaller, for example 0.2mm than the isolated elements for transfer."

Claim 5 of auxiliary request 6 is identical to claim 5 of auxiliary request 1.

Claim 1 of auxiliary request 7 differs from claim 1 of auxiliary request 6 in that feature F' is replaced by feature F and in that feature H is included at the end of the claim.

Claim 5 of auxiliary request 7 is identical to claim 5 of auxiliary request 1.

Claim 1 of auxiliary request 8 differs from claim 1 of auxiliary request 7 in that feature I is included between features D1 and C3.

Claim 5 of auxiliary request 8 is identical to claim 5 of auxiliary request 1.

Claim 1 of auxiliary request 9 differs from claim 1 of auxiliary request 8 in that feature J is included at the end of the claim.

Claim 5 of auxiliary request 9 is identical to claim 5 of auxiliary request 1.

Claim 1 of auxiliary request 10 differs from claim 1 of auxiliary request 3 in that feature G is removed.

Claim 1 of auxiliary request 11 differs from claim 1 of auxiliary request 4 in that feature G is removed.

Claim 1 of auxiliary request 12 differs from claim 1 of auxiliary request 5 in that feature G is removed.

V. The parties' submissions can be summarised as follows.

(a) *The appellants' main request (the patent as granted)*

(i) *Appellants*

The subject-matter of claim 1 as granted was new in view of document D6. That document did not disclose feature D2 in combination with the other features of claim 1 as granted. The embodiment according to Figures 5 and 6 of document D6 did not specify any characteristics of the decorative layer. The only disclosure in document D6 which referred to Moiré magnifiers was on page 16, second paragraph. That passage was not a definition of the decorative layer disclosed in document D6. It only mentioned embodiments and examples of the decorative layer. Their applicability to the embodiment of Figures 5 or 6 was not apparent. Page 16, second paragraph of document D6 disclosed a list from which the skilled person had to make a selection without any of the embodiments being disclosed as preferred. A Moiré magnifier was mentioned for security elements with a microlens structure. However, the second paragraph on page 16 of document D6 did not discuss any security elements. A combination of Moiré magnifiers and the embodiment illustrated in Figures 5 and 6 was not directly and unambiguously disclosed. Page 16, second paragraph of document D6 listed at least nine independent "preferred" characteristics of the decorative layer. Among these, a microlens structure and a Moiré magnifier were not even mentioned. That passage was furthermore not specific on whether the whole Moiré magnifier, i.e. the whole security element, was part of the decorative layer.

Page 16 and the remaining disclosure of document D6 referred to decorative layers having lenses but not a combination of lenses and image icons as required by feature D2. From claims 29, 39 and 49 of document D6, it followed that the security element was only formed once the decorative layer was applied to an external body. To conclude that the claimed subject-matter was not new in view of document D6, it was not sufficient to establish that the claimed subject-matter was not inconsistent with the disclosure of this document or that this document did not rule out that feature D2 was implemented in the disclosed embodiment.

(ii) *Respondents*

The subject-matter of claim 1 as granted was not new in view of document D6. Figures 5 and 6 of document D6 illustrated the invention defined in claims 1 and 39 of document D6. Feature D2 was disclosed in view of the Moiré magnifiers mentioned on page 16, lines 12 and 13 of document D6. No selection from two independent lists of considerable lengths was needed to arrive at the subject-matter of claim 1 as granted. Page 16, second paragraph only provided a single list of possible security elements contained in the decorative layer. This included Moiré magnifiers. Document D6 disclosed that the decorative layer itself comprised the security element (see page 3, lines 18 to 22; page 14, lines 22, 23 and 25 to 28; page 19, lines 24 to 28; and page 22, lines 16 to 18). It was thus unambiguously derivable that the decorative layer comprised the entire Moiré magnifier.

(b) *The appellants' auxiliary requests 1, 6, 7, 8 and 9*

(i) *Appellants*

Auxiliary requests 1, 6, 7, 8 and 9 should be part of the appeal proceedings since they had been presented in the opposition proceedings and were considered in the decision under appeal. There was a redundancy in view of claims 1 and 5 of these auxiliary requests. However, it had been offered to delete claim 5 from these auxiliary requests to resolve this redundancy. Features F and F' were clear to the skilled person.

(ii) *Respondents*

The claims of auxiliary requests 1, 6, 7, 8 and 9 did not meet the requirements of Article 84 EPC. The additional feature of claim 5 of these auxiliary requests ("*wherein the separation layer comprises a relief structure*") was redundant in view of feature F (or feature F') of claim 1 of these auxiliary requests. Additionally, features F and F' were unclear.

(c) *The appellants' auxiliary requests 2, 3, 4 and 5*

(i) *Appellants*

Claim 1 of auxiliary requests 2, 3, 4 and 5 was clear. In view of feature G, it was precisely defined that a direction existed along which the separation layer was larger or smaller than the isolated element for transfer. In other words, there was at least one direction in which the discontinuous area covered by the separation layer was larger or smaller than the corresponding area of the isolated element. The skilled

person understood feature G as defining that, for each isolated element, there was a corresponding area of the separation layer that, in at least one direction and in at least one region, had an extension that was 0.1 to 0.4 mm larger or 0.2 mm smaller than the extension of the corresponding isolated element in the same direction and in the same region. The fact that the claim did not define a specific direction did not result in a lack of clarity. Feature G referred to a discontinuous area and not to an amount of area. The situation was similar to the specification that a piece of paper in DIN A4 format was a specific length larger than a piece of paper in DIN A5 format or the specification that a tunnel was "larger" than the mountain through which it led. Both specifications were clear to the skilled person.

(ii) *Respondents*

The opposition division had decided not to admit auxiliary requests 2 to 5 into the proceedings. As apparent from point 3 of the Reasons for the decision under appeal, in particular, page 20, last paragraph and page 22, this discretionary decision had been based on the lack of *prima facie* allowability of these auxiliary request and on the fact that the amendments had been filed late and were based on the description such that they could not have been expected by the respondents. The opposition division's discretionary decision was thus sufficiently reasoned and should not be reversed by the board. Nor should auxiliary requests 2 to 5 be admitted in view of their lack of convergence.

Claim 1 of auxiliary requests 2, 3, 4 and 5 was not clear in view of feature G. It was not clear how an

area (a two-dimensional quantity) could be smaller or larger by a number of millimetres (a one-dimensional quantity) than "*the isolated elements for transfer*". A further lack of clarity was present since feature G specified a relationship between a discontinuous area (in the singular) and certain elements (in the plural). The position of the discontinuous area with respect to the isolated elements was undefined. It was open whether a total length of the discontinuous area (i.e. including regions separating portions of the discontinuous area) was meant or a sum of the lengths of the portions of the discontinuous area. Moreover, it was not clear whether this length was to be compared with a total length of the isolated elements or with the length of one of the isolated elements.

(d) *The appellants' auxiliary requests 10, 11 and 12*

(i) *Appellants*

Auxiliary requests 10, 11 and 12 were identical to auxiliary requests III, IV and V filed during the oral proceedings before the opposition division at 15.13 hrs. The opposition division had decided not to admit these auxiliary requests without giving the appellants an opportunity to comment on the reasons for non-admittance. This amounted to a substantial procedural violation. Reasons for not admitting these auxiliary requests were provided for the first time in the Reasons for the decision under appeal. According to point 4 of these Reasons, auxiliary request 10 would *prima facie* not be admissible "*since the **same** issue as with the auxiliary request 2 is present in said late filed auxiliary request III*". However, the only "issue" why auxiliary request II of the first new set of auxiliary requests (auxiliary request 2 in the appeal

proceedings) had been held to not be allowable was a lack of clarity in view of feature G (see point 3 of the Reasons for the decision). This feature had not been included in the claims of auxiliary requests III, IV and V filed during the oral proceedings at 15.13 hrs such that "*the same issue*" raised for auxiliary requests 2 to 5 could not be present in these auxiliary requests. Claim 1 of auxiliary requests III, IV and V filed during the oral proceedings at 15.13 hrs differed from that of auxiliary requests 3, 4 and 5 solely by the deletion of the contentious feature G. No new features had been added when presenting auxiliary requests III, IV and V in the oral proceedings before the opposition division. The deletion of feature G in these auxiliary requests was a *bona fide* attempt to overcome the clarity objection against feature G which had been raised for the first time in the oral proceedings before the opposition division.

(ii) *Respondents*

The opposition division's discretionary decision not to admit auxiliary requests III, IV and V filed during the oral proceedings before the opposition division at 15.13 hrs was sufficiently reasoned and should not be reversed by the board. It was apparent from page 23, last paragraph and page 24, first paragraph of the Reasons for the decision under appeal that the opposition division's discretionary decision was based on the consideration that these auxiliary requests included features from the description. The respondents could not have expected these amendments and had thus not been in a position to prepare themselves. The "same issue" mentioned in point 4 of the Reasons for the decision under appeal referred to the issue discussed in point 3 of the Reasons that claim 1 of auxiliary

requests 2 to 5 included features taken from the description (see, for example, page 20, last paragraph of the Reasons for the decision under appeal). According to page 5, second paragraph of the minutes of the oral proceedings before the opposition division, the chairman of the opposition division had informed the appellants that new claims should be from granted claims and could not have features from the description added during the oral proceedings. The appellants had thus been informed about the possible reasons for not admitting further requests and had had an opportunity to comment on this. Auxiliary requests 10, 11 and 12 were *prima facie* not allowable in view of objections under Article 84 and 123(2) EPC. Nor were these auxiliary requests convergent.

(e) Remittal to opposition division for further prosecution

The appellants requested that the case be remitted to the opposition division for further prosecution. The respondents submitted that they considered a remittal unnecessary and detrimental to procedural economy.

(f) Reimbursement of the appellants' appeal fee

The appellants requested that the appeal fee be reimbursed in view of the substantial procedural violation committed by the opposition division in its discretionary decision not to admit auxiliary requests III, IV and V filed during the oral proceedings before it at 15.13 hrs.

Reasons for the Decision

1. The appellants' main request (the patent as granted)

In the decision under appeal, the opposition division concluded, *inter alia*, that the subject-matter of claim 1 as granted lacked novelty in view of document D6, in particular the embodiment shown in Figures 5 and 6. In its view, feature D2 was disclosed on page 16, lines 6 to 13 of document D6 (see point 1.3.1 of the Reasons for the decision).

The appellants contest this view and submit that the latter passage of document D6 bears no relation to the embodiment shown in the figures.

It is undisputed that Moiré magnifiers (as disclosed on page 16, lines 12 and 13 of document D6) include feature D2. The issue in hand hinges on whether it can unambiguously and directly be derived from document D6 that the decorative layer discussed in the context of Figures 5 and 6 includes Moiré magnifiers.

Page 16, lines 12 and 13 of document D6 forms part of the general part of the description. It does not belong to the description of an embodiment (of the method or the transfer film disclosed in document D6) different from the embodiment illustrated in Figures 5 to 6 of document D6. The skilled person understands that this passage discloses details of the decorative layer that are applicable to the decorative layer according to embodiments of the invention, i.e. the embodiments

disclosed in document D6, such as the decorative layer of the embodiment shown in Figures 5 and 6.

Page 19, lines 5 to 7 of document D6 dealing with that embodiment discloses that further layers may be added to the decorative layer instead of or in addition to the layers 14 to 16, which generate an optically variable effect. The skilled person understands this statement as a pointer to page 16, second paragraph addressing preferred embodiments of the invention in which the decorative layer has one or more layers generating an optically variable effect.

Page 16, lines 7 to 11 of document D6 discloses that the decorative layer preferably has a replicating lacquer layer with a surface structure moulded into the replicating lacquer layer, for example a diffractive surface structure, a microlens structure, a matt structure, or a symmetrical or asymmetrical blaze lattice. It is unambiguously and directly derivable from this passage that the replicating layer having the microlens structure is provided as a part of the decorative layer.

The skilled person understands from page 16, lines 12 and 13 of document D6 that examples of security elements with microlens structure are Moiré magnifiers. This is the only example of microlens structures given in this context (the preceding sentence relating to spherical or cylindrical lenses does not provide alternatives to Moiré magnifiers). The skilled person thus unambiguously and directly derives from the second paragraph on page 16 of document D6 that the decorative layer comprises Moiré magnifiers without having to make independent selections from two or more lengthy lists of alternatives. It is undisputed that the Moiré

magnifiers disclosed on page 16, lines 12 and 13 of document D6 include lenses and image objects.

The skilled person is not confused by the reference to security elements in the cited passage on page 16 since document D6 addresses methods for producing security elements (see, for example, its abstract) which are to be transferred to a security document (see, for example, page 3, lines 18 to 20 and page 14, lines 25 to 28 of document D6). This also applies to the embodiment shown in the figures (see page 19, lines 26 to 28 of document D6). Page 16, second paragraph of document D6 thus does not describe background art but relates to the invention disclosed in that document.

The appellants submitted that, in view of claims 29, 39 and 49, document D6 did not disclose that the decorative layer comprised the entire security element, i.e. the entire Moiré magnifiers including the lenses and the image objects. In their view, it was possible that the security element was only formed once the decorative layer was applied to an external body.

However, it is unambiguously derivable from page 3, lines 18 to 22; page 14, lines 22, 23 and 25 to 28; page 19, lines 24 to 28; and page 22, lines 16 to 18 of document D6 that the decorative layer itself comprises the (entire) security element. In the situation disclosed on page 16, lines 12 and 13 of document D6, where the security elements are Moiré magnifiers, this necessarily implies that the decorative layer comprises the entire Moiré magnifiers, including lenses and image objects. The question whether this was also disclosed in claims 29, 39 and 49 of document D6 can be left open.

Whether document D6 discloses other details that could be present in the decorative layer in addition or alternatively to Moiré magnifiers is not relevant to the issue in hand. The above view is furthermore not based on the considerations that the claimed subject-matter was not inconsistent with the disclosure of document D6 or that document D6 did not rule out that feature D2 was implemented in the embodiment shown in Figures 5 and 6. As follows from the above discussion, the feature combination defined in claim 1 as granted, including feature D2, is unambiguously and directly derivable from document D6.

The subject-matter of claim 1 as granted is thus not new in view of document D6. The ground for opposition under Article 100(a) in connection with Article 54 EPC therefore prejudices the maintenance of the patent as granted.

2. **The appellants' auxiliary request 1**

In accordance with Article 12(3) RPBA, the statement of grounds of appeal and the reply must contain a party's complete appeal case. Accordingly, it must 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 requests, facts, objections, arguments and evidence relied on. In accordance with Article 12(5) RPBA, the board has discretion not to admit any part of a submission by a party which does not meet the requirements in Article 12(3) RPBA.

On page 17, third and fourth paragraphs, in point II. 2.2 of the Reasons for the decision under appeal, the opposition division concluded, *inter alia*, that the

claims of auxiliary request 1 did not comply with Article 84 EPC since the definition that the separation layer had a relief structure was redundantly present in claims 1 and 5 of auxiliary request 1.

The appellants acknowledged that there is a redundancy in view of claims 1 and 5 of auxiliary request 1, and they did not submit any reasons why the opposition division's conclusion in this regard was incorrect. The appellants' "offer" to file an amended set of claims in which claim 5 is omitted does not change this view. The appellants have not set out any reasons why it is requested that the decision under appeal in view of auxiliary request 1 be reversed.

The requirements of Article 12(3) RPBA are therefore not met for the appellants' auxiliary request 1. The board thus has discretion not to admit this auxiliary request into the appeal proceedings under Article 12(5) RPBA. Nor is it self-explanatory that the above conclusion by the opposition division is wrong.

Exercising its discretion under Article 12(5) RPBA, the board therefore decided not to admit the appellants' auxiliary request 1 into the appeal proceedings.

3. The appellants' auxiliary requests 2, 3, 4 and 5

3.1 According to the last sentence in point 5 of the minutes of the oral proceedings before the opposition division, the opposition division decided not to admit the appellants' auxiliary request 2 into the opposition proceedings. According to point 6 of the minutes, auxiliary requests 3, 4 and 5 were not admitted either.

In accordance with Article 12(6), first sentence RPBA, the board does not admit requests, facts, objections or evidence which were not admitted in the proceedings leading to the decision under appeal unless the decision not to admit them suffered from an error in the use of discretion or unless the circumstances of the appeal case justify their admittance.

The opposition division's decision not to admit auxiliary requests 2 to 5 into the opposition proceedings is not included in the Reasons for the decision under appeal. At the end of point 3 of the Reasons, the opposition division concludes that auxiliary request 2 was unallowable, at least in that its independent claims did not meet the requirements of Article 84 EPC and that the same applied to auxiliary requests 3 to 5. These conclusions are repeated on page 25, last paragraph of the decision. From the Reasons for the decision, however, it is not apparent that the opposition division had indeed decided not to admit auxiliary requests 2 to 5 into the opposition proceedings.

In contrast, on page 22, third full paragraph of the Reasons, it is stated that auxiliary request 2 was considered unallowable. According to the penultimate sentence in point 5 of the minutes of the oral proceedings before the opposition division, the chairman announced the decision of the opposition division that claim 1 is not clear (Article 84 EPC). This indicates that the opposition division examined auxiliary request 2 on its merits, suggesting that this auxiliary request had been admitted. It is not apparent that the discussion of allowability under Article 84 EPC in the Reasons for the decision (and the above statement in the minutes) was only an *obiter dictum*.

The Reasons for the decision under appeal and the minutes of the oral proceedings before the opposition division are thus ambiguous regarding whether auxiliary requests 2 and 5 were admitted by the opposition division.

Rule 111(2) EPC stipulates, *inter alia*, that decisions of the European Patent Office which are open to appeal must be reasoned. Under case law, a "reasoned" decision should deal with all important issues of dispute (see "Case Law of the Boards of Appeal of the European Patent Office", 10th edn. 2022 (Case Law), III.K. 3.4.3). The grounds upon which the decision was based and all decisive considerations on the factual and legal aspects of the case must be discussed in detail in the decision.

For the above reasons, the opposition division's decision not to admit auxiliary requests 2 to 5 into the opposition proceedings does not meet these requirements.

This conclusion is not changed in view of the passages cited by the respondents. Page 20, last paragraph of the Reasons for the decision refers to submissions by respondent II and does not set out reasons on which the opposition division's decision not to admit auxiliary request 2 was based. In the first three paragraphs on page 22 of the Reasons, the opposition division sets out that the amendments could not have been expected by the respondents, that they gave rise to new objections and that the amended claims were *prima facie* not clear. However, there is nothing in the Reasons for the decision under appeal that would indicate that, based on these considerations, the opposition division exercised its discretion and decided not to admit

auxiliary requests 2 to 5. In the subsequent paragraph (page 22, fourth paragraph of the Reasons for the decision), the opposition division concluded instead that auxiliary request 2 filed during the oral proceedings was "therefore" considered unallowable.

The respondents also submitted that auxiliary requests 2 to 5 should not be admitted into the opposition proceedings since they were not convergent. However, convergence is not the only criterion for whether these auxiliary requests are to be admitted into the appeal proceedings.

For the reasons set out above, the circumstances of the appeal case justify the admittance of auxiliary requests 2 to 5 into the appeal proceedings in order for the board to review the opposition division's conclusions on the merits of these requests in view of Article 84 EPC. Exercising its discretion under Article 12(6), first sentence RPBA, the board therefore decided to admit auxiliary requests 2 to 5 into the appeal proceedings.

- 3.2 Regarding feature G, the board shares the respondents' view that it is not clear how an area (a two-dimensional quantity) can be smaller or larger by a number of millimetres (a one-dimensional quantity) than "the isolated elements for transfer".

The appellants submit that claim 1 of auxiliary request 2 defined that a direction existed along which the separation layer was larger or smaller than the isolated element for transfer. In other words, there was at least one direction in which the discontinuous area covered by the separation layer was larger or

smaller than the corresponding area of the isolated element.

The board does not share this view. Claim 1 of auxiliary request 2 does not define a direction or specify that the terms "larger" and "smaller" refer to a length measured in a specific direction. The interpretation suggested by the appellants is not supported by the claim or by the patent as a whole.

The appellants correctly observe that feature G refers to a discontinuous area and not to an amount of area. However, the consideration that an alternative claim wording would be unclear does not imply that the wording of contested claim 1 was clear to the skilled person.

Nor do the appellants' references to a tunnel leading through a mountain and pieces of paper sized according to a DIN norm have a bearing on how the skilled person understands feature G relating to a discontinuous area and isolated elements in the context of contested claim 1.

Moreover, feature G establishes a relation between a (single) discontinuous area and (multiple) isolated elements. It is not apparent whether a total extension of the discontinuous area (i.e. including zones not covered by the separation layer but extending between regions covered by the separation layer) is meant or a sum of the extensions of individual regions covered by the separation layer. Nor is it apparent whether this is to be compared with a sum of extensions of the multiple isolated elements or with the extension of one isolated element.

The appellants set out that the skilled person understood from feature G that, for each isolated element, there was a corresponding area of the separation layer that, in at least one direction and in at least one region, had an extension that was 0.1 to 0.4 mm larger or 0.2 mm smaller than the extension of the corresponding isolated element in the same direction and in the same region.

This interpretation is neither supported by nor consistent with the wording of contested claim 1. According to feature G, "*the separation layer only covers a discontinuous area*" (underlining by the board). There is thus no room for an interpretation that there could be multiple discontinuous areas, one for each isolated element. While the term "discontinuous" suggests that the (single) discontinuous area comprises multiple regions, feature G does not refer to an extension of one of these regions. Nor does it compare the extension of one of these regions to the extension of one of the isolated elements.

Claim 1 of the appellants' auxiliary request 2 does not meet the requirements of Article 84 EPC in view of feature G. The same applies to claim 1 of the appellants' auxiliary requests 3, 4 and 5 which equally contain unclear feature G.

4. **The appellants' auxiliary requests 6 to 9**

Regarding auxiliary requests 6 to 9, the opposition division referred to its reasoning on auxiliary request 1 (see page 19, paragraph 6 of the Reasons for the decision under appeal). As set out above, on page 17 of the Reasons for the decision under appeal, the

opposition division concluded, *inter alia*, that the redundancy of the definition that the separation layer has a relief structure in claims 1 and 5 is contrary to Article 84 EPC.

The appellants have not submitted any reasons why the opposition division's conclusion in this regard was incorrect or why the decision under appeal on auxiliary requests 6 to 9 should be reversed. The requirements of Article 12(3) RPBA are thus not met for auxiliary requests 6 to 9. For the same reasons set out above for the appellants' auxiliary request 1, the board exercised its discretion under Article 12(5) RPBA and decided not to admit the appellants' auxiliary requests 6 to 9 into the appeal proceedings.

5. The appellants' auxiliary requests 10, 11 and 12

5.1 According to the appellants, auxiliary requests 10, 11 and 12 are identical to auxiliary requests III, IV and V filed during the oral proceedings before the opposition division at 15.13 hrs. The opposition division had decided not to admit these auxiliary requests into the opposition proceedings (see pages 22 to 25 of the Reasons for the decision).

As set out above, in accordance with Article 12(6), first sentence RPBA, the board does not admit requests, facts, objections or evidence not admitted in the proceedings leading to the decision under appeal unless the decision not to admit them suffered from an error in the use of discretion or unless the circumstances of the appeal case justify their admittance.

5.2 According to point 7 of the minutes of the oral proceedings before the opposition division, before the

above auxiliary requests were submitted, the chairman announced that probably no further auxiliary requests were to be admitted. From point 8 of the minutes, it is not apparent that the appellants had had an opportunity to comment on whether auxiliary requests III to V filed at 15.13 hrs should be admitted into the opposition proceedings before the chairman informed the parties that these auxiliary requests were not admitted.

On page 23, third paragraph of the Reasons for the decision, the opposition division explains that the "same issue" as with auxiliary request 2 was present in auxiliary request III. According to point 3 of the Reasons for the decision under appeal, the "issue" on which the decision under appeal is based regarding auxiliary request 2 is the opposition division's view that the claims were not clear (Article 84 EPC) in that one-dimensional units of measurement were claimed for an area which was two-dimensional. This "issue" is thus apparently solely caused by the presence of feature G in claim 1 of auxiliary request 2 (see also point 3. above). However, feature G is not present in claim 1 of auxiliary requests III to V filed during the oral proceedings before the opposition division at 15.13 hrs.

It cannot be derived from the minutes of the oral proceedings before the opposition division that the appellants had been given the opportunity to explain why, in their view, the objection under Article 84 EPC (that had been raised against auxiliary request 2) was overcome by the newly filed auxiliary requests III to V before the chairman announced the decision that these auxiliary requests were not admitted.

According to page 24, penultimate paragraph of the Reasons for the decision, the opposition division furthermore considered that the subject-matter of the amended claim had not been expected by the respondents. However, again, it cannot be established that the appellants had been given an opportunity to comment on this aspect before the decision not to admit the auxiliary requests was announced in the oral proceedings before the opposition division.

Whether the appellants had had the opportunity to comment on whether these auxiliary requests should be admitted into the opposition proceedings is different from whether the appellants had already had an opportunity to file auxiliary requests, whether the number of auxiliary requests was unreasonably large or whether the amendments included in the auxiliary requests were expected.

The respondents submitted that according to page 5, second paragraph of the minutes of the oral proceedings before the opposition division, the chairman of the opposition division had informed the appellants that new claims should be from granted claims and could not have features from the description added during the oral proceedings. In their view, the appellants had thus been informed about possible reasons for not admitting further requests and had had an opportunity to comment on this.

However, according to point 8 of the minutes of the oral proceedings before the opposition division:

"The chairman informed that these documents are not admitted by the opposition division according to Art. 114(2) EPC, because it is not prima facie

apparent that these requests are allowable."
(Underlining added by the board.)

According to page 24, fifth paragraph of the Reasons for the decision:

"The opposition has therefore solely exercised its discretion under Article 114(2) EPC, and in this context, has considered the allowability of the late-filed amendments on a prima facie basis." (Underlining added by the board.)

The opposition division's discretionary decision not to admit the newly filed auxiliary request was thus based on a *prima facie* assessment of their allowability. It is not apparent that the appellants had been given the opportunity to comment on this point before this decision was made.

This view is not altered by the fact that the appellants had been informed by the chairman of the opposition division that *"new claims should be from granted claims and new claims cannot have features from the description introduced during the oral proceedings"* (see page 5, second paragraph of the minutes).

For these reasons alone, the opposition division's decision not to admit auxiliary requests III, IV and V filed during the oral proceedings before the opposition division at 15.13 hrs has to be set aside.

5.3 In a further aspect, the appellants submit that feature G was not present in claim 1 of auxiliary requests III, IV and V as filed during the oral proceedings before the opposition division at

15.13 hrs. Therefore, it was not apparent how the "same issue" as with auxiliary request 2 could be present in these auxiliary requests.

The respondents submit that "same issue" mentioned in point 4 of the Reasons for the decision under appeal referred to the consideration that claim 1 of auxiliary requests 2 to 5 included features taken from the description (see, for example, page 20, last paragraph of the Reasons for the decision under appeal).

It is not explicitly indicated in point 4 of the Reasons for the decision what issue is meant by "the same issue". This is also not implicit in the context. On page 23, third paragraph of the Reasons, reference is made to the "same issue" without explaining what is meant by this term. The preceding paragraph explains the appellants' submission and does not refer to any issue. The subsequent paragraph of the Reasons discusses the deletion of claim features that are present in claim 1 of auxiliary request 2. It is not self-explanatory that this deletion gives rise to the "same issue" that the opposition division perceived in auxiliary request 2. Deleting a feature from a claim is also different from including a feature taken from the description into a claim during the oral proceedings. The term "same issue" is also used on page 24, fourth paragraph of the Reasons without explaining what it means. It is also not the task of the board or the parties to speculate on what the opposition division might have had in mind when using this term.

Moreover, the opposition division explicitly sets out that it considered the allowability of the late-filed amendments on a *prima facie* basis. The board does not take issue with the opposition division considering the

allowability of the late-filed amendments on a *prima facie* basis. However, it is not apparent from the Reasons of the decision under appeal if the opposition division considered the newly filed auxiliary requests to be *prima facie* allowable and, if not, for what reasons. It does not seem apparent that this was because of the "same issue" for which auxiliary request 2 was not considered allowable, i.e. a lack of clarity in view of feature G.

The opposition division thus exercised its discretion in an unreasonable way, thereby exceeding the proper limits of its discretion. The opposition division's decision not to admit auxiliary requests III, IV and V filed during the oral proceedings before it at 15.13 hrs suffers from an error in the use of discretion. Also for this reason, that decision has to be set aside.

- 5.4 Moreover, it is undisputed that the objection under Article 84 EPC in view of feature G - i.e. the objection on which the board's conclusion regarding auxiliary requests 2, 3, 4 and 5 is based (see point 3.2 above) - is clearly overcome by auxiliary requests 10, 11 and 12.

The board therefore decided to set aside the discretionary decision of the opposition not to admit auxiliary requests III, IV and V filed during the oral proceedings before it at 15.13 hrs and to admit the corresponding auxiliary requests 10 to 12 into the appeal proceedings in accordance with Article 12(6), first sentence RPBA.

6. **Remittal to opposition division for further prosecution**

The appellants request that the case be remitted to the opposition division for further prosecution. The respondents submitted that they considered a remittal unnecessary and detrimental to procedural economy.

In accordance with Article 11 RPBA, the board does not remit a case to the department whose decision was appealed for further prosecution unless special reasons present themselves for doing so. As a rule, fundamental deficiencies which are apparent in the proceedings before that department constitute such special reasons.

As set out above in point 5. on the admittance of auxiliary requests III, IV and V filed during the oral proceedings before the opposition division at 15.13 hrs, the appellants' right to be heard had been violated, and the reasons for the decision under appeal are deficient. The violation of the right to be heard under Article 113(1) EPC is a fundamental procedural deficiency in the first-instance proceedings that amounts to a special reason within the meaning of Article 11 RPBA and justifies remittal to the department that issued the contested decision (see Case Law, V.A.9.4.4a). Moreover, Rule 111(2) EPC gives parties to EPO proceedings a fundamental procedural right to be provided with the reasons for a decision. A breach of Rule 111(2) EPC is a fundamental procedural deficiency that can lead to a remittal as a special reason within the meaning of Article 11 RPBA (see Case Law, V.A.9.4.4b). The desire for procedural economy does not outweigh these considerations.

The board therefore decided to remit the case to the opposition division for further prosecution (Article 111(1), second sentence, second alternative EPC and Article 11 RPBA).

7. **Reimbursement of the appeal fee**

The appellants request that the appeal fee be reimbursed in view of the above alleged substantial procedural violation.

Rule 103(1)(a) EPC stipulates that the appeal fee is to be reimbursed in full where the board deems an appeal to be allowable if the reimbursement is equitable by reason of a substantial procedural violation.

The above procedural violation did not taint the entire opposition proceedings. For example, the opposition division's conclusions on the appellants' main request and auxiliary request 1 were not affected by the procedural violation alleged by the appellants, which therefore does not qualify as substantial (see also Case Law, V.A.11.6.2 and decision J 7/83, point 12 of the Reasons). In the appeal proceedings, the appellants pursued these requests and wanted the board to review the decision under appeal also in this respect. To this end, the appellants would have had to file an appeal even if the alleged procedural violation had not taken place.

In this situation, the board does not consider it equitable to order a reimbursement of the appeal fee under Rule 103(1)(a) EPC.

8. Conclusions

The ground for opposition under Article 100(a) in conjunction with Article 54 EPC prejudices the maintenance of the patent as granted. The board furthermore decided not to admit the appellants' auxiliary requests 1 and 6 to 9 into the appeal proceedings. However, the board decided to admit the appellants' auxiliary requests 2 to 5 and 10 to 12 into the appeal proceedings. The appellants' auxiliary requests 2 to 5 do not comply with Article 84 EPC. The case is remitted to the opposition division for further prosecution, and the appellants' request for reimbursement of the appeal fee is refused.

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.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated