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**Datasheet for the decision
of 6 March 2025**

Case Number: T 2317/22 - 3.4.03

Application Number: 18154768.8

Publication Number: 3333812

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Language of the proceedings: EN

Title of invention:

A SECURITY SHEET OR DOCUMENT HAVING ONE OR MORE ENHANCED
WATERMARKS

Patent Proprietor:

Crane & Co., Inc.
Crane Security Technologies, Inc.
Crane AB

Opponent:

OBERTHUR FIDUCIAIRE SAS / VHP SECURITY PAPER B.V.

Relevant legal provisions:

EPC R. 76(2)(c)
EPC Art. 113(1), 54
RPBA 2020 Art. 11

Keyword:

Admissibility of opposition - opposition substantiated (yes)

Right to be heard - substantial procedural violation (no)

Novelty - implicit disclosure (no)

Remittal - special reasons for remittal (yes)

Decisions cited:

T 0222/85, T 2077/19



Beschwerdekammern

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Case Number: T 2317/22 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 6 March 2025

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted on 10 August 2022
revoking European patent No. 3333812 pursuant to
Article 101(3) (b) EPC.

Composition of the Board:

Chairman	M. Papastefanou
Members:	J. Thomas
	E. Mille

Summary of Facts and Submissions

- I. The appeal of patent proprietors 1 to 3 is against the decision of the opposition division revoking European patent No. 3 333 812 B1.
- II. Patent proprietors 1 to 3 have together filed a single appeal and are also represented together. Therefore they will be referred to in this decision as "*patent proprietor*" or "*appellant*".
- III. The opposition had been filed against the patent as a whole. Grounds for the opposition were lack of novelty, lack of inventive step, insufficiency of disclosure and unallowable amendments which extended the subject-matter beyond the content of the application as filed (Article 100(a) to (c) EPC in combination with Articles 52(1), 54, 56, 83, 76(1) and 123(2) EPC).
- IV. The opposition division concluded that
- the subject-matter of claim 1 of the patent as granted as well as of auxiliary requests Ia, II and III was not new (Article 54(1) and (2) EPC),
 - the subject-matter defined in auxiliary requests I, IIIc, IV, IVa, IVb and IVc was found to extend beyond the content of the application as originally filed (Articles 123(2) and 76 EPC), so in accordance with this finding, auxiliary requests IIIc, IVa, IVb and IVc were not admitted into the proceedings, and
 - auxiliary requests Ib, IIa, IIb, IIc, IIIa, IIIb, III', IIIa', IIIb', IIIc', IV', IVa', IVb' and IVc' were not admitted into the proceedings due to their late filing and their *prima facie* non-allowability (Rule 116(1) and (2) EPC).

- V. The patent proprietor's appeal is based on all requests underlying the impugned decision.
- VI. The board summoned the parties to oral proceedings and issued a communication under Article 15(1) RPBA.
- VII. Oral proceedings before the board were held, at the end of which the parties confirmed their final requests as follows.

The appellant (patent proprietor) requested that the decision under appeal be set aside and that

- the opposition be rejected as inadmissible; or
- the case be remitted to the opposition division for further prosecution because of a substantial procedural violation committed by the opposition division; or
- the case be remitted to the opposition division for further prosecution in the event that the board concludes that claim 1 as granted is new over D5; or
- the patent be maintained as granted (i.e. the opposition be rejected); or
- the patent be maintained on the basis of one of auxiliary requests I, Ia, Ib, II, IIa, IIb, IIc, III, III', IIIa, IIIa', IIIb, IIIb', IIIc, IIIc', IV, IV', IVa, IVa', IVb, IVb', IVc, IVc' *"as on file at the end of the oral proceedings before the opposition division"*.

The respondent (opponent) requested that the appeal be dismissed and that the patent be revoked in its entirety.

- VIII. This decision refers to the following document:

D5: WO 95/09275

IX. Claim 1 of the patent as granted has the following wording (the feature numbering in square brackets is added by the board):

"[M1] A security sheet or document (10) having one or more enhanced watermarks (14) or watermark designs, which comprises:

[M2] a fibrous sheet material including one or more watermarks or watermark designs,

[M3] wherein each watermark design has one or more first regions (18) with reduced fiber densities relative to surrounding regions of the fibrous sheet material and

[M4] one or more second regions (16) with similar or increased fiber densities relative to surrounding regions of the sheet material, and

[M5] wherein each watermark design has an upper or face portion and a lower or back portion; and

[M6] means for enhancing the one or more watermarks or watermark designs by rendering them visually enhanced, machine detectable or readable, or both, said means characterised by comprising:

[M7] one or more transparent or translucent areas surrounding each of the one or more watermark designs."

X. The appellant's arguments, in so far as they are relevant to the present decision, may be summarised as follows.

The opposition division had incorrectly considered the notice of opposition to be sufficiently substantiated, which it was not. The opposition was consequently inadmissible. The opposition division did not provide sufficient reasoning in its decision on this point.

This represented a substantial procedural violation which justified remittal of the case to the department of first instance.

The subject-matter of claim 1 was new over document D5, since the combination of features M3, M4 and M7 was not disclosed in a direct and unambiguous manner in document D5. It could not be concluded that there was an implicit disclosure of these features, either, since these features did not necessarily arise when using the Fourdrinier method. Remittal to the department of first instance for assessing inventive step was justified because inventive step had not been discussed in the first-instance proceedings and the appellant should have the right to a judicial review of every aspect of the decision.

- XI. The respondent's arguments, in so far as they are relevant to the present decision, may be summarised as follows.

The opposition was sufficiently substantiated and the opposition division had not committed any substantial procedural violation with regard to this issue. Novelty of claim 1 of the patent as granted was anticipated by document D5 since the disputed feature combination M3, M4 and M7 was disclosed therein; these features were the implicit result when a paper with a watermark was manufactured using a Fourdrinier method with a dandy roll. With regard to the assessment of inventive step, the respondent agreed to the case being remitted to the opposition division for further prosecution.

Reasons for the Decision

1. Admissibility of the opposition
 - 1.1 The appellant contested the admissibility of the opposition on the ground that it did not comply with Rule 76(2)(c) EPC.
 - 1.2 According to Rule 76(2)(c) EPC, the notice of opposition shall contain the *"grounds on which the opposition is based, as well as an indication of the facts and evidence presented in support of these grounds"*.
 - 1.3 In the appellant's view, the discussion of lack of novelty and insufficiency of disclosure in the notice of opposition did not sufficiently support these grounds for opposition.
 - 1.3.1 The notice of opposition did not contain any indication of disclosure of all the features of claim 1 in document D5. Only one arbitrarily selected feature was discussed in more detail, namely feature M7, and the references referred to in document D5 concerned a manufacturing method, and not a product or device as defined in claim 1 of the patent. The disclosure of the remaining features in document D5, in particular the disclosure of features M3 and M4, was not discussed in the notice of opposition. These features were only discussed in the patent proprietor's reply or became clear after further investigation by the opposition division, but not in/from the notice of opposition alone.

1.4 The board is of the opinion that the notice of opposition provides sufficient support for the objection of lack of novelty for the following reasons.

1.4.1 The notice of opposition discusses lack of novelty of the subject-matter of claim 1 in view of document D5 for almost one page (notice of opposition, point II.1.2), also providing references to several passages of document D5.

Although claim 1 refers to a "*security sheet or document*" and the discussion in the notice of opposition refers to passages in document D5 dealing with manufacturing steps for producing a "*security sheet or document*", the skilled reader will easily identify the relevant structural features from the references to document D5 relating to the security sheet with a watermark. Therefore, even if the references to document D5 cited in the notice of opposition refer to a manufacturing method for a security sheet, the structural features of the security sheet itself will be readily understood by the reasonably skilled reader.

1.4.2 The notice of opposition also refers to conventional watermarks manufactured using the same methods as those used in the impugned patent (notice of opposition, section II.1.2, second paragraph). Since the manufacturing methods used are the same in the impugned patent and in document D5, the skilled reader will understand that the result of the manufacturing method of document D5 is a security sheet having a conventional watermark. The notice of opposition refers to such a conventional watermark when referring to the features of the preamble of claim 1.

- 1.4.3 Contrary to the appellant's view, there is no obligation under Rule 76(2)(c) EPC to provide a complete and detailed feature analysis in the notice of opposition. For the admissibility of the opposition, it is crucial that the skilled reader can understand without undue burden from the notice of opposition why something is objected to. This is the case here, since the features defined in the preamble of claim 1 of the patent were considered by the opponent as not going beyond a security sheet comprising a conventional watermark, i.e. as reflecting the state of the art. This also reflects the conventional formulation of claims in the two-part form according to Rule 43(1)(a) EPC.

Therefore the reasonably skilled person when reading section II.1.2. of the notice of opposition will understand that the opponent apparently did not see the need to discuss the features of the preamble, namely features M1 to M6, in more detail since, in the opponent's view, they simply referred to the state of the art.

- 1.4.4 Moreover, the board does not concur with the appellant's opinion that Rule 76(2)(c) EPC should be understood as meaning that no further investigation at all is allowed for understand the notice of opposition. In accordance with the case law of the Boards of Appeal, the requirement of Rule 76(2)(c) EPC is satisfied, if the opponent's case is properly understood, when being *"assessed on an objective basis, from the point of view of a reasonably skilled person in the art to which the opposed patent relates"* (see e.g. T 222/85, headnote II. and point 4 of the Reasons for the Decision, and T 2077/19, points 7 to 10 of the Reasons for the Decision). Therefore the investigations

necessary to understand the opponent's objections with regard to features M1 to M6 are part of the standard knowledge of the reasonably skilled reader and therefore not in contradiction with the requirements of Rule 76(2)(c) EPC.

- 1.4.5 In addition, the board cannot agree with the appellant that the opponent discussed only an "*arbitrarily selected*" feature in more detail in its notice of opposition. The only feature which is discussed in the notice of opposition in more detail by reference to Figure 5 of document D5 is feature M7, which is the only feature defined in the characterising portion of claim 1. It therefore does not refer to an "*arbitrarily*" selected feature, but to the one which was presented as being the differentiating feature from the closest prior art, i.e. the security sheet with a conventional watermark (see also Rule 43(1)(b) EPC).
- 1.5 Finally, for the admissibility of an opposition the substantiation of a single ground for opposition is sufficient since no "*partial inadmissibility*" is provided for in the EPC. Therefore the question of whether the ground of insufficiency of disclosure was sufficiently substantiated in the notice of opposition can be left unanswered since the ground of lack of novelty satisfies the requirement of substantiation.
- 1.6 In conclusion, the notice of opposition meets the requirements of Rule 76(2)(c) EPC at least with regard to the objection of lack of novelty, so the opposition as a whole is admissible.
2. Right to be heard (Article 113(1) EPC) - substantial procedural violation

- 2.1 The appellant objected that its right to be heard had been violated (Article 113(1) EPC), since its "*essential arguments*" regarding the admissibility of the opposition had "*obviously*" not been taken into account by the opposition division in its decision (Rule 111(2) EPC).

These "*essential arguments*" are summarised as follows:

- (a) Complete feature mapping for the lack-of-novelty argument, including all the features of claim 1 in relation to document D5, was missing from the notice of opposition. Hence the ground of lack of novelty was insufficiently substantiated since the discussion of features M1 to M6 was missing in the notice of opposition.
- (b) The notice of opposition was insufficiently complete to be understood without any further information from the parties or investigation by the opposition division at the end of the opposition period, i.e. the opponent's arguments presented in the notice of opposition could not be entirely understood when taken alone at the end of the opposition period without any further investigation.

In the appellant's view, the opposition division's decision did not demonstrably show that these arguments had not only been heard but also considered by the opposition division. No reasoning or other verifiable facts were provided in the opposition division's decision indicating that these objections had indeed been taken into account.

- 2.2 The board notes that the appellant's objections mentioned above under points (a) and (b) are referred to in the opposition division's decision as follows:

Ad (a): The "notice of opposition substantiates at least the ground under Art. 100(a) EPC in a sufficient manner" (Grounds for the decision, point 3.4).

Ad (b): "The opposition division came already in the summons to the preliminary opinion that claim 1 would lack novelty over D5 and hence the ground is considered as sufficiently substantiated" (Grounds for the decision, point 3.4; underlining by the board).

2.3 Hence the impugned decision deals with the appellant's "essential arguments", so these points were not completely ignored by the opposition division. Nevertheless, the opposition division's reasoning is not complete and correct for the following reasons.

Ad (a): The opposition division did not provide any reasoning as to why the objection of lack of novelty was sufficiently substantiated, i.e. why the feature mapping of features M1 to M6 in view of document D5 was not obligatory or necessary in the notice of opposition. The mere statement that the notice of opposition is "sufficiently substantiated" is not sufficient reasoning with regard to the argument put forward by the appellant/patent proprietor.

Ad (b): The opposition division commented on the question of whether it could form its opinion based on the notice of opposition alone, but did not consider the correct moment in time. The opposition division referred to the moment when it formed its preliminary opinion, at the time of issuing the summons to oral proceedings, instead of the end of the opposition period. Hence this

is not missing reasoning, but only incorrect reasoning.

2.4 Therefore the impugned decision is not complete with regard to point (a), as only a statement is made in the impugned decision, which is not a reasoning in relation to the appellant's argument. Hence the right to be heard has not been fully respected, but this, in the board's view, constitutes only a procedural but not a substantial procedural violation for the following reasons.

2.5 As stated under point 1. with sub-points above, the decision on the admissibility of the opposition as taken by the opposition division is correct.

The admissibility of the opposition was discussed with the parties during the oral proceedings before the opposition division, and the appellant was heard on this matter (see minutes of the oral proceedings before the opposition division, point 3. with sub-points).

Following this discussion of the admissibility of the opposition in the oral proceedings, the opposition division had taken all the relevant arguments into account in order to arrive at the correct decision. Only reasoning with respect to the argument mentioned above under point (a) is missing in the impugned decision.

Arguments which appear in the opposition division's view not to be relevant for arriving at a correct decision do not necessarily have to be commented on in the decision (see *Case Law of the Boards of Appeal of the EPO*, 10th edition 2022, I.B.2.4.2). Therefore the "essential arguments" of the appellant might either

have appeared not to be relevant to the opposition division or have been at least implicitly considered.

In any case, the above-mentioned points (a) and (b) had not been entirely ignored by the opposition division in the impugned decision.

- 2.6 Moreover, there is no obvious causal link between the alleged violation of the right to be heard and the final decision on admissibility of the opposition or the revocation of the patent.

The board does not accept the appellant's argument that the course of the proceedings might have been different had the opposition division reasoned its decision on the admissibility of the opposition better. The incomplete reasoning became evident only in the written decision, i.e. after the decision to admit the opposition (which the board considers correct) and to revoke the patent was taken and announced at the end of the oral proceedings. As mentioned earlier (see point 2.5, second paragraph, above), the minutes of the oral proceedings show that the question of admissibility was discussed sufficiently with the parties. The board, therefore, does not see how more complete reasoning on the question of admissibility of the opposition in the written decision could have influenced the course of the proceedings in any way.

The appellant has also not explained why the course of the proceedings might have been different, i.e. why the opposition division might have reached a different decision, if the opposition division had correctly considered the appellant's "*essential arguments*". The causal link between the incomplete reasoning in the opposition division's decision and the opposition

division's final decision itself has not been demonstrated by the appellant.

- 2.7 In addition, the board holds that remittal of the case to the department of first instance would be for the sole purpose of completing formal reasoning as to why the notice of opposition was sufficiently substantiated and why this could be understood as such from the notice of opposition alone. This would only result in a procedural delay, especially since the final decision on admissibility of the opposition is correct.
- 2.8 Finally, the appellant was in any event adversely affected by the impugned decision for other reasons, namely the lack of novelty as found by the opposition division (see Grounds for the decision, point 6. with sub-points). Thus, for a judicial review of the opposition division's decision, an appeal was necessary in any event.
- 2.9 Following the foregoing considerations under points 2.4 to 2.8 above, the board concludes that there is no substantial procedural violation that might justify remittal of the case to the opposition division.
3. Understanding of the Fourdrinier method using a dandy roll
- 3.1 Before discussing novelty in view of the disclosure of document D5, it is worth understanding how the Fourdrinier method functions using a dandy roll.
- 3.2 A dandy roll is a cylindrical roll with protrusions and/or recesses on its outer surface which allow watermarks to be created/generated in a sheet of paper during its manufacturing process. The paper is produced

from a very wet mixture of paper fibers which are very mobile due to a large quantity of water in the mixture. This mixture (i.e. the fibers) is pressed between the dandy roll and a horizontal mesh in order to form the paper. Depending on the different depths or heights of the recesses and protrusions on the surface of the dandy roll, embossed watermarks are created on the paper as thicker or thinner zones or regions compared with the surrounding zones or regions of the paper. When the protrusions or recesses of the dandy roll "push" or "move" the fibers within this wet fiber mixture, the fiber densities change from one paper region to an adjacent one, such that in the thicker portions of the paper the fiber densities are higher and in the thinner portions of the paper the fiber densities are lower compared with the respective surrounding portions of the paper.

- 3.3 Depending on the geometrical forms of the protrusions and recesses of the dandy roll, and on the composition of the wet paper fiber mixture, i.e. on the mobility of the fibers within the mixture, the fibers are "pushed around" to a greater or lesser extent from the region of low thickness to the neighbouring region(s) when the watermark is created. Therefore the change in the fiber densities between the watermark with a reduced paper thickness and its surrounding regions does not necessarily happen abruptly within the limited range of the protrusions or recesses, but the fiber density can change more or less gradually from one region to the neighbouring one. The manufacturing process does not necessarily create in the immediate surroundings of the watermark a region with a fiber density which is higher than the fiber density of the paper as a whole since "transitional zones" exist. Depending on factors such as the fiber mobility in the mixture, the size of the

protrusions on the dandy roll and the rotation speed, the fibers can be "*pushed*" to a greater or lesser extent "*away*" from the regions of low density of the watermark. As explained by the appellant during the oral proceedings with the use of the flip chart, it might be that regions surrounding a watermark of low fiber density can still have fiber densities which are lower than those of other paper regions farther away, i.e. regions which represent the mean value of the fiber density of the paper, even if their fiber density is higher than that of the watermark.

- 3.4 Therefore, if a watermark is manufactured which comprises one or more "*watermark regions*", all these regions may have either higher or lower fiber densities compared with the surrounding regions, or one region may have increased fiber density and another region may have a lower fiber density compared with the surrounding regions. Even transitional zones might occur where the fiber densities slowly change from one fiber density to another. Hence, between one region of low fiber density and any surrounding regions, there might occur regions of still-lower fiber densities when compared with more distant surroundings.
- 3.5 Consequently, the use of a dandy roll does not guarantee, contrary to the respondent's reasoning, that an embossed watermark with a lower fiber density is necessarily surrounded by an immediately neighbouring region having a similar or increased fiber density relative to surrounding regions of the sheet material, which in addition might be associated as part of the watermark.
- 3.6 Therefore no direct and unambiguous conclusion can be drawn with regard to the realised fiber densities of

the various regions of the paper only from the fact that a watermark with low fiber density is manufactured using a dandy roll in a Fourdrinier method.

4. Novelty in view of document D5 - patent as granted
- 4.1 The opposition division decided that the subject-matter of claim 1 of the patent as granted lacked novelty over document D5 (Article 54(1) and (2) EPC).
- 4.2 It is undisputed between the parties that features M1, M2, M5 and M6 of claim 1 are disclosed in document D5. The dispute concerns the disclosure of the combination of features M3, M4 and M7 in relation to Figures 4 and 5 of document D5.
- 4.3 Disclosure of the embodiment of Figure 4 of document D5
- 4.3.1 The embodiment discussed in document D5 in relation to Figure 4 discloses a "*low grammage patch*" or a "*decorative watermark 29*", both of which can be created using a dandy roll (D5: page 7, last paragraph to page 8, first paragraph). No details are disclosed in document D5 of exactly how the filigree black and white parts shown in Figure 4 are created. Nor does the description provide any indication as to whether only the black parts of the filigree geometry represent the "*decorative watermark 29*" or whether the black and the white parts within the circumference of this filigree black-and-white geometry are part of the "*decorative watermark 29*".
- 4.3.2 Furthermore, nothing is disclosed with regard to the exact fiber densities of this "*decorative watermark 29*" besides the fact that it might be a "*low grammage*

patch", which is understood to indicate a region with lower fiber density than its surrounding regions.

- 4.3.3 Claim 8 of document D5 defines that the "*low grammage area*" can be a "*watermark 29*". Based on this understanding, the skilled reader might conclude that the "*watermark 29*" as such can have lower fiber densities over its whole region(s), as argued by the appellant. However, it cannot be concluded from claim 8 that the "*watermark 29*" must be a "*low grammage area*". Moreover, claim 8 leaves it open whether the "*decorative watermark 29*" shown in Figure 4 of document D5 consists of two regions (the black and the white regions of the filigree) both having lower densities compared with the surroundings or having different fiber densities, e.g. densities as defined by features M3 and M4. Nothing of this kind can be deduced from the disclosure of document D5 with respect to the embodiment shown in Figure 4.
- 4.3.4 These two different areas, i.e. the black and the white parts of the filigree, could both have lower fiber densities and thus correspond to a "*low grammage patch*" if the black and the white parts of the filigree are considered to represent the "*decorative watermark 29*". Hence there is no direct and unambiguous disclosure that the "*decorative watermark 29*" must implicitly have first and second regions, i.e. black and white regions, with fiber densities as defined by features M3 and M4.
- 4.3.5 Hence the respondent's reasoning that the "*decorative watermark 29*" necessarily comprises features M3 and M4 because it is created using the Fourdrinier method is not convincing. Reference is made to point 3. with sub-points above.

- 4.3.6 Therefore the board concludes that the embodiment of Figure 4 lacks at least feature M4.
- 4.4 Disclosure of the embodiment of Figure 5 of document D5
- 4.4.1 The description of document D5 is rather short with regard to the embodiment of Figure 5. It only refers to this embodiment on page 8, fourth paragraph. A "watermark 37" is surrounded by an "outline or frame 36" made out of a transparentising resin. Therefore feature M7 is anticipated by the "outline or frame 36" shown in Figure 5. The disclosed "watermark 37" is composed of a single region and can be realised by a "low grammage patch". Hence feature M3 is disclosed in this embodiment.
- 4.4.2 The description of document D5 is, however, silent on the characteristics of the zone between the "watermark 37" and the "outline or frame 36". Whether this zone is part of the watermark or not remains unspecified. This region might be seen as a part of the watermark, representing a second region of the watermark. However, in that case, nothing is disclosed regarding its fiber density. The conclusion that the fiber density of this zone must be equal to or higher than that of the surrounding regions has no direct and unambiguous basis in the disclosure of document D5. The fiber density could also be lower than the surrounding region (see explanations with regard to the Fourdrinier manufacturing method set out under point 3. with sub-points above).
- 4.4.3 In the board's view, it is also not allowed on the one hand to consider the region between the "outline or frame 36" and the "watermark 37" as being part of a watermark and on the other hand to conclude that, since

the dandy roll only creates the watermark in the zone of "watermark 37", the fiber density in the zone between the "outline or frame 36" and the "watermark 37" must be similar or higher compared with the surrounding regions since it is part of the "normal" surrounding paper. If this zone is regarded as part of the watermark, its fiber density should also be assessed independently from that of the surrounding zones farther away, i.e. outside the "outline or frame 36", and not simply by reference to the zones surrounding the "watermark 37" in general.

4.4.4 Therefore the embodiment of Figure 5 has either a watermark being limited to the "watermark 37" and having only one region with lower fiber density and no second region at all, or a watermark having first and second regions with one region having a lower fiber density than the surrounding zones, namely the region shown in Figure 5 as "watermark 37", and a second region, namely the zone between the "outline or frame 36" and the "watermark 37", the fiber density of which is not specified. Even if this second region has a fiber density which can only be one out of a limited number of possible alternatives (i.e. lower than, same as or higher than the paper as a whole), this remains a question of inventive step and not of novelty. Hence there is no direct and unambiguous disclosure in document D5 that the second region, i.e. the zone between the "outline or frame 36" and the "watermark 37", has a similar or increased fiber density compared with the surrounding regions of the paper.

4.4.5 Moreover, it cannot be concluded, as the respondent did, that the manufacturing process of the "watermark 37" necessarily and implicitly creates the

second region, i.e. the zone between the "*outline or frame 36*" and the "*watermark 37*" with all the characteristics as defined by feature M4 only due to the mobility of the fibers and functioning of the Fourdrinier method using a dandy roll. Reasons therefor are given under point 3. with sub-points above.

- 4.4.6 The fiber density in the zone between the "*outline or frame 36*" and the "*watermark 37*" consequently remains unspecified, so the embodiment of Figure 5 of document D5 discloses features M3 and M7, but not feature M4.
- 4.5 Claim 1 is consequently new over the teaching of document D5, since feature M4 is missing in the relevant two embodiments. There is also no further general disclosure or indication that a second region is provided which is part of the watermark and which complies with the characteristics defined by feature M4. All the other features of claim 1 are disclosed in document D5, at least in the embodiment of Figure 5.
- 5. Remittal to the department of first instance
 - 5.1 Since the subject-matter of claim 1 of the granted patent is new over the teaching of document D5, the next step is the assessment of inventive step. To this end, the appellant requested that the case be remitted to the department of first instance for further prosecution.
 - 5.2 According to Article 11 RPBA, remittal of the case for further prosecution is possible if "*special reasons*" are present for doing so.
 - 5.3 In accordance with the appellant's reasoning, the board agrees that inventive step has not been dealt with in

detail by the opposition division since neither with regard to the main request, i.e. the patent as granted, nor with regard to any of the auxiliary requests was inventive step discussed in detail during the first-instance proceedings. The opposition division's decision, if the matter was discussed in substance in view of Article 52(1) EPC, was based on lack of novelty alone and not on lack of inventive step. The fact that inventive step has not been discussed in detail in the first-instance proceedings and must now be discussed for the first time constitutes "*special reasons*" within the meaning of Article 11 RPBA.

- 5.4 In addition, the board agrees with the appellant that the general objective of the proceedings before the Boards of Appeal is a judicial review of the first-instance decision. This is not possible if the matter is now decided on by the board for the first time.
- 5.5 The appellant also argued that, due to the rather strict rules of procedure of the Boards of Appeal, it might be particularly disadvantaged if it were not allowed to go through a two-stage procedure, thereby having the possibility of a judicial review.
- 5.6 The respondent also agreed to remittal of the case to the department of first instance for further prosecution.
- 5.7 The board consequently concludes that "*special reasons*" within the meaning of Article 11 RPBA are present, so the board grants the appellant's request for remittal of 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:



A. Vottner

M. Papastefanou

Decision electronically authenticated