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**Datasheet for the decision  
of 12 October 2006**

**Case Number:** T 0354/05 - 3.2.05

**Application Number:** 98943582.1

**Publication Number:** 0946374

**IPC:** B44F 1/12

**Language of the proceedings:** EN

**Title of invention:**

Tamper-evident form for securely carrying information

**Patentee:**

Documotion Research Inc.

**Opponents:**

Digikett Formular-Etikettendruck und Laminiertechnik GmbH  
Michel Lata / Folien Fischer AG

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 83, 54, 56

**Keyword:**

"Sufficiency of disclosure (yes); Prior uses proven up to the hilt (no); Novelty (yes); Inventive step (yes)"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0354/05 - 3.2.05

**DECISION**  
of the Technical Board of Appeal 3.2.05  
of 12 October 2006

**Appellant:**  
(Patent Proprietor)

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(Opponent 01)

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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
20 January 2005 concerning maintenance of the  
European patent No. 0946374 in amended form.

**Composition of the Board:**

**Chairman:** W. Moser  
**Members:** W. Widmeier  
P. Michel  
W. Zellhuber  
H. Preglau

## Summary of Facts and Submissions

I. The appellant (patent proprietor) lodged an appeal against the interlocutory decision of the Opposition Division maintaining European patent No. 0 946 374 in amended form.

Oppositions had been filed against the patent as a whole based on Article 100(a) EPC (lack of novelty, Article 54 EPC, and lack of inventive step, Article 56 EPC) and Article 100(b) EPC.

II. Oral proceedings were held before the Board of Appeal on 12 October 2006.

III. The appellant requested that the decision under appeal be set aside and that, as a main request, the patent be maintained in the form as granted; or, as first auxiliary request, the case be remitted to the Opposition Division with the order to request the competent Court in France to re-examine the evidence given by Mr Destere by hearing Mr Destere again on oath or in an equally binding form in accordance with Article 117(5) EPC and to decide on this case thereafter; or the Board itself orders that Mr Destere be heard before a French court in accordance with Article 117(5) EPC, and then takes a decision; or that the Board hears Mr Destere again; or, as second to sixth auxiliary requests, that the patent be maintained on the basis of the claims filed respectively as second to sixth auxiliary requests on 11 October 2006.

IV. Respondents I and II (opponent 01 and co-opponents 02) requested that the appeal be dismissed.

V. Claim 1 of the main request reads as follows:

"1. A tamper-evident form characterised by:-

an upper transparent lamina (6A, 6B, 6C, 6D, 6E, 6F, 6G), the upper surface of the upper transparent lamina being adapted to receive printed information from a printer, and

a lower non-transparent lamina (2A, 2B, 14C, 14D, 2E, 14F, 14G) bearing scrambling means (4A) visible through the upper transparent lamina, the scrambling means being selected such that information printed on the upper surface of the upper transparent lamina cannot be read whilst the lower non-transparent lamina bearing the scrambling means is beneath the printed information on the upper surface of the upper transparent lamina,

wherein the upper transparent lamina and lower non-transparent lamina are bonded together,

and wherein information printed on the upper surface of the upper transparent lamina becomes readable when the bond between the upper transparent lamina and lower non-transparent lamina is broken and the upper transparent lamina and lower non-transparent lamina are physically separated, said physical separation causing an indication that the security of information printed on the upper surface of the upper transparent lamina has been breached."

VI. This decision refers to the following documents:

D1: Sample of a Green International Insurance Card

D7: Exhibition catalogue "MAG Systèmes, EXPO MAG '96,  
Guide de l'exposition"

D18: Declaration of Philip Barton concerning a PIN  
mailer presented by WFC at the Oval Cricket Ground,  
London

D19: Copy of a letter of WFC Business Forms to National  
Australia Group concerning laser printing of  
Personal Identification Numbers

E1: Sample of a payslip

P16: Minutes of the oral proceedings of 17 July 2002  
before the District Court Hamburg

Z1: US-A-5,029,901

VII. The appellant argued essentially as follows:

A person skilled in the art can carry out the subject-matter of claim 1 of the main request even if it is taken into consideration that, by means of special tools and methods, it is possible to read the information printed on the upper surface of the upper transparent lamina whilst the scrambling means are still beneath. The corresponding feature of claim 1 of the main request does not mean that it must be impossible to read the information under any circumstances. The patent in suit contains therefore sufficient information to enable the skilled person to carry out the invention.

In the present case there is not any written prior art. All evidence submitted by the respondents is based on testimonies of various witnesses so that it is impossible to provide counterproof. These testimonies, which should not be considered in isolation from each other but in conjunction, include many contradictions and insufficiencies.

No physical evidence was submitted to support Mr Destere's testimony. Document D1 was admittedly produced after the priority date of the patent in suit (cf. document P16, page 2) so that it does not constitute prior art. The features of the so-called MAG96-card have not been shown clearly. Mr Destere could not remember how this card was made tamper evident so that it is doubtful whether this feature was present. It is thus not possible to construct from Mr Destere's testimony a subject-matter for a comparison with the subject-matter of claim 1. Document D7 (cf. pages 78 to 81) shows that what was exhibited at the EXPO MAG '96 on the stand of Michel Lata was the SESAM card, which is different from what was described by Mr Destere as the MAG96-card.

Likewise, not any document has been presented to support Mr Bornhöft's testimony. Document E1 which is supposed to correspond to the payslip referred to in Mr Bornhöft's testimony does not show all features of the subject-matter of claim 1 of the main request. Mr Bornhöft could not remember in detail what he had seen in his office. He was not even interested in the sample sent to him by Mr Bracht.

The third prior use brought forward by co-respondents II is to be considered late filed evidence and thus to be ignored. Apart from that, no sample of the subject-matter of the prior use, a PIN mailer, has been presented. The features of this PIN mailer are therefore unknown.

Thus, none of the three prior uses has been substantiated sufficiently so that they cannot put novelty of the subject-matter of claim 1 of the main request into question.

Document Z1 does not disclose an upper transparent lamina. Thus it cannot disclose scrambling means which are visible through an upper transparent lamina. The subject-matter of claim 1 of the main request has a clear advantage over document Z1 because the information printed on the upper lamina is hidden immediately whereas it needs three steps to achieve this with the form of document Z1. The subject-matter of claim 1 of the main request therefore involves an inventive step.

VIII. Respondent I and co-respondents II argued essentially as follows:

There exist many ways to make the information printed on a transparent lamina readable even if there are scrambling means beneath. The patent in suit, however, does not teach a person skilled in the art how to prevent this and thus how to realize the feature that the information printed on the upper surface of the upper transparent lamina cannot be read whilst the lower non-transparent lamina is beneath the printed



information. This requires special materials for the upper lamina and for the toner used for printing the information. These materials are not mentioned in the patent in suit and were unknown at the priority date of the patent in suit. The skilled person is therefore not able to put the subject-matter of claim 1 of the main request into practice so that the requirement of Article 83 EPC is not met.

The fact that the testimonies of the witnesses comprise contradictions cannot be used to put the credibility of the witnesses into question. On the contrary, this supports their credibility because it is normal that after so many years they cannot remember exactly and completely what they saw.

The green insurance card shown as a reproduced sample by document D1 will in use be destroyed so that it was not possible to provide samples which had been produced before the priority date of the patent in suit. Thus, although document D1 does not constitute prior art, it shows the features of the MAG96-card exhibited on the EXPO MAG '96. Mr Destere could not remember how tamper evidence was realized in this card. However, he could remember that it was tamper evident. This is because it was Mr Destere's aim at that time to replace wire printers by laser printers rather than to achieve tamper evidence. Thus, the details of the latter were not important for him. Apart from that, tamper evidence is a self-evident feature in combination with such cards (cf. paragraph [0004] of the patent in suit) so that it was also a feature of the MAG96-card.

It is irrelevant whether or not Mr Bornhöft was interested in the payslip sent to him by Mr Bracht. He saw a sample of this payslip in his office and could remember details of it. Document E1, whose production date is unknown, but which corresponds to the payslip Mr Bornhöft had seen, shows all features of the subject-matter of claim 1 of the main request.

Due to confidentiality agreements, the third prior use, a PIN mailer of WFC Business Forms, could not be presented earlier. This prior use is relevant and should therefore have been admitted into the procedure by the Opposition Division. Document D18 shows the features of this PIN mailer. It follows that this PIN mailer corresponds to the subject-matter of claim 1 of the main request.

Thus, the subject-matter of claim 1 of the main request is anticipated by any of the three prior uses so that this subject-matter lacks novelty.

The subject-matter of claim 1 of the main request is based on the same effect as document Z1 which is mentioned in paragraph [0007] of the patent in suit, i.e. on scrambling means in the form of a camouflage image. As tamper evidence is also already realized in document Z1, no inventive step is needed to use this effect also in combination with a laser printer and thus to arrive at the subject-matter of claim 1 of the main request.

## Reasons for the Decision

### 1. *Article 83 EPC*

Respondent I argued that, by using, for example, an adhesive tape applied to, and then removed from, the upper transparent lamina, it would be possible to remove and to read the printed information without destroying the security indicator. It would therefore be necessary to use special materials for the transparent lamina and for the toner of the printer to avoid this, and to realize the feature of claim 1 of the main request that the information printed on the upper surface of the upper transparent lamina cannot be read whilst the lower non-transparent lamina is beneath the printed information. The patent in suit does not comprise information about these materials, so that the subject-matter of claim 1 of the main request could not be carried out.

The Board cannot follow this argument. Claim 1 of the main request specifies that, while the scrambling means of the lower lamina is beneath the printed information of the upper transparent lamina, this information cannot be read. The suggestions made by respondent I as to how to make the information readable, are not in line with the wording of the claim. The claim specifies that the information cannot be read; it does not say that the information cannot be made readable by special tools or methods. Thus, for carrying out the subject-matter of claim 1 of the main request it is sufficient for a person skilled in the art to know, with respect to this feature, that a transparent lamina carrying printed information on its upper surface is placed

above a non-transparent media which carries scrambling means. This information is even comprised in the claim itself. The Board is therefore satisfied that the subject-matter of claim 1 of the main request meets the requirements of Article 83 EPC.

2. *Prior Use*

2.1 The objections of respondent I and co-respondents II under Article 54 EPC are based on three alleged prior uses. In the appeal procedure, the respondents relied on the testimonies of Mr Bornhöft concerning the prior use of a payslip, and Mr Destere concerning the prior use of a green insurance card, and on documents D18 and D19 concerning the prior use of a PIN mailer.

2.2 Respondent I admitted that there is no evidence that the sample of a payslip designated as document E1 is the one Mr Bornhöft has seen. Co-respondents II admitted that the sample of a green insurance card designated as document D1 is not the one which Mr Destere has seen on the EXPO MAG '96.

Thus, documents E1 and D1 cannot be considered prior art within the meaning of Article 54(2) EPC and have therefore to be disregarded.

2.3 If a prior use is substantiated exclusively by testimonies of witnesses, as is the case with respect to the green insurance card and the payslip, it must be proven up to the hilt what has been used. If, in the absence of any support of the testimonies by prior art documents or subjects, the slightest doubt exists as to the features of the subject of the prior use or the

circumstances of the prior use, then such a prior use cannot be considered to be proven up to the hilt und must be judged to be insufficiently substantiated. It is to be noted that the burden of proof lies entirely with the party which submits the alleged prior use rather than with the counter party.

- 2.4 Mr Bornhöft could not describe all the details of the payslip he had seen in his office. He said that he assumes that document E1 was identical to the one he saw (cf. testimony of Mr Bornhöft, page 6, fourth paragraph). This means that he could not remember this payslip well. Otherwise he would have said either that it was the payslip he had seen or it was not. Especially, Mr Bornhöft was not able to give details about how the upper and lower laminas were connected to each other (cf. testimony of Mr Bornhöft, page 7, fourth paragraph). He said that one could read the information printed on the upper lamina by tearing the payslip and inserting the torn part between the lower and the upper lamina (cf. testimony of Mr Bornhöft, page 7, fourth paragraph, and page 8, third paragraph). However, he did not say whether it was possible to read the information without tearing the payslip (e.g. by arching the upper lamina from the lower lamina) and whether it was possible to separate the upper lamina from the lower lamina without destroying them and to attach them together again. Thus, he could not confirm definitely that the information printed on the payslip could not be read whilst the lower lamina is beneath the upper lamina and that the payslip was tamper evident.

2.5 Mr Destere declared that the document he had seen on the EXPO MAG '96 (designated by the Opposition Division as "MAG96-card") was tamper evident. However, Mr Destere could not remember definitely how this feature was realized (cf. testimony of Mr Destere, page 68, third paragraph to page 69, first full paragraph). Mr Destere said that the transparent layer carrying the information and the non-transparent layer carrying the scrambling means were attached to each other by an adhesive and that after removal of the non-transparent layer it was not possible to re-attach the removed part. However, he could not explain why it could not be re-attached. Mr Destere only was aware of the various methods of making documents tamper evident. However, he could not say which of these known methods was used in combination with the MAG96-card (cf. page 68, third paragraph). Moreover, tamper evidence in combination with a green insurance card of the kind as described as MAG96-card is not necessary because, as explained by respondent I and co-respondents II, the card is attached to the windshield of a car with all information visible. The problems of the then existing insurance card mentioned by Mr Destere (cf. testimony of Mr Destere, page 65, second paragraph) were counterfeiting and misuse of such cards rather than a protection against reading a number and an indication that it has been read. This number, if printed on the outside of the transparent layer, can be manipulated without the need to remove the non-transparent layer carrying the scrambling means. It is therefore doubtful whether the MAG96-card was in fact tamper evident within the meaning of claim 1 of the main request. It has to be repeated in this respect that the burden of proof lies entirely with the party which submitted the

prior use, i.e. respondent I and co-respondents II. It is not the burden of the counter party, i.e. the appellant, if doubts exist, to prove the contrary.

2.6 The third alleged prior use relates to a PIN mailer which, according to document D18, was presented to a group of persons on 22 August 1997 at the Oval Cricket Ground, London. It is not clear from document D18 whether or not this presentation was confidential. Normally, business gatherings at places such as mentioned in document D18 are confidential. Moreover, the details in document D18 as to the features of the PIN mailer are rather vague. It cannot be derived from these details whether the PIN mailer consisted of a lower non-transparent and an upper transparent layer, whether the scrambling means were comprised on the lower non-transparent layer and whether the information was printed on the upper surface of the upper transparent layer. These features are also not derivable from document D19. Apart from that, there is no evidence that document D19 relates to the same PIN mailer as mentioned in document D18. Moreover, document D19 was communicated under a confidentiality agreement (cf. bold printed sentence on page 1 of document D19). Thus, it is neither evident whether the prior use of the PIN mailer took place in public nor what exactly has been used.

2.7 Summarizing, the testimonies of Mr Bornhöft and Mr Destere referred to in the appeal procedure and documents D18 and D19 do not prove the respective alleged prior uses up to the hilt. These prior uses cannot therefore be considered to represent prior art within the meaning of Article 54(2) EPC. It is, for

this reason, not necessary to examine the relevance of the contentions of respondent I and co-respondents II in that respect.

3. *Novelty*

It follows from point 2 above that the subject-matter of claim 1 of the main request is to be considered novel and thus to fulfil the requirements of Article 54 EPC because no other prior art has been cited by the respondents with respect to the issue of novelty.

4. *Inventive step*

Document Z1, which is considered by co-respondents II to render the subject-matter of claim 1 of the main request obvious, discloses confidential information bearing articles consisting of a base sheet and a cover sheet. In all described embodiments, the information is printed on the inside of the base sheet and/or cover sheet or on a separate sheet between the base and cover layer, and the scrambling camouflage image and an opaque coating are printed on the outsides or, in one embodiment, on the insides of base sheet and cover sheet (cf. column 4, lines 3 to 14 and 46 to 51; column 4, line 62 to column 5, line 2; and column 5, lines 16 to 25 and 32 to 42). Document Z1 cannot therefore render an information bearing article obvious where the cover sheet is transparent and where the information is printed on the outside of the cover sheet as is the case with the subject-matter of claim 1 of the main request. This subject-matter thus involves an inventive step (Article 56 EPC).



**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The patent is maintained as granted.

The Registrar:

The Chairman:

D. Meyfarth

W. Moser