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**Datasheet for the decision
of 15 September 2021**

Case Number: T 1273/16 - 3.2.05

Application Number: 10736810.2

Publication Number: 2435255

IPC: B42D15/10, G09F3/02

Language of the proceedings: EN

Title of invention:

Anti-counterfeit device for valuable documents

Patent Proprietor:

Centro Grafico DG S.p.A.

Opponent:

Leonhard Kurz Stiftung & Co. KG

Relevant legal provisions:

EPC Art. 100(c), 123(3)
RPBA Art. 12(4)

Keyword:

Extension beyond content of application as filed (yes: main request)
Admittance of the auxiliary requests (yes)
Extension of the scope of protection (yes: all auxiliary requests)



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Case Number: T 1273/16 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 15 September 2021

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 18 March 2016
rejecting the opposition filed against European
patent No. 2435255 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman P. Lanz
Members: O. Randl
A. Bacchin

Summary of Facts and Submissions

- I. The opponent filed an appeal against the decision of the opposition division rejecting the opposition against European patent No. 2 435 255 ("the patent").
- II. The oral proceedings before the board took place on 15 September 2021. As announced in a letter dated 4 May 2021, the respondent was not represented at the oral proceedings. The proceedings were continued in application of Rule 115(2) EPC and Article 15(3) of the Rules of Procedure of the Boards of Appeal in the version of 2020 (RPBA 2020).
- III. The appellant (opponent) requested that the decision under appeal be set aside and the patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed. Alternatively, the respondent requested that the appeal be set aside and that the patent be maintained in amended form on the basis of the claims filed as auxiliary requests 1 to 11 by letter of 13 January 2016.

- IV. Claim 1 of the patent reads as follows (the feature references used by the appellant are indicated in square brackets):

"**[A]** A multilayer anti-counterfeit device comprising consecutively:

- **[B1]** a carrier layer (1);
- **[B2]** a layer (a) of release lacquer permitting the detaching of the subsequent layers;
- **[C1]** an anti-scratch layer (b) made of lacquers resisting to scratches;

- [C2] a durable layer (c) made of lacquers resisting to chemical attacks;
- [D1] a layer (d) made of an embossing lacquer and provided with engraved holographic or not holographic diffractive areas;
- [E1] a metalized reflecting layer (e);
- [F1] at least one layer (f) provided with registered prints ;
- [C3] at least one barrier layer (g) made of durable lacquers;
- [B3] an adhesive layer (h); and
- [B4] a sub layer (2) for the application of said anti-counterfeit device,

characterized in that

- [D2] the embossing lacquer layer (d) provides holographic or not holographic diffractive areas alternating with not diffractive areas;
- [E2] said underlying metalized reflecting layer (e) is provided only below and in correspondence with said diffractive areas;
- [F2] the at least one layer (f) provided with registered prints is arranged only in correspondence with the not diffractive areas and adjoining the metalized reflecting area (e) which is provided only in correspondence with said diffractive areas;
- [F3] a window, i.e. an area without the metalized reflecting area (e) through which the underlying prints localized only between said holographic or not holographic diffractive areas are visible in transparency;
- [C4] said at least one barrier layer (g) placed above said adhesive layer (h) being located below and in alignment with said reflecting layers (e)."

NB: The wording of the claim has been taken from the text intended for grant as annexed to the communication under Rule 71(3) EPC ("Druckexemplar"); claim 1 of the B1-publication appears to contain several errors.

Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that:

- the words "made of lacquers" are absent from feature C2
- features C3 and C4 have "one or more barrier layers" instead of "at least one barrier layer"
- feature F2 has "is positioned in between" instead of "adjoining"

Claim 1 of auxiliary request 2 differs from claim 1 of auxiliary request 1 essentially in that:

- the words "characterized in that" have been replaced by "wherein"
- features D2 and E2 have been moved
- features F2 and F3 were associated with feature F1
- features C3 and C4 were brought together

Claim 1 of auxiliary request 3 differs from claim 1 of auxiliary request 1 in that:

- the word "consecutively" is absent from feature A
- the words "the layer (a) of release lacquer below the carrier layer (1)", "the anti-scratch layer (b) below the layer (a) of release lacquer", "the durable layer (c) below the anti-scratch layer (b)", "the embossing lacquer layer (d) below the durable layer (c);" and "below the embossing lacquer layer (d)" have been added at the end of feature B2, C1, C2, D1 and E1, respectively
- the words "below the embossing lacquer layer (d)" were added to feature F2

Claim 1 of auxiliary request 4 differs from claim 1 of the main request in that:

- the words "made of lacquers" are absent from feature C2
- the words "made with normally visible pigments and dyes, inks which are visible under ultraviolet and/or infrared light, thermo-chromic pigments, photo-chromic pigments, iridescent and optically variable or not variable pigments" (feature F1') were added at the end of feature F1

Claim 1 of auxiliary requests 5, 6 and 7 differ from claim 1 of auxiliary requests 1, 2 and 3, respectively, by the addition of feature F1'.

Claim 1 of auxiliary requests 8 to 11 differ from claim 1 of auxiliary requests 4 to 7, respectively, by the additional feature "wherein the metalized reflecting layer (e) is transparent or semi-transparent and between it and the barrier layer (g) a further layer (e') is inserted so as to partially or totally cover the holographic area bearing graphisms printed such that they are visible through the transparent or semi-transparent metalized layer (e)".

V. The parties argued as follows.

(a) Main request: Added subject-matter

(i) Appellant (opponent)

Claim 1 of the patent is based on original claim 1, which was substantially amended during the examination procedure.

Feature A

Feature A of claim 1 as granted has been amended with respect to the original claim 1 by the addition of the feature "consecutive layer" [sic]. Consequently, the following layers have to be arranged consecutively in the anti-counterfeit device: the "carrier layer" is followed by the "release lacquer", the "anti-scratch layer", the "durable layer", the "layer made of an embossing lacquer", the "metallized [sic] reflecting layer", the "at least [sic] one layer provided with registered prints", the "barrier layer", the "adhesive layer" and finally the "sub layer". This sequence of layers is not disclosed in the original application. Even if the representation in Figure 1 were to be used as support, (i) layer f is not arranged between layers e and g, (ii) the adhesive layer is not followed by a "sub-layer for the application of said anti-counterfeit device", and (iii) no "multilayer anti-counterfeit device" is shown which contains such a layer (feature A: "comprising"). In the embodiment of Figure 1, the security element consists of the layers shown there (see also page 4, second paragraph of the original Italian application: "formato dai seguenti strati") so that the open enumeration in granted claim 1 according to feature A constitutes an inadmissible intermediate generalisation. A "reinterpretation" of this feature so that it does not apply to layer f is not possible because feature F2 does not make any specification with regard to the vertical arrangement of the layers; it only does so with regard to the horizontal arrangement.

Feature D1

This feature is not disclosed in the original application. In the technical field under consideration, "engraved" refers to a process in which material is removed from the surface to be processed by means of a tool, i.e. a special machining process for introducing a relief structure. A relief structure can also be provided, for example, by a displacing process. In original claim 1, however, only a "lacca permettente la goffratura in rilievo" is mentioned. Also, in the passage of the description on page 5, lines 4 to 13, there is no reference to the insertion of the structures by means of "engraving". Even if the opposition division's view - that the feature "embossing lacquer" is disclosed by the originally filed application - were to be accepted, the inclusion of the structures by means of "engraving" is in any case not supported by the original application.

Feature B4

The opposition division's opinion that the inclusion of this feature is supported by the original figures and the "substrato (2)" shown in these figures is incorrect. The terms "substrates" and "sub-layer" have a different meaning. The "substrato (2)" shown in the figures is precisely not part of the "dispositivo anticontraffazione multistrato", as is clear from the figures and the figure description (page 4, third paragraph). A corresponding sub-layer, which is part of the "multilayer anti-counterfeit device" and supports it, is not apparent to the skilled person from the figures and the relevant figure description.

Feature D2

The inclusion of feature D2 is not supported by the originally filed application documents. The feature "lo strato (d) presenta aree olografiche groffate ubicate in zone delimitate che si alternano con aree non olografiche" of original claim 1 does not contain any indication that diffractive areas alternate with non-diffractive areas. The subsequent features of original claim 1 ("strati (f) che sono localizzati unicamente in corrispondenza di aree non diffrattive che non sono in corrispondenza di aree olografiche o non olografiche" "gli strati riflettenti essendo presenti solo in corrispondenza di dette aree diffrattive") at best disclose that the layers f are arranged corresponding to non-diffractive areas and not corresponding to holographic or non-holographic areas. There is no disclosure of an alternating arrangement of holographic or non-holographic diffractive areas and non-diffractive areas. Furthermore, it is clear from the feature on page 10, lines 20 to 23, that holographic areas alternate with non-holographic areas. This is completely different from feature D2. Furthermore, there is no contradiction which could justify a "reinterpretation" in line with feature D2.

Feature F2

This feature is not supported by original claim 1. The corresponding text passage only contains statements to the effect that one or more layers f are arranged between layers e, but not that one or more layers f are "adjoining the metalized reflecting area". An "arrangement between" and an "adjoining to" have a different technical meaning. In the case of an "arrangement between" ("disposti tra"), it is mandatory

that metallic reflecting layers are provided on both sides of the one or more layers f. It is also possible that even larger areas are provided between the layer f and the metallic reflective layers in which neither of these two layers are provided, or that further layers are provided. The meaning of "adjoining the metalized reflecting area" is that the layers f are directly adjacent to a metallic area, i.e. that they have a common boundary line. No empty space and no further layers are provided between the "metalized reflecting area" and the "layer provided with registered prints". Furthermore, the term "adjoining" only requires that the "at least one layer provided with registered prints" be adjacent to the "metalized reflecting area" on one side. This is in contrast to the meaning of the feature "between metalized reflecting layers", which requires an arrangement between layers and thus is a two-sided limitation.

Feature F3

This feature is not supported by the original application. Original claim 1 requires that a window be formed by the plurality of holographic or not holographic diffractive areas. The original wording "formata tra le varie aree diffrattive olografiche o non olografiche" corresponds to a completely different technical concept than feature F3. Furthermore, the figures are merely sectional representations and thus cannot provide any information about the shape of the layers when viewed from above.

(ii) Respondent (patent proprietor)

Feature A

Granted claim 1 requires that layer f be positioned below layer d in correspondence with the not diffractive areas of it adjoining metallised reflecting areas e, which in turn are below and in correspondence with the diffractive areas of the embossing lacquer layer d alternating with the not diffractive areas of the embossing lacquer. Put differently, reflecting areas e alternate with registered prints f below layer d. Hence, both layers e and f are below layer d. Moreover, claim 1 requires that the barrier layer g be positioned below and in alignment with reflecting layers e. It follows that layers d, e, f and g are arranged according to the original disclosure of the application, for instance, shown in Figure 1, i.e. they are not arranged strictly "consecutively". This may appear in contradiction with the word "consecutively" added in claim 1, thus rendering claim 1 as granted unclear. However, the characterising portion of claim 1 indicates a different relative arrangement of the layers clearly supported by the application as filed. The addition of the word "consecutively" can be seen as a problem of clarity under Article 84 EPC, but lack of clarity is not a ground for opposition. Moreover, according to the headnote of decision T 23/86, "[t]he question of whether a claim is 'clear' in the sense of Article 84 EPC must be looked at in opposition proceedings only if the patent proprietor has made amendments referred to in Article 102(3) EPC [1973]. Otherwise, the claim should be understood as it stands, having regard if necessary to the description and drawings". This principle is also clearly stated in the Guidelines, D-V,5, which refer to decision G 3/14:

"Clarity is not a ground for opposition. Opposition proceedings are not designed as a procedure for generally amending (or revoking) patents that contain any kind of defect, and therefore opposition proceedings are not to be regarded as a continuation of examination proceedings. As a general rule this means that a granted claim has to be lived with even if new facts (e.g. new prior art) demonstrate that the claim is unclear ..." Regarding the sub layer 2, feature B4 means that the sub layer 2 is the target substrate of the device where the device is to be applied, i.e. it is not comprised by the anti-counterfeit device, as clearly disclosed for instance in Figure 1 of the original application. Again, this can only be seen as a clarity issue. Consequently, the addition of the word "consecutively" does not constitute added subject-matter.

Feature D1

Page 5, lines 11 to 13, of the original Italian description reads: "Nello stesso strato vengono incise, solo in zone delimitate, le strutture diffrattive olografiche o non olografiche otticamente variabili." In Italian, the word "incise" exactly defines a removal process. Thus, feature D1 is fully supported by the application as filed.

Feature B4

The sub layer 2 is the target substrate of the device where the device is to be applied, i.e. it is not part of the anti-counterfeit device, as clearly disclosed for instance in Figure 1 of the application as filed. It is not clear why the word "sub layer" should be interpreted as a partial layer. In Italian, the word

"substrato" is the combination of the words "sub" (from Latin, "sub" is a prefix indicating "below") and "strato", which is commonly translated as "layer". Therefore, "sub layer" is nothing more than the literal translation of the word "substrato". Therefore, feature B4 is fully supported by the application as filed.

Feature D2

This feature is supported by original claim 1 (in Italian), in combination with page 5, lines 11 to 13, of the description. From these passages of the original application, it is clear that diffractive areas alternate with not diffractive areas and that diffractive areas can be either holographic or not holographic. Therefore, feature D2 is fully supported by the application as filed.

Feature F2

Original claim 1 (in Italian) states that below the layers d, one or more layers f provided with registered prints and/or graphics are provided positioned in between metallised reflecting layers e, located below the layer d and adjoining the one or more layers f located only at non-diffractive zones which do not correspond with holographic or not holographic areas, reflecting layers being provided only in correspondence with the diffractive areas. According to the Collins Online Dictionary, the main definition for "adjoin" is "to be next to" or "to be contiguous to". As shown above, original Italian claim 1 says both that layers f are positioned in between reflecting layers e and that layers e are contiguous to/adjoin layers f. This implies that layers f adjoin layers e.

Feature F3

Original claim 1 (in Italian) refers to a window, i.e. an area through which the underlying print f is visible in transparency being formed between the various holographic or not holographic diffractive areas d. Considering also the disclosure of the original description on page 2, lines 12 to 22, feature F3 is supported by the application as filed.

(b) Auxiliary requests: admittance and compliance with Article 123(2) (3) and Rule 80 EPC

(i) Appellant (opponent)

Auxiliary requests 1 to 11 should not be admitted to the proceedings. They are *prima facie* not suitable to overcome the objections under Article 123(2) EPC retained by the board in its provisional opinion. They also give rise to the following further objections.

Auxiliary request 1

The amendments made in claim 1 according to auxiliary request 1 give rise to objections under Rule 80 and Article 123(3) EPC. The replacement of "at least one barrier layer" with "one or more barrier layers" cannot remove a ground for opposition. Moreover, the deletion of the feature "made of lacquers" and the replacement of the feature "adjoining" with "is positioned in between" contravenes Article 123(3) EPC.

Auxiliary request 2

The objections raised with regard to auxiliary request 1 also apply to auxiliary request 2. Furthermore, it is

not apparent how the further amendments and reformulations made here are intended to remove a ground for opposition (Rule 80 EPC).

Auxiliary request 3

In addition to the objections already raised with respect to auxiliary request 1, the deletion of the word "consecutively" triggers an objection under Article 123(3) EPC.

Auxiliary request 4

The deletion of the feature "made of lacquers" triggers an objection under Article 123(3) EPC.

Auxiliary requests 5 to 7

The amendments made to claim 1 in these auxiliary requests trigger the objections under Article 123(3) and Rule 80 EPC mentioned above for auxiliary requests 1, 2 and 3.

Auxiliary request 8

The amendments made in claim 1 of auxiliary request 8 trigger the objections under Article 123(3) EPC raised above for auxiliary request 4.

Auxiliary requests 9 to 11

The amendments made in auxiliary requests 9 to 11 trigger the objections under Rule 80 and Article 123(3) EPC raised above for auxiliary requests 1 to 3.

(ii) Respondent (patent proprietor)

Auxiliary request 1

In the amended claim 1, the verb "adjoining" has been substituted by "positioned in between" which is supported by page 10, line 25, of original claim 1 (in Italian). Moreover, "at least one or more barrier layer g" has been substituted with "one or more barrier layers g", which is supported by the original claim 1 in Italian, lines 14 and 15.

Auxiliary request 2

In claim 1 according to auxiliary request 2, the distinction in the preamble and the characterising portion has been removed for clarity reasons. Apart from this, no words have been deleted, and no fresh parts have been added. Simply, portions of the claim have been moved to better positions, thus rendering the claim clearer. As the word "consecutively" has been maintained and no features have been added or deleted, the claim does not contravene Article 123(3) EPC.

Auxiliary request 3

The amendments of claim 1 are clearly supported by the application as filed (see Figures 1 to 3). The deletion of the word "consecutively" is justified in view of the jurisprudence of the boards (in particular, T 271/84 and T 108/91). A strictly literal interpretation of "consecutively" in granted claim 1 would be in contradiction with several claimed features. Amended claim 1 according to auxiliary request 3 reflects the sequence of layers given by the characterising portion of claim 1 as granted, which in turn reflects the true

structure of the multilayer anti-counterfeit device disclosed originally in the application considered as a whole. The proposed amendment removes the inconsistency explained above in claim 1 as granted and reflects the true disclosure of the application as a whole. In accordance with decisions T 271/84 and T 108/91, the above amendments do not contravene Article 123(3) EPC.

Auxiliary requests 4 to 7

These requests correspond respectively to the main request and auxiliary requests 1 to 3 in which a further limitation has been added based on original claim 2 (in Italian). This limitation further distinguishes claim 1 from the state of the art.

Auxiliary requests 8 to 11

These requests correspond respectively to auxiliary requests 4 to 7 in which a further limitation has been added. This amendment is supported by original claim 3 (in Italian). This limitation further distinguishes claim 1 from the state of the art.

Reasons for the Decision

1. Claim interpretation
- 1.1 What exactly is claimed?

Claim 1 concerns a multilayer anti-counterfeit device comprising several layers. The last layer mentioned (feature B4) is "a sub layer ... for the application of said anti-counterfeit device". This wording raises the question of whether this sub layer is part of the anti-

counterfeit device. The board has reached the conclusion that it cannot be because otherwise the claim would require the device to be applied to one of its parts, which is not technically meaningful. Nor is feature B4 worded such that the multilayer device is only required to be suitable for being applied to a sub layer. The only meaningful technical interpretation of claim 1 is that the claim concerns the assembly formed by the anti-counterfeit device and the sub layer onto which it is applied.

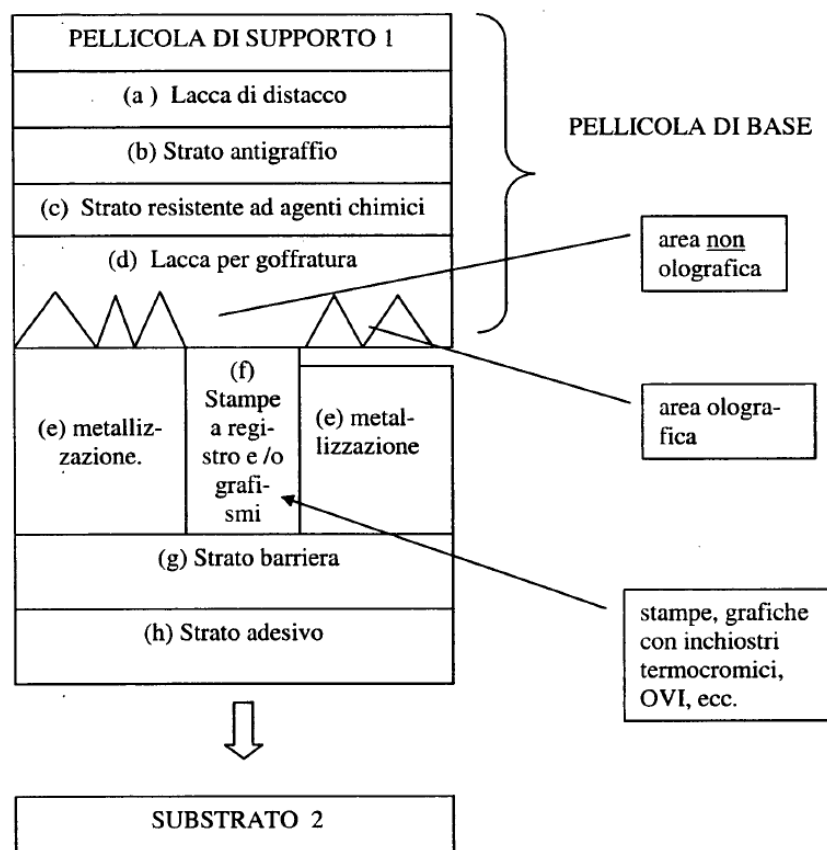
1.2 "comprising consecutively"

The preamble of claim 1 requires the anti-counterfeit device to comprise "consecutively" a carrier layer and layers a to h (but not the sub layer, see point 1.1). There is no definition of the term "consecutively" in the patent. The word "consecutively" is not even found once in the English translation of the original application, nor is its Italian equivalent (*consecutivamente*) found in the original application.

The Oxford English Dictionary (OED) defines the adverb "consecutively" as "in continuous succession, continuously". In the context of claim 1, it requires the device not only to comprise the various layers mentioned in the preamble but to comprise them in the very order in which they are cited.

Claim 1 also comprises feature F2, according to which layer f is arranged in correspondence with the not diffractive areas of feature D2 and adjoining the metallised reflecting area e, which is provided only in correspondence with the diffractive areas of feature D2. The skilled reader of claim 1 would understand that this requirement qualifies the "consecutiveness" of the

layers mentioned in the preamble of the claim by limiting it to layers 1, a to e, g and h. If there were any doubts in this respect, the skilled reader would refer to the description and see that the embodiment shown in Figure 1 of the patent exactly matches with this understanding of claim 1. In this device, the layers a to e, g and h are provided in consecutive order, but layer f is provided on the same level as layer e.



Thus, the skilled person would have understood that the anti-counterfeit device of claim 1 comprises a consecutive arrangement of layers a to h (with the exception of layer f) on a carrier layer, and that layer f is provided at a position "adjoining" layer e (for the interpretation of "adjoining", see point 1.5).

1.3 Feature F1: "registered prints"

According to feature F1, at least one layer is provided with "registered prints". In the particular context of security elements, the term "register" normally refers to the "exact correspondence of superimposed images" (OED). Paragraph [0009] of the patent contains a quasi-definition of "prints and/or graphisms" as "prints made by normally visible pigments and dyes, inks which are visible under ultraviolet and/or infrared light, thermochromic pigments, photo-chromic pigments, iridescent and OVI type-optically pigments". Thus, the board interprets "prints" as impressions that necessarily involve inks, dyes or pigments.

1.4 Feature C3: "barrier layer"

Paragraph [0009] of the patent offers a definition of what is meant by "barrier layer", namely "a layer made of resistant bi-component and/or UV-polymerizable lacquers, synthetic polymers, but preferably acrylic, polyurethane, epoxy resins, polyesters, with thicknesses ranging from 0.5 to 2 microns, but preferably from 0.6 to 1 microns". Feature C3 itself requires the barrier layer to be made of durable lacquers.

1.5 Feature F2: "adjoining"

Feature F2 requires layer f to be provided such that it is "adjoining" the reflecting layer e. According to the OED, the adjective "adjoining" can be defined as "adjacent, contiguous; neighbouring; (also) physically joined, attached, connected". The Italian equivalent ("adiacente") is not found in the original application.

Arguably, the word "adjoining" was chosen to translate the words "disposti tra" used in original claim 1 (see page 10, line 25), a literal translation of which would be "arranged between".

However, as pointed out by the appellant, the expressions "arranged between" ("disposti tra") and "adjoining" have different technical meanings because:

- if an element A is "arranged between" elements B, elements B have to be on both sides of element A, and there can be other elements C or gaps between elements A and B
- if element A is arranged "adjoining" element B, there has to be a common boundary, which excludes other elements C or gaps, and element B may be provided on only one side of element A

In the absence of any definition in the patent, the word "adjoining", which as such is clear, has to be interpreted according to its normal meaning, which is given above. The fact that it might have been intended to convey the meaning of "disposti tra" cannot lead to a different interpretation. Thus, the board has reached the conclusion that feature F2 requires that layer f be provided adjacent to the reflecting layer e.

1.6 Feature F3

Feature F3 is incomplete. As it stands, claim 1 states that the object of the preamble is "characterised in that ... a window ...". The board interprets it to mean that the claimed multilayer device plus the sub layer comprise a window as defined in feature F3.

2. Added subject-matter (Article 100(c) EPC)

For the purposes of applying Article 100(c) EPC, the "content of the application as filed" is that of the international application PCT/IT2010/000211 as filed, which, once accorded an international date of filing, is equivalent to a regular European application (Article 153(2) in conjunction with Article 70(2) EPC).

The English translation of claim 1 published in the A1-publication appears to be a translation of claim 1 of the Italian priority document rather than a translation of claim 1 of the original international application filed in Italian. However, as indicated above, the examination of the amendments in the context of Article 100(c) EPC is not based on the A1-publication but on the original international application.

In the course of the grant proceedings, claim 1 was considerably amended. The amendments of the English equivalent of original claim 1 and claim 1 as granted are shown below; additions are underlined, deletions are shown as crossed-out text (again, the feature references have been added in square brackets):

1. **[A]** A multilayer anti-counterfeit device comprising consecutively:
 - **[B1]** a carrier layer (1);
 - **[B2]** a layer (a) of release lacquer permitting the detaching of the subsequent layers;
 - **[C1]** an anti-scratch layer (b) made of lacquers resisting to scratches;
 - **[C2]** a durable layer (c) made of lacquers resisting to chemical attacks;

- [D1] a layer (d) made of an embossing lacquer and provided with engraved holographic or not holographic diffractive areas;
- [E1] a metalized reflecting layer (e);
- [F1] at least one layer (f) provided with registered prints;
- [C3] at least one or more barrier layers (g) made of durable lacquers;
- [B3] an adhesive layer (h); and
- [B4] a sub layer (2) for the application of said anti-counterfeit device, characterized in that
 - [D2] the embossing lacquer layer (d) presentsprovides embossed holographic or not holographic diffractive areas situated in delimited zones alternating with not-holographic diffractive areas;
 - [E2] said underlying reflecting metalized layer (e) is provided only below and in correspondence with said diffractive areas;
 - ~~below said layer (d) there are one or more layers (f) with registered prints and/or graphisms placed between metallised reflecting layers (e), below said layer (d) and contiguous to said one or more layers (f) which are located at not diffractive zones which do not correspond with holographic or not holographic areas, the reflecting layers being provided only in correspondence with said diffractive areas;~~
 - [F2] the at least one layer (f) provided with registered prints is arranged only in correspondence with the not diffractive areas and adjoining the metalized reflecting area (e) which is provided only in correspondence with said diffractive areas;
 - [F3] a window, i.e. an area without the metalized reflecting area (e) through which the underlying prints localized only between said holographic or not

holographic diffractive areas are visible in transparency;

- [C4] said at least one ~~the~~ barrier layers (g) placed above said adhesive layer (h) being located below and in alignment with said reflecting or not reflecting layers (e);

~~a window or area through which the underlying print (f) is visible, being formed between the various holographic or non holographic diffractive areas (d).~~

2.1 Feature A

The appellant takes issue with the addition of the word "consecutively" during the grant proceedings. The insertion of the word was proposed by the examining division, as can be seen from the text intended for grant as annexed to the communication under Rule 71(3) EPC ("Druckexemplar").

The opposition division dealt with this objection in point 4.2 of the Reasons for the decision under appeal:

"It was disputed if the word "consecutively" inserted in the second line of claim 1 conflicts with Art. 123(2) EPC, since originally layer (f) provided with registered marks is not disclosed to be located below metalized layer (e) as suggested by the word "consecutively". However, from feature F2 it is clear that layer f is not situated below layer e, but rather next to it (see § 4.1 here above). The insertion of "consecutively" has thus rather introduced a clarity problem (contradiction), which the skilled man can interpret only such that layer f is not situated below layer e, so that the word "consecutively"

does not apply to the relational position of these two layers.

The introduction of "consecutively" caused thus a clarity problem (which is not a ground for opposition), and not a problem according to Art. 123(2) EPC."

The board has explained above (see point 1.1) how it interprets feature A. It cannot find any fault in the opposition division's reasoning regarding this issue. The appellant's counter-arguments are based on an interpretation of claim 1 which the board cannot endorse. When the claim is understood as explained above (see points 1.1 and 1.2), the embodiment of Figure 1 provides a sufficient basis for the addition of the expression "consecutively".

The appellant also argued that if Figure 1 is used as a basis for supporting feature A in this embodiment, the security element consists of the layers shown there (see also the second paragraph on page 4 of the original Italian application documents: "... formato dai sequenti strati ..."). Thus, the open enumeration in the granted claim 1 according to feature A constitutes an inadmissible intermediate generalisation. The board shares this point of view. By inserting the word "consecutively", the applicant drew on the embodiment of Figure 1. However, this embodiment does not provide a sufficient basis for the "comprising" language of claim 1.

2.2 Feature D1

This feature was amended by the insertion of the words "and provided with engraved holographic or not holographic diffractive areas".

The appellant pointed out that there was no reference to the insertion of the structures by means of "engraving" in the original application.

The Italian equivalent of "engraved" is "inciso". The respondent referred to the sentence on page 5, lines 11 to 13, of the original application, which reads:

"Nello stesso strato vengono incise, solo in zone delimitate, le strutture diffrattive olografiche o non olografiche otticamente variabili;"
(underlining by the board)

In view of this disclosure, the board has reached the conclusion that feature D1 is supported by the original application.

2.3 Feature B4

This feature was already present in original claim 1. Therefore, it did not have to be included, and its alleged "inclusion" as such cannot be said to contravene Article 123(2) EPC.

In point 4.8 of the Reasons for the decision under appeal, the opposition division noted the following:

"sub layer (2)" has originally been disclosed as "substrato (2)". It is moreover clear to the

skilled man that with "sub layer (2)" the same is meant as with "SUBSTRATE 2" in the drawings."

The appellant argued that the terms "substrates" and "sub-layer" had a different meaning, namely "substrate" versus "partial layer" ("Teil-Schicht"). The board cannot endorse this argument. It would have been clear to the skilled person that the "substrato (2)" or "SUBSTRATO 2", which is present in original claim 1 and in the figures, respectively, and the "sub layer (2)" of claim 1 refer to the same layer.

Concerning the argument that the "SUBSTRATO 2" of the figures is not part of the "dispositivo anticontraffazione multistrato", the board refers to its remarks on the interpretation of claim 1 (see point 1.1 above).

2.4 Feature D2

The appellant argued that feature D2, according to which the embossing lacquer layer provides holographic or not holographic diffractive areas alternating with not diffractive areas, was not supported by the original application. In point 4.5 of the Reasons for the decision under appeal, the opposition division dismissed this objection as follows:

"Feature D2 ... was originally disclosed in Italian claim 1, page 10, line 23 - page 11, line 8 ... (The Opponent is of the opinion, that page 10, lines 20-22 does not disclose feature D2. The Opposition division agrees that these lines are unclear in that they seem contradictory to page 10, line 23 - page 11, line 8, and should be read rather as: "lo strato (d) presenta aree olografiche

o non olografiche diffrattive goffrate ubicate in zone delimitate che si alternano con aree non diffrattive".)"

The following table compares feature D2 with the corresponding part of original claim 1. Significant differences are underlined:

Original claim 1	Feature D2
... lo strato (d) presenta aree olografiche <u>goffrate</u> ubicate in zone delimitate che si alternano con aree non <u>olografiche</u> ...	the embossing lacquer layer provides holographic <u>or not</u> holographic diffractive areas alternating with not <u>diffractive</u> areas

The most significant difference consists in the addition of the reference to not holographic diffractive areas. This is equivalent to replacing "holographic" in the original feature with "diffractive" in feature D2. Whereas the original feature required there to be an alternation of holographic and non-holographic areas, feature D2 requires an alternation of diffractive and not diffractive areas. This is an extension of subject-matter because, although all holograms are diffractive structures, there are diffractive structures that do not qualify as holograms.

The opposition division seems to have seen support for this addition in features of original claim 1 (page 10, line 23, to page 11, line 8).

According to this passage, there is at least one layer f with registered prints and/or graphics below layer d. It is placed between metallised reflecting layers e that are also provided below layer d and

contiguous to layer(s) f, the latter being located only in correspondence with non-diffractive areas which are not in correspondence with holographic or non-holographic areas ("*... che sono localizzati unicamente in corrispondenza di aree non diffrattive che non sono in corrispondenza di aree olografiche o non olografiche ...*"), the reflecting layers being provided only in correspondence with diffractive areas.

However, this disclosure does not warrant replacing "holographic" with "diffractive" in what is now feature D2. All that is disclosed is that the layers f are provided in correspondence with non-diffractive areas (irrespective of whether they are holographic or not) whereas the reflective layers e correspond to diffractive areas (and in particular to the holographic areas mentioned before). There is no justification for the opposition division's rewriting of the passage on page 10, lines 20 to 22. In any case, there is no clear and unambiguous disclosure of feature D2 in original claim 1, and the opposition division's reference to an apparent contradiction confirms this finding.

However, there is also the disclosure of page 5, lines 11 to 13, of the original application (cited above, see point 2.2), according to which the optically variable holographic or non-holographic diffractive structures are engraved into the embossing layer d. This passage provides the skilled person with the information that the diffractive structures engraved in the embossing layer d can be, but do not have to be, holographic. Thus, there is a basis for feature D2.

2.5 Feature F2

According to feature F2, the layer f is arranged in correspondence with the not diffractive areas and adjoining the metallised reflecting area e which is provided only in correspondence with diffractive areas.

The opposition division's finding that this feature is disclosed in the original application was justified as follows in point 4.1 of the Reasons for the decision under appeal:

"Feature F2 of granted claim 1 ... has originally been disclosed in original claim 1, page 10, line 25 - page 11, line 6. The wording "disposti tra" (page 10, line 25) is translated with "adjoining". The skilled man understands, taking especially figure 1 in consideration, that "adjoining" means "next to". Furthermore, since claim 1 of the granted patent discloses that the diffractive areas alternate with the not diffractive areas (see feature D2 ...) the skilled man understands that layer (f) must be positioned "in between" metalized reflecting areas (e), which is exactly the meaning of "disposti tra". Put in different words, although feature F2 is somewhat unclear because it uses singular for layer (e), the skilled man understands, taking feature D2 and figure 1 into consideration, that F2 must be interpreted as: "the at least one layer (f) provided with registered prints is arranged only in correspondence with the not diffractive areas and adjoining the metalized reflecting areas (e) which are provided only in correspondence with said diffractive areas"."

As explained above (see point 1.5), the board interprets the adjective "adjoining" in a different way. The fact that the term might have been chosen to translate "disposti tra" is irrelevant for the interpretation of the term "adjoining" because the term as such is clear and does not have to be interpreted on the basis of the patent or the original application. The fact that feature F2 - possibly erroneously - refers to a single reflecting area e rather than to a plurality is consistent with the board's interpretation because one layer A can be adjacent to one layer B but it cannot be arranged between one layer B. The argument that the singular must be erroneous presupposes the interpretation chosen by the opposition division and cannot, therefore, be cited in support of it.

Consequently, the board reaches the conclusion that feature F2 has no basis in the original application.

2.6 Feature F3

The feature, as interpreted by the board (see point 1.6 above), requires the multilayer device applied on the sub layer to comprise an area without the metallised reflecting area e through which the underlying prints localised only between the holographic or not holographic diffractive areas are visible in transparency.

In point 4.7 of the Reasons for the decision under appeal, the opposition division dismissed the objections concerning this feature as follows:

"Feature F3 ... was inter alia disclosed in original claim 1, page 11, lines 12-15. The wording "i.e. an area without the metalized reflecting area

(e)" which is not disclosed in this passage of original claim 1 is disclosed e.g. in figure 1. The Opponent is of the opinion, that the wording "in transparency" was not disclosed, but the Italian word "traspare" implies "in transparency". Furthermore, the word "varie" means several in this case, so there must only be several holographic or not holographic diffractive areas, they do not have to be different from each other as the Opponent suggested."

The following table compares the disclosure of page 11, lines 12 to 15, of the original application (in the English translation) with feature F3:

page 11, lines 12-15	Feature F3
... a window or area through which the underlying print (f) is visible (<i>traspare</i>), [the window] being formed between the various holographic or non-holographic diffractive areas d.	a window, i.e. an area <u>without the metalized reflecting area (e)</u> through which the underlying prints localized only between said holographic or not holographic diffractive areas are visible <u>in transparency</u>

There is a second passage dealing with the window effect on page 2, lines 12 to 22, of the original application. According to this passage, the claimed device differs from the prior art in that a window (or transparency) effect is obtained in correspondence with the non-holographic areas through which the underlying graphic prints are visible. The latter are printed in perfect register in the demetallised areas so as not to interfere with the holographic areas, which are provided with the metallic reflection layers. It is

clear from this passage that the window areas have no metallic reflecting layer.

Moreover, the prints are visible in transparency. Besides the use of the verb "traspare" in original claim 1, the window effect is also called the transparency effect on page 2, lines 12 and 13 ("*effetto finestra ovvero di trasparenza*"). Thus, feature F3 has a basis in the original application.

2.7 Conclusion

Claim 1 was unallowably amended because features A and F2 have no proper basis in the original application (see points 2.1 and 2.5 above).

Consequently, the ground of opposition in accordance with Article 100(c) EPC prejudices the maintenance of the patent as granted, and the main request cannot be allowed. There is no need for the board to examine the other objections raised against the main request.

3. Auxiliary requests

3.1 Admittance

The opposition division found the main request before it to be allowable and did not have to decide on the auxiliary requests filed on 13 January 2016, nor did it have to examine whether they were admissible. This does not mean that they are automatically part of appeal proceedings. Their admission is within the discretion of the board under Article 12(4) RPBA 2007, according to which, without prejudice to the power of the board to hold inadmissible requests which could have been presented

or were not admitted in the first instance proceedings, everything presented at the outset of the appeal proceedings shall be taken into account by the board. However, the appellant never objected to their admittance until one month in advance of the oral proceedings before the board and the board sees no good reason apparent from the first-instance proceedings not to admit the requests into the appeal proceedings.

3.2 Compliance with Article 123(3) EPC

The board notes that the feature "made of lacquers" is absent from feature C2 in all auxiliary requests. This deletion extends the protection conferred by granted claim 1, in violation of the requirements of Article 123(3) EPC. Consequently, none of the auxiliary requests on file can be granted.

4. Conclusion

Since the ground for opposition in accordance with Article 100(c) EPC prejudices the maintenance of the patent as granted (see point 2. above) and all the auxiliary requests on file violate Article 123(3) EPC (see point 3.2 above), there is no allowable request. Consequently, the patent has to be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated