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

Case Number: T 1174/18 - 3.2.05

Application Number: 13150092.8

Publication Number: 2612763

IPC: B42D15/00

Language of the proceedings: EN

Title of invention:

Identity document with secure image

Patent Proprietor:

ASSA ABLOY AB

Opponent:

Giesecke+Devrient Mobile Security GmbH

Relevant legal provisions:

EPC Art. 54(1), 56, 84, 100(a), 111(1), 123(2), 123(3)

EPC R. 80, 103(1)(a)

RPBA Art. 12(4)

RPBA 2020 Art. 11, 13(2)

Keyword:

Novelty (no: main request)

Admittance (no: auxiliary requests 1,2,4,5; yes: auxiliary requests 3, 7)

Inventive step (no: auxiliary request 3)

Amendments are occasioned by a ground for opposition (yes)

Lack of clarity (no)

Added subject-matter (no)

Remittal to the opposition division for further prosecution (yes)

Reimbursement of the appeal fee (no)

Decisions cited:

G 0001/03, G 0003/14, G 0001/16, J 0007/83, T 1115/09,

T 0792/12, T 1646/12, T 0688/16



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Case Number: T 1174/18 - 3.2.05

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

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 20 March 2018
revoking European patent No. 2612763 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman P. Lanz
Members: O. Randl
T. Karamanli

Summary of Facts and Submissions

- I. The patent proprietor filed an appeal against the decision of the opposition division to revoke European patent No. 2 612 763.
- II. The opposition division was of the opinion that the subject-matter of claim 1 of the main request was not new. None of the six auxiliary requests filed by the patent proprietor was admitted into the opposition proceedings.
- III. The following documents were cited by the opposition division in the decision under appeal:
- D1: EP 0 251 253 A2
 - D2: DE 10 2008 008685 A1
 - D3: DE 39 32 505 A1
 - D4: DE 10 2004 027306 A1
 - D5: EP 1 291 827 A1
 - D6: DE 102 47 591 A1
 - D7: WO 2005/048182 A1
- IV. The statement setting out the grounds of appeal was filed on 30 July 2018.
- V. The summons to oral proceedings was issued on 7 May 2020. The oral proceedings before the board took place on 15 April 2021.
- VI. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or that the patent be maintained in amended form on the basis of the amended claims and the amended description

(auxiliary request 1, corresponding to request 2 of the modified requests filed at the oral proceedings of 15 April 2021) or on the basis of auxiliary requests 2 to 5 (corresponding to requests 3 to 6 of the modified requests filed at the oral proceedings of 15 April 2021), or of auxiliary request 7 filed at the oral proceedings of 15 April 2021, or on the basis of auxiliary requests 8 to 25 (corresponding to requests 9 to 26 of the modified requests filed at the oral proceedings of 15 April 2021). Furthermore, it requested that the appeal fee be reimbursed.

VII. The respondent (opponent) requested that the appeal be dismissed. Furthermore, it requested that the case be remitted to the department of first instance for further prosecution if the issue of inventive step became relevant.

VIII. Independent claim 1 of the patent as granted (main request) reads (the feature references used by the board have been added in square brackets):

"[1] An identification document (100), comprising:
[2] a substrate (204) [3] comprising an image area (104) wherein at least one first portion of the surface of the image area (104) is made of a first material;
[4] at least one patch of a security material (112) covering at least one second portion of said image area (104), [5] the security material (112) having reflective or holographic properties which are different to the ones of the first material; and characterized by
[6] a laser engraved security image (108) extending at least over each one of said at least one first and second portions in a continuous manner."

Claim 1 of auxiliary request 1 differs from claim 1 of the main request by the additional feature "wherein the first and second portions are arranged beside each other, not above each other".

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

- feature 3 has been amended to read "[**3b**] comprising an image area (104) wherein ~~at least one first portion of the entire~~ surface of the image area (104) is made of a first material"
- feature 4 has been amended to read "[**4a**] at least one patch of a security material (112) applied on and covering at least one second portion of said image area (104)"
- the words "and characterized by" have been deleted
- feature 6 has been amended to read "[**6a**] a laser engraved security image (108) extending at least over each one of said surface of the image area (104) made of said first material and said at least one first and second portions patch of a security material (112) in a continuous manner".

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

- the feature "[**7**] wherein the first material comprises at least one of polycarbonate, polyvinyl chloride, and polyethylene terephthalate" has been added
- the words "and characterized by" have been deleted.

Claim 1 of auxiliary request 4 differs from claim 1 of auxiliary request 2 in that the features "[**7'**] the first material comprising at least one of polycarbonate, polyvinyl chloride, and polyethylene terephthalate" and "[**8**] wherein the security image (108) comprises at least one of an identity

picture, character, symbol, letter, word, and number" have been added.

Claim 1 of auxiliary request 5 differs from claim 1 of the main request in that:

- the words "and characterized by" have been deleted
- the feature "[9] wherein at least one operating parameter of the laser engraver is adjusted depending upon whether the security image (108) is being engraved into the first material or whether the image is being engraved into the security material (112)" has been added.

Auxiliary request 6 was withdrawn during the oral proceedings before the board.

Claim 1 of auxiliary request 7 differs from claim 1 of the main request in that:

- the words "and characterized by" have been deleted
- the features "[10] wherein the image area (104) consists of a patchwork of multiple of first and second portions and [11] wherein the security image (108) extends in a continuous manner over multiple transition zones from one portion type to the other portion type" have been added.

Claim 8 of auxiliary request 7 reads:

"A method of manufacturing an identification document (100) according one of the preceding claims, comprising:
providing a substrate comprising an image area (104) wherein at least one first portion of the surface of the image area (104) is made of a first material;
positioning a security material (112) covering at least one second portion of said image area (104), the

security material (112) comprising at least one of reflective and holographic properties which are different to the ones of the first material; laser engraving a security image (108) such that the image extends on a continuous manner at least over each one of said at least one first and second portions; wherein the image area (104) consists of a patchwork of multiple of first and second portions and wherein the security image extends in a continuous manner over multiple transition zones from one portion type to the other portion type."

IX. The parties have argued as follows.

(a) Main request: Interpretation of granted claim 1

(i) Appellant (patent proprietor)

Based on the disclosure of the patent, the relevant skilled person, i.e. an engineer with some knowledge on the manufacturing of identification documents, would clearly and unambiguously have been taught that the core of the invention is that the laser engraved security image extends over each of the different materials in a continuous manner, i.e. over the first material (i.e. the first portion of the surface of the image area) and the at least one patch of a security material covering at least one second portion of that image area. Otherwise, the extension of the laser engraved security image over both parts, namely that of the first material and that of the security material would not have made any technical sense. The opposition division claimed that paragraph [0020] of the patent defined that the first portion of the surface of the image area and the security material may be 1-100 % overlapping. However, the opposition division misquoted

the patent. Paragraph [0020] states that the percentage of security material in the image area compared to the base material of the identification document "can vary anywhere between about 1 % and about 100 %."

(underlining added). There is no disclosure of 100% but only of "about 100%". Taking into consideration that the whole patent stresses the importance of the extension of the laser engraved security image over two different materials, i.e. the first material and the security material, the skilled person would have understood this sentence of the description such that a transition zone between a first portion made of the first material and a second portion made of the security material was mandatory, even if the percentage of security material in the image area was very low or very high. The opposition division's interpretation does not correspond to a meaningful interpretation taking into consideration Article 69 EPC. The skilled person would not have interpreted claim 1 such that no security material was within the image area or that the image area was totally covered by security material. On the contrary, the first portion of the first material and the second portion of the security material are arranged such that at least one transition zone is provided over which the laser engraved security image extends from one material to the other. Consequently, there have to be parts where the first material and the security material do not overlap. All embodiments clearly comprise this essential arrangement of the first material and the security material and the laser engraved security image on both materials. The respondent's interpretation is nonsensical ("Unsinn"). Decision T 1115/09 deals with a range of values as such but does not apply to a case where it has to be combined with other features. Paragraph [0017] of the patent only makes clear that security material can also

be provided outside the image area. This disclosure does not alter the fact that according to feature 6, the two different materials have to be provided side by side. When asked by the board whether, in view of its explanations regarding the interpretation of claim 1 (and in particular of its understanding that the engraved image physically alters the material layer forming the first and second portions), the patch of security material covering the second portion of the image area was to be considered as part of the second portion, the patent proprietor explained that this was indeed the case.

(ii) Respondent (opponent)

Claim 1 of the patent leaves entirely open whether and to what extent the first and second portions overlap. The fact that the first portion is defined as a portion of the image area surface and that the second portion is defined as a portion of the image area but not a portion of the image area surface does not lead to the conclusion that the two portions would not overlap. On the contrary, the wording of claim 2 is such that overlapping of the first and second portions falls within the scope of protection of claim 1. Claim 2 defines that the entire surface of the image area is made of the first material, on the very portions of which the "patch" of the security material is applied. This ultimately means that the term surface of the image area cannot be understood to mean that the surface of the image area would remain uncovered by the "patch" of the security material. Claim 2 being a limitation of claim 1, it cannot be in conflict with the latter. In summary, it cannot be inferred from the distinction between a portion of the image area surface and a portion of the image area that they are two

completely adjacent, i.e. non-overlapping, portions. This conclusion is supported by paragraph [0022], according to which "one or more layers of security material 112 [are] fixed, secured, or otherwise applied to a top major surface of the substrate 204".

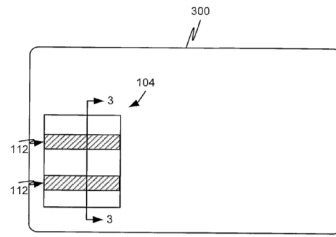


Fig. 3A

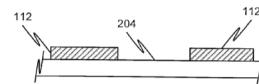


Fig. 3B

According to paragraph [0020], the security material can occupy "any fraction" of the image area. Thus, a 100% overlap is also envisaged. The skilled person would have understood the statement in paragraph [0020] that the percentage of security material "can vary anywhere between about 1 % and about 100 %" such that 0% is excluded (because there has to be a second portion) but not 100%. If this had been intended, it would have been easy to express this in claim 1, to add a corresponding sentence and/or to avoid the reference to "any fraction". Decision T 1115/09 dealt with a similar situation and interpreted the expression "about 10" to mean " $10 - \epsilon$ ", "10" or " $10 + \epsilon$ " (Reasons, point 2.4). Accordingly, "about 100%" should be interpreted to mean either " $100\% - \Delta$ " or "100%" (" $100\% + \Delta$ " being meaningless). Thus, the value of 100% is also encompassed in the expression "about 100%". The word "about" was most likely added because it proved difficult to obtain a 100% coverage. The patent discloses a number of different ID documents. For example, in paragraphs [0009] and [0010], different embodiments with a different layered structure are disclosed. Both paragraphs [0009] and [0010] refer to

the fact that the image should be located above all layers. However, the wording of paragraphs [0009] and [0010] clearly leaves open whether these layers of different materials should be arranged on top of or next to each other. Only one specific example is disclosed in the figure description which, according to paragraphs [0013] and [0015], is not intended to limit the invention. It would be against common EPO practice to interpret the wording of a claim so narrowly that it only relates to a particular embodiment, without a corresponding limitation in the wording of the claim, to maintain or establish novelty over the prior art. The fact that the respondent's interpretation is far from nonsensical can be seen from document D3, according to which the arrangement is more difficult to counterfeit (see col. 19, line 62).

(b) Main request: Novelty of claim 1 over document D3

(i) Appellant (patent proprietor)

Document D3 does not disclose feature 6 if the latter is interpreted in a reasonable way. The identification document of document D3, particularly as shown in Fig. 21, shows a substrate 30 onto which a hologram 17 is applied. Micro-reliefs 85 are generated by a laser in this hologram 17. However, there is no laser engraved security image which extends from one material to the other in a continuous manner as claimed. Here, only the hologram 17 is partly modified (see document D3, column 19, line 36 ff). Obviously, and contrary to the opposition division's opinion, the modification made in the hologram does not create a laser engraved security image continuously extending from one material to the other; it simply extends within the security

material in the form of the hologram. Hence, document D3 is not novelty-destroying.

(ii) Respondent (opponent)

As correctly stated in the decision under appeal, the identification documents disclosed in document D3 are novelty-destroying for claim 1 of the patent as granted when the latter is correctly construed in the sense that the security material can cover the entire image area.

(c) Auxiliary request 1: Admittance

(i) Appellant (patent proprietor)

The request was filed in response to the board's change of mind in respect of its interpretation of claim 1 of the main request. The claim was amended by means of a disclaimer meant to exclude possible interpretations of claim 1 which do not correspond to the embodiments shown. The disclaimer is directly and unambiguously disclosed in the original application as a whole. (When asked for the precise basis, the appellant referred to all the figures and the corresponding parts of the description.) The amendment is clearly a reaction to the interpretation of claim 1 by the board. There was no incentive to file it at an earlier stage because the previous interpretation of the board was different. The deletion of one sentence of the description is justified by the fact that this sentence had been used to establish that a 100% overlap of the first and second portions was possible. By deleting this sentence, the basis for such an interpretation is removed. Therefore, Article 123(2) EPC is not contravened, nor is Article 123(3) EPC because the

scope of the claim has been clearly narrowed as the amendment only excludes one configuration. Moreover, the deletion of the fourth sentence in paragraph [0020] does not result in an extension of the scope of claim 1.

(ii) Respondent (opponent)

Auxiliary request 1 was filed late, namely during the oral proceedings before the board. The appellant has amended its case but has not provided any reasons why this was not done at an earlier stage of the proceedings. The newly added claim feature has no support in the original application. Its insertion into claim 1 violates Article 123(2) EPC. Even a disclaimer has to have a basis in the original application. The deletion of the fourth sentence of paragraph [0020] is inadmissible because it modifies the interpretation of claim 1. Without the deletion, claim 1 encompasses percentages of security material above $1\%-\Delta$, whereas the deletion has the effect that it also encompasses percentages between 0 and $1\%-\Delta$. Thus, the requirements of Article 123(2) and (3) EPC are not fulfilled.

(d) Auxiliary request 2: Admittance

(i) Appellant (patent proprietor)

The request constitutes a reaction to the decision under appeal, which had been given "out of the blue". There was no reason to file requests in response to the written submissions of the opponent filed shortly before the oral proceedings because they had been filed within the one-month time limit set by the opposition division. The objective situation was clearly in favour of the patent proprietor at that time. In this context,

the appellant cited decision T 688/16, in accordance with which an opposition division's discretion not to admit late-filed requests based on Rule 116(2) EPC can only apply if the patentee has been informed of the reasons why the patent should not be maintained and has been invited to react. In the absence of a communication pursuant to Rule 116(1) EPC, there is no necessity to file auxiliary requests (see Reasons, point 2.2). The situation on which this case is based is exactly the same. The summons *expressis verbis* outlined that the granted patent fulfilled the requirements of the EPC and that the opposition would likely be rejected. According to auxiliary request 2, the entire image area is made of a first material, and the engraved image extends over both the first material and the patch(es). This is clearly disclosed in the embodiments, where the patches have the shape of strips. The two materials are clearly side by side. Thus, there is no violation of Article 123(2) EPC. Article 123(3) EPC is not violated either because the claims are clearly narrower than the granted claims. When asked what the basis for the combination of features of new claim 8 in the original application was, the appellant replied that it left the determination of the basis to the board.

(ii) Respondent (opponent)

Considering that the appellant had filed not less than five auxiliary requests during the oral proceedings before the opposition division, it is not clear why this particular request was not filed at the same time. It is not correct that the opposition division did not explain its change of mind at all. The amendments to claim 1 do not arise from the disclosure of granted dependent claim 2, at least because claim 2 is so

unclearly worded that the feature "of which" can refer to both the image 104 and the first material. It is therefore unclear to which of the two materials the patch is applied. The merger of the "first portion" of former claim 1 and the unspecified "portion" of former claim 2 has arguably led to the creation of an *aliud*. Consequently, claim 1 is inadmissibly extended and highly unclear. Furthermore, there are two references to a security material 112, both using the indefinite article. It is not clear to what extent the first security material 112 relates to the second. Furthermore, claim 3, which was previously presented as claim 4, is inadmissibly extended due to the deletion of the feature "essentially". This deletion was not occasioned by a ground for opposition (Rule 80 EPC). Prior to the deletion, this claim did not exclusively refer to the so-called patchwork. The deletion of the feature "essentially" means that only the patchwork is present. However, this is not disclosed in the original application. Although former claim 4 was dependent on claim 1 alone, claim 3 now depends on new claim 1, which is a combination of former claims 1 and 2. This combination of features has no basis in the original application. Also, the subject-matter of claim 8 is inadmissibly extended since a device claim feature was added to the method claim. This combination is not disclosed in the original application. Also, it is not clear what the effect of the device features is in the context of the method claim. Thus, auxiliary request 2 is neither allowable nor *prima facie* relevant. Moreover, claims 2, 6, 8 and 10 contain amendments not occasioned by a ground for opposition.

(e) Auxiliary request 3: Admittance

(i) Appellant (patent proprietor)

The addition of the feature regarding the choice of materials for the first material into claim 8 was made to keep claims 1 and 8 consistent. It does not give rise to an inadmissible extension.

(ii) Respondent (opponent)

Auxiliary request 3 is not to be admitted because it does not converge with the previous auxiliary requests but arbitrarily refers to further features. Claims 1 and 8 do not contain any features not already known from the prior art. The image area is made of a first material, namely polycarbonate, PVC or PET. Polycarbonate is a common material for identity documents and, in particular, chip cards. Document D3 discloses the use of polyester film. Both polycarbonate and PET are polyesters. This feature is also disclosed in document D7, page 11, line 7. Thus, the presence of an inventive step is doubtful. As the use of polycarbonate for cards was already notoriously known, the skilled person would have arrived at the subject-matter of claim 1 based on document D3 and common general knowledge. Moreover, there is no basis for the amendments of method claim 8. The features of claim 6 belong to a different category and cannot serve as a suitable disclosure. Furthermore, the allegedly restrictive features are structural features. The amendments to the current claim 8 therefore either have no disclosure at all or the patent proprietor refers to the description, thus opening up a discussion on clarity. Moreover, claims 3, 6, 7 and 10 comprise

amendments not occasioned by a ground for opposition and therefore violate Rule 80 EPC. Consequently, auxiliary request 3 should not be admitted into the proceedings.

(f) Auxiliary request 3: Inventive step

(i) Respondent (opponent)

The selection of materials expressed in claim 1 is not inventive because the most common polymer materials have been selected. The skilled person starting from document D3 and looking for a suitable material that is laser-writable and onto which a patch can be glued would have found in document D3 itself a prompt to use polyester as the substrate (see col. 11, line 64, and col. 22, line 42). It is not apparent what special effects or advantages the selected materials provide. The patent does not mention any (see paragraph [0021]). The effects mentioned by the appellant are very ordinary. The material used for the device of document D3 may be expected to show the same advantages. In addition to document D3, the skilled person would also have considered document D7, which belongs to the same technical field and discloses a laser-writable document (see the abstract and figures). In the passage bridging pages 3 and 4, polycarbonate and polyester are mentioned as suitable materials for the laser-writable layer. A similar disclosure is found on page 11, first paragraph, where polycarbonate is mentioned (see also the last paragraph on this page). Thus, the skilled person would have been taught to use the claimed materials as in documents D3 and D7. There is nothing that would have deterred the skilled person from using such materials. The carrier layer 20 shown in Fig. 7 of document D3 is a substrate. There is no apparent

synergy between the choice of material and feature 6. When asked by the board why the skilled person would have applied the teaching of document D3, which relates to the carrier foil 20 rather than the substrate 30, to the substrate, the respondent referred to document D7 and explained that this material was the only specific material disclosed and met all the requirements. Moreover, the substrate in document D7 was made from several layers, and layer 20 was part of it (see Fig. 3, which is a section of the card of Fig. 1). Another relevant passage of document D7 is Fig. 4 and the corresponding description (page 11, first paragraph).

(ii) Appellant (patent proprietor)

The reference to polyester in document D3 relates to the transfer film and not the substrate. The materials selected in claim 1 are a good choice suitable for mass production that make it possible to improve the counterfeit protection of the ID document. Document D3 or D7 do not disclose that the engraving should extend over this particular substrate. The claimed materials are known as such but not in combination with a patch and a specially engraved image. This is not disclosed in document D7 either. There is no reason why the skilled person would have used the teaching of document D7 regarding layer 20 in the context of document D3. The invention consists in counterfeit protection obtained by applying the image in a continuous manner onto different materials. The specific material is not the sole distinguishing feature because the application of the image in a continuous manner depends on the material. (When asked by the board what the material used in document D3 was, the appellant expressed its belief that a different

material was used.) In document D7, layer 20 is laser-writable, and layer 22 has to be transparent. Thus, there would have been no incentive for the skilled person to apply the teaching relating to layer 20 to the device of document D3, in which the laser-writable layer has to be opaque. When asked what the specific effect of the selected materials was and what other materials the skilled person might have chosen, the appellant referred to its prior submissions.

(g) Auxiliary request 4: Admittance

(i) Appellant (patent proprietor)

The arguments raised in favour of the admittance of auxiliary request 2 also apply to auxiliary request 4.

(ii) Respondent (opponent)

The arguments raised against the admittance of auxiliary request 2 also apply to auxiliary request 4.

(h) Auxiliary request 5: Admittance

(i) Respondent (opponent)

Claim 1 of auxiliary request 5 does not converge with any of the previous claims. Method features have been inserted into the device claim. This constitutes an inadmissible extension. Moreover, claim 1 is highly unclear. Its ambiguity results from the fact that such features are not detectable in the final product. The way in which the operating parameters are adjusted cannot be determined by analysing the ID document. Consequently, this request should not be admitted.

(ii) Appellant (patent proprietor)

The adjustment of the operating parameters defines the ID document in that the "continuous manner" of feature 6 is further improved. Thus, the product claim is narrowed by the product-by-process feature.

(i) Auxiliary request 7: Admittance

(i) Respondent (opponent)

The request was filed late. The lack of compliance with Rule 80 EPC could have been remedied before.

(ii) Appellant (patent proprietor)

The objection under Rule 80 EPC was raised for the first time during the oral proceedings. The appellant was not aware that this provision also governed amendments unrelated to the substance of the case.

(j) Auxiliary request 7: Compliance with Article 84 EPC

(i) Respondent (opponent)

Claim 1 is unclear because it associates the terms "patch" and "patchwork" and raises new questions such as: Is the patchwork formed by patches? Can there be patches made of the first material? It is not because claim 1 is based on a combination of former claims 1 and 4 that the clarity objection is inadmissible under decision G 3/14. It is the deletion of the word "essentially", which previously mitigated the term "patchwork", that makes the claim unclear.

(ii) Appellant (patent proprietor)

As claim 1 is based on granted claims, there cannot be any admissible clarity objection.

(k) Auxiliary request 7: Compliance with Article 123(2) EPC

(i) Respondent (opponent)

Claim 1 violates Article 123(2) EPC because the features of granted claims 2 and 4 are not disclosed in combination in the original application.

(ii) Appellant (patent proprietor)

Auxiliary request 7 complies with Article 123(2) EPC.

(l) Remittal to opposition division

(i) Appellant (patent proprietor)

During the oral proceedings before the board, the appellant requested that the oral proceedings before the board be adjourned.

(ii) Respondent (opponent)

The respondent requested in writing that the case be remitted to the department of first instance for further prosecution if the issue of inventive step were to become relevant. During the oral proceedings before the board, the respondent also stated that it agreed with the appellant's proposal that the oral proceedings be adjourned rather than that the case be remitted.

(m) Reimbursement of the appeal fee

(i) Appellant (patent proprietor)

The opposition division handled the case in an inappropriate and biased manner against the patent proprietor. As mentioned on pages 8 ff, item 3 of the decision under appeal, the opposition division stated that auxiliary requests filed during the oral proceedings would be considered late-filed. Only the addition of features from the granted dependent claims would be allowed under Article 114(2) EPC, but the addition of features taken from the description would not be allowed. As the preliminary opinion of the opposition division had been totally favourable for the patent proprietor, there was no necessity to file auxiliary requests. The opponent's written submission filed one month before the oral proceedings did not differ essentially from the submissions formerly filed with regard to contents. Accordingly, there was no reason for the patent proprietor to reconsider its defence. At the beginning of the oral proceedings, the chairman of the opposition division informed the parties that the opposition division had changed its mind and considered document D3 to be novelty-destroying. No reason for this change of mind was given other than the arguments presented by the opponent. Moreover, none of auxiliary requests 1 to 5 was admitted because they were found to be late-filed and contravening Article 123(2) EPC. Auxiliary request 6 (which only combined granted claims) was not admitted by the opposition division for being late-filed. This course of action constitutes a substantial procedure violation justifying a reimbursement of the appeal fee. This situation is similar to the one in decision

T 688/18, in accordance with which a decision not to admit auxiliary requests lacked a legal basis in the absence of an unfavourable communication under Rule 116(1) EPC. The statement in the board's communication that it would not be equitable to reimburse the appeal fee due to the fact that the appellant would have had to file an appeal to have the decision reviewed with respect to the main request is not in line with Rule 103(1)(a) EPC and the established jurisprudence. If this understanding of Rule 103(1)(a) EPC were correct, a reimbursement of the appeal fee would depend on the extent and kind of the appellant's appeal. However, there is no such requirement in Rule 103(1)(a) EPC. The only requirement is that a reimbursement has to be equitable by reason of a substantial procedural violation. A "substantial procedural violation" is an objective deficiency affecting the entire proceedings (J 7/83). Whether there has been a substantial procedural violation is to be determined on an objective basis (J 32/95, T 160/09). A procedural violation of the principle of the protection of legitimate expectation leading to the revocation of the patent may constitute a substantial procedural violation (see also decisions T 1607/08, T 2246/13 and T 1423/13). In this case, in view of the behaviour of the opposition division, the whole oral proceedings were conducted in a way unfair for the patentee, thus violating the principle of the protection of legitimate expectation. The fact that the board intends to remit the case to the department of first instance clearly proves that a procedural violation occurred. The request for refund of the appeal fee is reasonable.

(ii) Respondent (opponent)

There is no reason to remit the case just because the opposition division did not maintain its preliminary view at the oral proceedings. The opposition division had repeatedly stressed that its view was only preliminary. Therefore, the patent proprietor should have filed auxiliary requests as a precautionary measure. Its failure to do so is without excuse. Decision T 688/16 does not support the assertion that the opposition division should have admitted the late-filed auxiliary requests 1 to 6. The facts on which decision T 688/16 is based are not comparable as in this case auxiliary requests 2 and 3 were constituted only by deleting some features from claim 1 and the dependent claims concerned, without adding features from the description. Moreover, the board saw no reasons for not admitting the auxiliary request (see Reasons, point 2.4). It did not rule out the possibility that there may have been grounds on the basis of which the opposition division, despite a favourable preliminary opinion, could not admit auxiliary requests not submitted until the oral proceedings. However, in the case at issue, auxiliary requests 1 and 2 were not admitted because of the addition of features from the description. Auxiliary requests containing features taken from the description not raised until the oral proceedings are, as a rule, not admitted because an additional search may become necessary. In decision T 881/09, the board made use of its discretion under Article 12(4) RPBA 2007 not to admit such a request. The overriding principle of economy of procedure gives the opposition division the discretion to dismiss late-filed requests under certain circumstances (see "Case Law of the Boards of Appeal of

the European Patent Office", 9th edition, 2019, hereinafter "Case Law", IV.C.5.1.3). The opposition division had some discretion to reject late-filed requests despite the favourable preliminary opinion expressed in its communication. Auxiliary requests 3 to 5 had not been admitted because of a *prima facie* lack of compliance with Article 123 EPC. Moreover, the patent proprietor had had at least one and a half months to react to the opponent's written submission of 11 December 2017 and submit auxiliary requests in good time. It did not do so for tactical reasons. This constitutes an abuse of procedure.

Reasons for the Decision

1. Main request
- 1.1 Interpretation of granted claim 1
- 1.1.1 "Image area"

According to features 2 and 3 of claim 1, the substrate of the claimed ID document comprises an image area. According to the Oxford English Dictionary, the term "area" usually designates "a region, section, or subdivision of a surface, object, etc.". In the current context, the term cannot designate a mere surface because feature 3 requires this portion of the surface of the image area to be "made of a first material". Thus, "image area" is understood to designate a portion of the substrate at least part of which is situated at the surface of the substrate. This portion is an "image area" because at least one image is to be provided on it (see also paragraph [0016] of the patent).

1.1.2 The "portions" of the image area and their relationship

(a) Claim 1 considered in isolation

The "first portion of the surface of the image area" is introduced in feature 3, which requires this portion to be made of a first material.

Feature 4 introduces a "second portion of said image area". Contrary to the first portion, the second portion is not characterised via its constitution (which may or may not be the same as that of the first portion) but by the fact that it is covered by "security material", some properties of which differ from those of the first material (feature 5).

There was disagreement on whether the whole image area may be covered by security material. The wording of features 3 and 4 in itself does not rule out this particular case.

The correct understanding of feature 6, according to which the ID document comprises a laser engraved image "extending at least over ... said ... first and second portions in a continuous manner", is important in this context.

The board notes that the expression "extending ... over" can be understood in different ways. First, the feature that the engraved image extends over the first and second portions can be understood to mean that the engraving extends on the surface of each portion or is provided in the material forming each portion ("physical interpretation"). This would mean that both portions have to be on (or at least close to) the outer

surface of the substrate. Second, the expression "extending ... over" can also be understood to mean "extending above", similar to the way in which a bridge may be said to extend over a river although it does not extend on the surface of the river ("geometrical interpretation").

Feature 6 requires the engraved image to extend "over each one of said ... first and second portions". As has been said above, the second portion is defined by the fact that it is covered by security material. Thus, the outer surface of the image area is formed by security material in the region of the second portions. The second portion itself is not on the outer surface of the image area because it is covered by security material. Unless the patch of security material is sufficiently thin for the engraving to reach the underlying material (for which there is no indication in claim 1), the above-mentioned "physical interpretation" of the expression "extending ... over" appears not to be appropriate. This interpretation requires that the patch of security material covering the second portion is itself part of the second portion. However, this reading of feature 6 appears to be unnatural. Feature 6 rather suggests that the patch of security material is provided on top of the second portion. Consequently, if no assumptions are made on the relative thickness of the patch, the requirement that the security image is "extending over" the second portion can only be met if the "geometrical interpretation" is used.

(b) Context of claim 1

As claim 1 appears not to be completely clear in this respect, it is legitimate to also consider the disclosure of the granted patent as a whole.

(i) Claim 2

Claim 2 requires "the entire surface of the image area" to be "made of the first material on portions of which the at least one patch of security material is applied". The board has doubts that this statement can be used to interpret claim 1 because it is itself in need of interpretation. According to the board's understanding, claim 2 intends to convey that the patch is applied to certain portions (which are not explicitly identified with the second portions of claim 1) and that these portions are made from the first material. Put another way, this appears to be a product-by-process feature stating that the security patches are applied onto portions made from the first material. This disclosure appears not to be helpful, let alone decisive, for the interpretive questions raised by feature 6.

(ii) Paragraph [0017] of the description

Paragraph [0017] of the patent as granted, which belongs to the description of Fig. 1, contains the following sentence:

"The security material 112 can be incorporated into the entirety of the identification document 100 or it can be applied to a portion of the identification document 100, such as the portion corresponding to the image area 104."

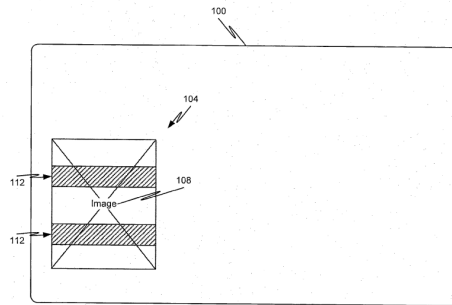


FIG. 1

The first alternative is irrelevant in the current context because it refers to an incorporation of security material into the bulk of the ID document. However, the second alternative discloses the possibility that the security material be applied to the portion corresponding to the image area 104. The most natural reading of this statement is that the entire image area may also be covered by security material. This understanding favours the "geometrical interpretation" of feature 6.

(iii) Paragraph [0020] of the description

This paragraph is again part of the description of Fig 1. It reads:

"Although Fig. 1 depicts the image area 104 as being the only area on the identification document 100 that includes the security material 112, the invention is not so limited. For example, it is contemplated that the security material 112 can be incorporated into other portions of the identification document 100. Further still, the security material 112 can occupy any fraction of the image area 104. In particular, the percentage of security material 112 in the image area 104 as compared to the base material of

the identification document 100 can vary anywhere between about 1% and about 100%. As a few more non-limiting examples, the percentage of security material 112 in the image area 104 can be between about 25% and 50% and even more specifically about 33%." (Underlining by the board.)

The board notes that this passage mentions that the security material can occupy "any fraction" of the image area. This arguably includes 100% of that area.

The passage then discloses what appears to be a particular case ("In particular ..."). Referring to this disclosure, the opposition division asserted that:

"... paragraph 20 of the opposed patent clearly defines that the first portion of the surface of the image area and the security material may be 1-100% overlapping (not 1-99% as the proprietor asserted)." (See point 2.4 of the Reasons of the decision under appeal.)

Contrary to the assertion of the opposition division, paragraph [0020] does not contain a proper definition of a claim feature (which would have had to be taken into account - see, for instance, decision T 1646/12 of 26 June 2015, Reasons, point 2.1). Nonetheless, the opposition division correctly pointed out that paragraph [0020] did not disclose a 99% fraction. However, the value of 100% is not directly and unambiguously disclosed either. The drafter of the patent referred to a value of "about 100%", although there was no good reason not to refer to 100% if full coverage was meant. Arguably, the precision "about" was added intentionally to convey that the part of the

image area not covered by the security material could be tiny (be it 2%, 0.5% or even less) but not nil.

Decision T 1115/09 was cited in this context. In this decision, a different board had to decide whether an amount of "no more than about 10 ppm of oxygen" fell within the range of "more than 10 ppm oxygen and up to 250 ppm" (Reasons, point 2.1). However, this question is different from the question raised by paragraph [0020], namely whether a percentage of 100% is necessarily comprised by the range "between about 1% and about 100%". Consequently, the findings of decision T 1115/09 are not directly applicable. In the eyes of the board, it is not possible to determine the precise meaning of the term "about" followed by a numerical value in general terms, irrespective of the precise context. What exactly is meant can only be determined in view of the particular circumstances of each case.

(iv) Paragraph [0022] of the description

This paragraph describes the second step of the process for building the ID document shown in Figs. 3A and 3B.

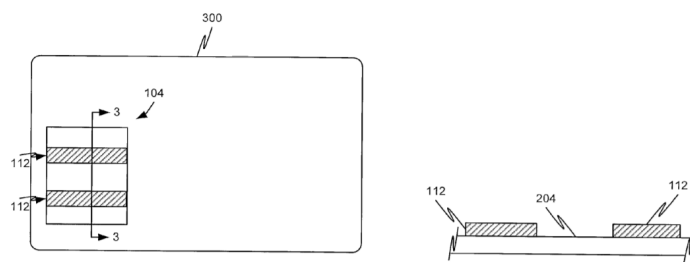


Fig. 3A

Fig. 3B

It contains the following statement:

"Application of the security material 112 creates a first portion of the image area 104 having an exposed substrate 104 and a second portion of the

image area 104 having an exposed security material 112."

Here the two portions are clearly non-overlapping. However, as this is only one particular embodiment, it is not possible to draw conclusions on the scope of claim 1 other than to say that this case is encompassed. This is undisputed.

(c) Conclusion

The most natural reading of feature 4 is that the (at least one) patch of security material covering the (at least one) second portion is not part of the second portion. Consequently, the expression "extending ... over" is to be understood in such a way that the security image is provided in or above the first and second portions. When understood in this way, claim 1 encompasses the case in which the first and second portions coincide and the entire surface of the image area is covered with security material.

The description of the granted patent itself contains passages which the board understands to be in line with this interpretation (in particular paragraph [0017] and the reference to "any fraction" in paragraph [0022]). The sentence that the percentage of security material "can vary anywhere between about 1% and about 100%" can arguably be understood to exclude 100%, but the context of this passage suggests that this is a particular case. Thus, the description as a whole also appears to support the interpretation obtained on the basis of the wording of the claim alone. At the very least, it cannot be said to favour a different interpretation.

Based on the above, the board concludes that claim 1 encompasses the particular case where the first and second portions coincide and the laser engraving is provided in a patch of security material covering the entire image area.

1.2 Ground for opposition of lack of novelty
(Articles 100(a) and 54(1) EPC) based on document D3

Document D3 discloses data carriers comprising diffraction structures (in particular holograms) representing standard information. The information is individualised by non-holographic measures in the form of irreversible changes in the standard appearance. This makes it possible to clearly distinguish it from the standard appearance (see claim 2). Fig. 3 shows a sectional view of transfer strip 19.

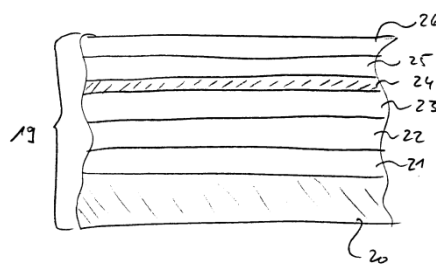


Fig 3

It consists of a carrier tape 20 on which a wax release layer 21 is applied. On top of this, there is a protective layer 22 and a layer of thermoplastic material 23, which is slightly less sensitive to heat than the separating layer 21. The thermoplastic material 23 is covered with a thin metal layer 24. The diffraction structure is embossed into the raw strip formed by layers 20 to 24. In a subsequent process step, the hologram is modified by selective removal, alteration or destruction in suitable layers. The individualisation can be obtained using a laser beam

pen. Fig. 21 shows a sectional view of a card 30 in connection with two exemplary inscription variants.

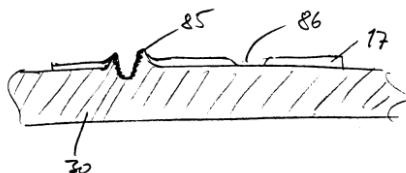


Fig 21

The hologram 17 is not only completely destroyed under the high energy effect of the laser beam, but the card substrate is also deformed in such a way that a micro-relief 85 is present in this area. However, by reducing the laser energy, it is possible to remove the hologram layers locally so that the data is formed by cut-outs 86 in the hologram (see col. 19, line 51, to col. 20, line 19). Figs. 22 and 23 show these variants.

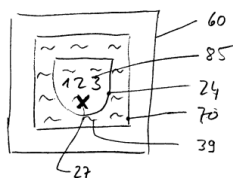


Fig 22

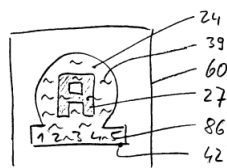


Fig 23

In Fig. 22 (see also col. 20, line 47, to col. 21, line 4), the holographic information covers the whole surface of rectangle 70. The micro-relief 85 is provided within that surface. In Fig. 23 (see col. 21, lines 4 to 33), the hologram 42 has the outline of a circle positioned on a rectangular bar. In the area of the bar, there are numerals 86 corresponding to recesses of the hologram surface generated by a laser pen. Thus, in both cases, the laser engraved security image extends over the portions of security material.

The opposition division concluded that feature 6 was disclosed in Fig. 21 and the passage extending from col. 19, line 51, to col. 20, line 19. In this embodiment, 100% of the image area is covered by security material. In view of its understanding on how claim 1 is to be construed (see point 1.1), the board agrees that claim 1 encompasses this embodiment, which, therefore, anticipates the subject-matter of claim 1.

Thus, the board concludes that the ground for opposition under Articles 100(a) and 54 EPC prejudices the maintenance of the patent as granted.

Consequently, the appellant's main request cannot be allowed.

2. Auxiliary request 1: Admittance

In the case at hand, the summons to oral proceedings was notified after the date on which the revised version of the Rules of Procedure of the Boards of Appeal (RPBA 2020, OJ EPO 2019, A63) entered into force, i.e. 1 January 2020 (see Article 24(1) RPBA 2020). Thus, in accordance with Article 25(3) Article, 13(2) RPBA 2020 applies.

The appellant presented the filing of this request during the oral proceedings before the board as a reaction to the board's change of mind in respect of its provisional interpretation of granted claim 1. However, in its letter dated 9 April 2021, the respondent had provided arguments against the board's provisional interpretation of claim 1. The appellant could not rely on the board's dismissal of these arguments, and the board's change of mind in view of these arguments cannot have come as a total surprise to

the appellant. The reasons given by the appellant are not "cogent" within the meaning of Article 13(2) RPBA 2020, justifying clearly why the circumstances leading to the amendment are indeed exceptional in the particular appeal.

Moreover, the board notes that the amendments on which auxiliary request 1 is based are *prima facie* highly problematic in view of the requirements of Article 123 EPC on at least two counts.

First, the deletion of the fourth sentence of paragraph [0020] of the patent raises serious concerns of compliance with Article 123(3) EPC because this sentence might be considered relevant to the interpretation of claim 1. The appellant itself admitted that the purpose of the deletion was to rule out a certain interpretation of claim 1. The sentence under consideration arguably defines a lower limit ("about 1%") for the percentage of security material in the image area. By deleting the sentence, this lower limit is set aside. This may result in an extension of the scope of protection offered by claim 1.

Second, the "disclaimer" added to claim 1 ("wherein the first and second portions are arranged beside each other, not above each other") raises questions as to whether it meets the requirements of Article 123(2) EPC. The basis offered by the appellant (i.e. "all the figures and the corresponding parts of the description") is insufficient in this respect. Although this feature may be present in the embodiments disclosed in the application as filed, there is *prima facie* no clear and unambiguous disclosure of the feature combination as defined in claim 1 of auxiliary request 1 in the original application. The appellant's

argument that the board's finding that claim 1 encompasses certain embodiments means that these embodiments have a basis in the original application is based on a confusion of the concepts of disclosure and scope of protection. Virtually any patent claim encompasses an infinity of embodiments not disclosed in the patent.

In view of the above, the board exercised its discretion under Article 13(2) RPBA 2020 and decided not to admit the appellant's auxiliary request 1 into the appeal proceedings.

3. Auxiliary request 2: Admittance

This request was first filed together with the statement of grounds of appeal.

In the case at hand, the statement of grounds of appeal was filed before the date on which the revised version of the Rules of Procedure of the Boards of Appeal (RPBA 2020) entered into force. Thus, in accordance with Article 25(2) RPBA 2020, Article 12(4) to (6) RPBA 2020 does not apply. Instead, Article 12(4) of the Rules of Procedure of the Boards of Appeal in the version of 2007 (RPBA 2007 - see OJ EPO 2007, 536) continues to apply.

Article 12(4) RPBA 2007 requires the board to take into account everything presented by the parties under Article 12(1) RPBA 2007 if and to the extent it relates to the case under appeal and meets the requirements in Article 12(2) RPBA 2007. However, according to Article 12(4) RPBA 2007, the board has the discretionary power to hold inadmissible facts, evidence or requests which could have been presented or

were not admitted in the first-instance proceedings (see "Case Law", V.A.4.11.1).

Auxiliary request 2 could have been filed during the oral proceedings before the opposition division. Therefore, its admittance is within the discretion of the board under Article 12(4) RPBA 2007.

The appellant invoked decision T 688/16. In the case on which this decision is based, the opposition division had refused to admit an auxiliary request filed during the oral proceedings. According to the deciding board, the opposition division had no discretion not to admit this auxiliary request under Rule 116(2) EPC because the communication under Rule 116(1) EPC did not contain an unfavourable preliminary opinion of the opposition division. On the contrary, the opposition division had changed its preliminary view only during the oral proceedings. Thus, the patent proprietor should have been offered the opportunity to react by filing a new request, and this request could not have been refused admittance on the grounds that it was late-filed (Reasons, point 2.2).

However, the case at hand is different from the case on which decision T 688/16 is based because the opponent filed written submissions in response to the communication under Rule 116(1) EPC arguing against the preliminary opinion of the opposition division. Thus, unlike in decision T 688/16, the patent proprietor should have expected that the opponent's new arguments might convince the opposition division and that it might therefore not adhere to its preliminary opinion. Consequently, the patent proprietor could and should have filed auxiliary request 2 in response to the

opponent's arguments already during the oral proceedings before the opposition division.

Moreover, when asked where the basis for the combination of features of new claim 8 was to be found in the original application, the appellant replied that it left the determination of the basis to the board. The appellant's approach appears to be based on a misunderstanding of the board's role and the parties' duties in opposition appeal proceedings. It is not the task of the board to fill the gaps in submissions made by the parties. Consequently, the board finds that the appellant has not indicated a basis for the amendment of the method claim and therefore, that auxiliary request 2 is not sufficiently substantiated.

In view of the above, the board exercised its discretion under Article 12(4) RPBA 2007 and decided not to admit auxiliary request 2 into the appeal proceedings.

4. Auxiliary request 3

4.1 Admittance

Like auxiliary request 2, this request was first filed together with the statement of grounds of appeal, but it could have been filed during the oral proceedings before the opposition division. Therefore, its admittance is within the discretion of the board under Article 12(4) RPBA 2007.

However, the board sees no reason not to admit this request. The objection based on Article 123(2) EPC is unfounded because the original independent method claim 9, on which claim 8 is based, refers to an ID

document "according to one of the preceding claims". Therefore, the addition of the feature of original claim 6 to claim 8 does not result in an inadmissible extension of subject-matter.

Accordingly, the board exercised its discretion under Article 12(4) RPBA 2007 and decided to admit the appellant's auxiliary request 3 into the appeal proceedings.

4.2 Inventive step

Document D3 belongs to the same technical field as the patent and is a suitable starting point for the examination of inventive step.

The subject-matter of claim 1 differs from the embodiment shown in Figs. 21 and 22 of document D3 in that the first material comprises at least one of the polymers polycarbonate, PVC or PET.

The skilled person wishing to carry out the embodiment of Figs. 21 and 22 of document D3 would have needed to choose a material for the substrate. The question of inventive step boils down to the question of whether the skilled person would have chosen polycarbonate, PVC or PET.

Document D3 itself refers to polyester (see col. 11, line 64, and col. 22, line 42), but this disclosure is made in respect of the carrier foil rather than the substrate of the ID document. Moreover, there are polyesters other than polycarbonate or PET.

Document D7 discloses a laser-writable data carrier (see page 1, first paragraph) with improved counterfeit

protection (see page 2, second paragraph). It is plausible that the skilled person looking for a suitable substrate material would have considered the teaching of document D7. Document D7 clearly suggests the use of polycarbonate (see page 11, lines 7 and 29). As a consequence, polycarbonate would have been an obvious choice.

The appellant's counter-arguments failed to convince the board because:

- document D3 discloses feature 6 (see point 1.2), and the alleged synergy between this feature and the choice of polycarbonate, for which no evidence was presented, can at best be a "bonus effect" (see "Case Law", I.D.10.8); and
- the fact that the polycarbonate used in document D7 has to be transparent would not have hindered the skilled person from choosing a non-transparent grade of polycarbonate if needed.

Consequently, the board concludes that the subject-matter of claim 1 of auxiliary request 3 lacks inventive step in view of the combination of documents D3 and D7 (Article 56 EPC).

It follows that auxiliary request 3 cannot be allowed.

5. Auxiliary request 4: Admittance

This request was first filed together with the statement of grounds of appeal. The reasons that have led the board not to admit auxiliary request 2 also apply to the admittance of auxiliary request 4.

Therefore, the board exercised its discretion under Article 12(4) RPBA 2007 and decided not to admit the

appellant's auxiliary request 4 into the appeal proceedings.

6. Auxiliary request 5: Admittance

This request was first filed together with the statement of grounds of appeal, but it could have been filed for the same reasons as for auxiliary request 2 already during the oral proceedings before the opposition division. Therefore, its admittance is within the discretion of the board under Article 12(4) RPBA 2007.

Claim 1 of auxiliary request 5 differs from claim 1 of the patent as granted (main request) in that "at least one operating parameter of the laser engraver is adjusted depending upon whether the security image ... is being engraved into the first material or whether the image is being engraved into the security material".

The addition of this product-by-process feature is *prima facie* highly problematic because it is not apparent how the unspecified adjustment of an unspecified operating parameter would result in structural differences detectable on the ID document obtained. Consequently, claim 1 is either unclear (if the additional feature is taken into account) or its subject-matter lacks novelty over document D3 (if the feature is considered non-limitative and ignored).

Therefore, the board exercised its discretion under Article 12(4) RPBA 2007 and decided not to admit the appellant's auxiliary request 5 into the appeal proceedings.

7. Auxiliary request 6

This request was withdrawn by the appellant during the oral proceedings before the board.

8. Auxiliary request 7

8.1 Admittance

Auxiliary request 7 was filed during the oral proceedings before the board after the board had stated that the former auxiliary request 7 could not be admitted into the proceedings for the sole reason that several of its claims did not *prima facie* comply with the requirements of Rule 80 EPC. The amended auxiliary request 7 clearly overcomes this objection, which was raised for the first time during the oral proceedings before the board.

Consequently, the board exercised its discretion under Article 13(2) RPBA 2020 and decided to admit the appellant's auxiliary request 7 into the appeal proceedings.

8.2 Compliance with Rule 80 EPC

The respondent did not raise any objection under Rule 80 EPC regarding amended auxiliary request 7. The board is satisfied that all amendments to the claims of auxiliary request 7 are occasioned by grounds for opposition under Article 100 EPC. Consequently, auxiliary request 7 complies with the requirements of Rule 80 EPC.

8.3 Compliance with Article 84 EPC

In its decision G 3/14 (OJ EPO 2015, 102), the Enlarged Board of Appeal found that, in considering whether, for the purposes of Article 101(3) EPC, a patent as amended meets the requirements of the EPC, the claims of the patent may be examined for compliance with the requirements of Article 84 EPC only when, and then only to the extent that, the amendment introduces non-compliance with Article 84 EPC (see Order).

Claim 1 is based on granted claims 1 and 4. According to granted claim 4, which depends on granted claim 1, "the image area ... consists essentially of a patchwork of multiple of first and second portions ...". Consequently, the association of "patches" and a "patchwork" of first and second portions was already claimed in the granted patent. The alleged lack of clarity was already present in the granted claims and cannot be examined for compliance with the requirements of Article 84 EPC in application of decision G 3/14.

It was argued that the deletion of the word "essentially", which was present in granted claim 4 but is absent from claim 1 of auxiliary request 7, introduced a lack of clarity. This objection is unfounded. On the contrary, the deletion of this word has improved the clarity of the claimed subject-matter because it is not necessary to elucidate whether a given set of first and second portions "essentially consists" of a patchwork.

Consequently, within the domain of scrutiny open to the board in application of decision G 3/14, auxiliary request 7 complies with Article 84 EPC.

8.4 Compliance with Article 123 EPC

None of the respondent's objections are well founded:

- The deletion of the word "essentially" (present in granted claim 4, which has now been added to claims 1 and 8) is unproblematic. This is because the disclosure that the "image area ... consists essentially of a patchwork of multiple first and second portions" comprises the disclosure of an image area that consists of a patchwork of multiple first and second portions.
- It is true that former claim 4 was dependent on claim 1 alone, whereas claim 3, which is its equivalent in the amended set of claims, depends on new claim 1, which corresponds to a combination of former claims 1 and 2. However, the feature of claim 3 is also disclosed in very general terms in paragraph [0025] of the original application (corresponding to paragraph [0016] of the patent), whereas the feature of granted claim 2 is disclosed in paragraph [0026] of the original application (paragraph [0017] of the patent). Consequently, this combination of features has a basis in the original application, regardless of the combinations involved in the granted claims.
- The addition of the feature of original device claim 4 into method claim 8 is also unproblematic because the method claimed is a method of manufacturing an ID document "according to one of the preceding claims", which include original claim 4.

Consequently, auxiliary request 7 meets the requirements of Article 123(2) EPC.

9. Remittal to the opposition division

The remittal of the case to the opposition division is within the discretion of the board according to Article 111(1) EPC.

The subject-matter of claims 1 and 8 of auxiliary request 7 has not been examined by the opposition division as to its patentability. The amendments that led to these claims are such that the interpretation of the claims is bound to change. In particular, it is questionable whether the claims cover an ID document in which the security material covers the entire image area. This may raise new questions, such as whether document D3 is still the most relevant piece of prior art for the examination of novelty and/or inventive step. Moreover, none of the parties had submitted substantiated arguments in favour of or against the patentability of the claimed subject-matter of auxiliary request 7 prior to the oral proceedings before the board. Therefore, in accordance with Article 11 RPBA 2020, special reasons present themselves for remitting the case to the opposition division for further prosecution.

The board has taken note of the parties' desire to have the case decided by the board without a remittal and their willingness to discuss these matters at the oral proceedings before the board. However, the board has doubts that this way of proceeding would have allowed for a fair and thorough consideration of the matters to be decided upon.

The parties also proposed to adjourn the oral proceedings before the board. However, remittal of the

case is preferable if only because the examination of the EPO's own motion provided for in Article 114(1) EPC is less restricted in opposition proceedings than in appeal proceedings (see decision G 9/91 of the Enlarged Board of Appeal, Reasons, point 18) and may, for instance, introduce additional state of the art of its own motion if need be.

Thus, it is appropriate to set aside the decision under appeal and remit the case to the opposition division for further prosecution on the basis of auxiliary request 7.

10. Reimbursement of the appeal fee

In accordance with Rule 103(1) (a) EPC:

"the appeal fee shall be reimbursed in full ... where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation, ..."

The request for a reimbursement of the appeal fee is based on an alleged procedural violation consisting in the opposition division's decision not to admit any of the appellant's auxiliary requests filed during the oral proceedings before the opposition division.

Regardless of whether the behaviour of the opposition division may have constituted a procedural violation, the board notes that it did not affect the proceedings before the opposition division as a whole but only the auxiliary requests. To have the opposition division's decision on the main request reviewed, the patent proprietor had to file an appeal anyway.

However, for the reimbursement of the appeal fee to be equitable, there has to be not only a substantial procedural violation but also a causal link between this procedural violation and the necessity to file the appeal (see "Case Law", V.A.9.7.1, for instance, decision T 792/12, Reasons, point 10.3.1).

A reimbursement is equitable if the procedural violation affects the entire first-instance proceedings (decision J 7/83 defines a substantial procedural violation as "an objective deficiency affecting the entire proceedings", see Reasons, point 12) such that it would justify the remittal of the case without further ado.

In this case, there is no such causal link. The patent proprietor's appeal is primarily directed at setting aside the first-instance decision refusing their main request that the opposition be rejected. Since this issue is not affected by the alleged procedural violation, a reimbursement of the appeal fee would not be equitable. The board observes that it is indeed true that under these circumstances and in view of the requirement of a causal link set out above the question of whether the reimbursement of the appeal fee is equitable may depend on the extent of the appellant's appeal.

Consequently, the requirements of Rule 103(1)(a) EPC are not met and the request for reimbursement of the appeal fee has to be refused.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated