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**Datasheet for the decision  
of 25 October 2021**

**Case Number:** T 1202/18 - 3.4.03

**Application Number:** 11816358.3

**Publication Number:** 2604440

**IPC:** B42D25/00, B41M3/14, C09D11/00,  
G07D7/12

**Language of the proceedings:** EN

**Title of invention:**  
LIGHT-EMITTING MEDIUM

**Patent Proprietor:**  
Dai Nippon Printing Co., Ltd.

**Opponent:**  
BANQUE NATIONALE DE BELGIQUE

**Headword:**

**Relevant legal provisions:**  
RPBA 2020 Art. 11

**Keyword:**  
Remittal - special reasons for remittal: different  
intepretation of claims - fresh case

**Decisions cited:**

T 1252/05, T 0908/07, T 0340/12, T 2266/13, T 1276/07

**Catchword:**



**Beschwerdekammern**

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**Chambres de recours**

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Case Number: T 1202/18 - 3.4.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.03**  
**of 25 October 2021**

**Appellant:** BANQUE NATIONALE DE BELGIQUE  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 2 March 2018  
rejecting the opposition filed against European  
patent No. 2604440 pursuant to Article 101(2)  
EPC.**

**Composition of the Board:**

**Chairman** M. Stenger  
**Members:** M. Papastefanou  
G. Decker

## **Summary of Facts and Submissions**

- I. The appeal of the opponent is against the decision of the opposition division rejecting its opposition against the grant of the European patent EP 2 604 440 B1.

The opposition was based on the opposition grounds under Article 100(a) EPC (lack of novelty and inventive step). In the impugned decision, the opposition division concluded that the opposition grounds invoked by the opponent did not prejudice the maintenance of the patent as granted and rejected the opposition.

- II. Reference is made to the following documents:

D1: EP 1 179 808 A1  
D2: WO 2005/021277 A1  
D3: WO 02 46528 A1  
D4: EP 2 602 119 A1 (with the priority document, D4\* [in Japanese], and its full English translation, D4\*\*)  
D5: DE 10 2006 017 764 A1  
D8: EP 1 291 194 A1  
D9: JP 2003-335085 (with an English machine translation D9\*)  
D10: JP 10-315605 (with an English machine translation D10\*)  
D11: JP 10-251570 (with an English machine translation D11\*)  
D12: JP 2006-274097 (with an English machine translation D12\*).

D1 to D3 were filed with the notice of opposition, D4 and D5 were filed with opponent's letter of

27 November 2017 and not admitted by the opposition division. D8 to D12 were filed with the statement of the grounds of appeal.

III. At the end of the oral proceedings before the board the requests of the parties were as follows:

The appellant-opponent ("opponent") requested that the decision under appeal be set aside and that the patent be revoked in its entirety.

The respondent-patent proprietor ("proprietor") requested, as a Main Request, that the appeal be dismissed, i.e. that the patent be maintained as granted. As an auxiliary measure the proprietor requested that the decision under appeal be set aside and the patent be maintained in amended form on the basis of one of the claim sets according to auxiliary requests 1 to 15, all filed with the letter dated 24 September 2021. It further requested that, should the board admit documents D8 and D9 into the proceedings, the case be remitted to the opposition division for further prosecution.

IV. Claim 1 of the patent as granted (proprietor's main request) is worded as follows:

*A light-emitting medium including a light-emitting image on a substrate, wherein:*

*the light-emitting image includes a plurality of first pattern elements containing a first fluorescent material and a plurality of second pattern elements containing a second fluorescent material;*

*the plurality of first pattern elements and the plurality of second pattern elements form a*

*plurality of micro-characters;  
there is no portion where the first pattern element  
and the second pattern element are in contact with  
each other;  
the plurality of micro-characters form micro-  
character rows, and the first pattern elements form  
a latent image in the micro-character rows;  
when invisible light within a first wavelength  
range is irradiated, the first fluorescent material  
and the second fluorescent material emit light of  
colors that are viewed as the same color with each  
other; and  
when invisible light within a second wavelength  
range is irradiated, the first fluorescent material  
and the second fluorescent material emit light of  
colors that are viewed as different colors from  
each other, whereby the latent image in the micro-  
character rows is caused to appear.*

- V. The wording of the claims of the auxiliary requests is not relevant for this decision.
- VI. During the oral proceedings before it, the board stated its preliminary opinion regarding the necessity of a revised definition of the term "micro-characters" in claim 1. After discussing with the parties, the board arrived at a definition which is less restrictive than the one in the decision under appeal. Subsequently, the question whether the case should be remitted to the opposition division for reassessment of the various issues in view of the new definition was discussed. At the end of the oral proceedings the chair announced the board's decision.
- VII. The parties' arguments, as far as they are relevant for this decision can be summarised as follows:

*On the definition of "micro-characters"*

The **proprietor** agreed with the opposition division's definition in the decision under appeal. The skilled person reading the patent would have understood that the characters had to transfer language, i.e. have a meaning in a language. This was also supported by the original Japanese text of the international application. The opponent's objections to the definition in the impugned decision were submitted only after the board had issued summons to oral proceedings and its preliminary opinion. They constituted an amendment of the opponent's appeal case and should not be admitted to the proceedings.

The **opponent** explained that it had objected to the definition of the opposition division during the opposition proceedings and in the statement of the grounds of appeal and there was no amendment to its case. The definition in the impugned decision was unjustifiably restrictive, since there was no indication in the patent that a character should have a meaning in a language or that it should be undiscernible without magnification.

*On the question of remittal*

The **proprietor** agreed with the remittal. The definition of "micro-characters" established by the board was less restrictive than the one by the opposition division and the relevance of the prior art documents had to be re-assessed. Moreover, most of the prior art documents were late-filed and their admission in the proceedings depended (also) on their relevance. In essence, there

was a fresh case, which should be remitted to the opposition division.

The **opponent** objected to the remittal. A remittal would cause more delay in settling the case. There were several relevant prior art documents available which put the validity of the patent seriously into question. Leaving such a patent in force gave an unfair advantage to the proprietor. The proprietor should have been prepared to discuss all the issues in appeal.

The parties' arguments are dealt with in more detail in the reasons for the decision.

### **Reasons for the Decision**

1. The invention in the attacked patent
  - 1.1 The invention relates to a light-emitting medium including a light-emitting image which appears when invisible light within a specific wavelength range is irradiated on it.
  - 1.2 The light-emitting image includes pattern elements in the form of micro-characters. A first part of these pattern elements ("first pattern elements") includes a first fluorescent material, such as a fluorescent ink, and form a latent image, which is normally invisible in ambient light conditions. A second part of those pattern elements ("second pattern elements") includes a second fluorescent material.

When the image is irradiated with invisible light of a first wavelength, all the pattern elements emit a visible light which is viewed as one colour. When the image is irradiated with invisible light of a second



wavelength, the first and second parts of the pattern elements emit lights of different colours and the latent image becomes visible.

1.3 The light-emitting medium is used in valuable documents, such as banknotes, cash vouchers, identity cards, etc. as an anti-counterfeit measure (see paragraphs [0001] to [0008] of the patent specification).

2. Claim interpretation

2.1 It is common ground that the patent specification does not provide a definition of the term "micro-character(s)" used in the claims.

2.2 During the first instance opposition procedure the interpretation of this term was discussed at length with the parties. One of the main questions was what type of sign/symbol can be considered a "character" and whether signs such as dots can be regarded as characters. The aspect of the size of the characters was also discussed in view of the prefix "micro-".

2.2.1 The opposition division gave two different definitions in the course of the opposition procedure.

In the annex to the summons to the first instance oral proceedings, the opposition division considered that a *character need[ed] to be, by definition, a graphic symbol used in writing or printing* (see annex to the communication dated 10 April 2017, point 4.1.1, fourth paragraph).

In the decision under appeal, the opposition division held that *the term "micro-character" [was] considered*

*to be any kind of sign or symbol, undiscernible without magnification, which [was] used for writing a language, a language following, by definition, an accepted convention (see page 7, fourth paragraph).*

As stated in the minutes of the oral proceedings (see points 4 to 7), the opposition division arrived at this definition after discussing the matter with the parties, but no details about the discussion are mentioned other than that the proprietor referred to a certified translation of the Japanese terms "Moji", "Monji" and "Ji".

- 2.3 Leaving the aspect of size aside for the moment, it is evident that the second definition by the opposition division is more restrictive than the first, since it calls for the sign or symbol to be used for writing a language, in other words it should have a meaning in a language.
- 2.4 In its preliminary opinion, the board gave a first assessment of the case based on the definition of "micro-character" in the impugned decision, noting that neither of the parties had *directly contested* the definition in the impugned decision or provided an alternative one.
- 2.5 In its letter of 24 September 2021 (i.e. after the board had issued summons to oral proceedings), the opponent pointed out that it did not agree with the opposition division's definition (see point I) and repeated a definition it had put forward during the opposition procedure, according to which a "character" should be understood as *any kind of mark, space or symbol used in writing or printing* (see last line on page 3 of that letter).

- 2.6 The proprietor claimed that the opponent's arguments constituted an amendment to its appeal case, and requested that they not be admitted under Article 13(2) RPBA 2020. It further stated that the skilled person reading the patent specification as a whole would adopt the definition of "micro-characters" as set out in the impugned decision. The proprietor referred also to the original Japanese text of the international patent application, and explained that the term "Moji", which was used therein, meant a character transferring language (i.e. a meaning - see also point 2.8.2 below).
- 2.7 The board notes that several prior art documents were submitted by the opponent after the expiration of the opposition period and their admission in the proceedings has yet to be decided upon. A commonly used criterion in deciding whether a late-filed prior art document is to be admitted is its *prima facie* relevance.
- 2.7.1 Documents D1 to D3, which were filed in time, were considered by the opposition division not to be disclosing micro-characters. Documents D4 and D5, filed by the opponent in preparation to the opposition oral proceedings, were not admitted by the opposition division because they were held not to disclose (rows of) micro-characters according to the definition in the impugned decision. The opponent filed documents D8 and D9 with its statement of grounds of appeal, arguing that they disclosed micro-characters according to the definition in the decision under appeal and that they should be admitted into the proceedings as a legitimate reaction to the more restrictive definition adopted by the opposition division during the oral proceedings.

It is, thus, evident to the board that the admission of documents D4 to D9 as well as the assessment of D1 to D3 depends on what is to be understood as a "micro-character".

- 2.7.2 Furthermore, the proprietor filed new auxiliary requests 1 and 2 as a reaction to the board's preliminary opinion that documents D8 and D9 might be admitted into the procedure and also requested remittal of the case to the opposition division in case the board admitted documents D8 and D9 (see proprietor's letter of 24 September 2021, penultimate paragraph on page 1 and first paragraph of page 2).

It is, thus, not only the opponent's request to admit several prior art documents that depends on the definition of "micro-characters" but also the admission of the proprietor's new auxiliary requests and its request for remittal.

- 2.7.3 Taking all these aspects into consideration, the board concluded that it was necessary to arrive at a definition of the term "micro-characters" before any further assessment of the case could take place. It also decided to take into account all the relevant arguments of the parties.

Hence, at the beginning of the oral proceedings, the board informed the parties that before any discussion on the objections against the patent, the meaning of "micro-characters" had to be established first.

- 2.7.4 Regarding the proprietor's objection about the late-filed arguments of the opponent, the opponent pointed out (see letter of 24 September 2021, point I) that it had expressed its disagreement to the opposition

division's definitions already during the opposition procedure, before and during the oral proceedings. It had also referred to these objections again in its statement of the grounds of appeal. The arguments brought forward in its letter of 24 September 2021 were, thus, no new arguments amending its appeal case, but rather an expansion of its previous argumentation.

The board finds that the question of whether or not these arguments constitute an amendment to the opponent's appeal case can be left open. As explained before, the board considers the definition of the term "micro-characters" to be crucial for the case. It decided, therefore, to take all the parties' arguments into account. Moreover, in view of the fact that the board raised the issue of a new definition only at the beginning of the oral proceedings, exceptional circumstances within the meaning of Article 13(2) RPBA 2020 can be acknowledged that justify the admission of any late-filed arguments.

2.8 What is a "character"?

2.8.1 As stated before, the patent does not provide any definition of the term. In several embodiments of the claimed invention, the letters "D", "N" and "P" are used as examples of characters (see e.g. Figures 2, 6A, 6B, 8A, 9A, 9B).

2.8.2 The proprietor explained that in the original international application, which was filed in Japanese, the term "Moji" was used. "Moji" in Japanese meant a character which transferred language, i.e. which had a meaning in a language. In the translation into English, the term "character" was used, because the term "letter" was considered too restrictive. It was

commonly accepted that a "letter" referred to an alphabet, like the Latin alphabet, but for other writing systems, like the Chinese or the Japanese, the term "character" ("Japanese/Chinese character") was commonly used. So, the original meaning was that the pattern elements of the fluorescent image formed (micro-)characters having a meaning in a language.

Even when looking at the English text of the patent, the skilled person would arrive at the same conclusion. All the embodiments in the patent used the letters "D", "N" and "P" as examples of (micro-)characters. These were letters of an alphabet and conveyed meaning in a language. There was no example in the patent using other types of symbols/marks, such as dots. The skilled person had no reason to regard abstract symbols as characters falling under the claimed invention.

Hence, the definition by the opposition division in the impugned decision was justified and corresponded to what a skilled person would understand by reading the patent specification.

- 2.8.3 The opponent pointed out that the patent was written in English and any interpretations of its content based on the Japanese text of the original international application were not appropriate, especially since the proprietor had never asked for a correction of the translation.

It was true that the embodiments referred to the letters "D", "N" and "P", however, the claim used the term "character" and not "letter". The skilled person would, thus, understand that the term "character" was broader than "letter", i.e. it comprised more (other symbols/signs) than letters. In the context of the

patent, the term "character" would not necessarily refer exclusively to letters but also to other graphical symbols used in writing or printing.

The opposition division's definition in the impugned decision was, therefore, unjustifiably restrictive.

- 2.8.4 As a first point, the board agrees with the opponent that the language of the patent is English, according to Article 14(2) EPC. The meaning of the terms in the Japanese text of the international application has no bearing on the interpretation of the text of the patent, irrespective of what the intention of the author of the original (Japanese) application might have been.

The proprietor has at no point during the first or second instance procedures requested any correction of the translation of the English text of the patent (application) in order to bring it into conformity with the application as originally filed. Any references to the original Japanese text are thus not to be taken into account when interpreting the text of the patent.

- 2.8.5 Secondly, the board finds that the restriction of characters to symbols conveying meaning in a language is not supported by the content of the patent.

Although it is true that the embodiments of the invention in the patent use the letters "D", "N" and "P" as examples of characters, the claims do not refer to (micro-)letters but to (micro-)characters. In the board's view, the skilled person would understand that the term "character" is broader than the term letter, as also argued by the opponent.

Moreover, the pattern elements of the light-emitting image do not include/convey any message as part of their anti-counterfeit function. A part of the pattern elements (first pattern elements) include a latent image, such as a letter "A" (see e.g. Figure 8A of the patent), but the form and shape of the pattern elements themselves is not important as long as they combine to form this latent image. The board understands that the repeated use of the letters "D", "N" and "P" in the examples in the patent refers to the name of the proprietor (Dai Nippon Printing Co., Ltd), and may have been done e.g. for publicity purposes. In other words, there is no need for the micro-characters to have a meaning in a language in order to fulfil their anti-counterfeit function as described in the patent.

2.8.6 The term "character" in English may refer to the signs of writing systems which do not use an alphabet, such as the Japanese or Chinese writing systems, as the proprietor explained. In the board's view, however, this is not the only possible reference. The board notes that the patent refers to a light-emitting medium and image formed on a substrate such as a value bearing or security document (a bank note, an identity card, a cash voucher), and destined to prove the authenticity of that substrate.

This image would normally be formed on the substrate by printing. The patent refers to fluorescent ink as fluorescent material. Hence, the technical context of the patent is what is called "secure printing", i.e. printing using special techniques and/or materials elements that would help to prove the authenticity of the substrates they are printed on. The term "character" has a different meaning in this context. A person skilled in (secure) printing would understand a



"character" to be any sign or symbol that is to be printed on a substrate. Expressions such as "Unicode set of characters" or "Special characters" are commonly known and used in this context.

The board's view is, therefore, that the skilled person reading the patent would not consider that a character is to be understood as a sign of e.g. the Japanese or Chinese writing system, but rather any sign or symbol that is used in printing.

2.8.7 In this context, the board finds the definition suggested by the opponent (see point 2.5 above) to be overly broad, especially since a "space" can be understood as merely an empty area of the image or the substrate, i.e. an area without any sign or symbol printed on it. In such a case, any "empty" area (i.e. without any printing on it) on a substrate could be considered a series of spaces and thus held to include a series of "micro-characters" according to the opponent's definition. In the board's view this goes beyond what is intended with "micro-characters" in the patent.

2.9 The term "micro"

2.9.1 Although both parties agreed that this term (prefix) relates to the size of the character(s), they did not agree on which size range(s) it referred to.

The patent does not provide any concrete limitations, either. Paragraph [0024] states that the size of a micro-character is *preferably not more than 300  $\mu\text{m}$  (micrometres) square*. 200  $\mu\text{m}$  square are mentioned as an example. Claim 6 defines that the size of a micro-character is *not more than 300  $\mu\text{m}$  square*. The same is

also stated in paragraph [0013].

- 2.9.2 According to the opposition division's definition in the impugned decision (see point 2.2.1 above) the micro-character is *undiscernible without magnification*.

The board notes, as the opponent also pointed out, that according to the minutes of the oral proceedings, the definition given by the opposition division was that a micro-character *[could] not be read without magnification*.

The parties disagreed whether "undiscernible" had the same meaning as "cannot be read" or was more restrictive. In view of the following considerations, this question can be left open.

- 2.9.3 The opponent argued that the term "micro-" should be understood as an order of magnitude, i.e. a size in the scale of micrometres. However, there was no specific limitation to sizes or ranges of sizes in claim 1. There was nothing in the patent that indicated whether or not a micro-character could be read or discerned with or without magnification. Moreover, according to the patent (see paragraph [0025]), any size above 100  $\mu\text{m}$  could be discerned by the human eye.

This limitation was, therefore, not supported by the content of the patent.

- 2.9.4 The proprietor agreed that the term should be understood as an order of magnitude. The skilled person would understand that a character in that size range would not be discernible without magnification.

The definition of the opposition division matched the

skilled person's understanding in that aspect.

- 2.9.5 The board notes, as the opponent also pointed out, that the patent does not give any indications about whether a micro-character can be discerned or read with or without magnification.

The board also notes that the size ranges mentioned in the patent do not exclude that a micro-character can be discerned by an average human eye without magnification. It is generally known, for example, that a human hair has a thickness between 17 and 180  $\mu\text{m}$ . It is also commonly known that an average human eye can discern individual human hairs, at least within a part of this thickness range, without magnification. Although this aspect is not decisive, it is worth mentioning to show that the size ranges mentioned in the patent do not exclude that a micro-character within these ranges can be discernible without magnification.

- 2.9.6 The board's conclusion, is therefore, that the term "micro-" is to be understood as an order of magnitude, i.e. a size in the range of micrometers. The question of whether a micro-character can be discerned (or read) with or without magnification is irrelevant.

In addition, in the absence of any specific size limitations, the board considers inappropriate to set strict limits to the size range of the micro-characters. In other words, it is not appropriate to limit the size of the claimed micro-characters in the range of 1 to 999  $\mu\text{m}$ , since 1000  $\mu\text{m}$  is 1 mm (millimetre) and over the "micrometre scale". At the same time, it is also true that even sizes of millimetres can always be expressed in  $\mu\text{m}$ , e.g. 2mm as 2000  $\mu\text{m}$ . The board takes the view that the skilled

person would choose whether to express a size as micrometres or millimetres (or nanometres at the other end of the scale) depending on the circumstances. There may be cases where it would be more appropriate to refer to 800  $\mu\text{m}$  as 0,8 mm and others where 1,2 mm would be stated as 1200  $\mu\text{m}$ .

#### 2.10 "Micro-character" - definition

Taking all the above considerations and arguments into account, the board concludes to the following definition:

*A micro-character is any graphical symbol, such as any letter, sign or mark to be used in printing, with dimensions the skilled person would express using the micrometre scale.*

### 3. Remittal

3.1 After the conclusion of the discussion on the interpretation of the term "micro-character" with the definition stated above, the board pointed out that the new definition was less restrictive than the one adopted by the opposition division. As a consequence, the assessment of the case, including the relevance of the prior art documents, both those on file as those late-filed, whose admission had yet to be decided upon, had to be done anew. The question of whether there was a fresh case that should be remitted to the opposition division was then discussed.

3.2 The opponent disagreed with a remittal. There was no fresh case, and in any case there was no absolute right to have issues decided in two instances. Moreover, the case was already delayed 5 years after the grant of the

patent, and a remittal to the opposition division, with a possible subsequent appeal, would add more delay.

3.2.1 The opponent explained that it had made clear its position regarding the opposition division's definition of the "micro-characters" already during the opposition procedure. The proprietor had had the duty to consider documents D1 to D5 in preparing for the oral proceedings before the opposition division, even taking into account the first, broader definition given by the opposition division in the annex to the summons. In fact, the proprietor had filed auxiliary requests in preparation to the opposition oral proceedings taking into account the opponent's submissions, e.g. by modifying the term "micro-characters" to "micro-letters" in some of the auxiliary requests, or introducing explicit size ranges in others.

3.2.2 Documents D8 to D12 were filed with the statement of the grounds of the appeal as reaction to the impugned decision. Although objecting to their admission, the proprietor had responded to the arguments based on those documents, especially those based on D8 and D9.

3.2.3 The proprietor had provided arguments in its reply to the appeal about the question of whether dots can be regarded as micro-characters or not (see pages 15 and 16 of the reply to the appeal). The opponent had also provided arguments against the proprietor's auxiliary requests in the grounds of the appeal.

Hence, there was no fresh case, neither legally nor factually.

3.2.4 Moreover, the opponent pointed out that, according to the board's preliminary opinion, D9 could be decisive

for the outcome of the case. There were several relevant prior art documents which could invalidate the patent and it would be unfair for the public to prolong the life of the patent.

- 3.3 The proprietor agreed with the remittal of the case to the opposition division.
- 3.3.1 The proprietor agreed with the opposition division's definition of "micro-characters" and had never accepted the definition by the opponent. It was a surprising change of circumstances that the board provided a new definition during the oral proceedings, especially in view of the board's preliminary opinion.
- 3.3.2 Most of the prior art documents were late filed and their admission had yet to be decided. Their relevance, as well as the relevance of documents D1 to D3 had to be re-assessed. New combinations of documents of the prior art may now be possible which were not foreseen in view of the "old" definition of "micro-characters". The patent may be at risk and it would be only fair to remit it to the opposition division for a new assessment.
- 3.4 The board understands that the new definition of the term "micro-character" calls for a new interpretation of the claims. Any assessment of the relevance of the prior art documents up to now has been based on a different interpretation of the claims. In fact, the whole of the discussion during opposition and appeal proceedings was based on a different interpretation of the claims.

Even if arguments were provided by the parties regarding some aspects, like some prior art documents

as the opponent points out, all these arguments were made in view of another interpretation of the claims.

Therefore, the board's view is that there is a fresh case.

3.5 During oral proceedings, the opponent referred to several decisions of the Boards of Appeal seeking support for its arguments against the remittal of the case. These decisions relate to cases where new prior art documents were admitted in appeal and the case was subsequently not remitted to the first instance department. The board does not find these decisions applicable in the present case, since there is no new prior art admitted, but a change in the interpretation of the claims, which is, in the board's view, a more substantial change of the facts of the case.

3.5.1 More specifically:

- In T 340/12, a new prior art document submitted with the statement of the grounds of appeal was admitted by the board. The board explicitly stated that there was no fresh case after the admission of the new prior art, contrary to the board in the present case.
- In T 908/07, the board introduced a new prior art document in advance of the oral proceedings. The question of remittal was never raised by any of the parties.
- In T 2266/13, the board admitted a new prior art document submitted with the statement of the grounds of appeal for the first time and did not remit the case because it considered that the

content of the document was relatively short and simple and the patent proprietor had sufficient time to study it.

- In T 1276/07, the board apparently admitted at least some of the new prior art documents filed by the appellant-opponent with the statement of the grounds of appeal. The question of remittal was never discussed. Despite the new prior art documents, the board dismissed the opponent's appeal.
- In T 1252/05, the board confirmed that there is no automatic right to a remittal after the admission of new prior art documents.
- The opponent also referred to T 1252/05 as support to its argument that there is no absolute right of having an issue decided in two instances. The board agrees with the opponent on this point. In the present case, however, there are not only some issues that have to be decided upon, but the whole assessment of the case has to be done anew (see also point 3.4 above).

3.6 Under Article 11 RPBA 2020, a board would normally not remit a case to the first instance department unless special reasons present themselves for doing so.

3.6.1 In the present case, the board took the view, after having issued its preliminary opinion, that it was necessary to arrive at a new definition of the term "micro-character" because the one in the decision under appeal was unjustifiably restrictive. From a procedural point of view, the parties had only the oral proceedings before the board to react to this new issue



raised by the board at the beginning of the oral proceedings.

3.6.2 There is a series of issues in the present case which are affected by the change in the interpretation of the claims, such as the admission of several late-filed prior art documents (D4 to D12), two late filed auxiliary requests (auxiliary requests 1 and 2 filed with the proprietor's letter of 24 September 2021), the assessment of documents D1 to D3, as well as the request for remittal by the proprietor. Moreover, the admission of the proprietor's remaining auxiliary requests (renumbered as auxiliary request 3 to 15), which were filed with the reply to the appeal but not substantiated in time (see also point 4 of the board's communication under Article 15(1) RPBA 2020), has yet to be decided upon, and their relevance in view of the new interpretation of the claims as well as the prior art documents would also have to be discussed. As already stated, all these issues amount to a fresh case.

3.6.3 The board takes the view, thus, that on the one hand it cannot deal with all these issues without undue burden at this point of the procedure. On the other hand, it considers unfair to force the parties to a reaction to all those new issues during the limited time of the oral proceedings. The board's conclusion is, therefore, that there are special reasons within the meaning of Article 11 RPBA 2020, which call for a remittal of the case to the opposition division for further prosecution.

3.7 Summarising, the present decision of the board relates only to the interpretation of the claims, and more specifically, to the definition of the term "micro-

character" in the present context (see point 2.10 above). No decision is taken on the admission of prior art documents D8 to D12 and of the proprietor's auxiliary requests 1 and 2 filed with the letter of 24 September 2021. The same applies to the proprietor's auxiliary requests 3 to 13, which correspond to auxiliary requests 1 to 13 filed with the reply to the appeal and which were filed for the first time during the opposition proceedings. The admission of documents D4 and D5 should also be reconsidered by the opposition division in view of the new interpretation of the claims.

## Order

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

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



S. Sánchez Chiquero

M. Stenger

Decision electronically authenticated