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**Datasheet for the decision  
of 8 February 2022**

**Case Number:** T 1249/18 - 3.3.06

**Application Number:** 06768119.7

**Publication Number:** 1903144

**IPC:** D21H21/42, B32B15/08, G07D7/20,  
B42D15/00

**Language of the proceedings:** EN

**Title of invention:**

THREAD AND PRODUCTION METHOD THEREFOR, FORGERY PREVENTING FORM  
USING THREAD, AND FORGERY PREVENTING PRINTED MATTER, AND  
FORGERY JUDGING METHOD USING THEM

**Patent Proprietor:**

Toppan Printing Co., Ltd.

**Opponent:**

Giesecke+Devrient Currency Technology GmbH

**Headword:**

Counterfeit preventive paper/TOPPAN

**Relevant legal provisions:**

EPC Art. 123(2), 54, 56  
RPBA 2020 Art. 13(1), 13(2), 12(3), 12(6), 12(2)  
RPBA Art. 12(4), 12(2)

**Keyword:**

Late-filed novelty objection - not justified - not prima facie relevant : not considered

Late-filed objections of novelty and added subject-matter - submitted during oral proceedings without cogent reasons: not considered

Amendments - allowable (yes)

Novelty - (yes)

Inventive step - (yes)

**Decisions cited:**

G 0002/10

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 1249/18 - 3.3.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.06**  
**of 8 February 2022**

**Appellant:** Giesecke+Devrient Currency Technology GmbH  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
27 March 2018 to maintain European Patent  
No. 1903144 in amended form.

**Composition of the Board:**

**Chairman** J.-M. Schwaller  
**Members:** P. Ammendola  
J. Hoppe

## Summary of Facts and Submissions

I. This appeal lies from the interlocutory decision of the opposition division to maintain the patent in amended form on the basis of the main request filed on 21 December 2017, claim 1 thereof (hereinafter the **maintained claim 1**) reading as follows:

*"1. A counterfeit preventive paper (10) comprising paper sheets (15a, 15b) and a thread (1) inserted into the paper sheets (15a, 15b),*

*characterized in that the thread (1) comprises a string-like and light permeable substrate (2) having front and back sides, at least one metal thin film layer (3, 4) formed in a pattern of either character or figure or both on one side and an opposite side of the substrate (2), and a colored resin layer (7, 8) on each of the metal thin film layers (3, 4) patterned same as the respective metal thin film layer (3, 4), wherein due to difference in light permeability between a region having the metal thin film layer and a region not having the metal thin film layer, a contrast is caused between the former region and the latter region when held to light;*

*and in that the paper (10) satisfies the following conditions (a) and (b):*

*(a) the respective colored resin layer (7, 8) can be recognized as the pattern by reflected light when viewed from the one side, and, if the paper (10) is viewed from the opposite side with reflected light, the laterally or vertically inverted pattern of the recognized colored resin layer (7, 8) is hardly visible, and*

*(b) if the paper (10) is viewed with transmitted light while held to light, the pattern of the recognized colored resin layer (7, 8) is visible as a shadow."*

Claims 2 to 12 define preferred embodiments of above counterfeit preventive paper (hereinafter **CP paper**) and claim 13 defines a method of judging authenticity of the CP paper according to claim 1.

II. With its grounds of appeal, the opponent (hereinafter **appellant**) argued that maintained claims 1, 11 and 12 had no basis in the application as filed (Article 123(2) EPC), that the subject-matter of such claim lacked novelty vis-à-vis **D1** (WO 03/061980 A1) and inventive step in view of the combination of *inter alia* document **D7** (WO 92/10608 A1) with either D1 or common general knowledge.

In particular, the objection under Article 123(2) EPC comprised several sub-sections addressing the wording of maintained claim 1 as well one section entitled "Claim dependencies" starting with the passage: *"The originally filed claim set is drafted in US style and consequently, a linear dependency is introduced. To demonstrate this issue we herewith refer to claims 3 to 14 of the originally filed claim set referring to dependent claim 2. However, the claim set as provided with the amended Main Request with the submission dated December 21, 2017 introduces a broader dependency throughout the claims. Merely to provide an example we herewith refer to claims 11 and 12 of the Main Request"*, followed by the reasons which, in appellant's opinion, proved that maintained claims 11 and 12 infringed Article 123(2) EPC as they referred not just to maintained claim 1.

The inventive step objection based started from Figure 7 of D7.

- III. The patent proprietor (hereinafter **respondent**) replied requesting to dismiss the appeal as a main request and he submitted four sets of amended claims as auxiliary requests 1 to 4.

In particular, the set of claims of **auxiliary request 2** only differs from the one upheld by the opposition division in that its claims 11 and 12 read as follows (amendments in respect of upheld claims 11 and 12 made apparent by the board):

*"11. The counterfeit preventive paper (10) according to ~~any of claims 1 to 9~~, characterized in that the pattern forming character or figure is provided in laterally or vertically inverted direction when viewed from the one side of the substrate (2) having the metal thin film layer (3, 4) and the colored resin layer (7, 8) corresponding to the pattern."*

*"12. The counterfeit preventive paper (10) according to ~~any of claims 1 to 11~~, characterized by further comprising a printed portion (P) printed as a counterfeit preventive printed material on the counterfeit preventive paper (10)."*

- IV. With letter dated 15 April 2019 the appellant raised further novelty and inventive step objections based on Figure 1 of D7.
- V. In the preliminary opinion of the board the objection under Article 123(2) EPC against claim 1 of the main request and the novelty attacks against claim 1 of the main request based on D1 or D7 were not found to be

convincing. As regards the novelty objection in the light of D7 and the objections under Article 56 EPC based on D1, D4 or D7 the board questioned whether they should be admitted.

VI. At the oral proceedings, held on 8 February 2022, the discussion addressed first the objections under Articles 123(2), 54 and 56 EPC against claim 1 of the main request. The appellant maintained in particular the novelty objection based on D1 as submitted in writing and it further argued that the new issue based on Figure 1 of D7 should be admitted in view of its *prima facie* relevance. It also submitted for the first time a novelty objection based on Figure 7 of D7 and requested its admittance into the proceedings in view of its *prima facie* relevance. The appellant further declared maintaining the objection of lack of inventive step starting from Figure 7 of D7 only and referred in this respect to the claims of D7. It however withdrew its objections of lack of inventive step based on D1 or D4 as closest prior art.

During the subsequent discussion of auxiliary request 2, the appellant submitted for the first time an objection under Article 123(2) EPC to dependent claims 5, 6 and 10, arguing that these claims resulted from undisclosed selections of alternatives. It pleaded that such new objection be admitted in view of its *prima facie* relevance and of the fact that the grounds of appeal contained an objection under Article 123(2) EPC directed in general to all upheld dependent claims.

The respondent disputed the admittance of any of the belated objections of novelty based on D7, as well as of the line of argument on inventive step starting from Figure 7 of D7 as it was also based on claims of D7

that had never been mentioned in appellant's written submissions. It also contested the admittance of the new objection under Article 123(2) EPC raised against claims 5, 6 and 10 of auxiliary request 2, and stated to be unable to discuss this belated objection during the oral proceedings.

The respondent finally withdrew the previously pending main and first auxiliary requests.

VII. The parties' final requests were as follows:

The appellant requested that the decision under appeal be set aside and the patent be revoked.

The respondent requested that the patent be maintained in amended form based on one of auxiliary requests 2 to 4 filed with its reply to the grounds of appeal.

## **Reasons for the Decision**

### *Auxiliary request 2*

1. Added subject-matter (Article 123(2) EPC)
  - 1.1 According to the contested decision claim 1 at issue finds a basis in the definition of the CP paper of original claim 15 (which comprised "*the thread according to claim 2*"), amended to incorporate the description of the thread in original claims 2 (which described "*[a] thread according to claim 1*") and 1, further modified by the incorporation of features "(a)" and "(b)" of original claim 18, which defined "*[a] method of judging authenticity of the counterfeit preventive paper according to claim 15*".



1.1.1 The appellant submitted that features "(a)" and "(b)" were only originally disclosed as steps of the testing method according to claim 18 as filed and the passages from page 15, line 12 to page 16, line 4 and from page 16, line 26 to page 7, line 7 as filed. It also argued that the original application provided no disclosure as to how the CP paper had to be made in order to display the properties "(a)" and "(b)". Therefore, the definition of the structural features of the presently claimed CP paper in terms of its ability to display the properties "(a)" and "(b)" would amount to a new functional definition of the CP paper's structural features, not present in the original application.

1.1.2 For the board, the question to be answered is what a skilled person can derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (see G 2/10, Reasons 4.3). In line with this requirement, the board stresses that original claim 18 defined a method of judging authenticity "*of the counterfeit preventive paper according to claim 15*" (emphasis added), and so a skilled reader of said claim 18 would conclude that it necessarily implies (and thus discloses) that at least some embodiments of the CP paper of original claim 15 must pass the test, and so must display the functional properties "(a)" and "(b)", thereby implicitly disclosing CP paper in accordance with original claim 15 that displays these properties. The alleged fact that the original application failed to disclose how the CP paper had to be made in order to display these properties is therefore irrelevant in view of the compliance of claim 1 at issue with Article 123(2) EPC.

- 1.1.3 The appellant further brought forward in writing (point 1.1 of the grounds of appeal) that the contrast visible when "*held to light*" (i.e. the pattern visible under transmitted light) described in original claim 2 exclusively referred to the contrast between the "*region having the metal thin film layer*" and the region not having such layer, that was present on the "opposite side" of the substrate. Instead, present claim 1 would describe a similar contrast referring cumulatively any region having the metal thin layer and any region not having a thin metal layer, as present on both the "*one side*" and the "*opposite side*" of the substrate.
- 1.1.4 In the convincement of the board a skilled person reading original claim 2 would note that, in consequence of its reference to original claim 1, it also implies the presence of a contrast between the "*region having the metal thin film layer*" and the region not having such layer present on the "*one side*" of the substrate. Hence, in the board's view, the skilled person would immediately conclude that the contrast visible when the thread is "held to light" described in original claim 2 is necessarily determined by the positioning of all thin metal layers that may interfere with the light transmission through the thread, i.e. this contrast depends on (the positioning of) the regions having the metal thin layer and the regions not having such layer on both sides of the substrate. Hence, the wording of claim 1 relating to the contrast between any such regions finds a direct and unambiguous basis also in original claim 2.
- 1.1.5 Accordingly, the board finds that claim 1 has a basis in the combination of original claims 1, 2, 15 and 18 and thus complies with Article 123(2) EPC.

1.2 The appellant also raised objections under Article 123(2) EPC in a generic way and in writing against the dependent claims. At the oral proceedings it then raised a further and more specific objection of added subject-matter against dependent claims 5, 6 and 10.

1.3 The board notes that the appellant mentioned in point 1.2 of its grounds of appeal only a general objection of added subject-matter in view of the dependencies of the dependent claims. This objection was further specified only in respect of claims 11 and 12 of the main request, which are however not present in auxiliary request 2. The appellant's further general statement that the claim set as provided allegedly introduced "a broader dependency throughout the claims" than the originally filed claims is not in line with Article 12(3) RPBA 2020 that requires the appellant to specify expressly all facts and arguments relied on in the grounds of appeal. Also the general reference to the written submissions and arguments as provided in the opposition proceedings cannot substitute the presentation of the party's complete case as required by Article 12(3) RPBA 2020 (Article 12(2) RPBA 2007).

As the above objection was thus insufficiently substantiated in the grounds of appeal, the board exercised its discretion not to take it into account under Article 12(4) RPBA 2007 (Article 12(3) RPBA 2020; Article 12(2) RPBA 2007).

1.4 At the oral proceedings the appellant submitted further facts and arguments as regards an objection under Article 123(2) EPC against dependent claims 5, 6 and 10, based on the argument that these claims resulted from undisclosed selections from distinct lists of alternatives. It argued that such objection would be a

specification of the general objection to the claim dependency raised in point 1.2 of its grounds of appeal and that it should be admitted into the appeal proceedings in view of its *prima facie* relevance.

- 1.4.1 The board stresses however that the general objection to the claim dependency raised in the grounds of appeal has been found insufficiently substantiated (for the reasons given above). Furthermore, the alleged *prima facie* relevance of a new objection as such does not normally represent an exceptional circumstance for justifying lateness of filing under the provisions of Article 13(2) EPC RPBA 2020. Finally the respondent has contested the admissibility of this unjustifiably late objection of added subject-matter into the appeal proceedings.

Hence, in the absence of exceptional circumstances the board exercised its discretion under Article 13(2) RPBA 2020 not to take into account the new submissions as to the compliance of claims 5, 6 and 10 with Article 123(2) EPC raised for the first time by the appellant at the oral proceedings before the board.

- 1.5 As none of the objections of added subject-matter validly submitted by the appellant against the claims of auxiliary request 2 is found convincing, the board concludes that this request complies with Article 123(2) EPC.

## 2. Novelty (Article 54 EPC)

### 2.1 Novelty objection based on D1

- 2.1.1 The appellant submitted that the subject-matter of claim 1 at issue would be anticipated when duplicating

the "construction" shown in Figure 4 of D1 in accordance with the instruction provided by claim 20 of this citation.

- 2.1.2 In its preliminary opinion the board stressed that claim 20 of D1 does not explicitly require that the pattern of the resist and metal parts in the "construction" formed on the second side of the polymeric film must be the same as that obtainable by the method of claim 1 and embodied in Figure 4 in this citation. Hence, claim 20 neither discloses nor implies that the "construction" on the second side is substantially a duplicate of that of the first side, as implied by the appellant's line of reasoning.

As no counter argument in this respect has been provided by the appellant, the board finds the novelty objection to claim 1 based on D1 unconvincing.

- 2.2 Novelty objection based on D7

- 2.2.1 The appellant did neither demonstrate where in the opposition proceedings a novelty objection based on D7 Fig.1 was raised nor did it submit any justification for filing a new novelty objection based on Figure 1 (also in combination with Figures 4 and 5 and passages in the description of D7). At the oral proceedings it maintained that this objection should be admitted in view of its *prima facie* relevance and argued that the second feature in "(a)" of claim 1 under consideration, requiring that "*if the paper (10) is viewed from the opposite side with reflected light, the laterally or vertically inverted pattern of the recognized colored resin layer (7, 8) is hardly visible*", would appear necessarily present in Figure 1 of D7.

- 2.2.2 The respondent stressed that an objection based on D7 Fig. 1 had not been filed during the opposition proceedings. It also disputed that the objection as submitted in writing was *prima facie* relevant if only for the reason that it indisputably failed to address the second feature under "(a)". Moreover, contrary to the appellant's further submissions at the hearing, it was rather immediately apparent that such feature would not be possible in this prior art as this would be at odds with the explicit disclosure in D7, page 9, lines 21 to 26.
- 2.2.3 In the board's view, the novelty objection based on Figure 1 of D7 could and should have been presented already in the opposition proceedings (Article 13(1) second sentence, Article 12(2) and (6) RPBA 2020). Moreover, it has been filed after filing the grounds of appeal (Article 12(3) RPBA 2020) and thus belated without any justification and without providing all the details necessary at rendering apparent its *prima facie* relevance according to Article 13(1) RPBA 2020. The appellant's attempt at the oral proceedings to complete its line of reasoning in this respect is even more belated and raises further new issues as to the plausibility of the occurrence of the features of claim 1 in the prior art of D7. Thus, the board decided to disregard this objection exercising its discretion under Articles 13(1) and 25(1) RPBA 2020.
- 2.2.4 The appellant did also not submit any justification for filing a novelty objection based on Figure 7 of D7 for the first time at the oral proceedings before the board. It stressed however that the inventive step objection submitted with the statement of grounds of appeal also started from this prior art and considered

that such new objection was to be admitted in view of its relevance.

- 2.2.5 The board stresses that a novelty objection is not encompassed by an attack based on lack of inventive step but rather reflects a separate objection that needs to be presented with the appellant's complete appeal case according to Article 12(3) RPBA 2020 (Article 12(2) RPBA 2007). Moreover, the alleged *prima facie* relevance of a new objection does not normally represent an exceptional circumstance justifying lateness of filing under the provisions of Article 13(2) EPC RPBA 2020. Furthermore, the respondent has contested the admissibility of this unjustifiably late novelty objection based on figure 7 of D7. Hence, the board exercised its discretion in view of the provisions of Article 13(2), 25(1) RPBA 2020, not to take into account the objection of lack of novelty based on Figure 7 of D7.
- 2.3 Accordingly, the appellant's objections of lack of novelty of claim 1 do not prejudice the allowability of auxiliary request 2.
3. Inventive step (Article 56 EPC)
  - 3.1 It is common ground between the parties that the closest prior art is represented by Figure 7 of D7 and that the subject-matter of claim 1 of auxiliary request 2 provides a solution to the technical problem of rendering available a CP paper that carries an additional security element which is easier to produce.
  - 3.2 The appellant submitted that a skilled person aiming at solving such technical problem would have considered obvious, in view of either the common general knowledge

or the teaching in D1 (in particular Figure 4; page 6, lines 27 to 30; and page 7, lines 13 to 17) to remove the partially (light) transmitting thin aluminum layers 34A and 34B that are finally applied to the two sides of the structure of Figure 7 of D7, thereby arriving at a security article having all the features of claim 1. It stressed that D7 explicitly mentioned the possibility to remove one of the two thin aluminum layers (see page 8, lines 3 to 6, of D7) and that these layers appeared non-mandatory when considering that claims 1 and 5 of D7 described embodiments of this prior art without requiring the presence of thin aluminum layers.

3.3 The board finds this line of reasoning unconvincing for the following reasons.

3.3.1 Even assuming for the sake of an argument in favour of the appellant that D7 would describe optional the two thin aluminum layers of Figure 7, it is apparent that these layers provide a specific security effect explicitly described as desired in the sentence bridging pages 3 and 4 of D7 (reading: "[s]uch a thin layer of metal, if made of aluminium, which is preferred, serves to render the security element less visible when viewed in reflected light"). Hence removing the two layers 34A and 34B from the structure of Figure 7 of D7 implies to renounce to a desired feature of said security element.

The appellant argued that the justification for this renounce would be the self-evident gain in ease of production. However, in the board's view, the mere fact that the skilled person is aiming at a CP paper with an additional security element that is easier to produce does not render obvious to arbitrarily renounce



to whatever expressly desired features of the security element of departure, let aside to renounce specifically to the partially transmitting thin aluminum layers.

- 3.3.2 Furthermore the board notes that, as correctly pointed out by the respondent, even the passage in page 8, lines 3 to 6 of D7 (which does not refer directly to the embodiment of Figure 7) onto which the appellant relied, teaches rather that at least one partially transmitting thin aluminum layer must be present in this prior art.
- 3.3.3 Finally, it is also immediately apparent to the board that the mere fact that claim 1 and/or 5 of D7 do not identify such thin aluminum layers as mandatory, does not equate to a clear pointer to the possibility of omitting them in any embodiments of this prior art, i.e. in particular it also does not necessarily imply that specifically the two layers 34A and 34B in Figure 7 of D7 are also both optional. In view of this conclusion, it has also turned out unnecessary for the board to decide on the disputed admissibility of the part of the appellant's submissions that was based on the claims of D7 (that had been raised for the first time during the oral proceedings).
- 3.3.4 Nor has the appellant identified any specific common general knowledge or teaching in D1 that would motivate the skilled person to consider superfluous the effect of the partially transmitting thin aluminum layers expressly desired in the security element of D7.
- 3.3.5 Hence, it is only with hindsight from the subject-matter of claim 1 under consideration that a skilled person could have conceived solving the posed technical

problem by forfeiting to the two layers 34A and 34B in Figure 7 of D7.

- 3.4 Accordingly, the appellant's objections of lack of inventive step directed to claim 1 of auxiliary request 2 are found unconvincing.

## 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 with the order to maintain the patent in amended form based on auxiliary request 2, filed with the reply to the appeal of 17 December 2018, and a description to be amended where appropriate.

The Registrar:

The Chairman:



A. Pinna

J.-M. Schwaller

Decision electronically authenticated