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**Datasheet for the decision
of 16 June 2021**

Case Number: T 0311/19 - 3.2.01

Application Number: 13157079.8

Publication Number: 2772145

IPC: A24D1/02, A24C5/60, C09C1/00

Language of the proceedings: EN

Title of invention:
Smoking article with colour shifting marking

Patent Proprietor:
Philip Morris Products S.A.

Opponent:
JT International S.A.

Headword:

Relevant legal provisions:
EPC Art. 100(b), 100(a), 56, 111(1)
RPBA 2020 Art. 13(2), 11

Keyword:

Grounds for opposition - insufficiency of disclosure (no)
Inventive step - main request, first and second auxiliary requests (no) - third auxiliary request (yes)
Amendment after summons - taken into account (yes)
Remittal - regarding auxiliary requests 1-3 (no) -regarding adaptation of the description (yes)

Decisions cited:

Catchword:



Beschwerdekammern

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Case Number: T 0311/19 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 16 June 2021

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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 28 November 2018 rejecting the opposition filed against European patent No. 2772145 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: S. Mangin
P. Guntz

Summary of Facts and Submissions

I. The appeal was filed by the appellant (opponent) against the decision of the opposition division to reject the opposition filed against the patent in suit (hereinafter "the patent").

II. The opposition division held that
(1) the subject-matter of the claims as granted was novel and involved an inventive step (Article 100(a) EPC),
and
(2) the patent disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC).

III. Oral proceedings were held before the Board on 16 June 2021.

IV. The appellant (opponent) requested that the impugned decision be set aside, and the patent be revoked.

The respondent (proprietor) requested that the appeal be dismissed and the patent be maintained as granted or alternatively be maintained on the basis of auxiliary requests 1-3 submitted with the reply to the statement of grounds of appeal, corresponding to the auxiliary requests 1-3 filed during opposition proceedings on 7 September 2018.

V. Main request

(a) Independent claim 1 of the main request reads as follows:

A smoking article characterized by:
a colour shifting marking that comprises a first colour shifting pigment, wherein the first colour shifting pigment produces a first colour when viewed from a first angle and produces a second colour when viewed from a second angle.

- (b) Independent claim 13 of the main request reads as follows:

A wrapper for a smoking article comprising:
a surface; and characterized by :
a first colour shifting pigment provided on the surface, wherein the first colour shifting pigment produces a first colour when viewed from a first angle and produces a second colour when viewed from a second angle.

VI. Auxiliary request 1

- (a) Claim 1 of auxiliary request 1 corresponds to claim 1 of the main request with the additional feature:
"wherein the colour shifting marking is incorporated in or on a curved surface of the smoking article".
- (b) Independent claim 13 and dependent claims 14 and 15 are deleted.

VII. Auxiliary request 2

- (a) Claim 1 of auxiliary request 2 corresponds to claim 1 of the main request with the addition of the smoking article "comprising a tipping paper" and

the colour shifting marking being "provided on the tipping paper".

(b) Claim 12 of auxiliary request 2 corresponds to claim 13 of the main request, whereby claim 12 is directed to "a tipping paper" instead of "a wrapper".

VIII. Auxiliary request 3

Claim 1 and claim 10 of auxiliary request 1 correspond to claim 1 and claim 13 of the main request respectively with the addition in both claims 1 and 10 of the feature:

"wherein the smoking article further comprises a first region adjacent at least a portion of the first colour shifting marking, and wherein the first adjacent region is coloured the same colour as the first colour of the first colour shifting pigment".

IX. In the present decision, reference is made to the following documents:

D1: WO 2011/042354 A1

D3: US 2010/0072739 A1

D5: CN 102649889 A

D5': Computer-generated translation of D5

D7: US 2010/0219626 A1

Reasons for the Decision

1. Sufficiency of disclosure - Article 100(b) EPC

The Board confirms the decision of the opposition division which held that the invention was disclosed in

a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

- 1.1 The appellant submitted that claim 1 was broadly worded and encompassed any "smokable article" having "colour shifting marking". The scope of claim 1 did not just cover the marking made on cigarettes but also on packaging of cigarettes, and the packaging and the housing of e-cigarettes, which the description of the patent failed to disclose. Therefore, the invention was not sufficiently disclosed across the entire scope of the claim.

The appellant further submitted that the claims were drafted in terms of a result to be achieved, and the description failed to disclose how the result was achieved. The description failed to define any structural definition for the marking, the viewing angle or how providing a colour shifting pigment achieved the visual effect. In particular, the description did not disclose the chemical composition of pigments, nor the method of application or printing which achieved the desired novel visual effect.

- 1.2 The Board does not agree with the appellant.

While the claim might be broad, encompassing cigarettes and e-cigarettes and other smoking articles, claim 1 is directed to a smoking article, i.e. an article to be smoked by the user. Hence claim 1 cannot be considered as to encompass packaging for cigarettes or e-cigarettes. The packaging is indeed not an article to be smoked by the user but contains the smoking articles.

Furthermore, while claim 1 might be broad, the invention is sufficiently disclosed as held by the opposition division. Paragraph [0018] of the patent discloses the use of "goniochromatic pigments" and discloses commercially available colour shifting pigments that may be used. Paragraph [0019] of the patent discloses printing processes that may be used and paragraphs [0020]-[0024] disclose possible composition of the ink containing the colour shifting pigments. The patent discloses additional examples directed to wrappers including plug wrap, tipping paper and cigarette paper comprising a colour shifting marking. Thus, the person skilled in the art is given sufficient guidance on the type of products to use and on how to achieve the desired effect. In particular the skilled person is taught to apply on wrappers specific colour shifting pigments which have the property of changing color depending on the viewing angle. The appellant alleged that the skilled person would not be able to carry out the invention for all the smoking devices encompassed by claim 1, in particular e-cigarettes but failed to give any reasons or any evidence in support of his allegation, such that the Board cannot follow this argument.

2. Novelty - Articles 100(a) and 54 EPC

The Board concurs with the findings of the opposition division that the subject-matter of claims 1 and 13 is novel.

2.1 The appellant brought forward three novelty objections based on D2, paragraphs [0010], [0025] and [0026], D3, paragraphs [0015] and [0184] and D5, paragraphs [0003] and [0004].

The appellant argued that although the above documents indicated that colour shifting pigments were contained in a security feature or label that was itself provided on the packaging, a skilled person implicitly understood that it could be provided on the smoking article itself. In any event, the broad wording of "smoking article" in the claims also included housing and packaging.

- 2.2 The Board does not agree with the interpretation of the expression "smoking article" made by the appellant as mentioned above under 1.2 and judges that neither D2, D3, nor D5 disclose a smoking article having the features of claim 1. D1, D2 and D5 disclose security features on packaging of cigarettes and not security features directly on cigarettes or other smoking articles.

Whether the skilled person starting from the teaching of D2, D3 or D5 would understand that the security feature could be provided on the smoking article itself is a matter of inventive step.

3. Inventive step - Articles 100(a) and 56 EPC

Contrary to the opposition division's findings, the Board judges that the subject-matter of claim 1 does not involve an inventive step in view of D1 in combination with D3.

- 3.1 D1 discloses a smoking article such as a cigarette (see page 1, line 16) having a wrapping paper which is provided with a printed pattern and an embossed pattern which are positioned such that when viewed from different angles a different colour is predominant (see page 2, "Summary of the Invention"; see also page 3, lines 21, 22, according to which the wrapping paper

having the pattern is the tipping paper). The different colours may be provided by different pigments (e.g. red and blue, see page 5, lines 31-33). Starting from D1 as the closest prior art, the subject-matter of claim 1 undisputedly differs from the smoking article of D1 by a marking with a first colour shifting pigment, wherein the first colour shifting pigment produces a first colour when viewed from a first angle and produces a second colour when viewed from a second angle.

According to paragraph [0007] of the patent, using a colour shifting pigment allows a smooth and continuous colour shifting that allows a user to more readily identify the smoking article as genuine.

Hence, the technical problem to be solved may be regarded as to provide a smoking article comprising a marking that allows a user to more readily distinguish a genuine smoking article from counterfeit products.

D3 deals with optically variable security elements which can be employed as visible elements for protecting articles against counterfeiting (see par. [0001]). D3 aims in particular at improving security elements that change their colour depending on the angle, see paragraphs [0004] and [0012].

Thus, the skilled person starting from D1 and in view of the problem to be solved would turn to D3, dealing with the same technical problem.

The following paragraphs [0015], [0069] and [0184] of D3, which are relevant for the assessment of inventive step are reproduced below:

[0015] The object of the present invention is achieved by an optically variable security element which comprises a substrate which has on at least one surface a coating which consists of at least two coloured part-areas adjacent to one another which can be distinguished from one another and are simultaneously visible to the eye, where the part-areas comprise inorganic flake-form effect pigments or in-situ polymerised and/or crosslinked mesogenic materials, and at least one of the part-areas has different colours depending on the illumination and/or viewing angle, and where the colours of at least two of the part-areas are different from one another under any illumination and/or viewing angle.

[0069] Flake-form effect pigments which can be employed are, for example, the commercially available interference pigments available under the names Iriodin®, Colorstream®, Xirallic®, Lustrepak®, Colorcrypt®, Colorcode® and Securalic® from Merck KGaA, Mearlin® from Mearl, metal-effect pigments from Eckhard and goniochromatic (optically variable) effect pigments, such as, for example, Variochrom® from BASF, Chromafflair® from Flex Products Inc., and other similar commercially available pigments. However, this list should merely be regarded as illustrative and not restrictive.

[0184] Suitable articles to be protected are conventional security articles from the high-security sector and the moderate security sector, such as banknotes, cheques, credit cards, shares, passports, identity documents, driving licences, postage stamps, seals and labels, but also packaging materials or articles of daily use, such as, for example, clothing, shoes, domestic articles, or packaging for perfumes,

pharmaceuticals, cigarettes or delicatessen products. However, this list is illustrative and should not be regarded as limiting. The applicability of the security element according to the invention is basically limited only by economic considerations.

Thus, according to paragraphs [0015], [0069] and [0184] of D3, colour shifting pigments, including "Merck's Colorstream (TM), of the kind that produce a first colour when viewed from a first angle and a second colour when viewed from a second angle, are advantageously used on numerous articles to be protected from counterfeiting such as packaging materials or articles of daily use including for example packaging for cigarettes.

In the Board's judgment it would be obvious for a skilled person desiring to protect the smoking articles themselves against counterfeiting, to apply the teaching of D3, even if disclosed in the context of e.g. a packaging for cigarettes, to the smoking article of D1, which is in particular a cigarette. This would result in providing a single colour shifting pigment instead of two pigments on the printed and embossed pattern on the wrapping paper of D1, thereby arriving at the subject-matter of claim 1 without any inventive skills.

- 3.2 The opposition division and the respondent defined a different objective technical problem to be solved, namely "how to modify the article of D1 in order to achieve a novel visual effect while improving the manufacturing process of the article". The formulation of the objective technical problem was based on the effects of the invention providing a "novel visual effect", disclosed in paragraph [0007] of the patent,

and simplifying the manufacturing of the smoking article. The later effect was based on paragraph [0006] of the patent and on the fact that the colour shifting marking of the claimed invention did not require process steps of embossing or aligning a printing pattern (D1, page 10, lines 11-20) and did not require the use of specialised rollers (D1, page 4, lines 13 to 15) for subsequent process steps.

The respondent was of the opinion that D1 did not deal with the problem of protecting against counterfeiting. The aligned printing and embossing patterns were provided on the tipping paper in order to enable the user to distinguish the mouth-end of the cigarette. Hence, starting from D1 the objective technical problem associated with the difference could not be formulated such as to enable the user to distinguish genuine smoking articles from counterfeited ones.

Furthermore, the respondent was of the opinion that the problem of protecting against counterfeiting was an economical problem and not a technical problem. The technical problem was to improve the manufacturing process of the smoking article. Cigarettes were produced at such a speed that a simplification in the process could not be considered as a bonus effect, instead it was a crucial effect.

- 3.3 According to the teaching of D1, the structure of the wrapping paper for cigarettes may be obtained by first printing onto plain flat wrapping paper, a pattern of parallel stripes of alternating colours, e.g. red and blue, and then embossing the paper with ridges such that the peaks of the ridges coincide with the edges between the colour stripes (see page 6, lines 10-14). While the manufacturing process according to the present invention, using colour shifting pigments

instead of aligning two different pigments with an embossing as in D1, may be easier from an operational perspective (see paragraph [0006] of the patent), still the skilled person would turn to D3 when dealing with the problem of protecting against counterfeiting. The fact that when applying the teaching of D3 to D1 the manufacturing process might become less complicated, as it would not require aligning the printing pattern with an embossing pattern, is a direct consequence of using a colour shifting pigment.

Furthermore, although D1 does not explicitly refer to the problem of protecting against counterfeiting, it aims at providing a "unique visual effect", which the skilled person in the field of cigarettes associates with allowing the users to more readily identify the smoking article as genuine. Indeed, in the section "Background of the invention" of D1 various visual effects are reviewed: plain white or patterned tipping papers, band of the tipping paper located furthest from the mouth-end plain or printed with a brand name or logo and cigarette paper printed logo/indicia or serial number.

Moreover, in the section "Summary of the invention", (page 2, lines 13-15 and page 3, lines 17-19), D1 discloses that "a combination of the printed pattern and the embossed pattern provides a unique visual effect for the wrapping paper such that it appears to change colour when viewed from different angles".

The patent itself, see paragraphs [0005]- [0007], confirms that it is known to provide an indicia, such as an image, logo or text printed on cigarette wrappers, or colour shifting effects achieved by aligning printing and embossing features, for protecting against counterfeiting.

Finally, it must be noted that in the present context a protection against counterfeiting can only be regarded as an indication on the product allowing an identification of the product as genuine.

Hence, while D1 discloses that the wrapping paper with the printed and embossed pattern is preferably the tipping paper (page 3, lines 21, 22) and that this feature helps the user distinguish the mouth-end of the cigarette so that the user ignites the correct end of the cigarette (page 1, line 31 - page 2, line 2 and page 3, lines 23-26), this is in addition to the effect of enabling the user to recognise the genuine product.

As regards the argument that the problem of protecting against counterfeiting was economical, rather than technical, it is noted that an economical problem might well be considered in the assessment of inventive step if, as in the present case, it is solved by technical means, namely a colour shifting pigment.

- 3.4 Moreover, the opposition division and the respondent were of the opinion that starting from D1, the skilled person was taught away from replacing the type of marking from embossing and printing with two different pigments to printing with colour shifting pigments as in D3 for the following reasons:
- (i) The skilled person was already presented in D1, page 6, lines 16-20 with a possible solution to improve the manufacturing.
 - (ii) The skilled person was told on page 10, lines 12-20 of D1 that "it is important that the embossing is aligned accurately with the printing. To achieve this, (...) a light sensor can be used to detect the location of printed lines on the tipping/cigarette paper...". Replacing the striped pattern with a continuous colour

would not enable an adequate alignment with the embossed pattern.

(iii) Should the skilled person replace the stripped pattern with the colour shifting pigment, then the skilled person would not emboss the tipping paper resulting in a smooth surface with no tactile recognition possible.

(iv) There was no indication that the pigments used in D3 were suitable for application on products being in contact with the mouth of the consumer.

3.5 The above arguments cannot be followed:

Considering the problem of providing the user with a marking that will allow a user to more readily distinguish genuine smoking articles from counterfeit ones, the alternative solution proposed on page 6, lines 16-20 of D1 cannot be considered as an improvement, but at most only as an alternative:

"A similar visual effect of colour changing with viewing angle could also be achieved if the ridges 4 do not have an inverted V shape (triangular cross section) but instead have a rounded shape, or semicircular cross section, if the divide between the two colours lies along the top of each ridge 4. However, the effect will be more striking with a sharp edge".

Hence the alternative of using round shapes instead of V shapes having sharp edges will not allow for a clear and well-defined change of colour on the top of the round shapes.

When applying the teaching of D3 to D1, the skilled person might recognize that there is no need to emboss the wrapper. However, the skilled person would recognize that the embossing could be maintained if a tactile effect, in addition to the visual effect, was

desired, and that with a colour shifting pigment an alignment of the printing pattern and of the embossing pattern would not be necessary.

Finally D3 discloses using shifting pigments on various types of products (paragraph [0184]) and discloses different types of commercially available colour shifting pigments (paragraph [0069]). With this teaching, the skilled person would use one of the commercially available shifting pigments, ensuring beforehand that the pigment is safe for use on cigarettes' mouthpieces.

4. Admissibility of auxiliary requests 2-3

Together with its reply to the appeal, the respondent submitted auxiliary requests 1-3, which were already filed in opposition proceedings on 7 September 2018.

The appellant requested not to admit auxiliary requests 2 and 3 as they did not converge with the previous auxiliary requests. The appellant considered that the respondent was fishing for something patentable by employing the so-called "pick and mix" approach (Reference was made to Part III-I, 3.1. of the case law book).

The Board decided not to use its discretion not to admit auxiliary requests 2 and 3. Auxiliary requests 1-3 were submitted at the stage of the opposition proceedings to respond to the various objections raised by the opponent/appellant. The numerous objections regarding insufficiency of disclosure, novelty and inventive step were such that the respondent should be given a fair opportunity to address the objections. While auxiliary requests 2 and 3 were not convergent

with the main and the first auxiliary requests, these two requests constituted a reasonable attempt to overcome the objections without constituting an abuse of procedure or a disadvantage for the appellant. The principle of equality of arms would be disrespected if an opponent could attack a patent based on a broad variety of objections while the patent owner was bound to only use one single line of defense.

5. Admissibility of the objections against the auxiliary requests - Article 13(2) RPBA 2020

With letter of 14 May 2021, the appellant submitted objections against auxiliary requests 1-3.

5.1 The respondent requested not to consider the objections made by the appellant against auxiliary requests 1-3. These objections constituted an amendment to the appellant's appeal case made after notification of a summons to oral proceedings, which should in principle not be taken into account unless there were exceptional circumstances which were justified by cogent reasons by the party concerned. In the present case the appellant did not submit any reasons for submitting these objections at this late stage of the proceedings while the auxiliary requests 1-3 were submitted in opposition proceedings on 7 September 2018, two months before the oral proceedings in opposition and resubmitted with the reply to the statement of grounds of appeal on 14 August 2019. The respondent was of the opinion that the appellant should have submitted their objections either in opposition proceedings or in appeal proceedings before the notification of a summons to oral proceedings dated 30 June 2020 (more than 8 months after the filing of auxiliary requests 1-3 in appeal).

5.2 The appellant responded that he could not have foreseen the requests that the respondent would be submitting and could therefore not take position on them with the statement of grounds of appeal. The appellant further noted that the objections were directed to added subject-matter and inventive-step based on D1 in combination with D3 for auxiliary requests 1-3 and additionally D1 in combination with D7 for auxiliary request 3.

5.3 The Board considered that the objections of lack of inventive step in respect of auxiliary requests 1-3 did not constitute an amendment to the appellant's appeal case as these objections (in particular D1 in combination with D3 and with D7) were already raised for the main request and applied to auxiliary requests 1-3. An inventive step assessment of auxiliary requests 1-3 including the additional features comprised in these requests was already possible based on the submissions made for the main request. Indeed the respective features incorporated in auxiliary requests 1-3, the "colour shifting marking being incorporated in or on a curved surface of the smoking article", the smoking article "comprising a tipping paper" and the smoking article further comprising a "first region adjacent at least a portion of the first colour shifting marking, and wherein the first adjacent regions is coloured the same colour as the first colour of the first colour shifting pigment" were straight forward as they did not substantially require further discussion and were contested by the appellant as lacking an inventive step based on the same combination of document as for the main request.

6. Remittal to the opposition division regarding auxiliary requests 1-3 - Article 111(1) EPC and Article 11 RPBA 2020

The Board did not remit the case to the opposition division for assessing the allowability of auxiliary requests 1-3.

- 6.1 The respondent requested to remit the case to the opposition division to assess the allowability of auxiliary requests 1-3 as they would be assessed for the first time in appeal proceedings.
- 6.2 The appellant disagreed with the remittal to the opposition division as the changes were straightforward and could be dealt with in the appeal proceedings.
- 6.3 The Board considered that no special reasons presented themselves for remitting the case to the opposition division. The amendments made to auxiliary requests 1-3 were straightforward and did not alter significantly the legal and factual framework of the appeal. Furthermore, the appellant would rely on inventive step attacks that were a continuation of those presented for the main request, and as such they could be expected to be dealt with expediently by the respondent and the Board at the oral proceedings.

7. Auxiliary request 1 - Inventive step - Article 56 EPC

The subject-matter of claim 1 does not involve an inventive step in view of D1 in combination with D3.

- 7.1 As submitted by the appellant, the additional feature of claim 1, according to which the colour shifting marking is incorporated in or on a curved surface of

the smoking article, would directly result from the combination of D1 with D3 as explained above, as the skilled person would apply the colour shifting pigments on the wrapper paper of a cigarette which is (as seen on the product itself) a curved surface. In this respect it is noted that the respondent's argument according to which the colour shifting pigments would be applied on the flat surfaces of the ridges of the embossed pattern according to D1, hence not on a curved surface, is moot, because even in such case the wrapper paper still globally forms a curved surface (the wrapper paper of the cigarette still forming substantially a cylinder).

Therefore, for the same reasons as for claim 1 of the main request, the subject-matter of claim 1 of auxiliary request 1 does not involve an inventive step.

8. Auxiliary request 2 - Inventive step - Article 56 EPC

The subject-matter of claim 1 does not involve an inventive step in view of D1 in combination with D3.

8.1 As pointed out by the appellant, the additional feature of claim 1 of auxiliary request 2, according to which the colour shifting marking with the colour shifting pigment is provided on the tipping paper does not justify the presence of an inventive step, because D1 already discloses that the marking is preferably provided on the tipping paper (page 3, lines 21, 22). Thus when applying the teaching of D3 to D1 as explained above, the colour shifting marking will result on the tipping paper.

Therefore, for the same reasons as for claim 1 of the main request, the subject-matter of claim 1 of auxiliary request 2 does not involve an inventive step.

9. Auxiliary request 3 - Inventive step - Article 56 EPC

Independent claim 1 corresponds to the combination of granted claims 1, 3, 5. Corresponding amendments have been made to independent granted claim 13, which is now claim 10. Granted claims 3, 4, 5 and 15 are deleted. Hence, the claims according to auxiliary request 3 do not give rise to objections under Article 123(2) and (3) EPC.

This was not disputed; the appellant's sole objections in respect of auxiliary request 3 was that the claimed subject-matter did not involve an inventive step, in particular in view of D1 in combination with D3 or D7 (these were the sole attacks presented by the appellant at the oral proceedings).

9.1 The appellant was of the opinion that the features added to claim 1 did not provide the effect alleged by the respondent of a portion of the marking seeming to appear and disappear over the entire scope of the claim. This effect was only visible if the adjacent region was surrounding the marking as described in paragraph [0045] of the patent but this limitation was not in the claim.

Furthermore the appellant was of the opinion that the effect of appearing and disappearing was purely aesthetic and did not contribute to a technical effect.

The appellant formulated the technical objective problem as to provide a smoking article with portions having a colour similar to the first colour of the colour shifting pigment to achieve a disappearing effect.

Starting from D1 and in view of the problem to be solved the skilled person would consider D3 which disclosed in paragraphs [0012] and [0015] the provision of two "part-areas adjacent to one another" having different colours. The appellant was of the opinion that the skilled person would change the colours appropriately to provide the appearing and disappearing effect.

Alternatively the skilled person would consult paragraph [0007] of D3 disclosing "a paired optically variable device which comprises optically variable structures arranged alongside one another on a substrate which have the same colour under a certain illumination angle, but have different colours under all other illumination angles" or paragraph [0008] disclosing "a security paper which is provided in various surface regions with an ink application which comprises various iridescent pigments in the various regions, where the ink application is virtually invisible when viewed directly, but the ink application has a different colour in the various surface regions when viewed under at least one oblique viewing angle". The combination of D1 with either the teaching of paragraph [0007] or paragraph [0008] of D3 would lead to the subject-matter of claim 1.

The appellant was of the opinion that the skilled person would also consider D7, which disclosed in paragraphs [0015], [0020] and examples 3 and 7 two adjacent zones with iridescent effect such that both looked identical in one angle and different when viewed from another angle. Therefore, the skilled person would arrive at the subject-matter of claim 1 without inventive skills by combining the teaching of D1 with D7.

9.2 The Board does not concur with the reasoning of the appellant. The Board judges that the skilled person would not arrive at the subject-matter of claim 1 by combining the teaching of D1 with the teaching of D3 or D7.

9.2.1 The provision of a first region adjacent at least a portion of the colour shifting marking and wherein the first adjacent region is coloured the same colour as the first colour of the first colour shifting pigment enables the user to either view distinctively the colour shifting marking or to view at least part of the colour shifting marking blended with the adjacent region. This effect is better perceived if the colour shifting marking is surrounded by the adjacent region, but nevertheless occurs when the adjacent region is placed on one side of the colour shifting marking in the sense that the initial shape of the colour shifting marking will appear differently.

Neither D3 nor D7 disclose "a first region adjacent at least a portion of the colour shifting marking and wherein the first adjacent region is coloured the same colour as the first colour of the first colour shifting pigment".

9.2.2 Paragraphs [0012] and [0015] of D3 only disclose adjacent regions having different colours and nothing in D3 suggests the skilled person to modify the colour of the regions to provide the appearing / disappearing effect.

Paragraph [0007] relates to the prior art of D3. While paragraph [0007] discloses using colour shifting pigments and providing adjacent regions having the same

colour under a certain illumination angle and having different colours under all other illumination angles, paragraph [0007] does not disclose the particular arrangement of claim 1, whereby the first adjacent region is coloured the same colour as the first colour of the first colour shifting pigment. Furthermore, the skilled person is taught away from combining D1 with the prior art disclosed in paragraph [0007] as it reads at the end of the paragraph: "The use of security elements of this type in mass-produced articles, such as, in particular, bank notes, is therefore too expensive, too complicated and not variable enough".

Similarly paragraph [0008] of D3 relates to the prior art of D3 and discloses using iridescent pigments (TiO₂-coated mica flakes) being virtually invisible when viewed directly and having a different colour when viewed under another viewing angle. Paragraph [0008] does not disclose the arrangement of claim 1. Furthermore, the skilled person has no information on whether these types of security marking are suitable for mass production.

- 9.2.3 D7 discloses in example 3 two adjacent regions with:
- a first red dyed region with iridescent pigments based on mica/TiO₂ (Iriodin 235[®] from the supplier Merck) being colourless in normal observation and presenting a green iridescent effect visible only in oblique observation and;
 - a second red dyed region with iridescent pigments based on mica/TiO₂ (Iriodin 205[®] from the supplier Merck) being colourless in normal observation and presenting a gold iridescent effect visible only in oblique observation.
- It is noted that a pigment which has a colour in oblique observation and is colourless in normal

observation is not a pigment in accordance with the claim, as it must produce a first and a second colour. In example 3, none of the regions is coloured the same colour as one of the colour shifting pigments of the other region. While the effect of appearing / disappearing is achieved in example 3 of D3 when both regions are seen in normal observation (both colour shifting pigments are colourless and the two dyed regions appear red), the arrangement is different to the one of claim 1.

The same type of arrangement as in example 3 is used in example 7. The surface of both adjacent regions is green and visible as green only in normal observation when the colour shifting pigments are seen colourless.

From the more general teaching of paragraphs [0015] and [0020] of D7, the skilled person cannot derive an arrangement of an adjacent region as in claim 1.

Therefore the skilled person would not arrive at the subject matter of claim 1 by combining the teaching of D1 with the teaching of either D3 or D7.

9.2.4 In the letter dated 14 May 2021, the appellant also referred to lack of inventive step over document D2 (US 2007/01900298 A1) and over document D9 (EP 2 465 701 A2).

In the appellant's view, document D2 taught providing a "photo-obscuring effect" such that when viewed from a second angle, the underlying image became obscured (para [0098] and [0122] of D2). Document D9 provided two regions (16,18) with different colours and colour shifting effect (see, para [0054] to [0056]). As could be seen from Figs. 2a and 2b, the numbers appeared and

disappeared depending on the viewing angle.

However, in document D2 the photo-obscuring effect is a result of the provision of a reflective layer that causes the image to be visible at a first angle and obscured as incident light is reflected (see para [122]). As regards document D9, the appearance/disappearance of the numbers is the result of the provision of a substrate having an area of a first colour and an area of a second colour, then a black layer and a transparent layer, which layers have undergone a laser ablation and allow for different effects depending on the viewing angle (see par. [0057] to [0063]). Both the disclosure of D2 and that of D9 are thus substantially different from the provision of a first region adjacent at least a portion of the first colour shifting marking in accordance with claim 1, wherein the first adjacent region is coloured the same colour as the first colour of the first colour shifting pigment.

Accordingly, the teaching of these documents (when combined with D1) would not render obvious the subject-matter of claim 1.

9.2.5 The above argumentation applies mutatis mutandis to independent claim 10 directed to a wrapper for a smoking article comprising the features of claim 1.

10. Remittal to the opposition division regarding the adaptation of the description based on auxiliary request 3 - Article 111(1) EPC and Article 11 RPBA 2020

Both the respondent and the appellant agreed on a remittal of the case to the opposition division for the adaptation of the description to the third auxiliary

request as it could be done most efficiently in written proceedings, due to the complexity of the amendments.

The Board considers that these circumstances constitute sufficient reasons for remitting the case to the opposition division for adaptation of the description. Special reasons in the sense of Article 11 RPBA 2020 are only required where a case is remitted to the department whose decision was appealed for further prosecution i.e. decision.

Order

For these reasons it is decided that:

The decision under appeal is set aside. The case is remitted to the department of first instance with the order to maintain the patent in amended form on the basis of the claims of the 3rd auxiliary request and a description to be adapted.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated