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**Datasheet for the decision
of 10 May 2023**

Case Number: T 1683/19 - 3.4.03

Application Number: 11705983.2

Publication Number: 2539158

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B42D25/29, G03H1/00, G03H1/02,
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B42D25/324, B42D25/328,
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Language of the proceedings: EN

Title of invention:
SECURITY DEVICE

Patent Proprietor:
De La Rue International Limited

Former Opponent:
Giesecke+Devrient Currency Technology GmbH

Headword:

Relevant legal provisions:
EPC Art. 123(2)

Keyword:

Amendments - added subject-matter - main request (yes)

Auxiliary request 1 - patent as maintained by the opposition division - proprietor sole appellant - no power to challenge the patent - not examined

Auxiliary requests 2 to 7 - more limited versions of patent as maintained - prohibition of reformatio in peius - not examined

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

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Case Number: T 1683/19 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 10 May 2023

Appellant: De La Rue International Limited
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
8 April 2019 concerning maintenance of the
European Patent No. 2539158 in amended form.**

Composition of the Board:

Chairman T. Häusser
Members: M. Papastefanou
E. Mille

Summary of Facts and Submissions

- I. Against the interlocutory decision of the opposition division to maintain European patent No. 2 539 158 B1 in amended form both the patent proprietor and the opponent filed appeals.
- II. After having filed its statement of grounds of appeal and its reply to the patent proprietor's appeal, the opponent withdrew in its letter dated 26 April 2022 its opposition and its appeal. It is thus no longer party to these proceedings.
- III. After the board issued summons to oral proceedings and its preliminary opinion on the case, the appellant ("patent proprietor") stated in its letter dated 28 February 2023 that it would not attend the oral proceedings. The board then cancelled the oral proceedings and issues its decision in writing.
- IV. The patent proprietor requested as a main request that the decision under appeal be set aside and that the patent be maintained on the basis of the main request filed with the statement of the grounds of appeal, which corresponds to the main request underlying the impugned decision. In the alternative, the patent proprietor requested that the decision under appeal be set aside and the patent be maintained according to one of auxiliary requests 1 to 7, which were all filed with the statement of the grounds of appeal and correspond to the respective requests filed during the opposition procedure.

V. Claim 1 of the main request has the following wording (numbering (a), (b) (c) by the board):

- (a) *A security device comprising a first transparent, coloured element in a first region of the device and in a surface of which a first optically variable effect generating relief structure is formed; and a reflection enhancing layer extending over the first optically variable effect generating relief microstructure and following the contour of the relief, the reflection enhancing layer also being provided in a second region of the device laterally offset from said first transparent coloured element,*
- (b) *wherein the second region includes a second, transparent coloured element having a colour different from the colour of the first transparent coloured element;*
- (c) *and wherein the reflection enhancing layer is provided in discrete portions in the first region and second region respectively.*

VI. **Auxiliary request 1** corresponds to the request on the basis of which the patent was maintained by the opposition division. Claim 1 is worded as follows:

A security device comprising a first transparent, coloured element in a first region of the device and in a surface of which a first optically variable effect generating relief structure is formed; and a reflection enhancing layer extending over the first optically variable effect generating relief microstructure and following the contour of the relief, the reflection enhancing layer also being provided in a second region of the device laterally offset from said first transparent coloured element, wherein the second region

includes a second, transparent coloured element having a colour different from the colour of the first transparent coloured element; a surface of the second transparent, coloured element being provided with a second optically variable effect generating relief microstructure, the reflection enhancing layer extending over the second optically variable effect generating relief microstructure and following the contour of the relief; and wherein the reflection enhancing layer is provided in discrete portions in the first region and second region respectively.

- VII. Auxiliary requests 2 to 7 represent more limited versions of Auxiliary request 1. The wording of their claims is not relevant for this decision.

Reasons for the Decision

1. The claimed invention

The invention relates to a security device comprising an optically variable effect generating structure and a method for its manufacture. Such optically variable generating structures comprise e.g. holograms and diffraction gratings and are used as security features on documents of value such as banknotes, credit cards, etc.

2. The appellant did not respond to the board's preliminary opinion on the case. The board sees no reason to deviate from it.
3. Main request

- 3.1 In the decision under appeal, the opposition division held that the subject-matter of claim 1 of the main request extended beyond the content of the application as originally filed, contrary to the requirements of Article 123(2) EPC (see points 4.1 to 4.2 of the Reasons for the decision).
- 3.2 It is common ground that part (a) of claim 1 of the main request (see point V. above) corresponds essentially to original claim 1, part (b) stems from original claim 5 (dependent also on claim 1), while part (c) corresponds to original claim 3, which depended also on original claim 1.
- 3.3 The opposition division, in agreement with the opponent, held that original claim 5 comprised more features than feature (b). Those features were all associated to one another and there was no basis for isolating only feature (b) from the claim. The opposition division concluded that *the lifting of the "second transparent colour element" feature without its associated further features, particularly that the second element is provided with the relief microstructure, represent[ed] a broadening of scope within the sense of Art. 123(2) EPC, since the second colour element [was] not to be found in the application without the associated relief microstructure feature* (see point 4.1.3 of the Reasons for the decision).
- 3.4 The patent proprietor pointed to the passage on page 10, lines 11 to 17 of the originally filed application as basis for feature (b) (NB: on page 2 of the patent proprietor's statement of grounds of the appeal, "lines 11 to 17 of page 11" is referred to, but the board considers this to be a typing error, since the passage on page 11 does not appear to be relevant in this

respect and from the patent proprietor's arguments it is clear that it refers in fact to lines 11 to 17 of page 10).

- 3.4.1 This passage is reproduced here (emphasis by the board):

*A preferred embodiment of the current invention is a security device comprising an optically variable microstructure in the form of **one or more** holographic generating microstructures where the **one or more** holographic generating microstructures are formed in **at least one** region of a layer of a radiation curable resin where the layer is provided by registered printing of **at least two** differently coloured resins. Preferably the differently coloured resins are registered **to one or more** of the holographic generating microstructures.*

- 3.4.2 According to the patent proprietor, this passage directly and unambiguously disclosed a security device comprising an optically variable microstructure in form of **one** holographic generating microstructure, where the **one** holographic generating microstructure [was] formed in **one** region of a layer of resin, where the layer [was] provided by registered printing of **two** colours of resin. Moreover, the last sentence of the cited passage included the possibility that the two differently coloured resins could be registered to one holographic generating microstructure, which implied that one of the resins was provided without a holographic generating microstructure (see second paragraph on page 2 of the patent proprietor's statement of the grounds of appeal; emphasis in the original). This passage provided thus support for feature (b).

- 3.5 The board does not agree with the proprietor's interpretation of the cited passage, especially with regard to the last sentence. In the board's understanding, the fact that the two differently coloured resins may be registered to one holographic generating microstructure does not suggest that one of the resins is registered to the microstructure and the other is not registered to any microstructure at all. It rather indicates that both resins are registered to one (i.e. the same) holographic generating microstructure, i.e. the same (type of) microstructure is formed onto each one of them.
- 3.5.1 This interpretation is also corroborated by the rest of the originally filed application. There is no description of any embodiment comprising a transparent colour element without an optically variable effect generating relief microstructure formed on it (see for example Figures 5B, 6B and 7B). In the description of the method of manufacturing of the security devices there is no provision of a transparent colour element without such a microstructure, either (see Figures 1A and 2). In addition, original claim 6, which depends on claim 5, defines that the first and second optically variable effect generating microstructures are different. This implies that claim 5, where the second transparent coloured element is introduced for the first time, includes the possibility that the two microstructures are the same (of the same type).
- 3.5.2 The board is therefore of the opinion that the skilled person reading the application as a whole would directly and unambiguously derive that all transparent colour elements (resins) are to be provided with a holographic generating microstructure.

3.6 In addition, the board takes the view that, even if the patent proprietor's interpretation were to be followed, the cited passage would still not have supported feature (b).

3.6.1 According to the cited passage on page 10 and following the patent proprietor's interpretation, two different colours of resin are registered printed in the same (first) region of the security device. According to feature (b) of claim 1, however, the second transparent coloured element (resin) is included in a second (i.e. different) region of the security device. Hence, even if it were to be accepted that the cited passage on page 10 of the application supported the presence of two transparent coloured elements (resins) in one region one of which is not provided with a microstructure, it would still not support the presence of a second transparent coloured element (resin) in a different region without any microstructure formed on it.

3.7 The board, hence, reaches the same conclusion as the opposition division, namely that claim 1 of the main request includes subject-matter extending beyond the originally filed content of the application. The main request, therefore, does not fulfil the requirements of Article 123(2) EPC and is not allowable.

4. Auxiliary requests

4.1 Auxiliary request 1 corresponds to the request on the basis of which the opposition division maintained the patent. Since the patent proprietor is the sole appellant, the board has no power to challenge the patent as maintained by the opposition division. Therefore, auxiliary request 1 does not need to be

examined.

4.2 Auxiliary requests 2 to 7 are more limited versions of auxiliary request 1. In view of the prohibition of *reformatio in peius*, the patent proprietor and sole appellant cannot be found in a worse position at the end of the appeal than it was at the beginning. Since auxiliary requests 2 to 7 represent such worse positions in view of their more limited scope than auxiliary request 1, they do not need to be examined, either.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



S. Sánchez Chiquero

T. Häusser

Decision electronically authenticated