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Datasheet for the decision of 18 April 2023

Case Number: T 2257/19 - 3.4.03

Application Number: 08720207.3

Publication Number: 2229286

IPC: B42D25/355

Language of the proceedings: EN

Title of invention:
SECURITY ELEMENT PARTICULARLY FOR BANKNOTES, SECURITY CARDS AND THE LIKE, HAVING ANTI-COUNTERFEITING FEATURES

Patent Proprietor:
FASE S.R.L.

Opponents:
Hueck Folien GmbH
DE LA RUE INTERNATIONAL LIMITED

Headword:

Relevant legal provisions:
EPC Art. 123(2), 100(c), 123(3)
RPBA 2020 Art. 13(1), 13(2)

Keyword:
Amendments - added subject-matter (yes) - inescapable trap (yes) - relationship between Art. 123(2) and Art. 123(3)
Amendment after summons - taken into account (no) - objection not overcome

Decisions cited:

Catchword:
An inescapable trap (Article 123(2) and (3) EPC) intrinsically precludes the admission of new requests under Articles 13(1) and (2) RPBA 2020, as the requirements of Article 123(2) and (3) EPC cannot both be satisfied (Reasons 4.3).

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Case Number: T 2257/19 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 18 April 2023

Appellant: (Opponent 1)	Hueck Folien GmbH Gewerbepark 30 A-4342 Baumgartenberg (AT)
Representative:	Burger, Hannes Anwälte Burger & Partner Rechtsanwalt GmbH Rosenauerweg 16 4580 Windischgarsten (AT)
Respondent: (Patent Proprietor)	FASE S.R.L. Via Milano 71 20021 Bollate (MI) (IT)
Representative:	Modiano, Micaela Nadia Modiano & Partners Via Meravigli, 16 20123 Milano (IT)
Party as of right: (Opponent 2)	DE LA RUE INTERNATIONAL LIMITED De La Rue House, Jays Close, Viables Basingstoke, Hampshire RG22 4BS (GB)
Representative:	Gill Jennings & Every LLP The Broadgate Tower 20 Primrose Street London EC2A 2ES (GB)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 27 May 2019 rejecting the opposition filed against European patent No. 2229286 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	T. Häusser
Members:	A. Böhm-Pélissier
	D. Prietzel-Funk

Summary of Facts and Submissions

I. The appeal is against the decision of the opposition division to reject the oppositions against the European patent EP 2 229 286 B1.

II. Grounds for opposition were lack of novelty and inventive step, insufficient disclosure and unallowable amendments (Articles 100(a) to (c) EPC).

III. At the oral proceedings before the board the **appellant** (**opponent 1**) requested that the decision under appeal be set aside and the European patent revoked.

IV. The **respondent** (**patentee**) requested
(a) that the appeal be dismissed or
(b) that the patent be maintained in amended form on the basis of the claims of auxiliary requests 1 to 4 submitted with the letter dated 28 February 2023 or of auxiliary requests 4A, 4B or 4C submitted during the oral proceedings before the board.

V. The **party as of right** (**opponent 2**) has not submitted any observations and did not attend the oral proceedings before the board.

VI. **Claim 1** of the **main request** (patent as granted, in view of the new auxiliary requests a new labelling (A), ... (H), (H1), (H2), ... is introduced by the board; labelling (M1), (M2), ... introduced by the patentee):

(M1)/(A) *A security element (1), particularly for banknotes, security cards and the like*,

(M2)/(B) *comprising a first substrate (2) which is at least partially opaque when viewed in transmitted light*,
(M3)/(C) *magnetic areas (3, 4) being deposited on said substrate (2)*,
(M4)/(D) *said magnetic areas (3, 4) comprising at least two types of magnetic areas which have different coercivity values and whose residual magnetism is identical or different*,
(M5)/(E) *said different coercivity values being adapted to generate at least three mutually different codes*,
(M6)/(F) *said three codes being determined by all the magnetic areas that are present, by the magnetic areas with high coercivity value, and by the magnetic areas with low coercivity value, respectively*,
(M7)/(G) *said magnetic areas (3, 4) being separated one from another by areas (10) which are free of magnetic material*,
(M8)/(H) *at least some of said magnetic areas (3, 4) with low and high coercivity value being deposited so as to be superimposed one over another and onto said first substrate (2)*.

VII. Claim 1 of **auxiliary request 1** differs from claim 1 of the main request in that:

(H1) "onto" in feature (H) of the main request is replaced by "on".

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

(H2) "at least" in feature (H) of the main request is deleted.

IX. Claim 1 of **auxiliary request 3** differs from claim 1 of the main request in that feature (H) of the main request is replaced by:

(H3) *at least some of said magnetic areas (3, 4) with low ~~and high~~ coercivity value being deposited so as to be superimposed ~~one over another~~ on magnetic areas with high coercivity value and onto said first substrate (2).*

X. Claim 1 of **auxiliary request 4** differs from claim 1 of auxiliary request 3 in that the following feature is inserted between features (B) and (C):

(BC4) *the first substrate (2) being made of plastics onto which a full surface of aluminum is deposited,*

XI. Claim 1 of **auxiliary request 4A** differs from claim 1 of auxiliary request 4 in that the following feature is added at the end of the claim:

(J4A) *wherein said first substrate (2) is a support made of metalized polyester, text and/or graphic markings being defined by at least partial demetallization of the metallic layer on said first substrate in order to create negative and/or positive texts and/or markings, wherein the areas (10) which are free of magnetic material are provided between the magnetic areas (3, 4).*

XII. Claim 1 of **auxiliary request 4B** differs from claim 1 of auxiliary request 4 in that feature (BC4) is deleted and feature (J4A) is modified as follows:

(J4B) *wherein said first substrate (2) is a support made of metalized polyester, wherein text and/or*

graphic markings being [sic] defined by at least partial demetallization of the metallic layer on said first substrate in order to create negative and/or positive texts and/or markings, wherein the areas (10) which are free of magnetic material are provided between the magnetic areas (3, 4).

XIII. Claim 1 of **auxiliary request 4C** differs from claim 1 of auxiliary request 3 in that "at least" in feature (H3) is deleted and the following feature is added at the end of the claim:

(J4C) *wherein said areas (3) with high coercivity value and said areas (4) with low coercivity value, which generate an identical and/or different residual magnetism, are provided by overprinting.*

XIV. The **appellant** argued essentially as follows in relation to the requirements of Articles 123(2) and (3) EPC and in relation to the admission of the new auxiliary requests 4A to 4C (Articles 13(2) and (1) RPBA 2020):

(a) Feature (G) implied both horizontal and vertical separation of "said magnetic areas (3, 4)", in particular in view of feature (H) requiring that the low and high coercivity areas are superimposed.
(b) However, the vertical separation of the magnetic areas was not disclosed in the application as originally filed.
(c) Removing the feature of vertical separation would infringe the requirements of Article 123(3) EPC, feature (G) thus represents an inescapable trap.
(d) Therefore the new auxiliary requests 4A to 4C could not overcome the objections and therefore should not be admitted.

XV. The **respondent** argued essentially as follows in relation to the requirements of Article 123 (2) and (3) EPC and the admission of the new requests:

(a) The skilled person willing to understand the disclosure of the patent would not doubt that only a horizontal separation could be meant by feature (G).

(b) The opponent objected for the first time at the oral proceedings that feature (G) implied both a horizontal and a vertical separation and that feature (G) also created an "Article 123(2)/(3) EPC trap" situation. Therefore, the new requests should be admitted in response to this new situation. In particular auxiliary request 4C removed the option of vertical separation.

Reasons for the Decision

1. The invention as described

1.1 The aim of the present invention is to provide a security element, particularly for banknotes, security cards and the like, having magnetic elements in which the magnetic difference of the regions (magnetic codes) cannot be detected by normal instruments, but exclusively by means of dedicated sensors. However, the magnetic codes have to be reliable, relatively simple to be provided and suitable to be detected with devices whose feed rate is up to at least 50 banknotes per second.

1.2 This is achieved by a magnetic code which is complex enough that only someone who knows the basic principle - and the location of the coded areas - can detect the

content of the magnetic code. A first code related to the low coercivity bits (4) and a second code related to the high coercivity bits (3) is provided in the security element. Superimposed areas with low (4) and high (3) coercivity values provide a third code:

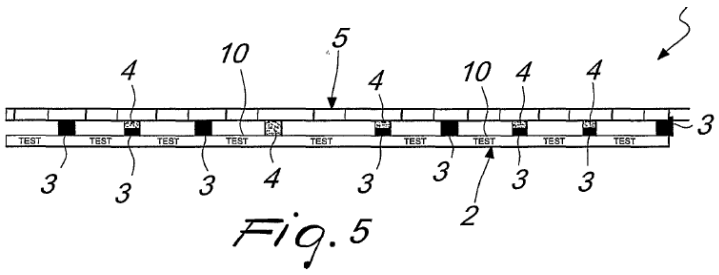

Fig. 5

impugned patent

2. Main Request - Articles 123(2)/100(c) and 123 (3) EPC

2.1 Feature (H).

2.1.1 The appellant held that feature (H) ("*at least some of said magnetic areas (3, 4) with low and high coercivity value being deposited so as to be superimposed one over another and onto said first substrate (2)*") was not disclosed in the underlying original patent application, because the option "*magnetic areas with low coercivity value positioned so as to be at least partially superimposed on magnetic areas with a high coercivity value*" was not disclosed in the originally filed documents. Original claim 11 only disclosed the opposite arrangement (magnetic areas with high coercivity value superimposed on magnetic areas with low coercivity value). The original description, page 7, lines 2 to 8, also provided basis only for the option defined in original claim 11. Original claim 6 did not provide basis that layers with high and low coercivity value can be superimposed in any order. This claim only referred to any magnetic layer without referring to layers with high/low coercivity value.

2.1.2 The respondent argued that in view of substrate 5 being equivalent to substrate 2 and the fact that a banknote could be rotated by 180° the order from the bottom to the top and from the top to the bottom could be considered equivalent therefore rendering the scope of protection of original claim 11 equivalent to the option "*low coercivity superimposing high coercivity*".

2.1.3 The board agrees with the appellant's argumentation and notes in particular that by the nomenclature both in the description (see, e.g., page 5, line 18) and in the claims as well as in Figure 5 ("*first substrate or first supporting layer 2*"), layer 5 being referred to as "*second supporting layer/substrate*" (see, e.g., page 7, line 17) a certain order of the layers in the banknote - also with regard to the method of producing the security element - is established and therefore the hypothetical case of the banknote being turned by 180° cannot be used to remedy the violation of Article 123(2) EPC.

2.2 Feature (G)

2.2.1 The appellant held that this feature was allegedly based on the originally filed description, page 9, lines 3 to 5 ("*Therefore, magnetic areas 3, 4, for example 2 mm long, spaced by spaces 10 without magnetic material for a length of for example 4 mm, are thus deposited between one text and the other*"). However, by removing this feature from the specific context of the corresponding very complex and specific embodiment and by placing it in the context of the originally claimed features (A) to (F) together with the new feature (H), new subject-matter was created.

2.3 Feature (C) in combination with feature (D) required that both the high coercivity (3) and the low coercivity (4) magnetic areas were deposited on the substrate (2). At the same time, however, feature (H) required that the high coercivity (3) and the low coercivity magnetic areas (4) were superimposed as shown in the second, fifth, seventh and eighth positions from the left in Figure 5.

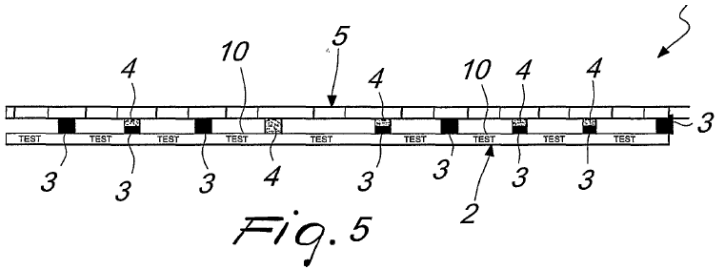

Fig. 5

impugned patent

2.4 Therefore, feature (C) had to be interpreted broadly to the extent that, in the case of superimposed layers, the layer package (combination of layers 3 and 4) was deposited on the substrate or that the layers were not deposited directly on the substrate. The latter was also not explicitly required by the wording of the claim.

2.5 The newly added feature (G) had to be read in the context of features (C) and (H). Layers 3 and 4 were deposited (in the "horizontal plane") on a substrate, but partially arranged on top of each other as a layer package (3, 4). Feature (G) now required that all magnetic areas 3 and 4 were separated by non magnetic material. This meant that areas 3 and 4, if deposited individually, had to be separated from each other, but also that areas 3 and 4, if deposited on top of each other (feature (H)), had each to be separated from each other, namely by non-magnetic material.

2.6 Thus, the separation had to be compulsory in the horizontal as well as in the vertical direction. However, such a vertical separation was nowhere disclosed in the originally filed application.

2.7 Patentee argued that such vertical separation was indeed not disclosed anywhere in the application, and in particular was not shown in the figures. The person skilled in the art would therefore never consider this option. It would make no technical sense, either, as the desired technical effect and the coupled effect of layers 3 and 4 would be lost.

2.8 The appellant argued further that the question of technical meaning did not arise. Article 123(2) EPC was solely about an interpretation of the claim wording. Apart from that, a separation of superimposed magnetic layers was quite common (cf. GMR or TMR sensors). It was also common practice to separate differently designed layers at least by a very thin layer. Separation of the superimposed layers 3 and 4 was therefore quite possible and even made sense, and could possibly even have further advantages.

2.9 It was further argued that removing the requirement of a vertical separation would broaden the scope of claim 1 in violation of Article 123(3) EPC. On the other hand it appeared impossible to heal the violation of Article 123(2) EPC in view of the original disclosure of the patent application underlying the impugned patent. In particular, it was not directly and unambiguously disclosed in the application in the context of only features (A) to (F) that separation of the magnetic areas could only mean separation in the "horizontal direction", although feature (G) in combination with feature (H) required separation in any possible

direction, in particular the "vertical direction". Consequently, there was a typical "Article 123(2)/(3) EPC trap" situation from which there was no way out.

2.10 The patentee considered that the argument that there was an "Article 123(2)/(3) EPC trap" situation was new and had not been raised in any of the opponents' submissions. In particular, it was only argued that feature (G) could be interpreted as requiring a horizontal or a vertical separation, but that this could lead to a trap situation was not argued in any of the submissions.

2.11 The board agrees with the arguments of the appellant. The appellant's argument does not constitute a new legal ground as it still concerns a violation of Article 123(2) EPC. Only - through the discussions during the oral proceedings - the consequences of this infringement proved to be those of a trap situation. The patent proprietor still has the theoretical possibility of reacting to this with new requests. However, it seems - as is inherent in an "Article 123(2)/(3) trap" situation - that there is no way out of this predicament.

2.12 Therefore, the subject-matter of claim 1 of the main request does not comply with the requirements of Articles 123(2) EPC, so that the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted.

3. Auxiliary requests 1 to 4 - Article 123(2) EPC

The same reasoning applies for these requests. This was not contested by the patentee. Therefore, the subject-matter of respective claim 1 of auxiliary requests 1 to

4 does not comply with the requirements of Article 123(2) EPC, either.

4. Auxiliary requests 4A to 4C - Admission (Articles 13(2) and (1) RPBA 2020)

4.1 By filing auxiliary requests 4A to 4C the respondent attempted to overcome the "Article 123(2)/(3) EPC trap" situation by better defining the horizontal separation of the magnetic areas and excluding vertical separation of the magnetic areas. However, as usual with an "Article 123(2)/(3) EPC trap", the exclusion of vertical separation would lead to a violation of Article 123(3) EPC, as this would broaden the scope of protection granted. On the other hand, healing of the violation of Article 123(2) EPC is impossible as the original application documents do not provide a sufficient basis for the presence of a vertical separation. The elimination of feature (G) (and (H)) as a whole would be all the more contrary to the requirements of Article 123(3) EPC.

4.2 Consequently, *prima facie* none of the auxiliary requests 4A to 4C can overcome the objections under Articles 123(2) and (3) EPC, irrespective of the discussion whether there are exceptional circumstances that would justify filing the new requests at this very last stage of the procedure.

4.3 An inescapable trap (Article 123(2) and (3) EPC) intrinsically precludes the admission of new requests under Articles 13(1) and (2) RPBA 2020, as the requirements of Article 123(2) and (3) EPC cannot both be satisfied.

4.4 Consequently, auxiliary requests 4A to 4C are not admitted into the proceedings under Articles 13 (2) and (1) RPBA 2020 because they *prima facie* cannot overcome the objections under Article 123(2) EPC without infringing the requirements of Article 123(3) EPC.

5. Summary

The subject-matter of claim 1 of the main request (patent as granted) and of respective claim 1 of auxiliary requests 1 to 4 does not fulfil the requirements of Articles 123(2) EPC. Auxiliary requests 4A to 4C are not admitted into the proceedings under Article 13(2) and (1) RPBA 2020. Consequently, the patent has to be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The European patent is revoked.

The Registrar: The Chairman:

S. Sánchez Chiquero T. Häusser

Decision electronically authenticated