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D E C I S I O N
of 11 May 1999

Case Number: T 0167/95 - 3.2.5

Application Number: 88306084.0

Publication Number: 0298687

IPC: B42D 15/10

Language of the proceedings: EN

Title of invention:

Credit card and method of making the same

Patentee:

National Business Systems Inc.

Opponent:

Landis & Gyr Betriebs AG Patentabteilung
GAO Gesellschaft für Automation und Organisation mbH

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 114, 111

Keyword:

"Amendments - added subject-matter (no)"
"Late submitted material - document admitted (yes)"
"Decision re appeals - remittal (yes)"

Decisions cited:

T 0029/96, T 0273/84

Catchword:

-



Case Number: T 0167/95 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 11 May 1999

Appellant: GAO Gesellschaft für Automation und
(Opponent 02) Organisation mbH
Eukenstrasse 12
81369 München (DE)

Representative: Klunker . Schmitt-Nilson . Hirsch
Winzererstrasse 106
80797 München (DE)

Respondent: National Business Systems Inc.
(Proprietor of the patent) 3200 Orlando Drive
Mississauga
Ontario L4V 1RS (CA)

Representative: Ayers, Martyn Lewis Stanley
J.A. Kemp & Co.
14 South Square
Gray's Inn
London WC1R 5LX (GB)

Other party: Landis & Gyr Betriebs AG Patentabteilung
(Opponent 01) 6301 Zug (CH)

Representative: Müller, Hans-Jürgen, Dipl.-Ing.
Müller, Schupfner & Gauger
Postfach 10 11 61
80085 München (DE)

Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted 23 December
1994 concerning maintenance of the European
patent No. 0 298 687 in amended form.

Composition of the Board:

Chairman: A. Burkhart

Members: P. Alting van Geusau
M. J. Vogel

Summary of Facts and Submissions

I. The mention of the grant of European patent No. 0 298 687 in respect of European patent application No. 88 306 084.0, filed on 4 July 1988, was published on 16 October 1991.

II. Notices of opposition were filed by the appellant (opponent 02) and other party (opponent 01) on 16 July 1992 and 10 July 1992, respectively. The oppositions were based on the grounds of Article 100(a) EPC.

In respect of an alleged lack of inventive step the appellant referred *inter alia* to

D4: Staufen Information: "Technische Information zu VKW-ID-Karten Folien", Vereinigte Kunststoffwerke GmbH., Staufen, 25 January 1983.

III. By a decision which was given at the end of oral proceedings held on 29 November 1994 and posted on 23 December 1994 the Opposition Division maintained the patent in amended form.

The independent claims 1 and 8 upheld by the Opposition Division read as follows:

"1. A credit card (1) comprising a plastic substrate (2) in the form of a card, a metal-containing layer (3) overlaid on at least substantially all of a first surface of said plastic substrate (2), and a transparent film (4) located on said metal-containing layer (3), the first surface side of the credit card being provided with printed graphics, characterised in

that the card is opaque, the printed graphics on said first surface side of the card are printed ink graphics formed only on said metal-containing layer (3) and of an ultraviolet curable ink, the metal-containing layer (3) is in the form of a metallic foil (3), is reflective and is adhesively bonded to said first surface of said substrate, and the transparent film (4) is (a) bonded to the metal-containing layer by means of an adhesive or (b) formed on an ultraviolet curable varnish."

"8. A method of making a credit card (1) with a scratch resistant metallic surface comprising the steps of providing a plastic substrate (2), applying a metal containing layer (3) to at least substantially all of a first surface of said plastic substrate (2), providing a transparent film (4) over said metal-containing layer (3), and providing the first surface side of the card with printed graphics, characterised in that said metal-containing layer (3) is adhesively bonded to said first surface of said plastic substrate (2) during said applying step and is in the form of a reflective metallic foil (3), the printed graphics provided on said first surface side of the card are formed by printing ink graphics with an ultraviolet curable ink on only said metal-containing layer (3) after the bonding of said metal-containing layer (3) to said first surface of said plastic substrate (2) and curing the ink graphics by applying ultraviolet light thereto, static electricity is discharged from the laminate of the metal-containing layer (3) and the plastic substrate (2) during printing, and the printed metal-containing layer (3) is provided with said transparent film (4) over it to protect said-metal-containing layer

(3), without breaking said layer, by (a) bonding, by means of an adhesive, a transparent film to said metal-containing layer or (b) forming said transparent film of an ultraviolet curable varnish applied over said metal-containing layer, thereby to provide an opaque credit card."

The Opposition Division was of the opinion that the cited prior art did not disclose or suggest a credit card comprising a metallic foil overlaid on at least substantially all of the first surface of the card, printed graphics applied directly onto the metallic foil and a transparent protective film protecting the metallic surface and the printed graphics.

- IV. On 22 February 1995 a notice of appeal was lodged against that decision and the appeal fee was paid on the same day. In the statement of grounds of appeal, filed on 28 April 1995, the appellant referred to document:

D11: DE-A-2 416 652

and submitted that the subject-matter of the amended claims did not meet the requirements of Article 123(2) and 56 EPC. The appellant requested setting aside the decision under appeal and revocation of the patent.

- V. In a communication issued in preparation for oral proceedings, requested auxiliarily by both the appellant and the respondent, the Board expressed the provisional opinion that the amendments to the claims appeared formally acceptable. It further addressed the newly cited D11 and concluded that the introduction of

this document would appear to concern a direct response to arguments given in the decision under appeal and that it merely supported the submissions already presented in the opposition proceedings. Therefore, there appeared to be no reason of equity in accordance with Article 104 for an apportionment of costs as had been requested by the respondent.

Moreover, newly cited D11 appeared to represent the closest prior art when considering the subject-matter of the amended patent and should therefore be allowed into the proceedings.

Its introduction, however, gave rise to a new situation as regards the assessment of inventive step and for that reason the Board considered remittal of the case to the first instance for further prosecution appropriate.

If the parties agreed to the provisional conclusions of the Board as set out in the communication the case could be remitted immediately to the Opposition Division.

VI. In response to the Board's communication the appellant submitted in its letter dated 27 October 1998 that if the case was remitted to the first instance the request for oral proceedings was withdrawn.

With letter dated 24 February 1999 the respondent agreed to the admission of D11 into the proceedings without the need for oral proceedings before the Board of appeal.

The respondent's earlier requests were replaced by a main request for remittal of the matter to the Opposition Division for reconsideration of the case in view of the newly cited D11 and an auxiliary request for maintenance of the patent in the form as upheld by the Opposition Division if the Board did not remit the case to the first instance.

- VII. In support of its request the appellant relied essentially on the following submissions:

Objection under Article 123(2) EPC:

The new description and claims 1 and 8 comprise the feature that the credit card is opaque without this feature being disclosed in the application documents as originally filed. The configuration of the credit card in accordance with the patent did not allow any conclusions as to such feature.

Objection under Article 56 EPC:

Newly cited D11 comprised most of the features of the independent claims 1 and 8. The remaining features related to well known printing and protection technics known to the skilled person and disclosed in D4.

- VIII. The respondent disputed the appellant's view and its arguments may be summarised as follows:

Article 123(2) EPC objection:

Although the description of the opposed patent did not state explicitly that the credit card was opaque, this

feature was directly and unambiguously derivable from the disclosure of the application documents originally filed. In this respect it could be derived from the description that graphics were provided on both the first and second surface sides of the card. Such arrangement required sufficient "opaqueness" of the white vinyl material of the card to avoid interference to the graphics on both sides of the card.

Article 56 EPC objection:

Once the case was remitted to the first instance the Opposition Division should consider and decide upon the alleged lack of inventive step.

IX. The other party did not file a response.

Reasons for the Decision

1. The appeal is admissible.

2. *Amendments*

2.1 Claim 1 is based on granted claim 1, which is based on the subject-matter of originally filed claims 1 and 4 to 7.

Claim 8 is based on granted claim 9 which is based on the subject-matter of originally filed claims 11, 15 (partly) and 17.

Additional features of independent claims 1 and 8, relating to the credit card being opaque, that the

metallic foil is reflective and is adhesively bonded to the first surface of the substrate, and that the printed ink graphics on the first surface side of the card are formed only on the metal-containing layer, are unambiguously derivable from the description of the preferred embodiment.

In accordance with the text on page 6, last line of the originally filed description, the metal containing layer is preferably a reflective continuous layer which is adhesively bonded to the substrate by means of the method described on page 9, from line 18 to page 10, line 14.

As regards the credit card being "opaque", the Board takes the view that instead of the strict literal meaning of the word "opaque", for which there is not sufficient evidence in the application as filed, this further feature should be interpreted in a manner that the card - in particular the plastic substrate preferably made of a white vinyl material (see page 8, line 10 of the originally filed description) - is sufficiently light impermeable to allow the use of printed graphics on both sides of the card without the graphics interfering with each other. Such interpretation is considered to be in line with what the skilled person would normally expect of credit cards of the nature disclosed in the patent in suit (see in this respect also D4, page 5, first paragraph "Die Herstellung von ID-Karten").

According to the text on page 11, lines 8 and 9 of the originally filed description the printed, metallized foil is provided with an overlamine of a transparent

film, which means that the printed graphics form the only graphics on the first surface side of the card (see in this respect also point 2.2 of the decision under appeal).

- 2.2 The appellant argued that the disclosure in the originally filed application documents did not allow a clear conclusion as to whether the credit card was "opaque".

As is explained above the Board is of the view that, although this property is not directly referred to in the originally filed application, the skilled person would immediately and unambiguously understand the preferred embodiment of the credit card disclosed in the originally filed application to be "opaque" to a certain degree so as to avoid interference to the graphics provided on both sides of the card because this is considered standard practice when using a white substrate.

Since no other material is referred to in the description the "opaqueness" of the substrate also applies to the credit card claimed in claim 1 or method of making a credit card in accordance with the feature of claim 8.

- 2.3 The dependent claims 2 to 7 and 9 to 12 are essentially repetitions of the subject-matter of granted claims 2, 3, 5 to 8 and 11 to 14 corresponding with the originally filed claims 2 , 3, 5 8, 9, 10 and 13 to 16, respectively.

- 2,4 In view of these assessments no objections under the

provisions of Article 123(2) and (3) EPC arise against the amended claims.

3. *Introduction of DE-A-2 416 652 (D11).*

3.1 The appellant submitted that D11 was cited in response to the conclusions drawn by the Opposition Division in the decision under appeal according to which the matter discussed in column 1, lines 22 to 31 of the patent was not related to prior art but rather concerned the problems encountered by the patent proprietor itself (see point 4.6 of the decision under appeal).

3.2 With reference to the notice of opposition page 3, first and second paragraph, and the response dated 15 April 1994, point 2, as well as to the decision under appeal, point 4.11, the Board is satisfied that the introduction of D11 concerns evidence introduced to support submissions already presented in the opposition proceedings in order to fill a gap in this initial line of argumentation of the opponent. Therefore, the citing of D11 cannot be considered to constitute an abuse of proceedings because it took place at the earliest possible moment (together with the statement of grounds of appeal) and can also not be considered as producing a totally new line of attack.

Under such circumstances a document filed after the 9-month period of Article 99 EPC may be allowed into the proceedings (see for example T 29/96).

In its reply to the Board's communication also the respondent agreed to the admission of D11 into the proceedings so that no further discussion of its

introduction is necessary.

- 3.3 It appears that, essentially for the reasons submitted by the appellant, D11 represents the closest prior art document when considering the subject-matter of the patent in suit.

It follows that the introduction of the new prior art document D11 gives rise to a substantially new situation as regards the assessment of inventive step. Therefore the Board considers it appropriate to remit the case to the first instance for further prosecution, as was requested by the respondent (see also T 273/84, OJ 1986, 346).

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

A. Townend

A. Burkhart