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D E C I S I O N
of 9 January 2002

Case Number: W 0017/01 - 3.2.5

Application Number: PCT/NL 00/00036

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Title of invention:
Security Document with a Perforation Pattern

Applicant:
Industrial Automation Integrators (IAI) B.V. et al

Opponent:
-

Headword:
-

Relevant legal provisions:
PCT Art. 34(3)(a)
PCT R. 68.2, 68.3(c), 13.1, 13.2

Keyword:
"Lack of unity of invention a priori (yes)"

Decisions cited:
-

Catchword:
-

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Case Number: W 0017/01 - 3.2.5
International Application No. PCT/NL 00/00036

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 9 January 2002

Applicant: Industrial Automation Integrators (IAI) B.V. et al

Representative: Eveleens Maarse, Pieter
Arnold & Siedsma

Subject of the Decision: Protest according to Rule 68.3(c) of the Patent Cooperation Treaty made by the applicants against the invitation of the European Patent Office (International Preliminary Examining Authority) to restrict the claims or pay additional fees dated 30 November 2000.

Composition of the Board:

Chairman: W. Moser
Members: W. Zellhuber
P. Michel

Summary of Facts and Submissions

I. International patent application PCT/NL/00/00036 was filed on 18 January 2000.

II. On 6 October 2000, the European Patent Office (EPO) in its capacity as International Preliminary Examination Authority (IPEA) indicated that it considered that there are three inventions claimed in the international application, and invited the applicant to restrict the claims or to pay two additional fees.

III. In the invitation, the IPEA argued that the claims included three groups of inventions not so linked as to form a single inventive concept as required by Rule 13.1 PCT.

The first group comprises independent claim 1 and dependent claims 9 to 12 and 16 to 22. Claim 1 reads as follows:

"1. Forge-proof document comprising a security feature in the form of a perforation pattern which displays grey tones when viewed against a bright background, **characterized in that** the document is manufactured from a material which transmits light to a limited extent, that at least some of the perforations forming part of the perforation pattern extend over only a part of the thickness of the document at the position of the perforation, and that the thickness of the remaining part of the document at the position of the perforation is modulated in accordance with the image to be displayed."

The second group comprises independent claim 2, dependent claims 3 to 5 and 9 to 22, and method claims 23 to 25. Claim 2 reads as follows:

"2. Forge-proof document comprising a security feature in the form of a perforation pattern which displays grey tones when viewed against a bright background, **characterized in that** at least some of the perforations forming part of the perforation pattern extend at an angle differing from 90° relative to the main plane of the document."

The third group comprises independent claim 6, dependent claims 7 to 22 and method claims 23 to 25. Claim 6 reads as follows:

"6. Forge-proof document comprising a security feature in the form of a perforation pattern which represents an image and which displays grey tones when viewed against a bright background, **characterized in that** material is arranged in the perforations."

IV. The applicant paid the additional fees under protest in accordance with Rule 68.3(c) PCT on 6 November 2000.

With regard to the subject-matter of claims 1 and 6, the applicant argued essentially as follows:

Claim 1 disclosed a perforation pattern in a material which transmitted light to a limited extent, and wherein the deepness of the perforation was modulated.

Claim 6 related to the same invention, "but wherein the resulting material under the perforation is filled with another material" (cf. applicant's letter of 6 November 2000, page 1, fourth paragraph). The features of claim 1 and claim 6 both related to the modulation of the optical effect of perforations so that they fell within the same inventive concept.

The applicant further noted:

"Claim 9 relates to an admittedly other variation on the perforation, wherein the shape of the perforation hole is different from that of a cylinder. One could regard this as the filling in of a larger cylinder, to give it a different shape. This would thus form another variation of the inventive concept of claim 1" (cf. page 1, last paragraph and page 2, first paragraph).

V. An invitation to pay the protest fee was issued on 30 November 2000, in which the review panel confirmed the finding expressed in the communication of 6 October 2000.

It was pointed out that claim 6 specified a forge-proof document with a security feature in the form of a perforation pattern with material arranged in the perforations, that material not being modulated. Hence, the subject-matter of that claim did not fall under the same inventive concept as that of claim 1.

Furthermore, claim 2 of the application specified perforations of a different shape than the cylindrical one and had therefore no common features with the cylindrical perforations according to claim 1 or the perforations containing a different material according to claim 6 of the application.

Finally, it was observed that, in his letter of 6 November 2000, the applicant apparently erroneously referred to claim 9 rather than to claim 2.

VI. The applicant paid the protest fee on 27 September 2000. No further reasoning has been received from the applicant.

Reasons for the Decision

1. The international patent application PCT/NL/00/00036 relates to a forge-proof document comprising a security feature in the form of a perforation pattern which displays grey tones when viewed against a bright background.

Such a document is known from document WO 98/19869. According to that document, the grey tones are produced by modulating the size and/or density of the perforation holes (cf. document WO 98/19869, page 4, lines 24 to 29).

2. The object of the application consists in developing new security features, cf. page 1, lines 12 to 14 of the application as filed.

3. For this purpose the application provides a plurality of independent measures.

3.1 A first security feature consists in that at least some of the perforations forming part of the perforation pattern extend over only a part of the thickness of the document at the position of the perforation, and that the thickness of the remaining part of the document at the position of the perforation is modulated in accordance with the image to be displayed.

That measure forms the subject-matter of claim 1 of the application.

3.2 A second security feature consists in that at least some of the perforations forming part of the perforation pattern extend at an angle differing from 90° relative to the main plane of the document.

That measure forms the subject-matter of claim 2 of the application. It is assessed as being another independent measure (cf. page 1, line 32 of the application). Moreover, contrary to claim 1 of the application, any modulation of the angle in order to obtain an image is not an essential feature of claim 2 of the application. It merely represents a preferred embodiment of the application, cf. claim 3 of the application.

3.3 A third security feature consists in that material is arranged in the perforations.

According to page 4, lines 12 to 24, and claims 7 and 8 of the application, the feature of material being arranged in the perforations may be construed as meaning that the perforations are filled with a material, for example an ink, or that the inner surfaces of the perforations are provided with a layer, for instance a vapour deposited layer.

That security feature forms the subject-matter of claim 6 of the application. Any modulation of the arrangement of the material within the perforations in order to obtain an image is not the subject-matter of claim 6 of the application. Filling of perforation holes with another material therefore cannot be regarded as a variation of the concept suggested in claim 1 of the application.

4. These security measures thus concern three technically different forms of shaping perforations of a perforation pattern. They are independent from each other and they do not include one or more of the same or corresponding special technical features which make a contribution over the prior art as required by Rule 13.2 PCT.

Admittedly, they all have the purpose of preventing the document from being forged, and the proposed measures result in a modification of the optical effect of the perforations.

However, this is an already known concept. The application refers to the above-mentioned document WO 98/19869, which discloses a forge-proof document comprising a perforation pattern wherein, for the purpose of preventing the document from being forged, the optical effect of the perforation holes is modified, in particular, by varying the size and/or density of the perforations.

Therefore, the general concept of modifying the optical effect of perforations for the purpose of making forge-proof documents does not constitute an inventive concept within the meaning of Rule 13.1 PCT.

5. The Board thus comes to the conclusion that the three groups of inventions as set out in paragraph III above are not so linked as to form a single inventive concept as required by Rule 13.1 PCT. The invitation under Article 34(3)(a) and Rule 68.2 PCT was therefore justified.

Order

For these reasons it is decided that:

The protest according to Rule 68.3(c) PCT is dismissed.

The Registrar: The Chairman:

M. Dainese W. Moser

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