

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

**Datasheet for the decision
of 22 November 2006**

Case Number: T 0601/02 - 3.5.03

Application Number: 93302420.0

Publication Number: 0562890

IPC: H04Q 7/32

Language of the proceedings: EN

Title of invention:

Mobile communication network with remote updating of
subscriber identity modules in mobile terminals

Patentee:

ORANGE PERSONAL COMMUNICATIONS SERVICES LIMITED

Opponent:

SWISSCOM MOBILE AG

Headword:

Remote updating of SIM/ORANGE

Relevant legal provisions:

EPC Art. 84, 100, 101, 102, 123(2),(3)
EPC R. 55(c)

Keyword:

"Extent of power to examine appeal"
"Maintenance in amended form not opposed by appellant
(opponent)"

Decisions cited:

G 0008/91, G 0009/91

Catchword:

-



Case Number: T 0601/02 - 3.5.03

DECISION
of the Technical Board of Appeal 3.5.03
of 22 November 2006

Appellant: SWISSCOM MOBILE AG
(Opponent) Viktoriastrasse 21
CH-3050 Bern (CH)

Representative: Saam, Christophe
Patents & Technology Surveys SA
Rue des Terreaux 7
P.O. Box 2848
CH-2001 Neuchâtel (CH)

Respondent: ORANGE PERSONAL COMMUNICATIONS
(Patent Proprietor) SERVICES LIMITED
St. James Court
Great Park Road
Almondsbury
Bristol BS12 4QJ (GB)

Representative: Spaargaren, Jerome
Electronic Intellectual Property
Fairfax House
15 Fulwood Place
London WC1V 6HU (GB)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 13 March 2002
rejecting the opposition filed against European
patent No. 0562890 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: A. Ritzka
M.-B. Tardo-Dino

Summary of Facts and Submissions

- I. This appeal is against the decision of the opposition division dated 13 March 2002 to reject an opposition against European patent EP 0 562 890 B. The opposition grounds were those of Article 100a, 100b and 100c EPC.

- II. In the notice of appeal the appellant (opponent) requested that the decision be set aside and the patent revoked. An auxiliary request was made that the patent be maintained in a more limited form and a conditional request made for oral proceedings.

- III. The respondent (patentee) requested that the appeal be rejected and the patent maintained, implicitly as granted. It submitted an amended set of claims as an auxiliary request and made a further auxiliary request for oral proceedings. Subsequently, a new representative having been appointed, the respondent confirmed its main request and introduced amended sets of claims of first to eleventh auxiliary requests.

- IV. The board issued a communication, inter alia expressing the preliminary view that the claims as granted did not comply with Article 123(2) EPC.

- V. In response to the board's communication the appellant presented its comments and the respondent maintained its main request that the patent as granted be maintained; five auxiliary requests to replace the auxiliary requests on file were submitted. It was further argued that the claims of each of the requests complied with the provisions of the EPC.

- VI. In a communication accompanying a summons to oral proceedings on 27 September 2006 the board raised matters to be discussed during the oral proceedings, in particular with regard to the question of whether the requests on file fulfilled the requirements of Article 123 (2) and (3) EPC.
- VII. With a letter dated 18 September 2006, i.e. shortly before the appointed date for oral proceedings, the appellant filed a set of claims and indicated that, if the patent were limited to these or similar claims it would not oppose maintenance of the patent in amended form. Such claims would meet all its objections and it would withdraw its appeal.
- VIII. On 19 September 2006 the respondent submitted a new main request and two auxiliary requests, the main request corresponding to the appellant's proposal, and the first and second auxiliary requests corresponding respectively to the first auxiliary request and the main request previously on file. As part of the main request amendments to the description were also made and replacement pages 1, 2A, 2B and 2C filed.
- IX. In its letter of 21 September 2006 the appellant agreed to the respondent's main request and withdrew its request for oral proceedings if the respondent's main request were considered allowable.
- X. In a communication of 21 September 2006 the board announced that it was not minded to cancel the oral proceedings. It further noted that the appellant's request, being a conditional request, did not appear to be admissible. It was observed that if the appellant

withdrew its appeal the decision of the opposition division would become final. The board further noted that certain of the issues raised in its communication accompanying the summons to oral proceedings were still open with respect to the requests submitted on 19 September 2006.

- XI. The appellant thereupon, in a letter of 22 September 2006, made a new main request, that the patent be maintained on the basis of the respondent's main request. This request was said to be unconditional. If the main request were allowed it was further requested that the oral proceedings be cancelled.
- XII. In a letter of 24 September 2006 the respondent drew attention to the principle of party disposition and stated that no issues remained to be addressed. It was argued that the board should concern itself only with the amendments to the claims during the appeal proceedings. These were allowable, being neither an abuse of procedure nor contrary to Article 123(2) EPC. It was requested that the oral proceedings be cancelled.
- XIII. The board thereupon cancelled the oral proceedings and stated that the procedure would be continued in writing.
- XIV. Claim 1 of the respondent's main request reads as follows:

"A mobile communications network comprising at least one switching network (10, 26) and a plurality of GSM mobile terminals (12),

the at least one switching network (10) and each mobile terminal (12) being arranged to transmit signals therebetween,

each mobile terminal (12) having a memory (20) for containing data for controlling the transmission of signals from the corresponding mobile terminal (12) to the at least one switching network (10, 26),

the memory being a GSM subscriber identity module adapted to receive data signals from the network to the mobile terminal having predetermined formats including the GSM short message format and to reject other signals, the data signals including display signals in the GSM short message format for causing said mobile terminal to display a message,

characterised in that:

the switching network (10, 26) is arranged to transmit updating signals to at least one of said mobile terminals (12) which alter the data of the memory (20) of the at least one mobile terminal (12), said updating signals being in the GSM short message format; and

said subscriber identity module is arranged to distinguish between said updating signals and said display signals, and being arranged to cause said mobile terminal (12) to display messages corresponding to said display signals and to cause the data of the subscriber identity module (20) to be updated on the basis of said updating signals."

Reasons for the Decision

1. In the present case the respondent (patentee) has in the course of the proceedings limited the claims by the

introduction of features from the description relating to the GSM system and requested that the patent be maintained in this limited form. The appellant (opponent) also requests maintenance of the patent as limited according to the respondent's main request. The board understands this as meaning that the appellant no longer wishes to pursue the appeal, insofar as the claims in their limited form are concerned, and in particular no longer maintains the various objections made in the course of the opposition proceedings under Articles 100a, 100b and 100c EPC, if the patent is maintained in this limited form.

2. As the enlarged board pointed out in its decision G 9/91 (see OJ EPO 1993, 408), opposition proceedings are contentious proceedings between parties normally representing opposite interests (point 2 of the reasons). Thus, the power of an opposition division or a board of appeal to examine and decide on the maintenance of a European patent under Articles 101 and 102 EPC depends upon the extent to which the patent is opposed in the notice of opposition pursuant to Rule 55(c) EPC, i.e. if the opponent refrains from attacking specific subject-matter then the EPO has no competence to deal with that subject-matter at all. As stated by the enlarged board in the above-mentioned decision, see point 3, "in any post grant opposition procedure the patent office cannot take any action in respect of a granted patent ... unless initiated by an admissible opposition". The competence of the patent office depends on the action taken by the opponent. This principle is all the more valid for the procedure before the boards of appeal, which is to be considered

as a judicial procedure (see G 8/91, OJ EPO 1993, 345, point 7 and G 9/91, OJ EPO 1993, 408, point 18).

3. The appeal has not been withdrawn, i.e. the appellant still requests that the decision of the first instance be set aside, which the board interprets as maintaining the grounds of opposition against the patent in the form allowed by the decision of the opposition division but not against the amended form. In this respect, the enlarged board has commented (see G 9/91, point 10) that subject-matter which is not opposed is, strictly speaking, not the subject of an "opposition". It was also noted by the enlarged board in G 9/91, point 19, that in the case of amendments of the claims during the opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC. In other words the principle of party disposition to which the respondent referred in the letter of 24 September 2006 applies, taking into account however the requirement of Article 102(3) EPC that amendments must comply with the provisions of the EPC.

4. In the present case the claims according to the main request contain subject-matter which was not the subject of granted claims and must therefore be examined for compliance with the requirements of the EPC.

5. Amendments

Claim 1 of the main request differs from claim 1 as granted in adding the following substantive features:

- (a) the mobile terminals are GSM mobile terminals;
- (b) the subscriber identity module is a GSM subscriber identity module; and
- (c) the predetermined formats include the GSM short message format and the display signals and the update signals are in the GSM short message format.
- (d) Additionally, the reference to "a memory containing data" has been modified to refer to "a memory for containing data".

The board considers that these amendments comply with the requirements of Article 84 EPC as to clarity and support. They moreover comply with Article 123(2) EPC.

Amendments (a) and (b) are respectively based on column 1, lines 9 to 13 and column 2, lines 17 to 22 of the published application. Amendment (c) is based on column 3, lines 37 to 42 and 46 to 50, and column 4, lines 30 to 34 of the published application.

With the possible exception of amendment (d) the amendments have a limitative effect. Amendment (d), although *prima facie* replacing a reference to a memory containing data by a reference to a memory for containing data, i.e. implying data need not be present, must be read in the context of the subsequent references in the claim to "the data of the memory" and to "the data of the subscriber identity module". The claim as now amended accordingly complies with Article 123(3) EPC.

Moreover, these amendments limit the scope of the claimed protection as compared to the claims on which the decision under appeal was based. The decision under

appeal stated that the subject-matter of the claims on which it was based was new and inventive.

6. The appellant having withdrawn all the objections against the maintenance of the patent on the basis of the amended claims, and in view of the considerations at points 1 to 5 above, the board, being bound by the extent to which the patent is opposed, has no power to consider the patent further. It follows that the appealed decision must be set aside and the patent maintained on the basis of the claims according to the respondent's main request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the order to maintain the patent on the basis of claims 1 to 5 of the respondent's main request.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland