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DECISION
of 9 December 2003

Case Number: T 1018/02 - 3.5.1

Application Number: 96202352.9

Publication Number: 0748135

IPC: H04Q 7/22

Language of the proceedings: EN

Title of invention:
Telecommunications system

Patentee:
BRITISH TECHNOLOGY GROUP INTER-CORPORATE LICENSING LIMITED

Opponents:
Schlumberger Systèmes SA
SWISSCOM AG
GEMPLUS
BULL CP8
Landis & Gyr Communications Sàrl
GIESECKE & DEVRIENT GmbH

Headword:
Telecommunications System/BTG

Relevant legal provisions:
EPC Art. 69(1), 76(1), 123(2)
EPC R. 57a, 67

Keyword:
"Amendments - added subject-matter (yes)"
"Substantive procedural violation (no)"

Decisions cited:
G 0001/93, G 0001/99, T 0299/89, T 0528/93, T 0840/93,
T 0407/02

Catchword:

Although a claim must not be interpreted in a way which is illogical or does not make any sense, the description cannot be used to give a different meaning to a claim feature which in itself imparts a clear credible technical teaching to the skilled reader. This also applies if the feature has not been initially disclosed in the form appearing in the claim (see point 3.8 of the Reasons).



Case Number: T 1018/02 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 9 December 2003

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted 2
September 2002 concerning maintenance of
European patent No. 0748135 in amended form.

Composition of the Board:

Chairman: S. V. Steinbrener
Members: R. S. Wibergh
E. Lachacinski

Summary of Facts and Submissions

I. This decision concerns the appeals filed by the Patent proprietor and Opponents 01 (having merged with former Opponent 04 Bull CP8, Louveciennes (FR) on 28 October 2002), 02, 03 and 06 against the decision of the Opposition Division finding European patent EP-B-0 748 135 in amended form to meet the requirements of the EPC. The patent is based on the European patent application EP-A-0 748 135, which is a divisional from PCT application WO-A-94/30023 (hereinafter "the parent application").

II. Claim 1 of the parent application reads:

"A telecommunications system comprising at least one host station (1) and a plurality of subscriber units (6,7), the or each host station being operable to transmit a message to at least one of the subscriber units, and each subscriber unit (6,7) having a multiplicity of fixed memory locations (22) and means responsive to the detection of the message to store the message in a selected one of the fixed memory locations which can not be overwritten from the subscriber unit (6,7), but which can be accessed from the subscriber unit when required".

Claim 12 is directed to a module for controlling a subscriber unit in a telecommunications system.

III. Claim 1 as granted reads:

"A telecommunications system comprising at least one host station (1) and a plurality of subscriber units

(6), the or each host station being operable to transmit messages to the subscriber units, and each subscriber unit having a multiplicity of fixed memory locations (17) and means responsive to the detection of a message to store the message in a selected one of the fixed memory locations, which can be accessed from the subscriber unit when required, said memory locations being provided in an integrated circuit card or other module (7) which is removably connected to the subscriber unit, characterised in that the or each host station is adapted to transmit a message coded in a specific format distinguished from other message formats used in the system, and in that the module (7) has means (16,9) for distinguishing the message coded in said specific format from said other message formats, means (10) for decoding and storing said message in a selected fixed memory location (17), and reading means (12) operable in response to the decoded message to instigate an action to be taken by the associated subscriber unit".

Claim 14 is directed to a module for controlling a subscriber unit in a telecommunications system.

IV. The opponents opposed the patent on the grounds mentioned in Article 100(a),(b),(c) EPC. In the course of the proceedings Opponent 05 withdrew its opposition. In the oral proceedings before the Opposition Division, the Patent proprietor defended the patent on the basis of a main request comprising an amended main claim and nine auxiliary requests.

V. Claim 1 of the then main request reads:

"[Preamble as granted],
characterised in that the or each host station is adapted to transmit a message coded in a specific format distinguished from other message formats used in the system, said message in said specific format comprising a read command, and in that the module (7) has means (16,9) for distinguishing a message coded in said specific format from said other message formats, means (10) for decoding and storing a message coded in said specific format in a selected fixed memory location (17), and reading means (12) operable in response to a decoded message to instigate an action to be taken by the associated subscriber unit".

VI. The Opposition Division decided that the main request and seven auxiliary requests related to claims containing subject-matter added in violation of Article 123(2) EPC. The then auxiliary request 2A was however found to be allowable. The patent was to be maintained on the basis of this request.

VII. In its notice of appeal the Patent proprietor requested that the decision be set aside and the patent be maintained on the basis of its main request before the Opposition Division.

VIII. All four opponents/appellants requested that the patent be revoked. Opponent 01 furthermore requested reimbursement of the appeal fee due to an alleged substantial procedural violation. Opponents 01, 03 and 06 asked for accelerated prosecution of the appeal due to pending infringement proceedings.

IX. In a first communication, the Board informed the parties that it was willing to grant the requests for accelerated prosecution. An invitation to oral proceedings before the Board was sent out on 7 October 2003. In an annex to the summons the Board commented on some of the issues presented by the parties.

X. By letter dated 7 November 2003, the Patent proprietor filed claims according to four new auxiliary requests, replacing the preceding auxiliary requests.

XI. By letter received by the Board on 10 November 2003, Opponent 02 informed the Board that a technical expert would attend the oral proceedings and requested that the expert should be heard as a witness. The witness would answer technical questions about the GSM standard and confirm the public nature of a meeting of experts known as SIMEG (SIM Expert Group) held in 1989.

At the same time an affidavit was filed in which the proposed witness stated that the SIMEG meetings were public.

XII. Oral proceedings before the Board were held on 9 December 2003.

XIII. The first issue to be considered was the hearing of the witness proposed by Opponent 02. After the witness had left the room the parties discussed this question, Opponents 01 and 02 requesting that he be heard and the Patent proprietor requesting that he be not.

The Board decided that the witness would not be heard, but could participate in the oral proceedings in his capacity as technical expert.

XIV. Opponent 02 submitted that the Patent proprietor's four new auxiliary requests had been filed too late in view of decision T 840/93, according to which claims of considerably altered scope should not be considered by a board when, as in the present case, divisional applications having similar scope are still pending. Furthermore, Opponent 06 objected to two of the Patent proprietor's auxiliary requests on the grounds that their subject-matter had been extended with respect to the Patent proprietor's main request before the Opposition Division.

XV. The Board decided that the four set of claims filed with the letter dated 7 November 2003 should be considered. The Patent proprietor then withdrew its main request. In consequence, the four auxiliary requests became the final main request and auxiliary requests 1 to 3.

XVI. Claim 1 of the *main request* reads:

"A telecommunications system comprising at least one host station (1) and a plurality of subscriber units (6), the or each host station being operable to transmit messages to the subscriber units, and each subscriber unit having a multiplicity of fixed memory locations (17) and means responsive to the detection of a message to store the message in a selected one of the fixed memory locations, which can be accessed from the subscriber unit when required, said memory locations

being provided in an integrated circuit card or other module (7) which is removably connected to the subscriber unit, characterised in that the or each host station is adapted to transmit a message coded in a specific format distinguished from other message formats used in the system, and in that the module (7) has means (16,9) for distinguishing the message coded in said specific format from said other message formats, means (10) for decoding and storing said message coded in said specific format in a selected fixed memory location (17), and reading means (12) operable in response to the decoded message to instigate an action to be taken by the associated subscriber unit, if the decoded message comprises a read command".

Claim 14 is directed to a corresponding module.

XVII. Claim 1 of the *first auxiliary request* differs from the main request in that the last feature reads:

"/... subscriber unit/, said message coded in said specific format comprising a read command".

XVIII. Claim 1 of the *second auxiliary request* differs from the main request in that the last feature reads:

"/... subscriber unit/, if the decoded message comprises a read command, said action being transmitting information requested by the read command".

XIX. Claim 1 of the third auxiliary request reads:

"[Preamble as the main request],
characterised in that
the or each host station is adapted to transmit a
message coded in a specific format distinguished from
other message formats used in the system,
said message coded in said specific format comprising a
read command, and in that
the module (7) has means (16,9) for distinguishing the
message coded in said specific format from said other
message formats,
means (10) for decoding and storing said message coded
in said specific format in a selected fixed memory
location (17), and
reading means (12) operable in response to the decoded
message to instigate an action to be taken by the
associated subscriber unit, said action being
transmitting information requested by the read
command".

XX. As to the objections under Articles 76(1) and 123(2)
EPC that the patent contains additional subject-matter,
the opponents presented the following arguments:

The expression "fixed memory location" was defined in
the description of the parent application as excluding
"first-in-first-out or circular buffers". This
exclusion had been omitted when filing the divisional
application. The result was an extension of subject-
matter when compared with the parent application, since
the invention as now claimed (and as granted) included
the specified kind of memories.

The "reading means" was not mentioned in the parent application. If the "reading means" referred to the execution of a read command, it was not originally disclosed that the means could be operable in response to a "message". A "message" was information to be stored, not to be read.

If the expression "message coded in a specific format" concerned the commands and instructions rather than information to be stored, it had not been initially disclosed that such a message was stored in a selected fixed memory location.

The word "instigate" had been introduced after filing and conveyed the idea that the module took an initiative. In reality it merely executed a command. Furthermore, only the read command, and not the other commands mentioned in the patent, could at all be said to influence an action to be taken by the subscriber unit. Finally, the word was obscure, and an obscure expression could never be unambiguously derivable from an application.

The above objections were said to involve "inescapable traps" in the meaning of the decision of the Enlarged Board of Appeal G 1/93 since the features could not be removed from claim 1 as granted without infringing Article 123(3) EPC. Thus the objections applied to all of the Patent proprietor's requests.

XXI. On the same points the Patent proprietor argued in the following way:

The term "message" had two different meanings in the description of the parent application. It denoted either a write command or any command sent using embedded SMS.

The reading means served to read the content of a decoded message.

The means operable in response to a decoded message to instigate an action to be taken by the subscriber unit did not take action in every instance and was not made use of, for example, by the write command. The feature should be understood in the way that it defined an active functionality of the module. It was made use of by the read command.

The means for decoding and storing a message coded in the specific format was made use of by the write command. Not every received message was decoded and stored, however. Similar to the means for instigating an action, the feature only required the module to have the functionality of decoding and storing messages.

XXII. The Patent proprietor (appellant) requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or alternatively on the basis of one of auxiliary requests 1 to 3.

XXIII. All opponents (appellants) requested that the decision be set aside and the patent be revoked. Opponent 01 requested reimbursement of the appeal fee.

XXIV. At the end of the oral proceedings the Board announced its decision.

Reasons for the Decision

1. *The request to hear a witness*

1.1 Opponents 01 and 02 have requested that a technical expert accompanying Opponent 02 to the oral proceedings before the Board should be heard as a witness. This expert would answer technical questions about the GSM standard and confirm the public nature of a particular meeting of experts held in 1989.

The Patent proprietor objected to the request on the grounds that the witness had been presented too late, that he was not impartial since he worked for a firm which may be interested in seeing the patent revoked, and that it was in any case doubtful if he could remember events which occurred fourteen years ago.

1.2 The Board decided that it was not necessary for the expert to give evidence orally, since he was not expected to add anything relevant beyond what he had already stated in his affidavit. Nor did the Patent proprietor desire to put questions to him. He could however remain at the oral proceedings in his capacity as technical expert.

2. *The admissibility of the Patent proprietor's requests*

2.1 In the annex to the summons to oral proceedings, the Board had indicated that amendments "which are not submitted in good time prior to the oral proceedings" might be disregarded. The Patent proprietor had filed claims according to four new auxiliary requests one month before the oral proceedings. The amendments mainly involved formulation alternatives and were not substantial. Opponent 02 objected to these claims on the grounds that they were late filed and that, following decision T 840/93 (OJ EPO 1996,335), such requests should be strictly handled when, as in the present case, divisional applications claiming similar subject-matter are pending.

2.2 In case T 840/93 the reason for not allowing the new claims was that "not one of the requests corresponds to those considered by the department of first instance" (point 3.6) and that remittal was inappropriate, since divisional applications were still pending before the first instance (point 3.2.3). In the present case, however, the subject-matter claimed is very similar to that examined by the Opposition Division. The Patent proprietor's then main request (together with several auxiliary requests) was in fact refused under Article 123(2) EPC, and also the Board's second communication was largely concerned with the formal aspects of the claims, so it was to be expected that the Patent proprietor would try to overcome such objections by reformulations. One month was clearly sufficient for the opponents to analyse the amendments made. Thus, the new claims were filed in due time.

2.3 Opponent 06 objected to the Patent proprietor's main request and auxiliary request 2 on the basis that the subject-matter of claim 1 was extended with respect to the Patent proprietor's main request before the Opposition Division. He submitted that if a Patent proprietor in the first instance chooses to defend a main request which is limited in scope compared with the claims as granted, then he cannot during the appeal proceedings go beyond the limits of that request. If he did, he would not be adversely affected by the decision under appeal. Some case-law was cited, in particular T 528/93 and T 299/89 (not published in the OJ EPO).

2.4 The Board does not find the objection justified. Amendments of a European patent must comply with Rule 57a EPC. According to this rule, amendments are possible provided that they are occasioned by grounds for opposition. At first glance it may appear that this stipulation provides support for the view of Opponent 06, since an amendment consisting exclusively in removing limitations previously made during the opposition proceedings does not in itself serve to overcome a ground for opposition. The jurisprudence of the boards of appeal is however not this strict. Thus, in accordance with T 407/02 (not published in the OJ EPO, point 1.2) a patent proprietor who has only defended his patent in limited form before an opposition division is in principle allowed on appeal to return to a broader version or even to the patent as granted. Moreover, in the present case the Board is convinced - and Opponent 06 has not denied - that the amendments proposed by the Patent proprietor in accordance with his four requests, whether or not they lead to an extension of the scope as compared with the

Patent proprietor's main request in the proceedings before the first instance, are intended to overcome the objections raised under Article 100(c) EPC. (Since all parties have appealed, there is no need to consider *reformatio in peius* and hence no limitations to the applicability of Rule 57a EPC existing in this respect arise - see decision G 1/99 (OJ EPO 2001,381), point 10.2 of the reasons). The Patent proprietor's main request and auxiliary request 2 are therefore admissible under Rule 57a EPC. The decisions cited by Opponent 06 concern different situations, T 528/93 dealing with a claim which had been withdrawn in the first instance proceedings and reintroduced before the Board, and T 299/89 being involved with the extent to which a patent is opposed.

2.5 It follows that the Patent proprietor's main and three auxiliary requests are to be considered by the Board.

3. *Added subject-matter*

3.1 The patent-in-suit concerns a SIM (subscriber identity module) and the way the SIM communicates with an associated subscriber unit and the host station. Conventional SMS messages (short message service) can be stored in fixed memory locations in the SIM under the supervision of the processor in the subscriber unit. This technique is reflected by the preamble of claim 1. The invention contemplates extending this service to provide a remotely reconfigurable SIM. Different commands (referred to in the description as ECS, embedded command stream, see for instance column 3, line 51 to column 4, line 30 and column 6, lines 28 to 36 of the patent-in-suit) are recognised by the SIM.

For example, a write command has the effect of storing data in memory, a read command of transmitting data in the SIM back to the host station, etc.

- 3.2 The opponents have raised a number of objections under Article 100(c) EPC against the present claims (see point XX above). Several of these objections concern words which are obscure or of indefinite scope. One example is the word "instigate" in claim 1. As it does not appear in the parent application it could conceivably be interpreted in ways which go beyond the subject-matter as originally filed (as the Opposition Division in fact decided, see point 3.1 of the decision under appeal). Similarly, according to the parent application (see page 1, line 35 to page 2, line 4), the expression "fixed memory locations" does not comprise first-in-first-out or circular memories, a limitation which is omitted in the divisional application. Leaving out this limitation would be allowable if the expression "fixed memory locations" in itself excluded such memories, but if it does not, the divisional application (and therefore the patent) contains added subject-matter when compared with the parent application. The validity of both these objections thus depends on how the skilled person would understand certain more or less well known technical concepts used in the patent, a question which is clearly difficult to answer.

Also the meaning of the word "message" has been extensively discussed between the parties. The Opponents argue that it refers to data accompanying the write command whereas the Patent proprietor sees it as covering several kinds of commands, including the write

and read commands. It appears however to the Board that the meaning of this word is the easiest to determine, and therefore the objection based on this word will be examined first.

- 3.3 In the Patent proprietor's view the word "message" is used with two different meanings in the parent application: it either denotes a write command or any command sent using the embedded SMS (cf. the letter dated 30 May 2003, point 3.4). In the characterising part of claim 1 of the present main request the word should, according to the Patent proprietor, be understood in the second, wider meaning, as is clear from claim 4 (corresponding to claim 4 as granted).

Dependent claim 4 states that "the message in said specific format transmitted by a host station comprises information to be stored in the module (7), a request for information stored in the module and/or an instruction to execute a program stored in the module". Thus the "message" includes not only data to be stored but also for example a request for information (read command). The Board notes that dependent claims 8, 9 and 12 (corresponding to the respective claims as granted) - which also refer to "the message" - are consistent with this interpretation.

- 3.4 Thus, in view of the wording of the dependent claims it appears that the skilled person would understand "message" as indicated by the Patent proprietor. Whether or not this meaning is supported by the description of the patent is mainly a question under Article 84 EPC (support) and need not be further considered in opposition appeal proceedings. The

wording is clear enough to make an unambiguous contribution to the definition of the claimed system, and this suffices to be able to examine whether the feature involves added subject-matter.

3.5 Claim 1 as granted and in accordance with the main request thus states that the module includes means for decoding and storing a message, where the word "message" covers commands. The Patent proprietor does not deny that neither the parent application nor the divisional application contains such a disclosure. Nor is it implicit since, even assuming that the SIM processor stores the commands in memory before executing them, they would not be stored in "selected fixed memory locations", a term used in the description in connection with the message *data* to be stored (see e.g. page 5, lines 6 to 21 of the parent application and the corresponding passage of the A-publication of the divisional application, column 3, line 56 to column 4, line 13). Therefore it would appear that the addition (before grant) of this feature was contrary to Article 123(2) EPC.

3.6 The Patent proprietor has argued that the feature concerning the storing means cannot reasonably be understood in the way set out above. Claim 1 was an apparatus claim drafted in functional language to define structural features. The claim only required that storing means were present, but not that each and every command was stored.

3.7 The Board is not able to accept this reasoning. If storing means are provided "for decoding and storing said message", and the "message" can be any command,

then the means must be designed in such a way that any command can actually be stored. The parent application discloses that message *data* are stored, but this does not necessarily imply that *commands* can also be stored. The means for storing a message cannot simply be identified with the EEROM shown in figure 3 of the patent, even if this unit contains fixed memory locations. In the field of computer-implemented inventions a controlling computer is normally defined in terms of the program running on it. Therefore, a claim which mentions "means for storing certain data" does not merely imply hardware which *could be* programmed to store the data, but which *has been* so programmed. In the present case there is no indication in the parent application or in the divisional application that the processor in the SIM has been programmed to store (any kind of) incoming commands in the EEROM.

- 3.8 The Patent proprietor has furthermore pointed out that a claim must not be interpreted in a way which is illogical or does not make sense. The Board agrees. Still, the description cannot be used to give a different meaning to a claim feature which in itself imparts a clear, credible technical teaching to the skilled reader. This also applies if the feature has not been initially disclosed in the form appearing in the claim. Otherwise third parties could not rely on what a claim actually states (cf. Article 69(1) EPC: The terms of the claims *determine* the extent of protection whereas the description is only used to interpret the claims) and Article 123(2) EPC would become meaningless in respect of amendments to the claims.

3.9 For these reasons the Patent proprietor's main request is not allowable. Since the claims of all three auxiliary requests contain the "means (10) for decoding and storing said message coded in said specific format in a selected fixed memory location", they also contravene Article 123(2) EPC. Thus, this feature would have to be deleted to achieve consistency with the original disclosure. But, since it quite clearly makes a technical contribution to the subject-matter, this would not be possible under Article 123(3) EPC (cf. decision G 1/93, OJ EPO 1994, 541, headnote I).

3.10 It follows that the patent must be revoked. It is not necessary to decide whether claim 1 contains more features which are not disclosed in the parent application or in the divisional application as filed.

4. *Substantial procedural violation*

4.1 Opponent 01 has requested reimbursement of the appeal fee on the grounds that the proceedings before the Opposition Division were seriously flawed. Firstly, according to the Opponent, the Opposition Division did not apply Article 123(2) EPC correctly, since they only examined whether subject-matter had been added in relation to the parent application, neglecting the divisional application as filed. Secondly, the Opposition Division applied the principle of *res judicata* without a decision having been taken. Thirdly, it was improper of the Chairman of the Opposition Division to accuse the representative of the Opponent, when asking the Opposition Division to reconsider the allegedly decided point, of "abuse of the procedure".

4.2 Rule 67 EPC states that reimbursement of the appeal fee is possible by reason of a substantial procedural violation. Even supposing that the Opposition Division had applied Article 123(2) EPC incorrectly, in accordance with the established case law of the boards this cannot amount to a *procedural* violation (see "Case Law of the Boards of Appeal of the European Patent Office", 4th edition, 2001, EPO 2002, VII.D.15.4.5).

As to the question of *res judicata*, the Opponent has referred to the minutes of the oral proceedings before the Opposition Division, point 20. Here it is stated that the Opponent's request to examine whether claim 1 of the then auxiliary request 2A fulfilled the requirements of Article 123(2) EPC with respect to the divisional application as filed was rejected since a decision on this had already been taken. Under point 18 it is said that the Opposition Division decided that this claim did not contravene Article 123(2) EPC and that the grounds for opposition Article 100(c) did not prejudice the maintenance of the amended patent. Hence it appears that a decision had indeed been taken and the Opposition Division had no power to reconsider the question, whether or not Article 123(2) EPC had been correctly applied.

Thirdly, it cannot be an abuse of proceedings merely to ask for a decision on an issue believed not to be finally, or completely, decided. As to the Chairman's remark, the circumstances of mutual misunderstanding in which the request was made should be considered. In any case, it is not apparent that the Opponent's right to be heard was violated.

4.3 Thus the request for reimbursement of the appeal fee is refused.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The European patent is revoked.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

M. Kiehl

S. Steinbrener