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**D E C I S I O N**  
**of 15 February 2006**

**Case Number:** T 0983/04 - 3.4.03

**Application Number:** 95935472.1

**Publication Number:** 0739526

**IPC:** G07F 7/08

**Language of the proceedings:** EN

**Title of invention:**  
Real time tele-payment system

**Patentee:**  
Vazvan, Behruz

**Opponent:**  
Nordea Bank Finland PLC  
Siemens AG  
Giesecke & Devrient GmbH  
Motorola Inc.  
Nokia Corporation

**Headword:**  
Mobile payment part/VAZVAN

**Relevant legal provisions:**  
EPC Art. 100(c), 123(2) and (3), 108, 99, 104  
EPC R. 67

**Keyword:**  
-

**Decisions cited:**  
G 0009/93

**Catchword:**  
-



Case Number: T 0983/04 - 3.4.03

**D E C I S I O N**  
of Technical Board of Appeal 3.4.03  
of 15 February 2006

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**Decision under appeal:**

**Decision of the Opposition Division of the  
European Patent Office posted 6 August 2004  
revoking European patent No. 0739526 pursuant  
to Article 102(1) EPC.**

**Composition of the Board:**

**Chair:** R. G. O'Connell  
**Members:** G. Eliasson  
P. Mühlens

## Summary of Facts and Submissions

- I. This is an appeal against the revocation of European patent 0 739 526 on the ground of added subject matter (Article 100(c) EPC). Proposed amended claims in accordance with thirteen auxiliary requests were also found to add subject matter (Article 123(2) EPC).
- II. The appellant proprietor filed amended claims with the statement of grounds of appeal and with letters dated 5 January 2006 and 2 February 2006.
- III. At oral proceedings before the board the parties made the following requests:

The appellant proprietor requested that the decision under appeal be set aside and that the patent be maintained as granted (main request), or that the patent be maintained in amended form on the basis of one of auxiliary requests 1 to 7 filed with the statement of grounds of appeal, or on the basis of one of auxiliary requests 8 to 9 filed with the letter dated 5 January 2006, or on the basis of one of auxiliary requests 10 to 11 filed with the letter dated 2 February 2006.

The appellant proprietor furthermore requested that the opposition of respondent opponent 05 be rejected as inadmissible.

The appellant proprietor finally requested apportionment of costs and reimbursement of the appeal fee.

Respondent opponent 05 requested that the appeal be held inadmissible.

The respondent opponents 01 to 05 requested that the appeal be dismissed.

- IV. At the oral proceedings before the board the parties presented their arguments on the subject whether the claim requests of the appellant proprietor contained subject matter extending beyond the content of the application as filed. After the parties' arguments were heard, the chair declared the debate closed with regard to the question of added subject matter and interrupted the oral proceedings for deliberation. The appellant proprietor inquired during the adjournment of the oral proceedings whether it would be possible to file further auxiliary requests. He was informed by the board that this would only be possible if, after deliberation, the board should arrive at the conclusion that one of the appellant proprietor's request met the requirements of Article 123(2) and (3) EPC.

After deliberation the chair announced the decision to dismiss the appeal.

- V. Claim 1 of the application as originally filed reads as follows (labelling introduced by the board):

"1. A mobile payment system (43), characterised in that it is comprised of:

- A) at least one portable terminal (1, 6, 8), such terminal including a mobile payment part (10, 21) and other means for entering, transmitting,

receiving and printing of information relating to: the payments of bills of the telephone subscriber or the user of said portable terminal; transferring of money from the bank account of the subscriber or user to the others account; sending and receiving payment messages (13, 18, 19, 25, 29) or messages including the account balance, the statement of account, or the movement on the bank account (33, 34, 35) of the telephone subscriber or the user of the portable terminal (41, 37);

B) at least one computing station (2, 14, 24) which is located in the bank (3), said computing station including means for communicating with said portable terminal and for transferring the amount of payment (money) from the bank account of portable terminal's user and/or telephone subscriber to another bank account (17, 28), or from a customer's bank account, whose account information is entered into said portable terminal, to the calling party's account; and to receive and send messages about the account balance, the statement of account, or the movement on the bank account (33, 34, 35) of the portable terminal's subscriber or user;

C) at least one wireless communications network (4, 15, 26) through which said portable terminal can send and receive to or from said computing station said payment messages or messages about the account balance, the statement of account, or the movement on the

bank account of said portable terminal's subscriber or user."

VI. Claim 1 as granted and forming the appellant proprietor's main request reads as follows (labelling by the board):

- a) "A real time mobile payment system for bill payment of mobile users and/or providing users with all means for mobile banking, commerce, trading and sending and receiving information, the system utilizing
- b) short message service facilities of at least one mobile wireless communication network or a digital cordless communication system (5) and subscriber/user identity module (SIM or equivalent 10, 21, 39, 42), the system comprising
- c) at least one mobile terminal (1, 6, 8, 37, 41) using said identity module (10, 21, 39, 42) and comprising means for entering, transmitting, receiving, handling and displaying (11) of information essentially related but not limited to:
  - c1) the payments of bills of the telephone subscriber or the user of said mobile terminal; transferring of money from the bank account of the subscriber or user to the others accounts; sending and receiving at least payment messages (11, 13, 18, 19, 20, 25, 29, 33, 34, 35) or messages including the account balance, the statement of account, or the movement on the account (33, 34, 35) of the telephone subscriber or the user of the mobile

terminal (1, 6, 8, 37, 41) and communicating banking, payment, and commerce related and other required messages (11);

- d) at least one computing station (2, 14, 24) located in a bank (3) or any other required places, said computing station including means
  - d1) for direct short message communication with said mobile terminal or via messaging means of the communication network (4, 5) and
  - d2) for transferring the amount of payment from the account of mobile terminal's user or telephone subscriber to another account (17, 28), or from a customer's account, whose account information is entered into said mobile terminal, to another account;
  - d3) and/or to receive and send messages about the account balance, the statement of account, or the movement on the account (11, 33, 34, 35) of the mobile terminal's subscriber or user and communicating banking, payment, and commerce related and other required messages (11);
- e) at least the one mobile wireless communications network (4, 15, 26) or a digital cordless communication system (5) through which said mobile terminal can send and receive to or from said computing station said payment messages and/or at least messages about the account balance, the statement of account, or the movement on the account of said mobile terminal's subscriber or



user, and communicating banking, payment, and/or commerce related and other required messages (11)."

The main request furthermore comprises independent claims 3, 4, 8, and 9 defining a computing station, a mobile terminal, a smart card, and a method in a real time mobile system, respectively.

VII. Claim 1 according to auxiliary request 1 reads as follows (emphasis added by the board to indicate differences with respect to the main request):

- a) "A real time mobile payment system for bill payment of mobile users and/or providing users with means for mobile banking, **retail**, trading and sending and receiving information **in real-time basis**, the system utilizing
- b) short message service facilities of at least one mobile wireless communication network **(4)** or a digital cordless communication system (5) and subscriber/user identity module (SIM or equivalent, **39**), the system comprising
- c) at least one mobile terminal (1, 6, 8, 37, 41) using said identity module **(39)** and comprising means for entering, transmitting, receiving, handling and displaying (11) of information essentially related to
- c1) the payments of bills of the telephone subscriber or the user of said mobile terminal; transferring of money from the bank account of the subscriber

or user to the others accounts; sending and receiving at least payment messages (11, 13, 18, 19, 20, 25, 29, 33, 34, 35) or messages including the account balance, the statement of account, or the movement on the account (33, 34, 35) of the telephone subscriber or the user of the mobile terminal (1, 6, 8, 37, 41) and communicating banking, payment, **retail or trading and other related messages (11); said messages sent and received in real time basis without setting up any telephone call;**

- d) at least one computing station (2, 14, 24) located in a bank (3) or other **similar secure** places, said computing station including means
  - d1) for direct short message communication with said mobile terminal **through said communication system (4, 5)** or via messaging means of **said** communication network (4, 5) and
  - d2) for transferring the amount of payment from the account of mobile terminal's user or telephone subscriber to another account (17, 28), or from a customer's account, whose account information is entered into said mobile terminal, to another account;
  - d3) and/or to receive and send messages about the account balance, the statement of account, or the movement on the account (11, 33, 34, 35) of the mobile terminal's subscriber or user and communicating banking, payment, **retail or trading and other related messages (11) in real-time basis;**

- e) at least the one mobile wireless communications network (4, 15, 26) or a digital cordless communication system (5) through which said mobile terminal can send and receive to or from said computing station said payment messages and/or at least messages about the account balance, the statement of account, or the movement on the account of said mobile terminal's subscriber or user, and communicating banking, payment, and/or **retail or trading** and other **related** messages (11)."

Auxiliary request 1 further contains independent claims 3, 4, 8, and 9 defining a computing station, a mobile terminal, a user identity module, and a method in a real time mobile system, respectively.

VIII. Claim 1 according to auxiliary request 2 differs from that of auxiliary request 1 in that paragraphs d and d1 read as follows (emphasis by the board):

- d) "at least one computing station (2, 14, 24) located in a bank (3) or other similar secure places, said computing station including means
- d1) **for communication** with said mobile terminal through said communication system (4, 5) **via** messaging means of said communication network (4, 5) and"

Auxiliary request 2 further contains independent claims 3, 4, 8, and 9 defining a computing station, a

- mobile terminal, a user identity module, and a method in a real time mobile system, respectively.
- IX. Claim 1 according to auxiliary request 3 has the same wording as claim 1 according to auxiliary request 2. The request further contains independent claims 3, 4, 8, and 9 defining a computing station, a mobile terminal, a software program, and a method in a real time mobile system, respectively.
- X. Claim 1 according to auxiliary request 4 has the same wording as claim 1 according to auxiliary request 2. The request further contains independent claims 3 to 9 defining a computing station, independent claims 10 to 19 defining a mobile terminal, independent claims 21 to 26 defining a user identity module, and independent claim 27 defining a method in a real time mobile system.
- XI. Claim 1 according to auxiliary request 5 has the same wording as claim 1 according to auxiliary request 2. The request further contains independent claims 3 to 9 defining a computing station, independent claims 10 to 19 defining a mobile terminal, independent claim 21 defining a software program, and independent claim 27 defining a method in a real time mobile system.
- XII. Claim 1 according to auxiliary request 6 has the same wording as claim 1 according to auxiliary request 2. The request further contains independent claims 3 to 9 defining a computing station, independent claims 10 to 19 defining a mobile terminal, and independent claim 20 defining a method in a real time mobile system.

XIII. Claim 1 according to auxiliary request 7 has the same wording as claim 1 according to auxiliary request 2. The request further contains independent claims 3 to 9 defining a computing station, independent claims 10 to 19 defining a mobile terminal, and independent claim 21 defining a software program, and independent claim 27 defining a method in a real time mobile system.

XIV. Claim 1 according to auxiliary request 8 differs from claim 1 of auxiliary request 2 in that paragraphs b and c read as follows (emphasis by the board):

b) "short message service facilities of at least one mobile wireless communication network **(4)** or a digital cordless communication system (5) and subscriber/user identity module (SIM **or the like 10, 39**), the system comprising

c) at least one mobile terminal (1, 6, 8, 37, 41) using **a module called mobile payment part (10, 21, 39, 42)** and comprising means for entering, transmitting, receiving, handling and displaying (11) of information essentially related to"

Furthermore, the expression "and/or" (second occurrence) in paragraph e) of claim 1 of auxiliary request 2 has been replaced by "or" (see VII above).

The request further contains independent claims 3, 4, 8, and 9 defining a computing station, a mobile terminal, a user identity module, and a method in a real time mobile system, respectively.

XV. Claim 1 according to auxiliary request 9 has the same wording as that of auxiliary request 8. The request further contains independent claims 3 to 6 defining a computing station, independent claims 7 to 13 defining a mobile terminal, independent claim 14 defining a method in a real time mobile system, and independent claim 16 defining a user identity module.

XVI. Claim 1 according to auxiliary request 10 differs from claim 1 of auxiliary request 2 in that paragraph c reads as follows (emphasis by the board):

c) at least one mobile terminal (1, 6, 8, 37, 41) using said identity module (10, 21, 39, 42) **and in one of its embodiments including a software program called mobile payment part** and comprising means for entering, transmitting, receiving, handling and displaying (11) of information essentially related to"

Furthermore, the expression "(SIM or equivalent, 39)" in paragraph b) of claim 1 of auxiliary request 2 now reads "(SIM or equivalent 10, 21, 39, 42)". The expression "another account" in paragraph d2) (second occurrence) reads "to the another account;". Finally, the expression "and/or" in paragraph e) (second occurrence) reads "or".

The request further contains independent claims 3, 4, 8, and 9 defining a computing station, a mobile terminal, a user identity module, and a method in a real time mobile system, respectively.

XVII. Claim 1 according to auxiliary request 11 has the same wording as that of auxiliary request 10. The request further contains independent claims 3 to 6 defining a computing station, independent claims 7 to 13 defining a mobile terminal, independent claim 14 defining a method in a real time mobile system, and independent claim 16 defining a smart card.

XVIII. Regarding admissibility of the appeal, respondent opponent 05 presented essentially the following arguments:

The appellant proprietor had not presented legal or factual reasons why all grounds of revocation were incorrect and should be annulled. More particularly, the statement of grounds of appeal did not contest at all points 24 (charging/debiting said smart card), 37 (means for mobile commerce, banking, trading...), and 38 (combinations and sub-combinations of features not originally disclosed) of the decision. Pursuant to Article 10a, 10b and 10c of the Rules of Procedure of the Boards of Appeal (RPBA) a party had to submit its complete case at the start of the proceedings. Each one of these points alone was a ground for revocation.

XIX. As to the admissibility of the opposition of respondent opponent 05, the appellant proprietor presented essentially the following arguments:

Respondent opponent 05 had attempted to become the proprietor of the opposed patent by suing the appellant proprietor before the District Court of

Helsinki. Following G 9/93, which held that the patent proprietor may not oppose his own patent, the opposition of respondent opponent 05 should be rejected as inadmissible.

XX. Regarding patentability, the appellant proprietor presented essentially the following arguments relevant for the present decision:

- (a) It was immediately evident to a skilled person reading the application as filed that the "mobile payment part" in claim 1 as granted was equivalent to the Subscriber Identification Module (SIM) used in any normal mobile terminals (GSM telephones) at the priority date of the patent. Since the application as filed in Figure 4, left hand drawing, described a **normal** portable telephone which includes the inventive mobile payment part, it was evident that a **normal** mobile terminal cannot have something new permanently incorporated in the terminal, since otherwise it would not be a "normal" terminal. The SIM card, having the features of the present invention, is the only card that the users could have included in the normal mobile terminals (GSM phones) of the years 1994-1995. This is also apparent from the description referring to the terminal shown in the right hand of Figure 4 as "a portable telephone that includes the inventive mobile payment part, a charge slip printer and a user-friendly SIM card reader".
- (b) Moreover, the opposition division stated in its decision that according to the original



application "the mobile payment part dials" and the "mobile payment part pays". According to the opposition division "the SIM card can not perform the functions of dialling a telephone number or sending information. Therefore, the mobile payment part must be something different than the SIM card."

The arguments of the opposition division were incorrect. First it should be considered that if according to the understanding of the opposition division "the SIM card, at least in the embodiment shown in figure 4 on the right hand side, is not included in the portable terminal whereas the mobile payment part is included" then how was it even possible to send and receive short messages (SMS)? This simply proved that the "mobile payment part" resided in the SIM and that in the embodiment shown in figure 4 on the right hand side the SIM was included; otherwise sending and receiving short messages would not be possible because a user terminal could not have access to the short message service without a SIM.

- (c) In the opposed patent the SIM was not used without the terminal. The SIM used the resources of the terminal such as power source (battery), transmitter and receiver etc. in order to transmit and receive short messages. In order to make a call from the telephone number directory of the SIM it had to pass the number to the mobile telephone. The statement "the mobile payment part dials the telephone number of the computing station" did not mean that the mobile payment part

could not reside in the SIM because, as mentioned above, the SIM had processing and memory means by which any application could be run. It should be noted that the mobile payment part was a software that could display bills to the user (ie bill presentation and payment) and provided the user with different options such as "Payment amount, Bill ret: etc" and eg OK and Send-options to send the message via the mobile terminal. Such software could reside in the SIM as well as in the mobile terminal, as clearly said in the disclosure of the application as originally filed, page 7, lines 9 to 11, where it is said: "in order to send the payment messages by SMS, the software of SMS installed in the portable terminal can be modified so that it can also handle the payment parameters and/or commands of the inventive mobile payment part".

XXI. Regarding patentability, the respondent opponents presented essentially the following arguments relevant for the present decision:

- (a) The application as filed disclosed two embodiments. The first embodiment used a normal mobile phone for carrying out transactions (page 5, line 14 to page 6, line 11; left hand of Figure 4) while the other embodiment used a mobile terminal having a credit card or SIM card reader 36 (page 6, last paragraph; right hand of Figure 4). This credit card or SIM card reader was used for reading the card of a customer. There was no disclosure that a SIM was used at all in the second embodiment, since the mobile terminal could be connected to a

cordless network like a DECT which did not use a SIM for identifying subscribers and credit cards at the priority date of the patent were usually only equipped with magnetic strips (cf application as filed, page 4, lines 2 to 6). Therefore, the application as filed did not disclose that the term "mobile payment part" should be equated with SIM.

Furthermore, the application as filed described at page 5, lines 20 to 25, which functionalities the mobile payment part should have. These functionalities were incompatible with those of an SIM, at least at the filing date of the patent.

- (b) In claim 1 according to auxiliary requests 8 and 9 the phrase "using said identity module" was replaced by "using a module called mobile payment part". This amendment resulted in the scope of claim 1 being broadened with respect to the claims as granted and was therefore prohibited by Article 123(3) EPC.
  
- (c) The feature "and in one of its embodiments including a software program called mobile payment part" introduced in claim 1 according to auxiliary requests 10 and 11 was only optional and therefore did not change the scope of claim 1. Apart from the fact that the application as filed did not disclose that the mobile payment part was a software program, the objections raised against claim 1 as granted applied to auxiliary requests 10 and 11 as well.

XXII. With respect to the requests for apportionment of costs and reimbursement of the appeal fee, the appellant proprietor presented essentially the following arguments:

- (a) The claims as granted had been approved by the examining division without any objections. Therefore, if the opposition division found that the claims as granted did not comply with Article 123(2) EPC then the examining division should not have granted the patent but should have invited the applicant to overcome the objections under Article 123(2) EPC. On grant of the patent the appellant proprietor had had to translate the patent specification at his own expense into several other languages.
- (b) In the decision under appeal, the opposition division had interpreted Article 123(2) EPC in a very broad way contrary to the instructions given in the Guidelines.
- (c) Although the appellant proprietor had been given the possibility to speak at the oral proceedings before the opposition division, the opposition division had neither listened to nor analysed the arguments submitted by the proprietor.
- (d) The oppositions had no admissible grounds, but had caused extra costs to the appellant proprietor. In particular, the opposition division had made several statements in the communication with the summons to oral proceedings which were not correct, such as the statement that exclusive short message

communication without any voice operation was not an explicit feature of granted claim 1. However, as proven by the proprietor in his written submissions and at the oral proceeding before the opposition division, the granted claim 1 and the rest of the claims were exclusively based on short message communication without any voice operation. This issue had been the subject of examination and in the applicant's statement attached to his original application this matter had been mentioned. Otherwise, the EPO could not have granted the patent. Therefore, this important feature of the invention had been objected to by the opponents and the opposition division without any basis.

- (e) The opponents had abused the proceedings by submitting irrelevant documents. For example, the opponents, as well as the opposition division, had contended that document D2 (US 5 221 830A) was an important cited publication allegedly disclosing a real time short message system. At the oral proceedings, however, the opponents had contradicted themselves in arguing that the short message communication of mobile communication would not be considered a real-time solution. This simply proved that opponents had submitted irrelevant documents.
  
- (f) The late-filed documents cited by opponents O1 and O5 in the opposition procedure has caused extra work and costs for the appellant proprietor, taking into account that the opposition division had not refused to admit the late-filed documents

of opponents 01 and 05 despite the proprietor's request. The submission of new documents amounted in effect to a submission of fresh grounds for opposition. Such grounds could be considered in the proceedings only with the approval of the proprietor (G 10/91). The late-filed documents by opponents 01 and 05 were not even a bona fide attempt to overcome any objection raised, because after the appellant proprietor had studied these documents he realised that the late-filed documents brought nothing new which had not been taken into consideration in the examination and opposition proceedings.

#### **Reasons for the Decision**

##### 1. *Admissibility of the appeal*

- 1.1 Respondent opponent 05 argued that the appeal should be held inadmissible, since it failed to address *all* the reasons given in the decision under appeal for revoking the patent (cf item XVIII above). In particular, the objections raised in the decision under appeal against undisclosed combinations of features in the independent claims as granted were not dealt with at all in the statement of grounds of appeal. Referring to the jurisprudence of the boards of appeal cited in "Case Law of the Boards of Appeal of the European Patent Office, 4th Edition" at chapter VII.D.7.5.1, opponent 05 argued that the statement of grounds of appeal should make it clear why, in the appellant's opinion, the contested decision was wrong.

1.2 Although the statement of grounds of appeal shall state the appellant's complete case pursuant to Article 10a(2) RPBA, the board cannot subscribe to the argument of opponent 05 that that the statement of the grounds of appeal must explicitly deal with all the grounds given in the contested decision in order for the appeal to be admissible. It may very well be the case that the appellant's arguments and/or amendments relating to one of the objections raised in the decision under appeal would remove the other objections as well. Such a question, however, can only be answered in the course of a substantive examination of the appeal, a procedural step which pursuant to Article 110(1) EPC is to be carried out after the appeal has been found admissible. Thus, for the issue whether the requirements of Article 108 EPC are met, it suffices that the statement of grounds of appeal address the main reason given for the decision under appeal. It should be added that even if this were not the case, the appeal might nevertheless be admissible, when for example amendments filed by the appellant could overcome the objections raised in the decision under appeal ("Case Law, 4th Edition", Chapter VII.D.7.5.2 (d)).

1.3 As to the jurisprudence referred to by respondent opponent 05 in "Case Law, 4th Edition", chapter VII.D.7.5.1, some of the decisions cited in this chapter could arguably be interpreted as setting a high hurdle for compliance with Article 108 EPC. However an analysis of the *ratio decidendi* of these decisions does not provide any basis for such an interpretation of Article 108 EPC.

1.4 In the present case, the ground for revoking the opposed patent was that the subject matter of the patent extended beyond the content of the application as filed (Article 100(c) EPC). The opposition division found 16 different kinds of amendments of the claims as granted which in their opinion each extended the subject matter beyond the content of the application as filed. It is not contested that the extensive statement of grounds of appeal explicitly dealt with almost all of the numerous objections raised in the decision under appeal with respect to added subject matter. The statement of grounds of appeal was furthermore accompanied by seven sets of claims forming auxiliary requests 1 to 7, which sought to overcome the various objections raised in the decision under appeal.

1.5 Since the statement of grounds of appeal addresses the reason given in the decision of the opposition division for revoking the opposed patent, it meets the requirements of Article 108 EPC.

In the board's judgement the appeal by the proprietor is admissible.

## 2. *Admissibility of the opposition of opponent 05*

2.1 According to the appellant proprietor, opponent 05 had sought to acquire ownership of the patent through court proceedings before the District Court of Helsinki. The opponent 05 was therefore to be regarded as the proprietor and was, pursuant to G 9/93 (OJ EPO 1994, 891), not entitled to oppose his own patent: the opposition by opponent 05 should be found inadmissible.



2.2 As the appellant proprietor pointed out, it was held in decision G 9/93 of the Enlarged Board of Appeal that a European patent cannot be opposed by its own proprietor (see headnote). The situation treated in G 9/93 was that of the registered patent proprietor opposing his own patent. In the present case, however, respondent opponent O5 has not definitively acquired the status of proprietor of the opposed patent in the course of the opposition and appeal procedures. Hence G 9/93 is not applicable to the present case.

The opposition by respondent opponent O5 is therefore admissible pursuant to Article 99 EPC.

### 3. *Amendments*

3.1 The opposed patent was revoked on the ground that its subject matter extended beyond that of the application as filed (Article 100(c) EPC). The decision under appeal dealt with sixteen different amendments to the claims as granted which all were found to extend the subject matter of the patent beyond the content of the application as filed. As will be seen below, it suffices to concentrate on the first objection raised in the decision under appeal, since none of the appellant proprietor's requests is successful in overcoming this objection.

3.2 Claim 1 as originally filed specifies "at least one mobile terminal" including "a mobile payment part" (paragraph A). Claim 1 as granted does not contain the term "mobile payment part"; instead it specifies a "subscriber/user identity module (SIM or equivalent 10,

21, 39, 42)" which is used by the mobile terminal (see paragraphs b and c).

3.3 The appellant proprietor argued that the opposed patent had as object to provide a system in which bank transactions are possible using a "normal mobile phone" (application as filed, page 2, lines 18 to 27). According to the invention, communication with a bank is only possible with a mobile phone (mobile terminal) which is equipped with a "mobile payment part". The skilled person reading the disclosure of the application as filed would thus immediately understand that "mobile payment part" had to reside in a modified SIM, since otherwise the "normal mobile phone" could no longer be considered as a "normal" mobile phone. (see items XX(a) to (c) above). Furthermore, a SIM was required to send short messages (SMS).

3.3.1 The board is however not convinced by the above argument. As the respondent opponents pointed out, claim 1 is not restricted to the use of a mobile terminal which has a SIM card for identifying the subscriber in the mobile network (see item XXI(a) above). In particular the use of mobile terminals connected to a local wireless network, such as DECT, is envisaged in the description and also falls within the terms of claim 1 as granted. In a DECT system, no SIM is required for identifying the terminal.

3.3.2 Figure 4, right hand figure, shows a SIM card 29 inserted in the card smart card or credit card reader 36 of the mobile terminal. As the respondent opponents remarked (see item XXI(a) above) it is not necessarily a **SIM** card which is inserted in the card reader 36,

since according to page 6, lines 15, a customer's SIM card **or** credit card can be inserted in the card reader 36. Since, at least at the filing date of the opposed patent, a credit card normally did not include a smart card, let alone a SIM, it would appear that in this case, no SIM at all is included in the mobile terminal.

- 3.3.3 Finally, the application as originally filed discloses in the paragraph bridging pages 5 and 6 several functionalities that the mobile payment part should have. In particular, the mobile payment part is able to dial the telephone number of the computing station located in the bank (page 5, lines 17 to 24). As the opponents convincingly pointed out, the ability of the SIM to dial a number on its own was not known in the art at the filing date of the opposed patent. Therefore, the mobile payment part as described in the application as filed had functionalities which are incompatible with those of a SIM. Consequently, a skilled person would not equate the mobile payment part with a SIM card.

The statement at page 7, second paragraph, in the application as filed referred to by the appellant proprietor does not overcome the above objection, since it does not resolve the question of what is meant by a "mobile payment part".

- 3.4 Since the replacement of the feature "mobile payment part" by the feature "subscriber/user identity module (SIM or equivalent)" in claim 1 as granted is not directly and unambiguously derivable from the application as filed, the subject matter of the opposed patent extends beyond the content of the application as

filed. Therefore, maintenance of the patent according to the main request is prejudiced by the ground of opposition specified in Article 100(c) EPC.

3.5 In Claim 1 of auxiliary requests 1 to 7, the feature "mobile payment part" has been replaced in the same manner as in claim 1 of the main request. Therefore, maintenance of the patent in accordance with any one of auxiliary requests 1 to 7 is prejudiced for the same reasons as for the main request.

3.6 In claim 1 of auxiliary requests 8 and 9, the passage "at least one mobile terminal using **a module called mobile payment part**" in paragraph c replaces "at least one mobile terminal using **said identity module**" in claim 1 of the previous requests. Paragraph b specifies a subscriber/user identity module, as in the previous requests, with the difference that the expression "(SIM or equivalent)" is replaced by "(SIM or the like)".

3.6.1 The board finds however that this amendment contravenes Article 123, paragraphs (2) and (3) EPC, since as discussed above in connection with the previous requests, there is no basis for replacing "mobile payment part" with "said identity module" and therefore even less basis for replacing the former term with "a module called mobile payment part"; this amendment is therefore prohibited by Article 123(2) EPC. Furthermore, since the term "a module called mobile payment part" is more general than "said identity module", the protection defined by claim 1 of auxiliary requests 8 and 9 has been extended with respect to that of claim 1 as granted (see item XXI(b) above). Such amendment is prohibited by Article 123(3) EPC.

3.6.2 For the above reasons, in the board's judgement, auxiliary requests 8 and 9 do not meet the requirements of the EPC.

3.7 In claim 1 according to auxiliary requests 10 and 11 the term "at least one mobile terminal using said identity module **and in one of its embodiments including a software program called mobile payment part**" in paragraph c replaces the term "at least one mobile terminal using said identity module" employed in claim 1 as granted.

This amendment fails to overcome the objections raised against claim 1 as granted, since the added feature is merely optional. In addition, the board is unable to find any direct and unambiguous disclosure for the term "and in one of its embodiments including a software program called mobile payment part" (see item XXI(c) above).

Therefore, in the board's judgement, auxiliary requests 10 and 11 also include amendments prohibited by Article 123(2) EPC.

4. *Request for filing further requests:*

The appellant proprietor had inquired during an adjournment of the oral proceedings whether it would be possible to file further requests after the board had closed the debate with respect to added subject matter (item IV above).

The board has not admitted any further requests, since it does not see any prospect of overcoming the objections raised under item 3 above; in the decision under appeal the main request (patent as granted) as well as thirteen auxiliary requests did not overcome the objection raised under item 3.2 above. This was the ground for revoking the patent. As discussed above, the main request (patent as granted) and the eleven auxiliary requests filed during the appeal procedure likewise failed to overcome the same objection.

5. *Request for reimbursement of the appeal fee and compensation for costs*

The patent proprietor has requested apportionment of costs and reimbursement of the appeal fee (see item XXII above).

- 5.1 A reimbursement of the appeal fee under Rule 67 EPC can only take place if the appeal is allowable, and reimbursement is equitable by reason of a substantial procedural violation. Apart from the fact that the present appeal is not allowable, the board finds that no substantial procedural violation was committed. In particular, only reason XXII(c) above relates to an alleged substantial procedural violation (right to be heard was not ensured) (cf. "Case Law of the Boards of Appeal of the European Patent Office", 4th Edition, Chapter VII.D.15.4). The appellant proprietor has however failed to indicate which arguments were disregarded or not listened to properly. Having compared the remarks made in the statement of grounds of appeal with the reasons given in the decision under appeal, the board finds that the opposition division

has taken the arguments of the appellant proprietor into consideration but was not convinced by them. Therefore, the board does not see any indication that the patent proprietor's right to be heard was violated.

The other reasons (a), (b), (d) to (f) above can at most be considered to be allegations that the opposition division committed errors of judgement. Error of judgement by a department of first instance is normally not considered a procedural violation (op cit Chapter VII.D.15.4.5).

Therefore, the request for reimbursement of the appeal fee falls to be refused.

- 5.2 As to the request for apportionment of costs, the board draws attention to the principle that each party to opposition proceedings meets its own costs (Article 104(1) EPC). In particular, the EPC does not contain any provision that would enable the EPO to compensate the patent proprietor for the costs incurred in opposition proceedings. Therefore, the reasons XXII(a), (b) and (d) are not relevant. Article 104 EPC only provides for apportionment of costs between the parties. According to the jurisprudence of the boards of appeal, apportionment of costs is only awarded if the conduct of one party is not in keeping with the care required, that is if costs arise from culpable action of an irresponsible or even malicious nature ("Case Law", Chapter VII.C.12). The board is not aware of any evidence of abuse of procedure by any of the opponents in the present case which would warrant an apportionment of costs.

Therefore, in the board's judgement, the request by the appellant proprietor for apportionment of costs also falls to be refused.

**Order**

**For these reasons it is decided that:**

1. The appeal is dismissed.
2. The requests for apportionment of costs and reimbursement of the appeal fee are refused.

Registrar

Chair

D. Meyfarth

R. G. O'Connell