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Datasheet for the decision of 28 October 2008

Case Number: T 0712/06 - 3.4.03

Application Number: 98114233.4

Publication Number: 0895204

IPC: G07F 7/10

Language of the proceedings: EN

Title of invention:
IC card issuing system and IC card issuing method

Patentee:
KABUSHIKI KAISHA TOSHIBA

Opponent:
GIESECKE & DEVRIENT GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)

Relevant legal provisions (EPC 1973):
EPC Art. 54(1)(2), 56

Keyword:
"Novelty - main request (no)"
"Added subject-matter - 1st auxiliary request (yes)"
"Inventive step - 2nd auxiliary request (no)"

Decisions cited:
-

Catchword:
-

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Case Number: T 0712/06 **-** 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 28 October 2008

Appellant: (Opponent)
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Representative:
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Decision under appeal:
Interlocutory decision of the Opposition Division of the European Patent Office posted 28 February 2006 concerning maintenance of European patent No. 0895204 in amended form.

Composition of the Board:

Chairman: R. G. O'Connell
Members: G. Eliasson
U. Tronser

Summary of Facts and Submissions

I. This is an appeal by the opponent as sole appellant against the proposed maintenance of EP 0 895 204 in amended form.

II. The following documents *inter alia* were cited in the opposition procedure:

D3: EP 0 784 290 A;
D4: US 4 825 054 A;
D8: EP 0 430 257 A.

On appeal the appellant opponent filed the following new document:

D9: JP 6 203 223 A with English translation (D9').

III. At oral proceedings before the board, the parties made the following requests:

The appellant opponent requested that the decision under appeal be set aside and the patent revoked.

The respondent proprietor requested that the appeal be dismissed (main request), or maintained on the basis of the first auxiliary request sent with the letter dated 18 January 2007, or on the basis of the second auxiliary request submitted at the oral proceedings.

IV. Independent claims 1 and 13 as maintained by the opposition division and forming the respondent proprietor's main request read as follows:

"1. An IC card issuing system comprising:
a control section (11) which includes means for creating IC card instruction data items necessary to write issue data into an IC card (28) and means for sending the IC card instruction data items collectively; and
an issuing section (21) connected to said control section (II) via a signal line and including means for holding the IC card instruction data items sent collectively from said control section and means for sequentially inputting the held IC card instruction data items to said IC card (28) while verifying the response from said IC card (28),

wherein said control means (11) includes means for creating response data said IC card (28) is to return when the IC card instruction data items are sequentially inputted to said IC card (28), and means, for sending these data items collectively to said issuing section (21), and

said issuing section (21) includes means for holding the individual data items sent collectively from said control section and means for sequentially inputting the IC card instruction data items held in the holding means to said IC card (28) while collating the response data returned from said IC card (28) with the response data held in said holding means."

"13. An IC card issuing method comprising:
a first step which includes the step of creating IC card instruction data items necessary to write issue data into an IC card (28) and the step of

sending the IC card instruction data items collectively; and

a second step which includes the step of holding the IC card instruction data items sent collectively in the first step and the step of sequentially inputting the held IC card instruction data items to said IC card (28) while verifying the response from said IC card (28), wherein

said first step includes the step of creating response data said IC card (28) is to return when the IC card instruction data items are sequentially inputted to said IC card (28), and the step of sending these data items collectively, and

said second step includes the step of holding the data items sent collectively in said first step and the step of sequentially inputting the IC card instruction data items held in said holding step to said IC card (28) while collating the response data returned from said IC card (28) with the response data held in said holding step."

V. Claim 1 of the first auxiliary request differs from that of the main request in that the following passage is added at the end:

"said control section (11) includes means for creating magnetic encode data and print data for said IC card (28), and means for sending these

data items collectively to said issuing section (21), and

said issuing section (21) includes means for recording said magnetic encode data held in said holding means into said IC card (28), and means for printing on said IC card (28) on the basis of said print data held in said holding means, and

said issuing section (21) includes judging means for judging whether or not the medium (32) the operator has at the start-up of the IC card issuing apparatus is valid, and control means for permitting said issuing process when the judging means has judged that the medium is valid."

Independent claim 11 of the first auxiliary request differs from that of the main request in that the following passage is added at the end:

"said first step includes the step of creating magnetic encode data and print data for said IC card (28), and the step of sending these data items collectively, and

said second step includes the step of recording said magnetic encode data held in said holding step into said IC card, and the step of printing on said IC card (28) on the basis of said print data held in said holding step,

further including the step of judging whether or not the medium (32) the operator has at the start-up of the IC card issuing apparatus is valid, and

permitting said issuing process when it has been judged that the medium is valid."

VI. Claim 1 of the second auxiliary request reads as follows (board's marking indicating amendments with respect to the first auxiliary request):

"1. An IC card issuing system comprising:
a control section (11) which includes means for creating IC card instruction data items necessary to write issue data into an IC card (28) and means for sending the IC card instruction data items collectively; and

an issuing section (21) connected to said control section (11) via a signal line and including means for holding the IC card instruction data items sent collectively from said control section and means for sequentially inputting the held IC card instruction data items to said IC card (28) while verifying the response from said IC card (28), wherein

said control means (11) includes means for creating response data said IC card (28) is to return when the IC card instruction data items are sequentially inputted to said IC card (28), and means for sending these data items collectively to said issuing section (21), and

said issuing section (21) includes means for holding the individual data items sent collectively from said control section and means for sequentially inputting the IC card instruction

data items held in the holding means to said IC card (28) while collating the response data returned from said IC card (28) with the response data held in said holding means,

said control section (11) includes means for creating magnetic encode data and print data for said IC card (28), and means for sending these data items collectively to said issuing section (21), and

said issuing section (21) includes means for recording said magnetic encode data held in said holding means into said IC card (28), and means for printing on said IC card (28) on the basis of said print data held in said holding means,

said means for creating IC card instruction data items in said control section (11) selectively creates and collectively sends externally specified ones of the IC card instruction data necessary to write issue data into an IC card (28), magnetic encode data for said IC card (28), and print data for said IC card (28); and

said issuing section (21) includes means for inputting the IC card instruction data sent from the control section into said IC card (28), means for recording the magnetic encode data sent from said control section (11) into said IC card (28), and means for printing on said IC card (28) on the basis of the print data sent from said control section (11) and

said issuing section (21) includes judging means for judging whether or not the medium (32) the operator has at the start-up of the IC card issuing apparatus is valid, and control means for permitting said issuing process when the judging means has judged that the medium is valid."

VII. The appellant opponent presented essentially the following arguments in support of their requests:

(a) Document D9 filed with the statement of the grounds of appeal was to be considered highly relevant, as it could affect the outcome of the proceedings (see T 1002/92). Furthermore, it was cited against the corresponding Japanese application so that it was known to the proprietor.

(b) Document D9 disclosed all features of claim 1 of the main request. In particular the feature "control means including means for creating response data" in claim 1 should be construed as covering the case that the control section would read the response data from a database (see patent, paragraph 0052). This was also disclosed in document D9 (paragraph 0006).

(c) The feature "an issuing section ... connected via *a signal line*" in claim 1 of all requests was not directly and unambiguously derivable from the application as filed as the latter only disclosed "signal line**s**". Furthermore, in claim 1 of both auxiliary requests, the feature "means for sending these data items collectively to that issuing section" encompassed alternatives not originally

disclosed: In the claimed system, magnetic encode data and IC card instruction data items could be sent separately, whereas in the application as filed, all data items were sent together (step 133 in Figure 12B). Hence the above amendments contravened Article 123(2) EPC.

VIII. The respondent proprietor presented essentially the following arguments:

(a) Late-filed document D9 did not disclose an IC card issuing system comprising a control means for creating response data an IC card had to return when IC instruction data items were sequentially input to the IC card. Furthermore, in contrast to the claimed system, the response of the IC card to the IC card instruction data items was processed internally in the IC card (D9, paragraph 0007). Hence document D9 could not be considered more relevant than the documents considered in the decision under appeal, and should therefore not be introduced into the appeal procedure.

Furthermore, document D9 was cited against the corresponding Japanese application. As it could be expected that a competitor would carry out file inspections on the parallel national applications before filing a notice of opposition, it must be assumed that the opponent already had knowledge of document D9 when the notice of opposition was drafted. Hence, there were no reasons for the opponent to file document D9 at a late stage of the proceedings.

(b) The feature "a signal line" was disclosed in Figure 1 of the application as filed. Furthermore, although the corresponding passage in the description mentioned "signal lines", the skilled person would interpret this to mean "one or several signal lines", as it was immaterial to the function of the claimed system whether one or more signal lines were used.

Reasons for the Decision

1. The appeal is admissible.

2. *Document D9*

2.1 Document D9 was filed by the appellant opponent with the statement of grounds of appeal and was therefore filed outside the opposition period. The respondent proprietor argued that document D9 was not *prima-facie* highly relevant, and therefore, it should not be introduced into the appeal procedure.

2.2 The board finds that document D9 to be so relevant that it is likely to change the outcome of the decision, independently of the question whether or not document D9 would take away novelty from claim 1 of the main request. As document D9 was filed with the statement of the grounds of appeal, the respondent proprietor had in the board's judgement sufficient time to react (Article 114(2) EPC).

2.3 Document D9 is therefore admitted into the appeal procedure.

3. *Main request - Novelty*

3.1 Document D9 discloses an IC card issuing system comprising a control section ("host computer" 11) and an issue section (51 to 54) connected via a signal line to the control section (see D9', Figure 1 with accompanying text). The control section ("host computer") retrieves IC card instruction data items necessary to write issue data into an IC card and response data which the IC card is to return when the IC card instruction data items are sequentially input to the IC card. The IC card instruction data items and the response data are sent together, ie collectively, to the issue section (paragraphs 0005 and 0006). The issue section has memory means 52 for holding the individual data items sent collectively from the control section and means for sequentially inputting the IC card instruction data items held in the memory means 52. In response to having received and stored IC card instruction data items, the IC card returns response data to the issue section where the response data returned from the IC card are compared with the response data received from the control section and stored in the memory means (page 225, lines 1 to 4 and 12 to 15).

3.2 The respondent proprietor argued that document D9 did not disclose a control section with **means for creating** response data an IC card had to return when IC instruction data items were sequentially input to the IC card (item VIII(a) above). As the appellant opponent pointed out, however, the embodiments of the patent only disclose that the response data are read from the

write database file 16 (patent specification, Figure 1; step 105 in Figure 2; step 127 in Figure 12A; step 155 in Figure 16; paragraphs 0052, 0054, 0090). Hence in the light of the disclosed embodiments, the term "means for creating" in claim 1 has to be construed to cover "means for retrieving" or "means for reading from a database file".

In the system of document D9, the control section 11 sends response data together with the corresponding IC card instruction data items to the issuing section 51 (paragraph 0006). Thus, although document D9 does not disclose where the response data were generated, the control section nevertheless must have means for retrieving the response data, ie means which falls within the term "means for creating response data".

3.3 The respondent proprietor referring to paragraph 0007 of document D9 further argued that the response data from the IC card were compared internally in the IC card and not in the issue section (see item VIII(a) above). The board finds however that when reading paragraph 0007 in the context of the rest of the description, the reader is taught that a "response is output from the IC card in relation to this command" and at the issue section ("CPU 51") "this output information is compared with the response information defined in the write file" (paragraph 0006; see also paragraphs 0010 and 0019). Paragraph 0007 cited by the proprietor is concerned with an alternative embodiment for improving security by concealing the response data.

3.4 For the above reasons, in the board's judgement, the subject matter of claim 1 of the main request is not

new within the meaning of Article 54(1) and (2) EPC 1973.

4. *First Auxiliary Request - Added subject matter*

4.1 Claim 1 of the first auxiliary request specifies that the "control section (11) includes means for creating magnetic encode data and print data for said IC card (28), and means for sending these data items collectively to said issuing section (21)". In addition, claim 1 also specifies means for sending the IC card instruction data items and the response data collectively to the issuing section. The wording of claim 1 also includes the alternatives of sending the IC card instruction data items, response data, magnetic encode data and print data collectively in one batch, as well as the possibility of sending the magnetic encode data and the print data collectively to the issuing section but in a separate batch from that of the IC card instruction data item and the response data. This latter alternative, however, is not disclosed in the application as filed: The embodiments depicted in Figures 6 and 12B both specify that all the data items are sent to the issuing machine "at a time" (Figures 2 and 12B, steps 108 and 133, respectively). Although claim 1 of the first auxiliary request at a first glace seems to correspond to a combination of claims 1 to 3 as filed, with the deletion of a seemingly superfluous repetition in claim 2 that the control section in addition to including means for creating magnetic encode data and print data also included means for creating the IC card instruction data, this repetition of the latter feature in claim 2 as filed, however, had the effect of specifying that "these data items" in

"means for sending these data items" refers to the IC card instruction data, the magnetic encode data and print data.

4.2 For the above reasons, in the board's judgement, claim 1 of the first auxiliary request contains subject matter extending beyond that of the application as originally filed, and therefore contravenes 123(2) EPC.

5. *Second Auxiliary Request - Inventive step*

5.1 The system of claim 1 of the first auxiliary request differs from that of document D9 in that

(a) said control section (11) includes means for creating magnetic encode data and print data for said IC card (28), and means for sending these data items collectively to said issuing section (21),

said issuing section (21) includes means for recording said magnetic encode data held in said holding means into said IC card (28), and means for printing on said IC card (28) on the basis of said print data held in said holding means,

said means for creating IC card instruction data items in said control section (11) selectively creates and collectively sends externally specified ones of the IC card instruction data necessary to write issue data into an IC card (28), magnetic encode data for said IC card (28), and print data for said IC card (28); and

said issuing section (21) includes means for inputting the IC card instruction data sent from the control section into said IC card (28), means for recording the magnetic encode data sent from said control section (11) into said IC card (28), and means for printing on said IC card (28) on the basis of the print data sent from said control section (11) and

(b) said issuing section (21) includes judging means for judging whether or not the medium (32) the operator has at the start-up of the IC card issuing apparatus is valid, and control means for permitting said issuing process when the judging means has judged that the medium is valid.

5.2 The features belonging to group (a) have the technical effect of improving the flexibility of the IC card issuing system, as they allow the user freely to choose how the IC cards should be prepared. The features belonging to group (b), on the other hand, prevent unauthorized issuing of IC cards, thereby improving the security of the system.

The board cannot find any technical interaction between the two groups (a) and (b) of features, nor was the respondent proprietor able to indicate any such technical interaction or synergy effect arising from the combination of these two groups of features. Therefore, the two feature groups (a) and (b) can be treated separately in the assessment of inventive step.

The technical problems relative to document D9 are (A) to integrate the complete IC card issuing system while

increasing the flexibility; and (B) to improve the security against unauthorised use of the IC card issuing system.

5.3 Regarding problem (A), the system of document D9 relies on the fact that the IC cards have already been printed and encoded with magnetic encode data before they enter the stage of inputting IC card instruction data (paragraph 0012). Thus the steps of printing and magnetically encoding the IC cards are carried out by different machines independent of that performing the step of inputting the IC card instruction data items, and consequently, the machines for printing and magnetically encoding the IC cards are not controlled by the control section 11. A certain flexibility with respect to selecting whether all of printing, magnetically encoding and inputting IC card instruction data is thus available in the system of document D9 by simply bypassing one or more steps in the process of issuing IC cards.

5.4 A skilled person faced with the task of integrating the three steps of printing, magnetically encoding and inputting IC card instruction data into one system would be aware that such systems are part of the common general knowledge in the art, as exemplified by documents D3 and D4 (see D3, Figure 5 with accompanying text; D4, Figure 1 with accompanying text). The skilled person modifying the issuing section of the system of document D9 to include means for printing on the IC card and means for magnetically encoding the IC card, would furthermore consider it an obvious alternative to send all the required data for each IC card

collectively from the control section to the issuing section.

The skilled person having integrated printing, magnetic encoding and writing of IC card instruction data into the system of document D9 would as a matter of course seek to carry out this integration without sacrificing the flexibility which was present when these stages were carried out by different machines. It would therefore be obvious to introduce input means for the operator to specify which data items should be put on the cards. Hence the skilled person would arrive at a modified system having all the features (a) without exercising inventive skills.

5.5 As to problem (B), improving security against unauthorised use, Document D8 discloses an IC card issuing system where the operator has to insert a key card 8 and input a keyword from a keyboard 4 (Figures 1 and 3A; column 4, lines 23 to 31). The IC card issuing process will only start after the keyword has been verified by the system.

A skilled person faced with the problem of increasing security against unauthorised use of the system of document D9 would in the board's judgement consider the solution disclosed in document D8 for this purpose.

5.6 For the above reasons, in the board's judgement, the subject matter of claim 1 of the second auxiliary request does not involve an inventive step within the meaning of Article 56 EPC 1973.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

Registrar | Chair

S. Sánchez Chiquero | R. G. O'Connell