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Datasheet for the decision
of 2 February 2012

Case Number: T 0621/08 - 3.4.03

Application Number: 98907003.2

Publication Number: 963580

IPC: G07F 7/10

Language of the proceedings: EN

Title of invention:
Multi-application IC card system

Patent Proprietor:
MONDEX INTERNATIONAL LIMITED

Opponent:
GIESECKE & DEVRIENT GmbH

Headword:
-

Relevant legal provisions (EPC 1973):
EPC Art. 54

Keyword:
"Novelty (yes)"

Decisions cited:
-

Catchword:
-

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                       It can be changed at any time and without notice.
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Case Number: T 0621/08 - 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 2 February 2012

Appellant: (Patent Proprietor)	MONDEX INTERNATIONAL LIMITED 47-53 Cannon Street London EC4M 5SQ (GB)
Representative:	Robson, Aidan John Reddie & Grose 16 Theobalds Road London WC1X 8PL (GB)
Respondent: (Opponent)	GIESECKE & DEVRIENT GmbH Prinzregentenstrasse 159 D-81677 München (DE)
Decision under appeal:	Decision of the Opposition Division of the European Patent Office posted 29 January 2008 revoking European patent No. 963580 pursuant to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: G. Eliasson
Members: V. L. P. Frank
                 P. Mühlens

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Summary of Facts and Submissions

I.   This is an appeal by the patent proprietor against the
        decision of the opposition division to revoke the
        patent EP 0 963 580 (Article 101(2) EPC).

        The patent was opposed in its totality. Grounds of
        opposition were lack of novelty and inventive step
        (Articles 100(a), 54 and 56 EPC 1973).

II.   At oral proceedings before the board, the appellant
        proprietor requested that the decision under appeal be
        set aside and that the patent be maintained in amended
        form on the basis of the main request or on the basis
        of the first auxiliary request, both filed at the oral
        proceedings, or on the basis of the second or third
        auxiliary requests, both filed with letter of
        30 December 2011.

        The respondent opponent requested that the appeal be
        dismissed.

III.   Independent claim 1 of the main request reads as
        follows:

        "1. An IC card system comprising at least one IC card
             for storing multiple applications, an application
             to be loaded onto said card and means for
             determining whether said card is qualified to
             accept the loading of said application onto said
             card, wherein said IC card contains card
             personalization data, and said application is
             assigned application permissions data representing
             at least one set of IC cards upon which said

application may be loaded and wherein said
determining means compares said card
personalization data with said application
permissions data and wherein said application is
loaded onto said IC card in dependence on the
result of said comparison,
wherein card personalization data is data loaded
onto said card at a card personalization bureau
which configures the card for a card issuer to a
specific user or class of users, and said
determining means is provided on said card."

In claim 1 of the first auxiliary request the last
paragraph was amended as follows (the differences with
respect to claim 1 of the main request were highlighted
by the board):

"   wherein card personalization data is data loaded
       onto said card at a card personalization bureau
       which configures the card for a card issuer to a
       specific user or class of users **by using data
       representative of a card issuer and data
       representative of a product class**, ~~and~~ said
       determining means is provided on said card, **and
       said permissions data set includes one or more
       card issuers and one or more product classes**."

Each request contains further independent claims
directed to a process for loading an application on an
IC card, a process for deleting an application from an
IC card and an IC card system.

The claims of the 2nd and 3rd auxiliary requests are of
no relevance for this decision.

IV.   The following document is cited in this decision:

       D9 = Handbuch der Chipkarten, W. Rankl/W. Effing, 2nd
            ed. 1996, pp. 125, 126, 134-138, 197, 205—207,
            241-244, 322, 323, 332-337, 367

V.   In the decision under appeal, the opposition division
       found that:

       —   Document D9 disclosed an IC card system comprising a
            multi-application IC card and an application to be
            loaded onto said card. The IC card's determining
            means determined whether the card was qualified to
            accept the loading of the application or not on the
            basis of a comparison between the card
            personalization data and the application permissions
            data. The card personalization data corresponded to
            the application identifier (AID) and the
            "Nachladeschlüssel" of document D9 while the
            application permissions data were identical to the
            AID of the application to be loaded. The group of IC
            cards upon which said application could be loaded
            was the set of IC cards which had a preregistered
            AID and key corresponding to the application.

VI.   The appellant proprietor argued essentially as follows:

       —   According to Rule 22(1) EPC, the transfer of a
            European patent application was registered on
            production of documents satisfying the European
            Patent Office that such a transfer had taken place.
            As far as the European Patent Office was concerned,
            the requirements to record the transfer had not been

met at the date on which the appeal was filed.
Accordingly, the appeal was correctly filed in the
name of Mondex International Limited.

– The problem addressed by the present invention was
to provide IC cards in a system in which a card
issuer defined personalization data for a card,
which personalization data could then be matched
against data included in the application permissions
data assigned to an application to determine whether
or not an application might be loaded onto a card.
Thus, the data being compared did not relate to the
application as such but to whether or not the card
was of a type defined by the card issuer upon which
the particular application was to be loaded.
Document D9 described how a user could load a
further application onto his or her smartcard by an
application provider. It was clearly stated that the
application provider had to obtain a secret reload
code from the card issuer in order to do this. He
was therefore unable to load the application without
obtaining data from the end issuer. The Opposition
Division equated the application identifier (AID) of
document D9 with application permissions data in the
present application. An application identifier was a
standardized code associated with an application. It
was not used to identify a particular card or set of
cards, only to identify an application. Thus, use of
this to determine whether or not an application
might be loaded onto a particular card or set of
cards was not possible unless those cards were
already configured with matching data for the
particular application. The arrangement of the
present invention enabled any application to be

loaded onto a particular card or set of cards as defined by the end issuer via the personalization data.

–   In addition to the subject matter of the main request, claim 1 of the first auxiliary request included a more specific definition of the permissions data and of the personalization data. Therefore, it more specifically drew out the matching process between the permissions data and personalization data, and the nature of that data. Such an arrangement presented a significant improvement over the system of D9 and gave a card issuer much greater control over which applications could be loaded to which categories of users.

VII.   The respondent opponent argued essentially as follows:

–   The appeal seemed to be inadmissible. Although the appeal was lodged in the name of Mondex International Limited and, auxiliarily, in the name of StepNexus Holdings, the proprietor had requested previously an assignment of rights to Bamboo Holdings of Ugland House and a subsequent change of name to StepNexus Holdings. It was thus questionable who the real proprietor of the patent was and who was entitled to lodge the appeal.

–   The two features added to claim 1 of the main request were also disclosed in document D9, as this document disclosed that the card personalization data was loaded at a card personalization bureau and that the determination means was provided on the card. For these reasons, the finding of the

opposition division that the system of claim 1 was
not novel over the disclosure of document D9 still
applied.

– The features of claim 1 of the 1st auxiliary request
were also disclosed in D9, since the application
identifier (AID) was formed by the registered
identifier (RID) and the proprietary application
identifier extension (PIX). The RID however included
a code for the application service provider which
usually was the card issuer. On the other hand, the
PIX included the application's serial and version
numbers which identified the product class.

Reasons for the Decision

1.   *Admissibility of the appeal.*

1.1   The respondent opponent objected on the admissibility
        of the appeal. The appeal was lodged on 28 March 2008
        in the name of Mondex International Limited and,
        auxiliarily, in the name of StepNexus Holdings.
        Previously, however, the proprietor's representative
        had requested with the letter of 18 February 2008 an
        assignment of rights to Bamboo Holdings of Ugland House
        and a subsequent change of name to StepNexus Holdings.
        Thus it was questionable who the real proprietor of the
        patent was and who was entitled to lodge the appeal.

1.2   The transfer of a European patent application is
        governed by Rule 22 EPC. According to Rule 22(3) EPC
        the transfer shall have effect vis-à-vis the EPO only

at the date when and to the extent that documents
providing evidence of such transfer have been produced.

1.3   With the communication of 5 March 2008 the EPO refused
       to register the requested transfer in the European
       Patent Register, since the assignment document had not
       been signed by Mondex International Limited.
       As the indicated deficiency in the request for transfer
       was never corrected, no transfer was registered and the
       original applicant, Mondex International Limited,
       remained the present assignee.

1.4   The board finds that the requirements of Article 107
       EPC are fulfilled, as the appeal was lodged in the name
       of Mondex International Limited, who was the registered
       patent proprietor at the time of filing the notice of
       appeal, has since then not ceased of being a party to
       the proceedings and was undoubtedly a party adversely
       affected by the decision of the department of first
       instance revoking the patent.

       The appeal of the patent proprietor is thus admissible.

2.   *Main request – Novelty (Article 54 EPC 1973)*

2.1   It is common ground that document D9 discloses a multi-
       application IC card having means for determining
       whether the card is qualified to accept the loading of
       an application onto the card. It is also undisputed
       that the determination means are provided on the IC
       card, that the card contains card personalization data
       and that these data are loaded at a card
       personalization bureau (page 241, point 7.8, 2nd and 5th
       paragraph; page 242 and 243, REGISTER and CREATE FILE

commands; Figure 7.48; page 333, point CK3-
Initialisation; page 334, point CK4-Personalization).

According to D9 the REGISTER command is used by the
card issuer during card creation to allocate memory
space on the IC card to an application. The memory
allocation is required for preventing that one
application uses more memory than the one allocated to
it, overwriting other applications on the IC card. At
the same time a card and application specific key is
stored on the card. If at a later time the application
is to be loaded onto the card, the determining means on
the card compares this key with the application
identifier (AID) to decide whether the card is
qualified to load the application.

Document D9 differentiates between the initialization
and personalization steps during the creation of an IC
card. During the initialization step the data common to
all cards are written onto the card, while during the
personalization step the individual, user related data
are written on it. According to D9, the reason for this
two step approach is cost reduction, since
personalization devices have a throughput of about
700 cards/hour, while initialization devices one of
about 3500 cards/hour (page 333, last paragraph).

2.2   The appellant proprietor argued that the system of
        claim 1 of the main request differed from the system
        disclosed in D9 in two points.

        Firstly, the card and application specific key
        generated by the REGISTER command of D9 was common to
        all cards foreseen for running a specific application.

It was thus not part of the card personalization data, but of the initialization data, since it was common to all cards from a set of cards.

Secondly, the application identifier (AID) of D9 could not be equated to the application permissions data of claim 1, since the former was a standardised code associated with the application and was not used to identify a particular card or set of cards onto which the application should be loaded. It only identified an application. The AID could not be used to determine whether or not an application could be loaded onto a particular set of cards unless those cards were already configured with matching data for the particular application. On the contrary, the present invention enabled any application to be loaded onto a particular card or set of cards as defined by the end issuer via the personalization data.

2.3   With respect to the first point raised by the appellant proprietor, the board considers that whether the data that are used for determining that the card is qualified to load a given application are written at a particular processing step, ie either during the initialization or the personalization step, is a distinction that does not make a difference when assessing the features of a product, an IC card system in the case of claim 1.

As to the second point, namely that the application identifier cannot be equated to the application permissions data according to the patent, the board considers that the name given to the data associated with the application is irrelevant. What matters is

that according to claim 1 the determining means decide whether the IC card is qualified to load a given application on the basis of a comparison between data stored on the IC card and data associated with the application. Such a comparison is made in document D9.

2.4   The board judges, for these reasons, that the system of claim 1 of the main request is not new over the system disclosed in document D9.

3.   *1st auxiliary request*

3.1   Claim 1 of the 1st auxiliary request adds the following features to claim 1 of the main request:

    (a)   the personalization bureau configures the card by using data representative of a card issuer and data representative of a product class, and that

    (b)   the permissions data set includes one or more card issuers and one or more product classes.

3.2   Amendments

3.2.1   The respondent opponent objected that the wording used in claim 1, namely that the card personalization bureau configured the card for a card issuer to a specific user or class of users *by using* data representative of a card issuer and data representative of a product class, would contravene the requirements of Article 123(2) EPC, since such wording could include undisclosed subject-matter. However, no concrete example was given.

3.2.2 The board agrees with the appellant proprietor that the
       patent discloses that the personalization bureau *uses*
       the mentioned data in the configuring step of the card
       personalization data ([0029], [0034] - [0036], "issuer
       ID" and "product ID"). The board therefore considers
       the amendments permissible.

3.3   Novelty (Article 54 EPC 1973)

3.3.1 Feature (a):

       According to document D9, the IC-card stores a set of
       data called "Historical Characters" which are sent to
       the terminal as part of the Answer to Reset (ATR) in
       response to the terminal's initial reset command. The
       historical characters may contain a multitude of data
       related to the IC-card and the operating system. The
       card issuer, the card's and the chip's serial number,
       the version of the ROM mask of the chip and the version
       of the operating system are examples of these data
       (page 197, in particular the 4th paragraph).

       It follows that data representing the card issuer and
       the card's type, which is encoded in the card's serial
       number, are written on the card by the personalization
       bureau.

       The board considers therefore that feature (a)
       mentioned above is disclosed in document D9.

3.3.2 Feature (b):

3.3.2.1 The respondent opponent argued that the application
       identifier (AID) disclosed in document D9 was

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equivalent to the application permissions data
specified in claim 1.

According to D9, the AID was formed by the registered
identifier (RID) and the proprietary application
identifier extension (PIX). The RID was constituted by
a country code, the application's category and a code
for the application service provider, while the PIX
comprised for example the application's serial and
version numbers (pages 137 and 138; Figure 5.15). As
the application service provider was usually the card
issuer, the RID portion of the AID contained the card
issuer (see eg D9, page 332, "Datenübergabe", were it
was stated that "The card issuer or the application
service provider, respectively, have to provide all the
application's data to the card personalization service",
"Der Kartenherausgeber bzw. Anwendungsanbieter muß dem
Kartenpersonalisierer alle seine Anwendung betreffenden
Daten mitteilen."). On the other hand, the
application's version number contained in the PIX
portion of the AID defined a product class.

The AID of document D9 thus included the card issuer
and the product class, ie feature (b).

3.3.2.2 The board considers however that according to D9 card
issuer and application service provider is not
necessarily the same entity. The statement in D9
referred to by the respondent opponent about card
issuer and application service provider (page 332,
"Datenübergabe") means that whoever is responsible for
the application shall provide all the relevant data to
the card personalization service, but not that card
issuer and application service provider are identical.

3.3.2.3 Also the respondent's opponent argument that the application's serial or version number contained in the PIX should be considered as defining a product class is unconvincing. Claim 1 specifies that the card personalization bureau uses data representative of the product class for configuring the card personalization data. It makes however little sense that the personalization data includes an application's serial or version number, as would be the case if the product class is equated to the application's serial or version number. The board therefore considers that the serial or version number contained in the PIX portion of the AID cannot be considered to define a product class.

3.4   The board judges, for these reasons, that the system of claim 1 of the 1st auxiliary request is new over the disclosure of document D9, as D9 does not disclose that the permissions data set includes a card issuer or a product class.

4.   The decision of the opposition division was based on the finding of lack of novelty over document D9. As the issue of inventive step has not yet been argued by the parties, the board considers it appropriate to remit the case to the department of first instance for further prosecution (Article 111(2) EPC). This was also the desire expressed by both parties.

Order

For these reasons it is decided that:

1.   The decision under appeal is set aside.

2.   The case is remitted to the department of first
       instance for further prosecution.

Registrar   Chair

S. Sánchez Chiquero   G. Eliasson