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**Datasheet for the decision
of 15 December 2010**

Case Number: T 1822/08 - 3.4.01

Application Number: 03075844.5

Publication Number: 1333408

IPC: G07F 7/10

Language of the proceedings: EN

Title of invention:

System and apparatus for smart card personalization

Patentee:

NBS Technologies (US) Inc.

Opponent:

Giesecke & Devrient GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

RPBA Art. 13(3)

Relevant legal provisions (EPC 1973):

EPC Art. 100(c)

Keyword:

"Late-filed requests (admitted: main request and first auxiliary request) (not admitted: second and third auxiliary request)"

"Added subject-matter (yes: main request and first auxiliary request)"

Decisions cited:

-

Catchword:

-



Case Number: T 1822/08 - 3.4.01

D E C I S I O N
of the Technical Board of Appeal 3.4.01
of 15 December 2010

Appellant: NBS Technologies (US) Inc.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 23 July 2008
revoking European patent No. 1333408 pursuant
to Article 101(1) EPC.

Composition of the Board:

Chairman: B. Schachenmann
Members: H. Wolfrum
G. Assi

Summary of Facts and Submissions

- I. Present European patent No. 1 333 408 arises from application EP 03 075 844.5 which is a divisional application from the earlier application EP 97 921 189.3.

The appellant (patent proprietor, NBS Technologies Inc.) lodged an appeal against the decision of the opposition division, dispatched on 23 July 2008, revoking the patent for the reasons of added subject-matter (Articles 100(c) and 76(1) EPC 1973) and lack of novelty (Article 100(a) EPC 1973 in combination with Articles 54(1) and (2) EPC 1973) for claims 1 and 15 of the patent as granted.

The notice of appeal was received on 19 September 2008 and the prescribed fee was paid on the same day. On 2 December 2008 a statement of grounds of appeal was filed. By way of a main request, maintenance of the patent as granted was requested. Alternatively, it was requested to maintain the patent in amended form on the basis of a first and a second auxiliary request.

- II. The respondent (opponent) filed observations by letter dated 14 April 2009, reiterating among others objections under the ground of Article 100(c) EPC for the appellant's requests on file. In view of the amendments made to the appellant's auxiliary requests, reference was made to new documents, introduced as documents D8 to D13.
- III. In a communication of 18 August 2010 annexed to summons for oral proceedings, which were arranged upon

corresponding requests from both parties, the Board drew the parties' attention *inter alia* to specific points of discussion in the context of dealing with the objection of added subject-matter.

- IV. By facsimile received on 15 November 2010 the appellant replaced its former requests by four new requests filed as main request and first to third auxiliary requests.

By facsimile of 10 December 2010 the respondent filed further observations, in which reference to new documents D14 to D16 was made.

- V. Oral proceedings were held on 15 December 2010. The points of discussion were the admissibility of the appellant's requests and the question of added subject-matter (Articles 100(c) EPC and 123(2) EPC).

- VI. The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of a set of claims 1 to 27, according to a main request, or, alternatively, on the basis of a set of claims 1 to 27 according to a first auxiliary request, a set of claims 1 to 25, according to a second auxiliary request, or a set of claims 1 to 26, according to a third auxiliary request, all filed with the facsimile of 15 November 2010.

- VII. The respondent requested that the appeal be dismissed.

VIII. Independent claims 1 and 15 of the appellant's **main request** read as follows:

"1. A method of issuing portable programmed data carriers (160) using a personalization system (100) operable as an interface between a card issuer management system (150) and a personalization equipment (130) and performing the steps of:

- acquiring (815, 805) personalization data relating to a user of the data carrier by the personalization system (100) from the card issuer management system (150),

- transferring the personalization data relating to the user of the data carrier to the personalization equipment (130) in a manner specified by equipment characteristic data identified by a personalization equipment identifier for personalising and issuing of the data carrier at the personalization equipment (130),

characterised by comprising the steps of:

acquiring the personalization equipment identifier from the card issuer management system;

acquiring security data from an external security source (128, 940); and

transferring the security data to the personalization equipment as specified by the equipment characteristic data."

"15. A personalization system (100) for use in issuing portable programmed data carriers (160) and having means (101, 107) for connection as an interface between a card issuer manager system (150) and a personalization equipment (130) and comprising:

- a card issuer management system interface (101) for acquiring personalization data relating to a user of the data carrier by the personalization system (100) from the card issuer management system (150),
- a personalization equipment interface (107) for transferring the personalization data relating to the user of the data carrier to the personalization equipment (130) in a manner specified by equipment characteristic data identified by a personalization equipment identifier for personalising and issuing of the data carrier at the personalization equipment (130),

characterised by comprising:

means for acquiring the personalization equipment identifier from the card issuer management system;

a secure key management module (111) for acquiring security data from an external security source (128, 940) ; and

means for transferring the security data to the personalization equipment as specified by the equipment characteristic data."

Further independent claims 26 and 27 are directed to a "computer program comprising instructions for controlling a personalization system to carry out all of the steps of a method as claimed in any one of claims 1 to 14" and a "storage medium storing a computer program as claimed in claim 26", respectively.

Claims 2 to 14 and 16 to 25 are dependent claims.

Claim 1 of the **first auxiliary request** is further amended and reads:

"1. A method of issuing portable programmed data carriers (160) using a personalization system (100) operable as an interface between a card issuer management system (150) and a personalization equipment (130) and performing the steps of:

- acquiring (815, 805) personalization data relating to a user of the data carrier by the personalization system (100) from the card issuer management system (150),

- transferring the personalization data relating to the user of the data carrier to the personalization equipment (130) in a manner specified by equipment characteristic data for personalising and issuing of the data carrier at the personalization equipment (130),

characterised by comprising the steps of:

acquiring a personalization equipment identifier from the card issuer management system;

acquiring equipment characteristic data for a personalization equipment type from a record in a database identified by the personalization equipment identifier;

acquiring security data from an external security source (128, 940) ; and

transferring the security data to the personalization equipment as specified by the equipment characteristic data."

Independent claim 15 directed to a "*personalization system*" is correspondingly amended, whereas the wording of the further claims is the same as for the main request.

Independent claims 1 and 14 of the **second auxiliary request** are based on claims 1 and 15, respectively, of the first auxiliary request and further complemented by the feature "*wherein the personalization system checks (claim 1) / is operable to check (claim 14) for security requirements required by the card issuing process specified by a template record acquired from a database identified by a data format identifier supplied by the card issuer management system, and acquires (claim 1) / to acquire (claim 14) required secure data or functions from the external security source*".

Further independent claims 24 and 25 are directed to a "*computer program comprising instructions for controlling a personalization system to carry out all of the steps of a method as claimed in any one of claims 1 to 13*" and a "*storage medium storing a computer program as claimed in claim 24*", respectively.

Independent claims 1 and 14 of the **third auxiliary request** are based on claims 1 and 15, respectively, of the first auxiliary request and further complemented by the feature "*wherein the personalization system passes (claim 1) / is operable to passes [sic!] (claim 14) identifiers of card operating system and personalization equipment to the external security source to identify required security data or functions*".

The wording of the further claims is the same as for the second auxiliary request.

Reasons for the Decision

1. In the light of the entry into force of the EPC 2000, reference is made to Article 7(1), 2nd sentence of the Revision Act of 29 November 2000 ("Act revising the Convention on the Grant of European Patents (European Patent Convention) of 5 October 1973, last revised on 17 December 1991") and the transitional provisions for the amended and new provisions of the EPC (Decision of the Administrative Council of 28 June 2001), from which it may be derived which Articles of the EPC 1973 are still applicable and which Articles of the EPC 2000 shall apply.
2. The appeal complies with the requirements of Articles 106 to 108 EPC and Rule 99 EPC and is, therefore, admissible.
3. Admissibility of the appellant's requests (Article 13(3) RPBA)
 - 3.1 Article 13(3) of the Rules of Procedure of the Boards of Appeal (RPBA) stipulates that amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without the adjournment of the oral proceedings.

3.2 In the present case, the appellant replaced by the facsimile of 15 November 2010, *ie* one month before the oral proceedings, all of its former requests by four new requests.

The amendments to the new main request and the first auxiliary request endeavour to address the objections under the ground of opposition of Article 100(c) EPC which were already at the basis of the revocation of the patent by the opposition division. Thus these requests could well have been filed with the grounds of appeal and should have been filed, at the latest, in response to the respondent's comments on the grounds of appeal. Nevertheless, the Board acknowledges that the second auxiliary request which was filed with the grounds of appeal already comprised amendments that addressed the objection of added subject-matter. Moreover, given the circumstances of the present case, the respondent and the Board were to be expected to be prepared for a debate of the question of added subject-matter in the oral proceedings. For these reasons, the Board decided to admit the main request and the first auxiliary request into the proceedings.

By contrast, the second and the third auxiliary request are further amended by incorporation into the independent claims features of former dependent claims 13 and 14, respectively. These features had never played a role in opposition and appeal until the oral proceedings before the Board. In addition, no explanation was given by the appellant as to the purpose of the added features and their possible relevance for the patentability of the claimed subject-matter. Moreover, the amendments provoked the

respondent to provide a new submission by facsimile of 10 December 2010 only a few days before the date of the oral proceedings. Due to an interjacent weekend it was logistically impossible for the Board to provide the appellant in time with copies of prior art documents D14 to D16 which were freshly cited by the respondent. Under these circumstances, a proper preparation of the Board as well as a reasonable discussion of the second and third auxiliary requests in the oral proceedings which would have safeguarded the parties' right to be heard was virtually impossible. Therefore the Board decided not to admit the second and the third auxiliary request into the proceedings.

4. Added subject-matter (Articles 100(c) and 123(2) EPC)
- 4.1 Claim 1 of each of the main request and the first auxiliary request refers to a method of issuing portable programmed data carriers, in which a personalization system acquires personalization data from a card issuer management system and transfers them to a personalization equipment. The transfer of the personalization data occurs in a manner specified by equipment characteristic data for personalising and issuing of the data carrier at the personalization equipment. The equipment characteristic data for this task is identified in turn by a personalization equipment identifier which is also acquired from the card issuer management system. In addition, the last two features of claim 1 of both requests stipulate that security data is acquired from an external security source and transferred to the personalization equipment as specified by the equipment characteristic data.

A straightforward interpretation of the phrase "*as specified by the equipment characteristic data*" in the context of the claim definition as a whole is that the manner by which the security data is transferred to the personalization equipment is governed by the (ie the same) equipment characteristic data as specify the transfer of the personalization data.

- 4.2 In addition to objecting to an allegedly undisclosed generalisation of features relating to the acquisition of the equipment characteristic data in claim 1 of the main request, the respondent questioned the basis of disclosure for a method performing in combination all the steps set out in claim 1 of both the main request and the first auxiliary request.
- 4.3 With respect to the documents of the present application as filed, the appellant saw the said claimed subject-matter disclosed by "clause" number 9 in combination with a personalization system as shown by the examples of Figures 1B, 2, 5, 7 and 9, each including an external security source. Particular reference was made in this respect to the corresponding description given in paragraphs [0010], [0043], [0046], [0044], [0049], [0056], [0058], [0059] and to steps '805', '821' and '823' in the flowchart according to Figure 8 of the EP-A1 publication of the application. According to the appellant's submission, it was evident from the whole content of the application documents as filed that the method steps comprised in claim 1 of each of the requests under consideration were in fact performed by the personalization system which acted as an interface between a card issuer management system or an external security source and the personlization

equipment for personalizing and issuing of a data carrier. Moreover, from the cited passages of the application documents as originally filed it became apparent that the transfer of security data to the personalization equipment was specified by the equipment characteristic data, as was the transfer of the personalization data relating to a user of the data carrier.

- 4.4 The application documents as originally filed comprise a description subdivided into 104 paragraphs followed by a list of 31 numbered "clauses" describing "aspects of the invention", a set of claims 1 to 12 and Figures 1 to 14.

A literal disclosure of the last two features of claim 1 of both requests on file is exclusively to be found in clause number 9, whereas the originally-filed claims do not even mention a security source or security data. Clause number 9 reads, in combination with clause number 1 (within square brackets), to which it makes reference, as follows:

"[A method for issuing portable programmed data carriers comprising the steps of:

acquiring a personalization equipment identifier and personalization data for a cardholder from a card issuer management system;

acquiring equipment characteristic data for a personalization equipment type from a record in a database identified by the personalization equipment identifier; and

transferring the personalization data to personalization equipment as specified by the equipment

*characteristic data for the type of personalization equipment to issue the data carrier;]
further comprising the steps of :
acquiring security data from a security source;
and
transferring the security data to the personalization equipment as specified by the equipment characteristic data."*

Although the cited clause refers to several pieces of equipment, such as a card issuer management system, a database, a personalization equipment type, data carriers and a security source, it leaves open which piece or pieces of equipment would actually execute the various method steps listed in the clause. In this respect, the clause is silent in particular as to the presence of a personalization system, which, according to the claim definitions under consideration, is instrumental of performing the steps of acquisition and transfer of the various data.

Consequently, clause number 9 in itself does not provide a valid piece of disclosure for the subject-matter of claim 1 of each of the two requests on file.

- 4.5 Therefore, it needs to be checked whether the remainder of the application documents as originally filed discloses a personalization system which operates in the claimed manner, ie which, in particular, transfers security data in a manner specified by equipment characteristic data that are acquired according to a personalization equipment identifier for the transfer of the personalization data.

As an aside it is noted that the two claim definitions under consideration are ambiguous as to whether the various method steps would indeed be performed by the 'personalisation system'. However, since a respective clarification is readily conceivable and was indeed offered by the appellant, the Board accepts the appellant's interpretation of the claim definitions that in particular all method steps listed in the respective characterizing portion are to be understood as being executed by the personalization system.

- 4.6 Reference to a personalization system which transfers personalization data in a manner that is specified by equipment characteristic data for personalising and issuing of the data carrier is made in particular in paragraphs [0010] and [0043] of the description as originally filed. However, no reference is made in this context to acquisition and transfer of security data.

Reference to security data provided by the card issuer or another security source is made in turn on several occasions in paragraphs [0014], [0035], [0046] to [0051], [0054], [0058], [0059], [0062] and [0077] of the description as originally filed. However, no information is given there as to the manner in which such security data would be transferred to the personalization equipment. In paragraph [0049] it is merely stated that *"The [personalization] system 100 then transfers the secure key data to the personalization equipment 130 through the personalization equipment interface 107 along with the other data for the card."*

A flow chart which illustrates the operations of the smart card personalization system is shown by Figure 8. Figure 8 refers to the transfer of security data in 'block 823', the inscription of which reads "*Perform Secure Key Functions and Transfer Secure Keys to the Personalization Equip. per the Equip. Characteristics*". The other blocks '805' and '821' referred to by the appellant concern the acquisition of "Equipment Characteristic" using "Pers. Equip. ID" and the acquisition of "Secure Key Data", respectively. In the Board's view, the indication "*per the Equip. Characteristics*" in the inscription of 'block 823' does not have a clear and unambiguous meaning and, in particular, cannot unequivocally equated with the claimed requirement "*as specified by the equipment characteristic data*", as was argued by the appellant. This is all the more so, as corresponding paragraph [0059] of the description does not provide any explication of the said inscription but only states that "*If the card is protected by secure keys, the secure key functions are performed and the secure key data is transferred at block 823.*"

Moreover, the inscriptions in the flow chart blocks of Figure 8 which concern the acquisition and transfer of security data (ie blocks 819, 821 and 823) as well as the corresponding description of Figure 8 do not refer to an external security source. Indeed, in the absence of a respective explanation in the application documents as filed, it does not appear plausible that the transfer of security data obtained from an external security source should be specified by personalization characteristic data which are identified by means of a personalization equipment identifier that is obtained

from the card issuer management system for the transfer of personalization data, given the fact that the card issuer management system and the external security source constitute unrelated sources of data. In other words, one would rather expect an independent source of data, such as the external security source, to provide to the personalization system its own suitable identifier for corresponding equipment characteristic data for the transfer of the security data to appropriate personalization equipment.

4.7 The only concrete reference in the description as originally filed to an embodiment for which transfer of security data is discussed in combination with an identifier of the personalization equipment is in fact given in paragraph [0077] where it reads: "*An alternate embodiment of the smart card personalization system 100 passes the identifiers of the card operating system and the personalization equipment, as well as the application program identifier, to the security manager 940 which retrieves the appropriate security data and/or functions from the security database 942.*" This piece of disclosure, however, which refers to the embodiment illustrated by Figure 9, describes a transfer of data that takes place from the personalization system towards the security source (*ie* in a direction away from the personalization equipment) and, moreover, for which the manner of transfer of security data is in no way specified by equipment characteristic data.

4.8 In summary, it is noted that clause number 9, which literally recites the claimed manner of transfer of the security data to the personalization equipment, is

silent as to the concrete means which would perform the claimed steps and in particular does not mention a personalization system. Thus, "clause" number 9 constitutes an isolated piece of disclosure which falls short of disclosing the claimed subject-matter. On the other hand, in the remainder of the application documents as originally filed there is no clear and unambiguous description or explanation of a personalization system which would perform a transfer of security data in the claimed manner.

Consequently, claim 1 of each of the main request and the first auxiliary request on file contains subject-matter which extends beyond the content of the application as filed.

5. In conclusion, the Board finds that the appellant's main request and first auxiliary request do not comply with the requirement of Article 123(2) EPC and thus are not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

R. Schumacher

B. Schachenmann