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**Datasheet for the decision
of 16 November 2012**

Case Number: T 0124/09 - 3.4.01

Application Number: 98923270.7

Publication Number: 981804

IPC: G06K 19/00, G07F 19/00,
G07F 7/10, H04L 9/32, H04L 9/30

Language of the proceedings: EN

Title of invention:
Electronic transaction and smart card for a electronic
transaction

Patentee:
Comex Electronics AB

Opponents:
Bundesdruckerei GmbH
GIESECKE & DEVRIENT GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 123(3)
RPBA Art. 13

Keyword:
"Amendments - opposition proceedings"
"Admissibility of auxiliary requests (no)"

Decisions cited:
G 0004/95

Catchword:
-



Case Number: T 0124/09 - 3.4.01

D E C I S I O N
of the Technical Board of Appeal 3.4.01
of 16 November 2012

Appellant:
(Patent Proprietor)

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Respondent II:
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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 8 July 2008
revoking European patent No. 981804 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: H. Wolfrum
Members: F. Neumann
M. J. Vogel

Summary of Facts and Submissions

- I. The appellant (proprietor) lodged an appeal, received on 5 September 2008, against the decision of the opposition division, dispatched on 8 July 2008, to revoke European patent number EP 0 981 804. The appeal fee was paid on 5 September 2008. The statement setting out the grounds of appeal was received on 12 November 2008.

- II. Two oppositions had been filed against the patent as a whole based on Article 100(c) EPC 1973 and Article 100(a) EPC 1973 together with Articles 52(1), 54 and 56 EPC 1973.

- III. In the contested decision, the opposition division held that the subject-matter of independent claims 20 and 23 on file at that time was not new with respect to the disclosure of prior art document D4 (WO-A-96 32700).

- IV. In the statement setting out the grounds of appeal, the appellant held that the opposition division had read too much into the disclosure of D4 and maintained that the finding of lack of novelty of independent claims 20 and 23 on file when the decision was issued was therefore incorrect. A set of claims forming the basis of an auxiliary request was filed.

- V. In a communication issued in preparation of oral proceedings, the Board outlined the issues to be discussed with respect to added subject-matter, novelty and inventive step. The Board explained that the clarity of the claims would also have to be discussed in view of the amendments performed.

VI. In response to the communication of the Board, the appellant filed, with letter of 15 October 2012, three sets of claims forming the basis of a main request and first and second auxiliary requests. Submissions concerning the novelty and inventive step of the claimed subject-matter were presented and the appellant explained that certain amendments had been performed in order to adopt the original terminology.

VII. During the oral proceedings before the Board on 16 November 2012, the appellant filed two new sets of claims to replace the first and second auxiliary requests on file.

VIII. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1-26 of the main request filed with the letter of 15 October 2012 or alternatively on the basis of claims 1-25 of the first auxiliary request or claims 1-24 of the second auxiliary request, both auxiliary requests being filed during the oral proceedings before the Board.

Both respondents requested that the appeal be dismissed.

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

"A method for performing electronic transactions, in which a sender of transaction messages is assigned a smart card (1; 71) with an associated unique identity and a private key stored in the card in a protected

manner, and in which an associated public key is kept generally available, characterized in that in connection with an electronic transaction under the sender's own control, the sender creates through his own input of transaction information, independently of any connection to a communications network (5) and without computer dialogue with a receiver, on the basis of the input transaction information, a transaction message, which contains information necessary for the transaction, the transaction message being created in the smart card (1; 71) with the aid of software previously stored in the smart card and with the aid of sender information inserted in the card in advance, which sender information on the receiver side can easily be connected to a user identity, and, in his smart card, provides the created transaction message with his digital signature while using his own private key for subsequent output and transmission of the transaction message."

Independent claim 19 of the main request reads as follows:

"A smart card for carrying out electronic transactions, comprising means for storing card identification information, means for protected storing of a private key, means for storing an asymmetrical algorithm, means for input of transaction information into the card, processor means for creating in the card a transaction message based on input transaction information, such as information on amount and receiver, and optionally information stored in the card, such as information on sender and preferably a serial number, and for providing the transaction message with a digital

signature on the basis of said private key and said asymmetrical cryptographic algorithm, said transaction message containing the information required for the transaction and being created in the smart card with the aid of software previously stored in the smart card and with the aid of sender information inserted in the card in advance, which sender information on the receiver side can easily be connected to a user identity, and means for output of the signed transaction message, whereby the transaction messages (sic) is created by a sender under his own control in connection with an electronic transaction."

Independent claim 22 of the main request reads as follows:

"A combination of a smart card and a user-controlled communication unit, which is arranged for communication with the smart card and with which the card is adapted to be combined with a view to producing an electronic transaction message, the card comprising means for storing unique card identification data, means for protected storing of a private key, means for storing an asymmetrical algorithm and processor means for providing a created transaction message with a digital signature based on said private key and said algorithm, means for outputting the signed transaction message and said communication unit comprising means for input of transaction information in the card, characterized in that said processor means are disposed to create in the card a transaction message based on input transaction information entered, said transaction message containing data required for the transaction and being created in the smart card with the aid of software

previously stored in the smart card and with the aid of sender information inserted in the card in advance, which sender information on the receiver side can easily be connected to a user identity, whereby the transaction message is created by a sender under his own control in connection with an electronic transaction."

Claims 2-18, 20-21 and 23-26 are dependent claims.

The wording of independent claim 1 of the first auxiliary request is the same as the wording of independent claim 1 of the main request, except that the following wording, indicated in bold, has been inserted. Claim 1 is now directed to "A *method for performing **financial** electronic transactions...*" and defines that the transaction message is created "*independently of any connection to a communications network (5), **off-line, i.e. not connected to the communications network that is used for the subsequent transmission of the transaction message,** and without computer dialogue with a receiver...*".

The wording of independent claim 18 of the first auxiliary request is the same as the wording of independent claim 19 of the main request, except that claim 18 is now directed to "A *smart card for carrying out electronic transactions, comprising means for storing **unique** card identification information,*" and the wording "***independently of any connection to a communications network, off-line, i.e. not connected to the communications network that is used for the subsequent transmission of the transaction message, and without computer dialogue with a receiver, on the basis***

of input transaction information" has been inserted after the passage "which sender information on the receiver side can easily be connected to a user identity,".

Neither the wording of independent claim 21 nor that of dependent claims 2-17, 19-20 or 22-25 of the first auxiliary request plays a role in the current decision and so will not be reproduced here.

The wording of independent claim 1 of the second auxiliary request is identical to the wording of claim 1 of the first auxiliary request, with the exception of the following additions, indicated in bold: "...the transaction message being created **by the processor means** in the smart card (1; 71)..." and "...which sender information on the receiver side can easily be connected to a user identity **and is in the form of at least one of the following pieces of information: a card number, a cash card number, a charge card number, a credit card number, an account number, an invoice number and an ID number, and, in his smart card provides...**".

Independent claim 17 of the second auxiliary request is the same as claim 18 of the first auxiliary request except that the transaction message is created "based on input transaction information, such as information on amount and receiver, and information stored in the card", the "optionally" appearing before "information stored in the card" in the previous two requests having been removed. Moreover, the wording "**and is in the form of at least one of the following pieces of information: a card number, a cash card number, a charge card**

number, a credit card number, an account number, an invoice number and an ID number," has been inserted after *"which sender information on the receiver side can easily be connected to a user identity"*.

Again, neither the wording of independent claim 20 nor that of dependent claims 2-16, 18-19 or 21-24 of the second auxiliary request plays a role in the current decision and so will not be reproduced here.

- X. The arguments of the parties, insofar as they are pertinent to the present decision, are set out below in the reasons for the decision.

Reasons for the Decision

1. The appeal is admissible.
2. *Oral submissions by an accompanying person*
 - 2.1 In a letter dated 15 October 2012, the appellant's representative, Mr Heimdal, requested permission for Mr Malmqvist, who would accompany Mr Heimdal to the oral proceedings, to make oral submissions.
 - 2.2 During the course of the oral proceedings, Respondent I requested that Mr Malmqvist should not be allowed to speak. This request was made - somewhat inappropriately - after the debate concerning the admissibility of the main request (see below) had been concluded, the case for the appellant having been presented solely by Mr Malmqvist. Apart from the fact that Mr Malmqvist was

not an authorised representative, no reasons were provided in support of this request.

- 2.3 In decision G 4/95, the Enlarged Board of Appeal decided that "During oral proceedings under Article 116 EPC in the context of opposition or opposition appeal proceedings, a person accompanying the professional representative of a party may be allowed to make oral submissions on specific legal or technical issues on behalf of that party, otherwise than under Article 117 EPC, in addition to the complete presentation of the party's case by the professional representative" (see Headnote I).

In the present case, it was in fact Mr Malmqvist who presented the complete case for the appellant, Mr Heimdal only interjecting where necessary. However, the Board saw no reason to object to this arrangement as long as the presentation of the case was made under the continued responsibility and control of the professional representative Mr Heimdal. The Board therefore allowed Mr Malmqvist to continue with his oral submissions.

3. *The appellant's main request*

3.1 Admissibility

- 3.1.1 The respondents both requested that the appellant's main request filed with the letter of 15 October 2012 not be admitted into the proceedings.

With reference to Article 13 of the Rules of Procedure of the Boards of Appeal (RPBA) Respondent I held that

the amended version of the claims forming the basis of the main request represented an amendment to the appellant's case which raised complex legal questions, the solution of which was likely to delay the proceedings considerably. In particular, Respondent I held that the amendment of "*message information*" to "*transaction information*" and the change of "*on the basis of entered transaction information*" to "*on the basis of the input transaction information*" in claim 1 meant that a detailed examination of these amendments was required taking into particular account the requirements of Articles 123(2), 123(3) and 84 EPC. The examination of the amendments became all the more complex in view of the fact that basis for the amendments had not been indicated by the appellant and that in order to establish whether the protection conferred by the patent had been extended by the amendments, the description and drawings must be taken into account to interpret the claims (Article 69 EPC).

Respondent II supported this view and listed a number of additional concrete problems which were introduced with the amendments, the examination of which would inevitably delay the proceedings. For example, the term "*financial*" had been removed from line 1 of claim 1 of the granted patent leading to an infringement of Article 123(3) EPC. Similarly, the "*card unique identification information*" of claim 19 as granted had been changed to simply "*card identification information*". Moreover, the amendments gave rise to a number of objections under Article 84 EPC, from the simple lack of clarity of the term "*easily*" on line 18 of claim 1 and the nonsensical "*based on input transaction information entered*" on lines 14-15 of

claim 22 to the more intricate question of "*sender information*" in claim 19 which is on the one hand presented as optional (lines 20-22) but on the other hand as being mandatory (lines 27-28). The fact that method claim 1 and apparatus claim 19 were not fully analogous and that different amendments had been carried out in each of these claims only served to exacerbate the problems.

3.1.2 The appellant defended the amendments made to the claims, maintaining that, in order to ensure that the claimed subject-matter was new, it was necessary to perform a number of clarifying amendments so that the claim could not be misconstrued. It was explained that the amendment of "*message information*" to "*transaction information*" was performed to reflect the original wording used in the application. It was clear to the skilled person that these two wordings referred to the same thing. The same applied to the amendment of "*entered transaction information*" to "*the input transaction information*".

3.1.3 The amended claims were filed one month before the date of the oral proceedings, and thus before the deadline set by the Board for further submissions. Moreover, the amendments represent an attempt to avoid a potential objection of added subject-matter and an attempt to establish novelty with respect to document D4 and are therefore occasioned by grounds of opposition. The Board considers that the amendments were - at least to a large part - prompted by various issues mentioned in the communication of the Board. In view of this, even although the amendments to the claims give rise to a number of new problems, some of which have been

identified above, the Board exercised its discretion under Article 13 RPBA to admit the main request into the proceedings.

3.2 Article 123(3) EPC

3.2.1 Claim 1 of the patent as granted is directed to "*A method for performing financial electronic transactions ...*". In claim 1 of the main request now on file, the word "*financial*" has been deleted. The appellant insisted that this amendment was necessary since there was no basis in the application as originally filed for this wording.

As the respondents indicated, it is self-evident that the deletion of "*financial*" leads to an extension of the protection conferred by the patent: the claimed subject-matter is no longer restricted to the performance of **financial** electronic transactions but extends to **any type** of electronic transaction. The Board notes that there is no suggestion anywhere else in amended claim 1 which would even hint that the transaction being performed is financial in nature.

As a result, Article 123(3) EPC is infringed because the deletion of the word "*financial*" in claim 1 extends the protection conferred with respect to claim 1 as granted.

For this reason alone, the appellant's main request is not allowable.

4. *The appellant's first auxiliary request*

4.1 The amendments

In claim 1 of the first auxiliary request, the word "financial" has been reinstated and in claim 18, the word "unique" has been reinstated.

Furthermore, compared to claim 1 of the main request, the wording of claim 3 as granted has been incorporated into independent claim 1. A corresponding amendment has been made to each of independent claims 18 and 21. The Board notes that this amendment was already present in the previous version of the first auxiliary request which had been filed with the letter of 15 October 2012.

The appellant explained that the introduction of the reference to "*off-line, i.e. not connected to the communications network that is used for the subsequent transmission of the transaction message*" was intended to establish novelty and to clarify what is meant by the wording "*independently of any connection to a communications network*" which is used in each of the independent claims.

4.2 Admissibility

4.2.1 Both respondents requested that the first auxiliary request should not be admitted into the proceedings.

Respondent I observed that, apart from the re-insertion of the words "*financial*" and "*unique*", none of the objections raised by the respondents with respect to

the main request had been addressed in the amended claims of the first auxiliary request. These amendments merely attempted to reverse the amendments made in preparation of the oral proceedings and thus effectively just went round in a circle.

Respondent II observed that a manifest risk was involved in deleting "*financial*" from granted independent claim 1. This amendment was performed just four weeks before and in preparation of the oral proceedings. No fall-back position reverting to the more limited "*financial electronic transactions*" had been formulated at that time: both auxiliary requests filed at that time contained the same rather bold amendment. This meant that in order to attack the claims of the current first auxiliary request, it was necessary to turn to different objections than those which would have been relied upon with regard to the sets of claims which were presented in preparation of the oral proceedings.

In addition thereto, Respondent I pointed out that the clarity of claim 18, which did not derive from a combination of granted claims, would have to be considered. Indeed, claim 18 was unclear since it was not apparent to what extent "*off-line, i.e. not connected to the communications network that is used for the subsequent transmission of the transaction message*" was intended to further limit the expression "*independently of any connection to a communications network*". Moreover, the basis for this amendment in the original disclosure was not apparent.

4.2.2 The appellant argued that the wording of claim 18 now clearly expressed that the transaction message is created independently of any connection to the communications network which is used for subsequent transmission of the transaction message. The basis for this amendment comes from original claim 3.

4.2.3 It is established case law that the decision to admit new requests into the proceedings should be governed primarily by a general interest in the appeal proceedings being conducted in an effective manner.

In all of the requests filed in preparation of the oral proceedings, the word "*financial*" had been deleted from claim 1. In view of the fact that this amendment was defended at the oral proceedings, this was not merely an oversight, but was a deliberate attempt to avoid a potential objection under Article 123(2) EPC, an unfortunate consequence of which was that the protection conferred extended beyond that which had been granted. Only once it became clear that the Board considered this amendment to infringe Article 123(3) EPC did the appellant decide to revert to the more limited "*method for performing financial electronic transactions*" in claim 1. Had claim 1 of any of the auxiliary requests which were filed in advance of the oral proceedings retained the word "*financial*", it would have been clear that the appellant was willing to retract the risky - and, as it turned out, offending - amendment to the main request. Since the appellant apparently had no intention of retracting this amendment, the parties could focus their attention on the Article 123(3) EPC objection. The unexpected reinstatement of the word "*financial*" into claim 1 during

the oral proceedings meant that the issues to be discussed would no longer be centred on the question of Article 123(3) EPC and that other issues would have to be considered. In effect, the respondents would have to formulate a new case.

The Board considers that the nature of the amendments prevents the appeal proceedings being conducted in an effective manner. Indeed, even on a *prima facie* level, major clarity problems are immediately apparent. Instead of expediting the proceedings, as a result of the amendments, a number of additional issues have to be considered. For example, as respondent I has pointed out, the wording "*off-line, i.e. not connected to the communications network that is used for the subsequent transmission of the transaction message*" is unclear and inconcise in the context of claim 18 in view of the immediately preceding passage "*independently of any connection to a communications network*". The additional wording appears to be a superfluous repetition which does not clearly define any additional limitation. Moreover, in order to establish whether the change of "*message information*" in claim 1 of the granted patent to "*transaction information*" in claim 1 of the first auxiliary request meets the requirements of Article 123(2) and (3) EPC, it has to be established whether the various different terms "*transaction information*", "*message information*" and "*information that is necessary for the transaction message*" actually define the same thing, as the appellant maintains. Due to the inconsistent use of the different terms in both the contested patent and the original application, this is not at all evident.

Thus, the amendments which have been performed in the independent claims with respect to the claims of the granted patent are not clearly allowable and thus prevent the appeal proceedings being conducted in an effective manner. Although the amendments referred to in the immediately preceding paragraph were in fact also present in the claims of the two auxiliary requests filed in preparation of the oral proceedings, the fact that these previous requests contained a blatant contravention of Article 123(3) EPC meant that the preparation required by the respondents and by the Board in order to deal with these requests was very different to the preparation which would have been required had it been clear that the appellant would not insist on the unallowable deletion of "*finacial*". There was no indication prior to the oral proceedings that this situation may arise. The reinstatement, during the oral proceedings, of the word "*finacial*" in claim 1 of the first auxiliary request meant that the parties and the Board were presented with a new case since objections which did not have to be raised for the claims of the previous requests would now become decisive for the discussions. In view of the appellant's apparent insistence to maintain a broad claim 1, this shift in focal point could not have been predicted before the oral proceedings. For this reason, the Board exercised its discretion under Article 13 RPBA and did not admit the first auxiliary request into the proceedings.

5. *The appellant's second auxiliary request*

5.1 Admissibility

Independent claim 17 of the second auxiliary request contains the same amendments as referred to in section 4.2.3 above. Thus, for the same reasons as given with regard to the first auxiliary request, the Board exercised its discretion under Article 13 RPBA and did not admit the second auxiliary request into the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

R. Schumacher

H. Wolfrum