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Datasheet for the decision
of 22 October 2013

Case Number: T 0215/09 - 3.4.03

Application Number: 99902687.5

Publication Number: 1053535

IPC: G07F7/10

Language of the proceedings: EN

Title of invention:
CONFIGURATION OF IC CARD

Patent Proprietor:
MONDEX INTERNATIONAL LIMITED

Opponent:
Giesecke & Devrient GmbH

Headword:

Relevant legal provisions:
EPC 1973 Art. 84
EPC Art. 123(2), 123(3)

Keyword:
Claims - clarity - main request (yes)
Amendments - added subject-matter (no) - broadening of claim
(no)

Decisions cited:

Catchword:

Beschwerdekammern
Boards of Appeal
Chambres de recours

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Case Number: T 0215/09 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 22 October 2013

Appellant: (Patent Proprietor)	MONDEX INTERNATIONAL LIMITED 1st Floor, 47-53 Cannon Street London EC4M 5SQ (GB)
Representative:	Robson, Aidan John Reddie & Grose LLP 16 Theobalds Road London WC1X 8PL (GB)
Respondent: (Opponent)	Giesecke & Devrient GmbH Prinzregentenstrasse 159 81677 München (DE)

Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 3 December 2008 revoking European patent No. 1053535 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman:	R. Bekkering
Members:	V. L. P. Frank
	P. Mühlens

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 1 053 535 for the reasons of added subject-matter, extension of protection and lack of clarity (Article 123(2) and (3) EPC and Article 84 EPC 1973) (Article 101(3)(b) EPC).

II.   The appellant proprietor requested in writing that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of claims 1 to 11 of the main request or on the basis of claims 1 to 11 of the first auxiliary request, both filed with the letter of 2 April 2009.

The respondent opponent requested at the oral proceedings that the appeal be dismissed.

III.   The independent claims of the main request read as follows (amendments to the granted versions of these claims were marked by the board):

"1. A secure multiple application card system including an IC card comprising a microprocessor (710), a read-only memory (750) and an electronically erasable programmable read only memory (752), said system comprising:
means for manufacturing (101) said IC card and for storing at the time of manufacture in said read-only memory (750) an operating system and programming instructions **including at least one primitive or codelet;** and
means for personalizing (103) said IC card after the time of manufacture and for storing at the time of personalization in said electronically

erasable programmable read only memory (751) an
address table (140) with memory addresses of at
least one of said programming instructions,
wherein additional programming instructions can be
loaded onto the card at the time of
personalization and stored in the electronically
erasable programmable read only memory, and said
additional programming instructions comprise
updated versions of ~~the~~ previously stored
~~programming instructions~~ **primitives or codelets**
and the address table includes addresses for the
updated ~~programming instructions~~ **primitives or
codelets,**
and wherein the operating system will only access
those programming instructions in accordance with
addresses included in the address table."

"7.   A process for providing a secure multiple
      application card system including an IC card
      comprising a microprocessor, a read-only memory
      and an electronically erasable programmable read
      only memory, said process comprising the steps of:
      manufacturing said IC card and for storing at the
      time of manufacture in said read-only memory an
      operating system and programming instructions
      including at least one primitive or codelet, and
      personalizing said IC card after said time of
      manufacture by storing in said electronically
      erasable programmable read-only memory an address
      table with memory addresses; and
      wherein the step of personalizing the IC card
      includes storing additional programming
      instructions in the electronically erasable
      programmable read only memory and said additional
      programming instructions comprise updated versions
      of ~~said~~ previously stored ~~programming instructions~~

primitives or codelets, and ~~inserting~~ **including**
addresses for said additional programming
instructions in said address table, ~~whereby~~
wherein the operating system will only access
those programming instructions in accordance with
addresses stored in the address table."

IV.   The appellant proprietor argued on the main request
       essentially as follows:

-      The main request corresponded to the 1st auxiliary
       request in the opposition proceedings, with the
       reintroduction of *"those"* in the penultimate lines
       of claims 1 and 7, instead of the word *"the"*. The
       1st auxiliary request was refused by the opposition
       division for failing to fulfil the requirements of
       Article 84 EPC, i.e. for lacking clarity. The
       opposition division held that it was not possible
       to determine which programming instructions were
       referred to by *"the programming instructions"* of
       claims 1 and 7. It appeared that the opposition
       division interpreted the phrase *"only accesses the
       programming instructions in accordance with
       addresses included in the address table"* as
       describing the method by which the operating
       system accessed programming instructions, rather
       than describing which programming instructions
       were accessed. As a result the phrase *"the
       programming instructions"* was read in isolation
       and was interpreted to refer to previously defined
       programming instructions. However, that was not a
       correct interpretation.

-      In English, the position of the word *"only"* in
       claims 1 and 7 was significant. The word *"only"*
       appearing in claims 1 and 7 clearly referred to

the programming instructions, not the way that the operating system accessed programming instructions. There was a clear difference in meaning between:

(a) "only accesses the programming instructions in accordance with addresses included in the address table" and

(b) "accesses the programming instructions only in accordance with addresses included in the address table".

- The opposition division interpreted claim 1 as including phrase (b) when in fact it included phrase (a). The fact that the word *"only"* was positioned preceding *"programming instructions"* made it clear that the final phrase of claims 1 and 7 was a limitation of which programming instructions could be accessed by the operating system.

- It was therefore clear to a skilled person that the phrase *"only accesses the programming instructions in accordance with addresses included in the address table"* meant that the operating system accessed only those programming instructions which had an address entered in the address table. The operating system could not access programming instructions which did not have an address in accordance with an address in the address table. Thus *"the programming instructions"* appearing in the penultimate lines of claims 1 and 7 should not be read in isolation, but in combination with the entire phrase *"only accesses the programming instructions in accordance with addresses included in the address table"*. Hence it was clear that *"the programming instructions"* was

not a reference to previously defined programming
instructions at all.

-        In the main request in appeal the word *"the"* was
         replaced by *"those"*, in order to correspond
         exactly with the wording of the claims as filed
         and to further clarify the meaning of the phrase.
         The operating system accessed only those
         programming instructions having an address
         matching an address included in the address table.

The appellant proprietor further requested that the
case be remitted to the department of first instance,
as the issues of novelty, inventive step and
sufficiency of disclosure had not yet been addressed by
the opposition division.

V.   The respondent opponent argued on the main request
         essentially as follows:

-        The conclusion reached by the opposition division
         that the phrase *"the operating instructions"* or
         alternatively *"those operating instructions"* were
         unclear was correct. The independent claims
         referred to *"programming instructions"* and
         "additional programming instructions". Hence by
         referring to *"the"* or *"those programming
         instructions"* it was not clear whether the first,
         the second or both kinds of instructions were
         meant. Moreover, even according to the appellant
         two different interpretations of this feature were
         possible.

-        The granted independent claims required the
         operating system to only access programming
         instructions in accordance with addresses included

in the address table. There were no restrictions
on the type of programming instructions
(primitive, codelet or other programming
instructions) or on their storage location. Thus
all kinds of programming instructions were
accessed by the operating system only through
addresses in the address table. Due to the
reintroduction of the expression *"those"* only the
programming instructions referred to in the claim
were addressed in this manner, broadening thus the
scope of the claim and infringing Article 123(3)
EPC.

-       The application as filed only disclosed that
        primitives or codeletes were accessed through
        their addresses in the address table. However, the
        claims of the main request did not contain this
        limitation and specified merely that *"programming
        instructions"* were accessed in this way. The
        claims of the main request thus contained subject-
        matter that had not been disclosed in the
        application as filed, infringing Article 123(2)
        EPC.

The respondent opponent also requested that the case be
remitted to the department of first instance to address
the remaining issues in this case.

VI.   Oral proceedings were held on 22 October 2013. The
       appellant proprietor did not attend and was not
       represented at the oral proceedings, as announced in
       his letter of 2 October 2013.

Reasons for the Decision

1.   The appeal is admissible.

2.   Main request

2.1   Clarity

2.1.1   The IC card of claim 1 comprises a microprocessor, a
        read-only memory (ROM) and an electronically erasable
        programmable read-only memory (EEPROM).

        At the time of manufacture an operating system and
        programming instructions are stored in the ROM. These
        programming instructions include at least one primitive
        or codelet.

        After manufacture and during the personalizing step, an
        address table with memory addresses of at least one of
        said programming instructions is stored in the EEPROM.
        At this step additional programming instructions may
        also be stored in the EEPROM. These additional
        programming instructions comprise updated versions of
        the previously stored primitives and codelets, while
        the address table also includes the addresses of the
        updated versions.

2.1.2   Hence at this point the address table comprises
        addresses for:

        (a) the initial programming instructions that are
            neither primitives or codelets stored in the ROM,
        (b) the initial primitives and codelets stored in the
            ROM for which no update is provided,

(c) the additional programming instructions that are neither primitives or codelets stored in the EEPROM, and for

(d) the updated primitives and codelets stored in the EEPROM.

2.1.3   The last feature of the claim specifies that *"the operating system will only access those programming instructions in accordance with addresses included in the address table"*.

2.1.4   The respondent opponent argued that this feature lacked clarity, since it was not specified in the claim whether the initial programming instructions or the additional programming instructions were referred to by the phrase *"**those** programming instructions"*.

2.1.5   The appellant proprietor argued that the opposition division misinterpreted this feature, since it did not specify the method for accessing the programming instructions (ie in accordance with addresses included in the address table), but specified which programming instructions were accessed.

2.1.6   Article 84 EPC 1973 is not a ground for opposition listed in Article 100 EPC 1973. It is thus the established jurisprudence of the boards of appeal that the examination as to whether a claim is clear is limited to clarity issues arising from amendments made to the claims, but not to lack of clarity issues that were already present in the granted claims. Hence the board has to consider whether the introduction of the expression *"those"* in claim 1 renders the claimed secure multiple application card system unclear.

2.1.7   The board, however, does not consider that the
        expression *"the operating system will only access **those**
        programming instructions in accordance with addresses
        included in the address table"* used in claim 1 of the
        main request is less clear than the expression *"the
        operating system will only access programming
        instructions in accordance with addresses included in
        the address table"* of granted claim 1, since both
        expressions specify that access to the programming
        instructions is achieved through the address which is
        included in the address table. The so addressed
        programming instructions are *"those programming
        instructions"*. The board cannot recognize under the
        present circumstances any distinction between which
        programming instructions are accessed and the method
        through which they are accessed, since accessing the
        address table necessarily restricts the programming
        instructions that can be accessed to those listed in
        the address table.

2.1.8   Hence the board considers that the contested feature
        specifies that the operating system only accesses those
        programming instructions that are listed in the address
        table. *"Those"* programming instructions include all the
        programming instructions listed in the address table,
        ie the initial programming instructions that are
        neither primitives nor codelets stored in the ROM, the
        initial primitives or codelets stored in the ROM for
        which no update is provided, additional programming
        instructions that are neither primitives nor codelets
        stored in the EEPROM and the updated primitives and
        codelets stored in the EEPROM (cf point 2.1.2 of this
        decision). However, this feature further specifies that
        the operating system only accesses the programing
        instructions listed in the address table and does not
        access programming instructions which are not listed

there, such as eg the initial primitives and codelets
stored in the ROM that were replaced by the newer
versions stored in the EEPROM during the
personalization step. It is this feature that
contributes to the security of the claimed secure
multiple application card system.

2.1.9   The same objections of lack of clarity were also raised
        in connection with independent claim 7 which, although
        directed to a process for providing a secure multiple
        application card, comprises the same objected features
        as claim 1. The board considers that the same reasoning
        as put forward in connection to claim 1 applies to
        claim 7.

2.1.10 The board judges, for the above reasons, that claims 1
        and 7 of the main request are clear (Article 84 EPC
        1973).

2.2   Added subject-matter (Article 123(2) EPC)

2.2.1   The respondent opponent objected that the application
        as filed only disclosed that primitives or codelets
        were accessed through their address in the address
        table (cf page 5, lines 5-8 of the published
        application). Claim 1 of the main request was however
        not restricted to primitives or codelets, but referred
        in general to programming instructions.

2.2.2   The board however notes that claim 1 as filed referred
        to storing in the ROM programming instructions in
        general, while claim 4 as filed, which depends *inter
        alia* on claim 1, disclosed storing additional
        programming instructions in the EEPROM. Only claims 2,
        3, 5 and 6 as filed specified that the programming
        instructions comprised primitives or codelets. Hence

the combination of claims 1 and 4 as filed encompassed all kinds of programming instructions being stored in the ROM and the EEPROM.

2.2.3   The board finds for these reasons that the appellant's main request fulfills in this respect the requirements of Article 123(2) EPC.

2.3   Extension of the scope of protection (Article 123(3) EPC)

2.3.1   The respondent opponent argued that the scope of protection of claim 1 was extended with respect to the granted version, since the introduction of the expression *"**those** programming instructions"* restricted the instructions accessed by the operating system to the ones referred to in the claim, namely the programming instructions stored in the ROM and the additional programming instructions stored in the EEPROM. However the granted version of claim 1 did not contain this restriction and required that **all** programming instructions accessed by the operating system had a corresponding entry in the address table.

2.3.2   The board however is not persuaded that the scope of the patent has been extended by the introduction of the expression *"those"* in the last feature of claim 1. In the discussion on clarity (cf point 2.1.8 of this decision) the board found that this feature prevented the operating system from accessing programming instructions whose addresses were not specified in the address table. Hence the scope of protection of the patent has not been modified by the introduction of the expression *"those"*, since the last feature has not changed its meaning due to this introduction.

2.3.3   The board finds for these reasons that the amendments
        made to the patent do not extend the protection it
        confers (Article 123(3) EPC).

3.   *Further prosecution of the case*

3.1   According to Article 111(1) EPC 1973, a board of appeal
        may exercise any power within the competence of the
        department which was responsible for the decision
        appealed or remit the case to that department for
        further prosecution.

3.2   The appealed decision refused the patent for the
        reasons that the claim requests before the opposition
        division either were not clear (Article 84 EPC 1973),
        comprised added subject-matter (Article 123(2) EPC) or
        extended the scope of protection of the granted patent
        (Article 123(3) EPC). The other objections raised in
        the notice of opposition, ie insufficiency of
        disclosure, lack of novelty and/or inventive step, were
        not addressed in that decision.

3.3   The board thus considers it appropriate that the
        remaining objections against the maintenance of the
        patent be discussed before the opposition division, so
        that in the event of a further appeal, the parties can
        base their case on the reasoning delivered by the
        opposition division on these issues. This was also the
        express request of the parties.

3.4   The board decides for these reasons to remit the case
        to the department of first instance for further
        prosecution on the basis of claims 1 to 11 of the main
        request (Article 111(1) EPC 1973, 2nd sentence).

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 on the basis of claims
        1 to 11 of the main request filed with letter of
        2 April 2009.

The Registrar: The Chairman:

S. Sánchez Chiquero   R. Bekkering

Decision electronically authenticated