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Datasheet for the decision of 18 March 2014

Case Number: T 0334/11 - 3.5.06

Application Number: 99120094.0

Publication Number: 1001329

IPC: G06F21/20

Language of the proceedings: EN

Title of invention:
A user-computer interaction method for use by flexibly connectable computer systems

Patent Proprietor:
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Opponents:
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Kayser, Andreas

Headword:
Portable smart card apparatus/ALADDIN

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
Amendments - added subject-matter (yes)

Decisions cited:

Catchword:

Beschwerdekammern
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Case Number: T 0334/11 - 3.5.06

D E C I S I O N
of Technical Board of Appeal 3.5.06
of 18 March 2014

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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 10 December 2010 revoking European patent No. 1001329 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman: D. Rees
Members: S. Krischer
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. This appeal by the patent proprietor is directed against the decision of the opposition division, posted on 10 December 2010, to revoke the patent 1001329 for not complying with Articles 100(c) (main request) and 123(2) EPC (first auxiliary request).

II. A notice of appeal was received on 8 February 2011. The fee was received the same day. A statement of the grounds of appeal was received on 31 March 2011.

III. The proprietor requests therein that the decision be set aside and a patent be maintained on the basis of claims 1-12 of a main request, claims 1-6 of one of a first, second or third auxiliary request or claims 1-4 of a fourth auxiliary request, all filed with the grounds of appeal. The further text on file is: description paragraphs 1-78 and drawing sheets 1-5 of the patent.

IV. Opponents (respondents) 1, 4 and 5 request - at least implicitly - that the appeal be dismissed.

V. In the event that the board sets aside the appealed decision and considers the patentability of the claims, opponent 1 further requests that all objections previously raised under Article 100(a) EPC be considered by the board.

VI. In the event that the board considers claims to be allowable in the sense of Article 123(2) EPC, opponent 4 requests that the case be remitted to the opposition division to examine conformity with Articles 54 and 56 EPC.

VII. Opponents (respondents) 2 and 3 did not reply to the grounds of appeal.

VIII. There were conditional requests for oral proceedings from both sides.

IX. In its summons to oral proceedings, the board gave reasons for its preliminary opinion that claim 1 of all of the requests contravened Article 123(2) EPC.

X. In two otherwise identical letters dated 10 February 2014 and 7 February 2014, opponent 1 requested that the date of the oral proceedings be changed.

XI. In a letter dated 13 February 2014, the proprietor maintained its request for oral proceedings, but announced that it would not attend nor be represented at the oral proceedings. Furthermore, in the event that one of the requests were deemed to satisfy Article 123(2) EPC, it was requested that the case be remitted to the first instance. No arguments were put forward to rebut the board's preliminary opinion.

XII. In a communication dated 21 February 2014, the board informed the parties that the oral proceedings were cancelled. The request for a change of date was thereby rendered moot.

XIII. Claim 1 of the main request reads as follows:

"1. A portable smart card apparatus (110) for providing smart card functions to a host system (120), by communicating with a USB Interface (140) of the host system (120), said smart card apparatus (110) comprising:

a smart card chip (170), for performing said smart card functions;

a USB interface (140), for connecting the portable device apparatus (110) with said host system (120), via USB protocol; and

a microprocessor (130), for enabling at least one function selected from the group consisting of controlling the transfer of data between said USB interface (140) and said smart card chip (170), converting data from a USB format to the format of said smart card chip (170) and converting data from the format of said smart card chip (170) to a USB format;

characterised in that:

said smart card chip (170) communicates with said USB interface (140) of the host system (120) without a smart card reader."

XIV. Claim 1 of the first auxiliary request differs from claim 1 of the main request in the following deletions (marked as ~~struck through~~):

" a microprocessor (130)~~,~~ for ~~enabling at least one function selected from the group consisting of~~ controlling the transfer of data between said USB interface (140) and said smart card chip (170)~~,~~ ~~converting data from a USB format to the format of said smart card chip (170) and converting data from the format of said smart card chip (170) to a USB format~~;"

XV. Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in the following additions (underlined):

" a microprocessor (130) for controlling the transfer of data between said USB interface (140) and said smart card chip (170); and

a protocol translator (140) operative to translate from USB protocol into smart card protocol and from smart card protocol into USB protocol;"

XVI. Claim 1 of the third auxiliary request differs from claim 1 of the second auxiliary request in the following additions (underlined) and deletions (~~struck through~~):

"1. A portable smart card apparatus (110) for providing to a host system (120) smart card functions ~~to a host system (120)~~ in which information characterising a mobile user is employed to perform at least one computer operation at the host system, by communicating with a USB Interface (140) of the host system (120), said smart card apparatus (110) comprising:"

XVII. Claim 1 of the fourth auxiliary request differs from claim 1 of the third auxiliary request in the following additions (underlined) and deletions (~~struck through~~)::

" a protocol translator (140) operative to translate from USB protocol into an ISO7816 protocol of the smart card ~~protocol~~ and from the ISO7816 protocol of the smart card ~~protocol~~ into USB protocol;"

Reasons for the Decision

1. *Overview*

1.1 The patent *relates* to a portable smart card apparatus with a smart card [memory] chip (170 in figure 2; see also paragraph [45] of the published application (A2): "smart card chip (ICC) memory 170") and a micro-processor (130; [45]: "CPU 130") which can be connected to a computer ("host") via a USB interface [chip] (140; [48]).

1.2 The board considers it pointless to maintain oral proceedings when the appellant has declared it will not attend them nor be represented at them and, in view of the board's expressed preliminary opinion, when the only requests for oral proceedings from the opponents are conditional.

1.3 Claim 1 of all five requests contains amendments that do not satisfy the requirements of Article 123(2) EPC.

2. *Request for oral proceedings*

The appellant in its letter of 13 February 2014, while maintaining its request for oral proceedings, declared that it would not attend them nor be represented. Opponents 1 and 4 had also requested oral proceedings as an auxiliary request in the event that the decision to revoke the patent would not be upheld. Against this background, bearing in mind that the appellant has not filed any comment nor amendments after the board's communication which clearly pointed out objections under Article 123(2) EPC for all requests, there was no

reason to maintain oral proceedings: the proprietor did not wish to defend its requests orally, nor had written arguments or amendments been filed which would have justified a discussion of these amendments of the case, thus the board was in the position to decide in compliance with Article 113 (1) EPC.

3. *Original disclosure*

3.1 The appealed decision (section 1) considers independent claims 1 and 9 of the patent (the then main request) to extend beyond the application as originally filed because of the feature of the microprocessor enabling the function of converting data from a USB format to a smart card format and vice versa. The original description discloses that the USB interface chip wraps/converts the data.

3.2 The decision (section 2) also considers the then first auxiliary request to add subject-matter for the same reason. Claim 1 of the present main request is identical to claim 1 of the then first auxiliary request and differs from claim 1 of the then main request (i.e. the patent) only in that it reads at the end "[characterized in that:] said *smart card chip (170)* communicates" instead of "said *portable smart card apparatus (110)* communicates" (emphases added).

3.3 According to the decision (1.1), the proprietor cited paragraph [37] of the application as published as a basis for the feature objected to. But, according to the decision, this paragraph refers to figure 1 which is an embodiment different from the claims, since it has no smart card chip. The proprietor also cited the "protocol translator" of original claim 12 as a basis,

but the opposition division took the view that it is not possible to map the protocol translator to the microprocessor. Furthermore, there were doubts as to whether the translation of original claim 12 is the same operation as the conversion.

3.4 Main request

3.4.1 According to the grounds of appeal of the proprietor (page 2, paragraph 5), the subject-matter of figure 1 is covered by claim 1 of the current main request: The smart card chip (170) of the claim is identified with the CPU (30) in combination with the user's data memory (70) in figure 1. The board understands the proprietor's argument to be that these two devices simulate a smart card with its functionality.

Also the USB interface (140) is identified with the CPU (30), the reason for doing so being based on the last sentence of [37] which reads:

> "Some or all of the USB interface device 40, firmware memory 50 and RAM memory 60 may be within the CPU 30."

According to the proprietor this passage shows, in combination with original claim 15 dependent on original independent claim 12, that the microprocessor (simulating the USB interface) performs the conversion between USB and smart card formats.

3.4.2 According to the reply of opponent 4 (page 2, paragraphs 2, 3), original claims 12, 15 and [32] merely disclose a protocol translator doing the conversion. The formulation of claim 1 ("a micro-

processor (130) for enabling *at least one* function ... controlling ... converting ... and converting"; emphasis added; similar in claim 7) also protects systems with only one conversion, whereas [42]-[48] only disclose a bi-directional conversion. This represents an inadmissible generalisation.

3.4.3 According to the reply of opponent 5 (page 2, paragraph 5 to page 3, paragraph 4), the combination of CPU (30) and user's data memory (70) of the device of figure 1 does not provide a physical interface and a communication protocol of a smart card chip. Furthermore, paragraph [40] (= [45] of the patent) states that "user data memory 70 typically does not include ISO 7816-3 memory". Paragraph [49] (= [54] of the patent) makes clear that claim 1 describes the device of figure 2 and not that of figure 1:

> "A particular advantage of the embodiment of Fig. 2 is that smart card functionality is provided but there is no need for a dedicated reader because the plug 110 is connected directly to a USB socket in the host 120."

Paragraph [35] (= [40] of the patent) cited by the proprietor says that figure 1 is "in accordance with a preferred embodiment of the present invention". Opponent 5 points out that this formulation was included in the description when the application was filed and when there were independent claims which did not include a smart card chip.

Moreover (page 3, paragraph 2 of the opponent's reply), the embodiment of figure 2 on which claim 1 is based discloses in [48] (= [53] of the patent) that it is the

USB interface chip which does the conversion rather than the microprocessor as the latter only handles data in the ISO7816-3 protocol.

Furthermore in the view of opponent 5 (page 3, paragraph 4), this paragraph [48] (= [53] of the patent) also does not disclose "*controlling* the transfer of data" (emphasis added) by the microprocessor (the other option of claim 1), but only the *passage* of data through the microprocessor.

3.4.4 According to the reply of opponent 1 (page 3, first paragraph), the word "control" does not appear in the original application in the context of the microprocessor controlling the data transfer.

Moreover (paragraphs 3, 4), there is no original disclosure of a *generic device* which merely has to communicate with a USB interface, but solely of a device in form of a USB plug/key/token, see original claim 12 and [26] (= page 4, paragraph 7 of the original description). In particular, there is no original disclosure of a device that communicates without a smart card reader (see the end of claim 1) which is not a USB key.

3.4.5 The board is convinced by the arguments of the appealed decision and of the opponents.

3.4.6 The board takes the view that the device disclosed at figure 1 and [35]-[44] is indeed different from that of figure 2 and [45]-[49]: The device of figure 1 appears to represent a mere USB memory stick without any element of a smart card: Firstly, its memory is not of the smart card memory type ([35]: "USB plug device

including a CPU and a *non-ISO7816 memory*", emphasis added). Secondly, there is no passage in the original description disclosing a smart card functionality (for example cryptographic capabilities) for the device of figure 1. The only analogy between the USB plug of figure 1 and a smart card is that both have a memory (see [36]).

3.4.7 Since the device of figure 1 indeed does not relate to smart card functionality, it is not possible to incorporate features from the disclosure of that device into claim 1, because the latter explicitly provides smart card functions (see its first paragraph) and a smart card chip (paragraph 2).

3.4.8 In particular, even if one assumes that the microprocessor simulates the functionality of the USB interface chip, then there is still no disclosure for the device of figure 1 ([35]-[44]) that the USB interface chip would convert between USB and smart card formats. Paragraphs [43] and [44] disclose a "writing" and "reading" "using the memory's protocol" by the microprocessor, and a "wrapping" into USB packet format by the USB interface chip. Note that [35] discloses that the memory is of type non-ISO7816 (i.e. a non smart card memory). Thus there is no conversion from or into smart card format by the device of figure 1. This is only disclosed for the device of figure 2 in [48]:

> "[48] The USB interface chip 140 gets USB packets from the USB host 120. The USB interface chip 140 parses the data and passes it to the microprocessor 130. The data, which typically comprises a ISO7816-3 T=0/1 formatted packet, is passed by the microprocessor to the smart-card 170 in a ISO7816-3

protocol. The microprocessor 130 gets the response from the smart card 160 and passes the data to the USB interface chip 140. The USB interface chip 140 wraps the data in USB packet format and passes it to the host 120."

3.4.9 The board agrees with opponent 5 that paragraph [48] explicitly discloses for the embodiment of figure 2 that it is the USB interface chip (140) which wraps/converts/translates the ISO7816-3 packets (i.e. smart card packets) received via the microprocessor from the smart card chip (170) into USB packets.

3.4.10 As to the reverse direction, the board understands from [48] that it is also the USB interface chip (140) which (un)wraps/converts/translates the USB packets into ISO7816-3 packets, since the USB interface chip *parses* the data and *passes* it to the microprocessor which itself *passes* it (i.e. transmits it unchanged) to the smart card chip (160) in the smart card format.

3.4.11 As to the argument of opponents 5 and 1 that "the microprocessor controlling the transfer of data" is not originally disclosed, this depends on the question whether "controlling the data transfer" and "passing data" are synonymous. The board answers this question in the negative. It recognises an aspect of conditionality for "controlling" and of unconditionality for "passing"; i.e. a controlling microprocessor would decide whether certain data is passed or not.

The board notes that this objection in fact applies to claim 1 of all the present requests.

3.4.12 Therefore, claim 1 of the main request is not originally disclosed in the sense of Article 123(2) EPC.

3.5 First auxiliary request

3.5.1 Claim 1 of this request differs from that of the main request in that it no longer includes the options of converting between USB and smart card chip formats.

3.5.2 According to opponents 4 and 1, this is not allowable, since the conversion is an essential feature. Following T260/85, deleting a feature which had been presented as essential in the original application would add subject-matter, contrary to Article 123(2) EPC.

3.5.3 The board agrees with opponents 4 and 1 that the conversion between USB and smart card chip formats is indispensable in order to provide the claimed smart card functions to a host system which is only connected via USB with the smart card chip of the USB plug device and that in the context the deletion of this feature constitutes added subject-matter. Moreover, the board notes that the two conversions were already optional in claim 1 of the main request ("enabling at least one function selected from ... controlling ... converting ... converting"). Thus this objection would already apply to claim 1 of the main request.

3.5.4 Therefore, claim 1 of this request is also not originally disclosed in the sense of Article 123(2) EPC.

3.6 Second auxiliary request

3.6.1 Claim 1 of this request differs from that of the first auxiliary request in that it contains a *protocol translator (140)* performing a translation between USB and smart card protocols in addition to the USB interface (140 - nota bene with the same reference numeral).

3.6.2 The grounds of appeal indicate original claim 12 and [32] as a basis for this amendment.

3.6.3 According to opponent 4, there is no embodiment in the original description combining a USB interface (140) and a protocol translator (140).

3.6.4 The board cannot follow this argumentation, since both original claim 12 and [32] explicitly disclose a combination between a USB interface and a protocol translator.

3.6.5 However, they do *not* disclose a *microprocessor* together with these two. Moreover, in original claim 12 and [32], it seems that it is the *protocol translator* and not the USB interface which *translates/converts/ wraps* between USB protocol and smart card protocol. Therefore, it seems that claim 12 and [32] represent a *third embodiment* in addition to those of figures 2 and 1. As a consequence, it is not allowable to combine features arbitrarily from this embodiment with features from figure 2.

3.6.6 Therefore, claim 1 of this request is also not originally disclosed in the sense of Article 123(2) EPC.

3.7 Since the claims of *auxiliary requests 3 and 4* are based on the claims of the second auxiliary request, the objections with respect to Article 123(2) EPC raised for the latter also apply to these claims.

3.8 In sum all of the present requests violate Article 123(2) EPC and therefore none of them are allowable.

4. *Novelty and inventiveness*

Considering that novelty and inventive step have neither been discussed during the oral proceedings before the opposition division nor addressed in any way in the appealed decision (e.g. as an obiter dictum), the board did not discuss them during appeal.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

T. Buschek D. Rees

Decision electronically authenticated