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**Datasheet for the decision  
of 11 July 2012**

**Case Number:** T 0501/11 - 3.5.03

**Application Number:** 99903846.6

**Publication Number:** 1077007

**IPC:** H04Q 7/32, H04B 1/38

**Language of the proceedings:** EN

**Title of invention:**  
Improved GSM cellular terminal

**Patent proprietor:**  
S.I.SV.EL. Societa Italiana per lo Sviluppo dell'Elettronica  
S.p.A.

**Opponent:**  
Nägerl, Joël

**Headword:**  
GSM cellular terminal/S.I.SV.EL.

**Relevant legal provisions:**  
EPC Art. 56  
RPBA Art. 13(1)

**Relevant legal provisions (EPC 1973):**  
-

**Keyword:**  
"Inventive step - first and fifth auxiliary request (no)"  
"Admissibility - sixth to twelfth auxiliary requests (no)"

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 0501/11 - 3.5.03

**D E C I S I O N**  
**of the Technical Board of Appeal 3.5.03**  
**of 11 July 2012**

**Appellant I:**  
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**Appellant II:**  
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**Representative:**                      Nägerl, Joël  
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**Decision under appeal:**                      Interlocutory decision of the opposition  
division of the European Patent Office posted  
27 December 2010 concerning maintenance of  
European patent No. 1077007 in amended form.

**Composition of the Board:**

**Chairman:**                      A. S. Clelland  
**Members:**                      F. van der Voort  
   R. Menapace

## Summary of Facts and Submissions

- I. Appeals were filed by both the proprietor and the opponent against the decision of the opposition division finding European patent No. 1 077 007 in amended form to meet the requirements of the EPC.
- II. The opposition was against the patent as a whole and, *inter alia*, on the ground that the claimed subject-matter did not involve an inventive step (Articles 52(1) and 56 EPC).
- III. Following oral proceedings, the opposition division held that the patent in amended form according to a first auxiliary request met the requirements of the EPC. With respect to a main request the opposition division held that the subject-matter of claim 1 did not involve an inventive step having regard to the disclosure of:
- E2: DE 41 18 994 A.
- IV. In its statement of grounds of appeal, the proprietor-appellant (hereinafter appellant I) requested that the decision under appeal be set aside and that the patent be maintained on the basis of claims of a main request or one of first to tenth auxiliary requests, all as filed with the statement of grounds of appeal. Oral proceedings were conditionally requested.
- V. In its statement of grounds of appeal, the opponent-appellant (hereinafter appellant II) requested that the decision under appeal be set aside and that the patent be revoked. Oral proceedings were conditionally requested.

- VI. Each party submitted a written reply in response to the statement of grounds of appeal of the other party.
- VII. The board summoned the parties to oral proceedings. In a communication accompanying the summons, the board drew attention to issues to be discussed at the oral proceedings. The parties were also informed that the appeals would be considered in the same proceedings in accordance with Article 10(1) RPBA.
- VIII. With a letter dated 11 June 2012 appellant I filed a new main request and new first to twelfth auxiliary requests, which replaced the requests on file. Arguments in support were provided.
- IX. Oral proceedings were held on 11 July 2012 in the course of which appellant I withdrew the main request and the second to fourth auxiliary requests and filed an amended twelfth auxiliary request.

Appellant I requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the first auxiliary request or, alternatively, on the basis of one of the fifth to eleventh auxiliary requests, all as filed with the letter dated 11 June 2012, or the twelfth auxiliary request as filed at the oral proceedings.

Appellant II requested that the decision under appeal be set aside and that the patent be revoked.

At the end of the oral proceedings, after deliberation, the board's decision was announced.

- X. Claim 1 of the **first** auxiliary request is identical to claim 1 of the main request as decided on by the opposition division and reads as follows:

"A GSM cellular terminal comprising antenna means, control means, signal processing means, two SIM card readers, where corresponding SIM cards can be inserted for connection to corresponding service networks, characterized in that said GSM cellular terminal comprises two separate GSM signal processing means (BLK3, BLK3'), said two separate GSM signal processing means (BLK3, BLK3') comprising corresponding said two SIM card readers (I,I'), adapted to allow simultaneous use and management of said corresponding service networks."

Claim 1 of the **fifth** auxiliary request is identical to claim 1 of the first auxiliary request as decided on by the opposition division and reads as follows:

"A GSM cellular terminal comprising antenna means, control means, signal processing means, two SIM card readers, where corresponding SIM cards can be inserted for connection to corresponding service networks, characterized in that said GSM cellular terminal comprises two separate GSM signal processing means (BLK3, BLK3'), said two separate GSM signal processing means (BLK3, BLK3') comprising corresponding said two SIM card readers (I, I') and corresponding signal reception and transmission means (D, D1), and being adapted to allow simultaneous use and management of said corresponding service networks, in that said control means (BLK2) comprise program memory means (M)

associated with a management program (M') of said two SIM card readers (I, I') and of the corresponding signal reception and transmission means (D, D1), and in that said control means (BLK2) comprise a keyboard unit (K), which has an additional keyboard segment (K') adapted to transmit signals being apt to switch among said two SIM cards."

Claim 1 of the **sixth** auxiliary request differs from claim 1 of the fifth auxiliary request in that in the preamble the following feature is added:

"each SIM card reader (I,I') being a SIM card housing and a hardware interface (H,H') of a SIM card".

Claim 1 of the **seventh** auxiliary request differs from claim 1 of the sixth auxiliary request in that in the characterising portion the feature

"said two separate GSM signal processing means (BLK3, BLK3') comprising corresponding said two SIM card readers (I, I') and corresponding signal reception and transmission means (D, D1)"

is reworded as:

"said two separate GSM signal processing means (BLK3, BLK3') each comprising a SIM card reader (I, I') and a signal reception and transmission means (D, D1)".

Claim 1 of the **eighth** auxiliary request differs from claim 1 of the seventh auxiliary request in that twice "corresponding service networks" is replaced by "associated service networks" and in that "a signal

reception and transmission means (D, D1)" is replaced by "signal reception and transmission means (D, D1)".

Claim 1 of the **ninth** auxiliary request reads as follows:

"A GSM cellular terminal comprising antenna means, control means, signal processing means, two SIM card readers, each SIM card reader (I,I') being a SIM card housing and a hardware interface (H,H') of a SIM card, where corresponding SIM cards can be inserted for connection to associated service networks, wherein said GSM cellular terminal comprises two separate, first and second, GSM signal processing means (BLK3, BLK3'), said two separate GSM signal processing means (BLK3, BLK3') each comprising a SIM card reader (I, I') and a signal reception and transmission means (D, D1), and being adapted to allow simultaneous use and management of said associated service networks, and wherein said control means (BLK2) comprise program memory means (M) associated with a management program (M') of said two SIM card readers (I, I') allowing independent management of two SIM cards on one GSM cellular terminal alone, said management, in virtue of the availability of two reception and transmission means (D,D1), being a simultaneous one, said management program (M') allowing management of said signal reception and transmission means (D, D1), one related to the first signal processing means (BLK3) and the other to the second signal processing means (BLK3'), and wherein said control means (BLK2) further comprise a keyboard unit (K), which has an additional keyboard segment (K') adapted to transmit signals being apt to switch among said two SIM cards."

Claim 1 of the **tenth** auxiliary request differs from claim 1 of the ninth auxiliary request in that the following feature is added:

", and wherein said program memory means (M) comprises a primary function either to deactivate or put on hold one of two activated channels, while the other channel is in communication".

Claim 1 of the **eleventh** auxiliary request differs from claim 1 of the ninth auxiliary request in that the following feature is added:

", wherein said GSM cellular terminal further comprises optical and/or acoustic signalling means (BLK5) to indicate what SIM card can be used for transmission-reception by the subscriber, and wherein said optical and/or acoustic signaling means (BLK5) are integrated in standard signaling means (BLK4, L) comprised in the GSM cellular terminal".

Claim 1 of the **twelfth** auxiliary request differs from claim 1 of the ninth auxiliary request in that the following feature is added:

", and wherein said program memory means (M) comprises more than one of the following functions:

- an activated channel selection function;
- a primary function either to deactivate or put on hold one of two activated channels, while the other channel is in communication;
- a highlighting function of the activated selected channel;



- a managing function for optical and/or acoustic signals related to the activated channels;
- a managing function of the access priorities to index lists related to both SIM cards."

## **Reasons for the Decision**

### 1. *First auxiliary request*

- 1.1 It was common ground between the parties that E2 represented the closest prior art and that it disclosed the following features of claim 1 of the first auxiliary request:

A cellular terminal (E2, the figure) which includes antenna means A, control means (e.g., switching means ("Umschalteinrichtung") U and control handset ("Bedienhandapparat") B), and two subscriber identity module (SIM) card readers, in which one of the card readers is part of the handset B, while the other is SIM card reader LW ((col. 1, lines 19 to 27 and 56 to 62, and col. 2, lines 4 to 7)). Corresponding SIM cards K1, K2 can be inserted for connection to corresponding service networks. The cellular terminal includes two separate signal processing means which, respectively, include transceivers ("Sende-Empfangsgeräte") SEC and SED. The signal processing means are adapted to allow simultaneous use and management of the corresponding service networks (col. 1, lines 34 to 47). More specifically, during a first communication using the handset B and one of the transceivers SEC, SED, the other transceiver can simultaneously be used for receiving a further call, which, e.g., is switched to

an answering machine R, or for transmitting or receiving a fax by means of a fax machine FAX (col. 2, lines 34 to 44).

1.2 Appellant I argued that E2 does not disclose the remaining features of claim 1 of the first auxiliary request, i.e.:

i) the cellular terminal is a GSM cellular terminal;

ii) the signal processing means are GSM signal processing means; and

iii) the two signal processing means comprise "corresponding said two SIM card readers".

1.3 At the oral proceedings feature iii) was interpreted by appellant I and the board such that each of the two signal processing means comprised a respective (or corresponding) SIM card reader.

1.4 The board notes that in the cellular terminal of E2 the first transceiver SEC may be for the "C-Netz" and the second transceiver SED may be for a "D-Netz" (col. 1, lines 62 to 68, and claim 4). At the oral proceedings it was not disputed that in the context of E2 (col. 1, lines 7 to 15) the "C-Netz" is an analog mobile network and a "D-Netz" is a GSM network.

The board further notes that in E2 the implementation of the cellular terminal with transceivers for the "C-Netz" and a "D-Netz", respectively, is merely disclosed as an example (cf. col. 1, lines 40 to 45 ("insbesondere") and 62 to 68 ("z.B."),

"beispielsweise")). This is in line with the fact that only in dependent claim 4 the two transceivers are further defined as transceivers for the "C-Netz" and a "D-Netz", respectively. Further, it is noted that in E2 reference is made to a plurality of "D-Netze" (col. 1, lines 14 and 15 ("Im Bereich der Deutschen Bundespost werden diese Netze als sogenannte D-Netze betrieben.")).

- 1.5 Starting out from the disclosure of E2 the technical problem underlying the subject-matter of claim 1 may be seen in implementing the cellular terminal of E2 for use in two "D-Netze".

In view of the fact that E2 refers to existing "D-Netze", the formulation of this problem does not contribute to an inventive step. For the same reason, when faced with this problem, it would have been obvious to the person skilled in the art to accordingly implement the transceivers as transceivers for "D-Netze". Since the "D-Netze" are GSM networks (see point 1.4), the skilled person would thereby have arrived at a GSM cellular terminal, in which, in addition to the features referred to at point 1.1, the transceivers are GSM transceivers and, hence, the signal processing means, which include the transceivers, are GSM signal processing means (features i) and ii), cf. point 1.2).

Further, in an implementation of the cellular terminal of E2 with two GSM transceivers, in use, for example during a first communication via one of the GSM transceivers using the telephone number of one of the SIM cards and simultaneously transmitting a fax from the fax machine via the other GSM transceiver using the

other SIM card, each of the GSM transceivers is associated with a corresponding one of the SIM card readers, in which the SIM card readers may be defined as being part of the respective signal processing means, together with the corresponding transceivers. Hence, in use, each of the two signal processing means comprises a respective (or corresponding) SIM card reader (feature iii), cf. point 1.2).

1.6 At the priority date of the patent in suit, the skilled person would therefore, without the exercise of inventive skill, have arrived at a cellular terminal which includes all features of claim 1 of the first auxiliary request.

1.7 Appellant I argued that the simultaneous use of both transceivers as disclosed in E2 (col. 2, lines 34 to 44) and referred to above was only possible if one transceiver was for a "D-Netz" and the other for the "C-Netz". This was due to the presence of the switching means U which acted as a single two-way switch and, hence, could only connect one card reader to one of the transceivers at the same time. Since in the case of a "D-Netz" a connection between the transceiver and the card reader was always required for subscriber identification purposes, it followed that for a simultaneous use of both service networks the other transceiver had to be for the "C-Netz". Further, if faced with the problem of adapting the cellular terminal of E2 for two simultaneous GSM connections, the skilled person would simply have done away with the transceiver for the "C-Netz" and would have applied multiplexing techniques in order to allow two

simultaneous GSM calls using the single remaining transceiver for the "D-Netz".

The board does not find these arguments convincing. As set out above (see point 1.4) E2 explicitly discloses that the cellular terminal as shown in the figure is not limited to a use in the "C-Netz" and a "D-Netz" only. Neither can it be derived from E2 that the simultaneous use as referred to in E2, col. 2, lines 34 to 44, is restricted to this combination of networks. The appellant's argument is based on the assumption that the switching means U merely acts as a single two-way switch. However, in view of the fact that the switching means U is illustrated in the figure as having six terminals and that the switching means U supports, *inter alia*, a call set-up using the control handset in combination with a user-selected one of the SIM cards and a user-selected one of the transceivers (col. 2, lines 19 to 33) and supports a simultaneous use of both transceivers (col. 2, lines 34 to 44), the switching means cannot be equated with a simple two-way switch. Further, the board notes that, in any case, claim 1 of the first auxiliary request does not exclude that the cellular terminal includes a switching means between the card readers and the transceivers, as long as a simultaneous use of both service networks remains possible, as is the case with the cellular terminal of E2, see above. Further, the board notes that the application of GSM multiplexing techniques, as suggested by the appellant, would, in any way, still require two separate GSM transceivers, i.e. two separate GSM signal processing means, as claimed, as an intermediate step.

1.8 The board therefore concludes that the subject-matter of claim 1 of the first auxiliary request does not meet the requirements of Articles 52(1) and 56 EPC.

1.9 The first auxiliary request is therefore not allowable.

2. *Fifth auxiliary request*

2.1 Claim 1 of the fifth auxiliary request differs from claim 1 of the first auxiliary request in that the following features are added (see point X above):

- iv) the two separate GSM signal processing means comprise corresponding signal reception and transmission means;
- v) the control means comprise program memory means associated with a management program of the two SIM card readers and of the corresponding signal reception and transmission means; and
- vi) the control means comprise a keyboard unit, which has an additional keyboard segment adapted to transmit signals being apt to switch among the two SIM cards.

2.2 Feature iv) is known from E2 (see point 1.1 above, transceivers SEC, SED).

Further, E2 discloses that for controlling the switching means and for managing the card readers a commonly available processor ("gebräuchlicher, entsprechend verbreiteter Prozessor") can be used (col. 2, lines 47 to 52). In the board's judgement, this

suggests a software-based implementation of the control means, which, in turn, implies the use of a program memory means for storing the software. The board also notes that at the priority date of the patent in suit (16 February 1998) a software-based implementation of the control means of a GSM cellular terminal was well-known (cf. the patent in suit, Fig. 1, which shows a block diagram of a GSM cellular terminal according to the prior art, which includes a control block including a microcontroller unit J, a keyboard unit K, ROM program memory unit M and EEPROM memory O).

It would therefore have been obvious to the person skilled in the art to include in the control means of the GSM cellular terminal, as referred to at points 1.5 and 1.6 above, i.e. a cellular terminal which includes all features of claim 1 of the first auxiliary request, program memory means associated with a management program of the two SIM card readers and of the corresponding signal reception and transmission means (feature v)).

As to feature vi), the board notes that E2 discloses that, by a special entry ("gesonderte Eingabe") via the control handset B, a user, who wants to make a call, can select either of the two SIM cards and either of the two transceivers (col. 2, lines 19 to 33). Further, the board notes that at the priority date of the patent in suit it was well-known to provide cellular terminals with a keyboard unit for entering data, e.g. a telephone number, and for selecting a function (cf. the patent in suit, Fig. 1, keyboard unit K). Hence, it would have been obvious to the person skilled in the art to implement the special entry referred to in E2 in

the same way, i.e. by providing a keyboard segment adapted to transmit signals being apt to switch among the two SIM cards and which, together with the remaining keys of the cellular terminal, defines the keyboard unit (feature vi)).

2.3 In view of the above and the reasons given at point 1 in respect of claim 1 of the first auxiliary request, at the priority date of the patent in suit the skilled person would therefore, without the exercise of inventive skill, have arrived at a cellular terminal which includes all features of claim 1 of the fifth auxiliary request.

2.4 Appellant I argued in respect of feature v) that, since the switching means U in E2 was downstream of the transceivers SEC, SED, the control means for controlling the switching means U would not be able to control the transceivers SEC, SED themselves, but only their output signals. Hence, even if the control means were to include program memory means, these means would not be associated with a management program of the transceivers. Further, E2, col. 2, lines 12 to 18, disclosed that an incoming call received by one of the transceivers could automatically be connected to the handset, irrespective of which one of the two SIM cards was inserted in the handset. This was not possible with the cellular terminal of the invention, since according to feature v) each of the two SIM cards was always connected to a corresponding one of the signal processing means.

In the board's judgement, however, it goes without saying that in E2 the control means are not only



required for controlling the switching means U, as is explicitly disclosed in E2, but also for controlling other components of the cellular terminal, such as for power control of the transceivers SEC, SED, in a similar way as known in connection with prior art GSM cellular terminals (see the patent in suit, Fig. 1, power controller C connected to microcontroller unit J). Further, as set out at point 1.5 above, in an implementation of the cellular terminal of E2 using two GSM transceivers, in use, each of the transceivers is associated with a corresponding one of the SIM card readers. Neither feature iii) nor feature v) of claim 1 requires a fixed association between the signal reception and transmission means and the SIM cards, as suggested by the appellant.

2.5 The board therefore concludes that the subject-matter of claim 1 of the fifth auxiliary request does not meet the requirements of Articles 52(1) and 56 EPC.

2.6 The fifth auxiliary request is therefore not allowable.

### 3. *Sixth to ninth auxiliary requests*

3.1 As explained by appellant I at the oral proceedings, the amendments to claim 1 according to each one of the sixth to ninth auxiliary requests were made in order to take account of objections based on Article 100(c) EPC raised by appellant II and were not relevant to the issue of inventive step.

The board notes, see point X above, that claim 1 of the sixth auxiliary request further defines each SIM card reader as being a SIM card housing and a hardware

interface of a SIM card, that claim 1 of both the seventh and eighth auxiliary request merely includes clarifications, and that claim 1 of the ninth auxiliary request, apart from some clarifications, further includes the additional feature that the management program allows independent, simultaneous management "of two SIM cards on one GSM cellular terminal", which encompasses the independent, simultaneous management of the two SIM cards of the claimed cellular terminal. Indeed, having regard to the disclosure of E2 (see point 1 above), these clarifications as well as the above-mentioned additional feature do not appear to contribute to an inventive step.

3.2 Consequently, in view of the reasoning given above in respect of the subject-matter of claim 1 of the fifth auxiliary request, the subject-matter of claim 1 of each one of the sixth to ninth auxiliary request does not, *prima facie*, involve an inventive step.

3.3 Since the sixth to ninth auxiliary requests were thus not clearly allowable, exercising its discretion pursuant to Article 13(1) RPBA, the board did not admit these requests to the appeal proceedings.

#### 4. *Tenth auxiliary request*

4.1 Claim 1 of the tenth auxiliary request differs from claim 1 of the ninth auxiliary request in that the claim includes the additional feature that the program memory means includes a primary function either to deactivate or put on hold one of two activated channels, while the other channel is in communication (see point X above).

- 4.2 The board notes that in E2, while the other channel is in communication, an incoming second call, received via the second transceiver, may be switched to an answering machine R (col. 2, lines 34 to 44). It was well-known at the priority date that an answering machine usually plays a greeting message and subsequently gives the calling party the opportunity to leave a message, after which the call is ended, i.e. the channel is deactivated. It follows that, in the software-implementation of the cellular terminal as referred to at point 2.2 above, it would have been obvious to include in the management program associated with the program memory means the function of deactivating one of the two activated channels, including the corresponding transceiver, while the other channel is in communication.
- 4.3 The additional feature referred to above, at least according to its first alternative, does not therefore appear to contribute to an inventive step. Hence, in view of the reasons given above in respect of claim 1 of the ninth auxiliary request, the subject-matter of claim 1 of the tenth auxiliary request does not, *prima facie*, involve an inventive step.
- 4.4 The tenth auxiliary request was therefore not clearly allowable and, exercising its discretion pursuant to Article 13(1) RPBA, the board did not admit it to the appeal proceedings.

5. *Eleventh auxiliary request*

5.1 Claim 1 of the eleventh auxiliary request differs from claim 1 of the ninth auxiliary request in that the claim includes the additional features that the cellular terminal further includes optical and/or acoustic signalling means to indicate what SIM card can be used for transmission-reception by the subscriber, and that these means are integrated in standard signaling means comprised in the GSM cellular terminal (see point X above).

5.2 E2 discloses that a subscriber may make a call by using one of the SIM cards and one of the transceivers, both as selected by the subscriber (col. 2, lines 19 to 33). It therefore appears to be obvious that the subscriber should preferably be given information about which SIM cards he/she may select from. Implementing this by means of a visual indication also appears to be obvious, since at the priority date it was common that GSM cellular terminals were equipped with a display for displaying status information, user settings, telephone numbers, etc. (see also the patent in suit, Fig. 1 (display unit L)).

5.3 The additional feature referred to above, at least according to its first alternative, does not therefore appear to contribute to an inventive step. Hence, in view of the reasons given above in respect of claim 1 of the ninth auxiliary request, the subject-matter of claim 1 of the eleventh auxiliary request does not, *prima facie*, involve an inventive step.

5.4 The eleventh auxiliary request was therefore not clearly allowable and, exercising its discretion pursuant to Article 13(1) RPBA, the board did not admit it to the appeal proceedings.

6. *Twelfth auxiliary request*

6.1 Claim 1 of the twelfth auxiliary request seeks, *inter alia*, protection for a GSM cellular terminal which includes all features as defined in claim 1 of the ninth auxiliary request and in which the program memory means includes the following two functions: a primary function to deactivate one of two activated channels, while the other is in communication, and a managing function for optical signals related to the activated channels. This subject-matter corresponds to a combination of the features of claim 1 of the tenth auxiliary request and, in more general terms, the additional features of claim 1 of the eleventh auxiliary request.

6.2 In view of the reasons given above in respect of claims 1 of the tenth and eleventh auxiliary requests and taking into that no synergistic effect can be seen in the specific combination of the above-mentioned two functions, the subject-matter of claim 1 of the twelfth auxiliary request does not, *prima facie*, involve an inventive step.

6.3 The twelfth auxiliary request was therefore not clearly allowable and, exercising its discretion pursuant to Article 13(1) RPBA, the board did not admit it to the appeal proceedings.

7. Since, for the reasons set out above, none of the requests for maintaining the patent in amended form is allowable, it follows that the patent is to be revoked.

## **Order**

### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

G. Rauh

A. S. Clelland