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Datasheet for the decision of 7 December 2016

Case Number: T 1942/11 - 3.4.01

Application Number: 97921189.3

Publication Number: 0894312

IPC: G06K19/06, G06F11/00, G07F7/10

Language of the proceedings: EN

Title of invention:
SYSTEM AND APPARATUS FOR SMART CARD PERSONALIZATION

Patent Proprietor:
Ubiq Incorporated

Opponent:
GIESECKE & DEVRIENT GmbH

Headword:

Relevant legal provisions:
EPC Art. 123(2)
EPC 1973 Art. 84, 56
RPBA Art. 12(4)

Keyword:
Grounds for opposition - late-filed ground for opposition
Late-filed facts - admitted (no)
Claims - clarity (yes)
Inventive step - (no)

Decisions cited:
T 0501/92, G 0010/91, G 0003/14, T 0931/06

Catchword:

Europäisches Patentamt
European Patent Office
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Case Number: T 1942/11 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 7 December 2016

Appellant: (Opponent)	GIESECKE & DEVRIENT GmbH Prinzregentenstr. 159 81677 München (DE)
Representative:	Höhfeld, Jochen Klunker Schmitt-Nilson Hirsch Patentanwälte Destouchesstrasse 68 80796 München (DE)
Respondent: (Patent Proprietor)	Ubiq Incorporated Suite 580, 5909 Baker Road Minneapolis, MN 55345 (US)
Representative:	Beresford, Keith Denis Lewis Beresford Crump LLP 16 High Holborn London WC1V 6BX (GB)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 4 July 2011 concerning maintenance of the European Patent No. 0894312 in amended form.**

Composition of the Board:

Chairman	G. Assi
Members:	T. Zinke
	R. Winkelhofer

Summary of Facts and Submissions

I. The appellant (opponent) lodged an appeal, received on 2 September 2011, against the interlocutory decision of the Opposition Division, posted on 4 July 2011, maintaining European patent Nr. 0 894 312 in amended form according to a patentee's second auxiliary request underlying the decision. The appeal fee was paid on 2 September 2011. The statement setting out the grounds of appeal was received on on 8 November 2011.

The opposition had been filed against the patent as a whole and based on Article 100(a) EPC 1973 together with Article 56 EPC 1973 as well as Article 100(b) EPC 1973 together with Article 83 EPC 1973.

II. The present appeal proceedings follows a previous appeal proceedings T0931/06, in which the Board in a different composition decided to set aside a first decision of the Opposition Division maintaining the patent as granted. The case was remitted to the Opposition Division for further prosecution, in particular for considering the disclosure of document E3 (JP 07 311871 A) that had been late filed during the first appeal proceedings.

III. In its interlocutory decision leading to the present appeal, the Opposition Division held that independent claim 19 according to a main request (patent as granted) lacked inventive step in view of document E6 (JP 07 311684 A). Further, the Opposition Division found that claim 1 of a first auxiliary request (corresponding to claim 1 of the patent as granted) lacked inventive step in view of document E8 (WO 93/04433 A1) and the common general knowledge of a skilled person. With regard to a second auxiliary

request, the Opposition Division concluded that it met the requirements of Article 123(2) EPC and Article 84 EPC 1973 and that it was based on an inventive step (Article 56 EPC 1973) in view of document E8 as well as a combination of documents E8 and E6. The patent was thus maintained in amended form on the basis of said second auxiliary request (Article 101(3)(a) EPC). For this reason, third and fourth auxiliary requests underlying the decision were not considered.

IV. With the present notice of appeal, the appellant requested that the interlocutory decision be set aside and the patent be revoked in its entirety.
Oral proceedings were requested as an auxiliary request.

V. With the present statement setting out the grounds of appeal, the appellant, with regard to the claims of the second auxiliary request on the basis of which the patent had been maintained, submitted that the amendments of independent claims 1, 12 and 19 had not been originally disclosed (Article 123(2) EPC), that the subject-matter of claim 19 could not be carried out (Article 83 EPC 1973), that dependent claim 10 lacked clarity (Article 84 EPC 1973), and that claims 1 and 12 did not involve an inventive step considering documents E3 (JP 07 311871 A) or E8 as closest prior art, respectively.

VI. The respondent (patent proprietor) was informed about the statement of grounds by notification of 21 December 2011. However, it did not submit any response.

VII. By summons of 6 September 2016 the parties were summonsed to oral proceedings due to take place on

7 December 2016. A Board's communication under Article 15(1) RPBA was issued on 19 September 2016 drawing attention to the issues to be discussed during the oral proceedings.

VIII. With a submission of 22 November 2016, the respondent informed the Board that it would not be represented at the oral proceedings and requested that a *"decision be issued on the basis of the previous written submissions that the applicant has made"*.

IX. The appellant did not submit any written comments to the Board's communication.

X. Oral proceedings were held as scheduled on 7 December 2016 in the absence of the respondent.

The appellant's final request was that the decision under appeal be set aside and the patent be revoked.

The respondent simply requested in writing that a decision be issued.

At the end of the oral proceedings, the decision of the Board was announced.

XI. Claim 1 of the claim set according to the second auxiliary request on the basis of which the patent was maintained in amended form, reads as follows (for the sake of simplicity, said request is hereafter referred to as *"present request"*):

"1.
a) A method of issuing portable programmed data carriers (160) using a personalization system (100) operable as an interface between a card issuer

management system (150) and a personalization equipment (130) and performing the steps of;
b) - acquiring (815, 805) personalization data relating to a user of the data carrier by the personalization system (100) from the card issuer management system (150),
c) - transferring the personalization data relating to the user of the data carrier to the personalization system (130) in a manner specified by equipment characteristic data, and
d) - personalising and issuing of the data carrier at the personalization equipment (130),
further characterised by the steps of:
e) - acquiring (801) a personalization equipment identifier from the card issuer management system (150), and
f) - acquiring the equipment characteristic data for a personalization equipment type corresponding to said personalization equipment from a record in a database (126) identified by the personalization equipment identifier;
g) wherein the personalization system controls the personalization equipment; and wherein,
h) included in the equipment characteristic data, is a set of personalization programming control commands which control operation of the personalization equipment."

In the present decision, the Board relies on the feature analysis a) to h), as mentioned in the decision under appeal and reproduced in the statement setting out the grounds of appeal.

Independent claim 12 is correspondingly formulated and concerns a personalization system.

Reasons for the Decision

1. The appeal is admissible.

2. Respondent's request

2.1 The respondent did not file any explicit request during the appeal proceedings. In its submission of 22 November 2016 the respondent only requested that a *"decision be issued on the basis of the previous written submissions that the applicant has made"*.

2.2 It is established jurisprudence that in opposition appeal proceedings, in the absence of a request or reply from a respondent (patent proprietor), a Board of appeal must still examine the appeal (Article 110 EPC) and decide on it (Article 111 EPC 1973) (cf. e.g. decision T0501/92, OJ 1996, 261, Headnote IV).

Therefore, in the present case in which the respondent only requested that a decision on the appeal be issued, the Board has to verify whether the appellant's submissions with regard to the patent as maintained by the Opposition Division are well-founded or not.

2.3 It is also established jurisprudence that appeal proceedings are wholly separate and independent from the first instance proceedings (cf. Case Law of the Boards of Appeal, 8th edition, July 2016, section IV.E. 1). In particular, in the already cited decision T0501/92 the Board stated in section 1.1 of the Reasons that *"Any statement during first instance proceedings which may affect the procedure within the first instance proceedings is not applicable in any subsequent appeal proceedings, and has to be repeated*

during subsequent appeal proceedings if it is to be procedurally effective during such appeal proceedings."

It follows that the third and fourth auxiliary requests underlying the decision under appeal are not procedurally effective in the appeal proceedings because the respondent failed to make a statement in this respect. The Board has to decide on the present request, i.e. the second auxiliary request on the basis of which the patent had been maintained in amended form.

3. Article 83 EPC 1973

3.1 In the statement of grounds of appeal the appellant raised for the first time an objection under Article 83 EPC 1973 against claim 19 (computer program) according to the respondent's present request. Allegedly, there was no disclosure how the computer program could execute the step of *"personalizing and issuing of the data carrier at the personalization equipment"* according to claim 1, to which claim 19 refers.

3.2 The opposition relied on the ground under Article 100(b) EPC 1973. However, the objection regarded another issue, i.e. *"wie die Datenstruktur zum Erzeugen von tragbaren, programmierten Datenträgern aufgebaut sein könnte" (cf.* notice of opposition, point III.3.1 of the reasons).

3.3 According to Article 12(4) RPBA the Board has the power to hold inadmissible facts, evidence or requests which could have been presented in the first instance proceedings.

3.4 As mentioned above, the facts enforced under Article 100(b) EPC in the notice of opposition are clearly different from the facts provided for the first time in the present appeal proceedings. Moreover, the feature that the computer program comprises instructions for executing all the steps of claim 1 was already present in claim 24 of the granted patent. The Board sees no reason why the objection at issue was submitted so late. The appellant also provided no reasons in this respect.

3.5 Hence, the Board holds inadmissible under Article 12(4) RPBA the new objection unjustifiably raised with the grounds of appeal under the, however, validly enforced ground for opposition according to Article 100(b) EPC 1973.

4. Article 123(2) EPC

4.1 With regard to the respondent's present request, in the statement of grounds of appeal (cf. point 1) the appellant raised an objection against claim 1, in particular with regard to the combination of features g) and h).
Further, the appellant argued that it was not originally disclosed that the system interface acquires a personalization equipment identifier and the equipment characteristic data from the database (126), as it is claimed in claim 12.
In addition, the appellant argued that it was not originally disclosed that and how a computer program according to claim 19 could perform method step d) of claim 1.

4.2 Claim 1

Feature g) reads *"wherein the personalization system controls the personalization equipment"*).
Feature h) reads *"included in the equipment characteristic data, is a set of personalization control commands which control operation of the personalization equipment"*.

The Board agrees that the only literal disclosure of the term *"control"* of feature g) is present in the paragraph bridging pages 10 and 11 of the original application (corresponding to paragraph [0034] of the published patent specification). However, throughout the application it is clear for a person skilled in the art that the personalization system controls the personalization equipment by using, having regard to the embodiment depicted in Figure 10, the *"Program Commands"* of step 1011 , the *"Equipment Program Commands"* of step 1013 the *"O/S Program Commands"* of step 1025 and the *"Program Commands"* of step 1029.

Hence, the requirements of Article 123(2) EPC are met with regard to the amendments made to claim 1.

4.3 Claims 12 and 19

The objections under Article 123(2) EPC against claims 12 and 19 have been raised for the first time in the statement of grounds of appeal (cf. points 1.2 and 1.3), although corresponding features were already present in the claims of the granted patent.

Considering that the opposition was not filed on the ground of Article 100(c) EPC, i.e. that the subject-matter of the European patent extends beyond the content of the application as filed, said objections represents a fresh ground for opposition which,

according to decision G 10/91 (OJ EPO 1993, 420, cf. Headnote, point 3) may be considered in appeal proceedings only with the approval of the patentee.

In the present case, in the absence of any respondent's statement in this respect, this fresh ground for opposition is not to be considered.

5. Article 84 EPC 1973

5.1 In decision G 03/14 (OJ 11/2015, A102, cf. Catchword) the Enlarged Board of Appeal stated that "*In considering whether, for the purposes of Article 101(3) EPC, a patent as amended meets the requirements of the EPC, the claims of the patent may be examined for compliance with the requirements of Article 84 EPC only when, and then only to the extent that the amendment introduces non-compliance with Article 84 EPC.*"

5.2 In the present case, the raised clarity objections concern features g) and h) of claim 1, which represent amendments to claim 1 of the granted patent.

For this reason, the Board holds that clarity of amendments g) and h) can be considered.

5.3 In the appellant's view, lack of clarity arose when considering said features per se and also in view of claim 10 depending on claim 1.

In the statement of grounds of appeal (cf. point section 2), the appellant argued that according to feature g) of claim 1 the personalization equipment is controlled by the personalization system, whereas according to feature h) of claim 1 the personalization

equipment is controlled by personalization programming control commands. This would make the claim unclear.

The Board does not agree. The term *"control"* is very broad and encompasses various control possibilities like, for instance, a direct control with explicit instructions to an application or operating system of the personalization equipment but also the provision of personalization data that should be used by the personalization equipment in order to issue a data carrier. Hence, the Board interprets claim 1 in that both a control with and without using the personalization programming control commands is claimed.

5.4 A further clarity objection was raised in the statement of grounds against the use of the two terms *"programming control commands"* in claim 10 and *"personalization programming control commands"* in feature h) of claim 1. In particular, the appellant argued that the programming control commands of claim 10 are acquired from a record in a database identified by a card operating system identifier, whereas the *"personalization programming control commands"* of claim 1 are acquired from a record in a database identified by a personal equipment identifier. This would result in an uncertainty about the record of the database from which the *"programming control commands"* are acquired.

The Board disagrees. Since both terms are different and consistently used in the respective claims, both terms are to be interpreted as describing different commands that could be stored in different records of databases.

5.5 Hence, the Board concludes that claim 1 meets the requirements of Article 84 EPC 1973.

6. Articles 54(1),(2) and 56 EPC 1973

6.1 It is undisputed that the subject-matter of independent claims 1 and 12 of the respondent's present request is novel with regard to the prior art documents on record.

6.2 In the statement setting out the grounds of appeal (cf. point 3.1) the appellant argued that the subject-matter of claim 1 was not based on an inventive step starting from document E3 as closest prior art, this document having been admitted into the proceedings by the Board dealing with case T0931/06. As E3 is a Japanese patent application, it is referred in the following to the English translation prepared by a translation bureau and provided with letter of 31 October 2008.

It should be noted that, during oral proceedings of 18 May 2011 before the Opposition Division, an objection starting from document E3 had been raised against the then pending auxiliary request 1 but not against the then pending auxiliary request 2 which corresponds to the respondent's present request. Hence, the decision under appeal (cf. section 3.4) deals with this objection only in the context of auxiliary request 1.

6.3 In the decision under appeal (cf. point 3.4), the Opposition Division held that features a), b), c) (in part), d) and e) of claim 1 according to the then pending auxiliary request 1 were disclosed by document E3. In view of the remaining features c'), i.e. *"personalization data are transferred in a manner specified by equipment characteristic data"*, and f), the subject-matter of said claim 1 was considered to be novel and inventive.

This conclusion would then also apply to claim 1 of the then pending auxiliary request 2, i.e. claim 1 according to the respondent's present request, which includes two further features g) and h) with respect the claim 1 of the then pending auxiliary request 1.

6.4 In the statement setting out the grounds of appeal (cf. point 3.1), with regard to claim 1 of the auxiliary request 2 underlying the decision under appeal, the appellant argued that features c') and f) were indeed disclosed in document E3, contrary to the Opposition Division's opinion.
In particular, with regard to feature c') the appellant stated that the formatting rules of the attribute file of Figure 7 of E3 could be interpreted as disclosing the conversion of personalization data into a device specific form.
With regard to feature f) the appellant explained that with step S36 in Figure 9 of E3 (cf. paragraph [0036]) an *"individual attribute file"* was formed, which should be interpreted as a device-specific data set understandable by the respective end device.

With regard to further features g) and h), the appellant argued that the parameters *"kind"* and *"length"* of E3 had an ambivalent character, because they were device-specific data controlling the end devices, for instance by determining whether the data had to be interpreted as Japanese letters or in binary form (cf. E3, page 19). Moreover, these two parameters represented not only device-specific data but also control commands for performing the personalization. Since these parameters were included in the individual attribute file, this individual attribute file formed device-specific data, which included control commands

controlling the behaviour of the personalization device.

Hence, the subject-matter of claim 1 of the respondent's present request was not based on an inventive step starting from document E3 as closest prior art.

6.5 The Board agrees with the appellant that document E3 can be regarded as representing the closest prior art.

The claimed method differs from the method disclosed in E1 in the definition of the functional relationship between a central unit and peripheral units interconnected via a network.
According to E3, the central unit would correspond to the *"provision device of personal information 50"* and the peripheral units to the *"issue processing systems 10, 20, 30, 40"*.
In claim 1 of the present request, the central unit is the *"personalization system 100"* and the peripheral units are represented by the *"personalization equipment 130"*.

6.5.1 Document E3 discloses the generation of an individual attribute file by the provision device for each of respective issue processing systems. The individual attribute file describes how the personalization data should be interpreted by a *"main body"* of the respective issue processing system. The issue processing system is described as an *"independent system"* (cf. paragraph [0013]) and *"The issuing processing device has a function of recording information directly on each medium based on the main body's instruction"*.

Hence, document E3 discloses a method and a system with an independent control in the peripheral units that are able to generate individual instructions to be used on the basis of the received individual attribute file and individual personalization data.

6.5.2 As discussed above, the Board interprets the term *"control"* in claim 1 broadly. Further, the term *"equipment characteristic data"* as used in features c) and f) can also be understood in a broad way. It encompasses all data that might be characteristic of a personalization equipment; for instance, addresses of the equipment in the network, protocols that are used for communication between the personalization system and the personalization equipment, operating system commands and/or application program commands.

6.5.3 With this broad interpretation of the claim wording the Board sees the only difference between the subject-matter of claim 1 of the present request and the method disclosed in E3 in feature h). Namely, E3 does not disclose that *"a set of programming control commands which control operation of the personalization equipment"* is included in the equipment characteristic data.

6.6 The technical effect of this feature is that the peripheral units, i.e. the personalization equipment, can be built with less *"independent control functionalities"*, since the control of these peripheral units would be carried out by the central unit, i.e. the personalization system, which disposes of individual instructions suitable to control the peripheral units, i.e. *"programming control commands which control operation of the personalization equipment"*.

6.7 Hence, the technical problem would be to define a method allowing control of less independent peripheral units.

6.8 The person skilled in the art is aware of the possibility of conceiving different hardware structures. Thus, document E3 itself (cf. paragraph [0040]) discloses that different hardware constitutions may relied on.

The skilled person is, in particular, aware of the fact that, depending on the control functionality provided in a central unit and peripheral units, different control methods need to be implemented.
In systems equipped with functionally independent peripheral units, the control can be carried out by simply transmitting data files (as disclosed in E3).
On the other side, in systems with peripheral units with reduced functional autonomy, a more direct control based on individual instructions or commands provided by the central unit is necessary.

Hence, the claimed solution that the personalization system needs to provide programming control commands in order to control the personalization equipment is an obvious alternative to the less direct control as disclosed in E3.
For such a central control the personalization system needs to generate all the instructions to be executed by the personalization equipment. In this case, it would be obvious for a person skilled in the art to provide a memory (i.e. a database), in which these individual programming control commands are stored, and to provide the possibility of retrieving these

individual programming control command by an identifier, for example.

6.9 Hence, the subject-matter of claim 1 of the respondent's present request is not based on an inventive step starting from document E3 as closest prior art in combination with the common general knowledge of a person skilled in the art.

7. The respondent had been informed with the written communication of the Board about the intention to discuss inventive step of the present request with regard to the disclosure of document E3 during oral proceedings. However, the respondent was not represented at the oral proceedings and, in its submission of 22 November 2016, only referred to *"the previous written submissions the applicant has made"*. Moreover, in none of the written submissions in first opposition proceedings, subsequent appeal proceedings T0931/06 and second opposition proceedings, the claims of the present request were discussed by the respondent with regard to inventive step in view of E3. In the letter dated 20 September 2010, which introduced the then pending second auxiliary request into the second opposition proceedings, the section entitled *"Reference E3"* (cf. pages 4 to 5) only dealt with the claim wording of the patent as granted (i.e. the then pending main request). The Board considered this passage but could only find arguments that document E3 would not disclose the control of personalization equipment by equipment individual commands that are provided in a database of a central unit. This would amount to a statement that the claimed subject-matter was novel, which is not contested by the Board (cf. above). Rather, as explained, the Board does not see the presence of an inventive step.

During oral proceedings before the Board, due to its absence, the respondent abstained from providing its submissions in this regard. In accordance with the provisions of Article 15(3) RPBA, the respondent was then treated as relying only on its written case.

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:

R. Schumacher G. Assi

Decision electronically authenticated