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**Datasheet for the decision
of 5 October 2016**

Case Number: T 2047/11 - 3.5.06

Application Number: 02728139.3

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G06F9/06

Language of the proceedings: EN

Title of invention:
SERVICE PROVIDING METHOD AND INTEGRATED CIRCUIT

Applicant:
Sony Corporation

Headword:
Service providing/SONY

Relevant legal provisions:
EPC 1973 Art. 84

Keyword:
Claims - clarity (no) - support in the description (no)

Decisions cited:

Catchword:



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Case Number: T 2047/11 - 3.5.06

D E C I S I O N
of Technical Board of Appeal 3.5.06
of 5 October 2016

Appellant: Sony Corporation
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 11 May 2011
refusing European patent application No.
02728139.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman W. Sekretaruk
Members: S. Krischer
A. Teale

Summary of Facts and Submissions

I. The appeal is directed against the decision of the examining division, dated 11 May 2011, to refuse application 02728139.3 for lack of conciseness (Article 84 EPC) and lack of inventive step (Article 56 EPC) citing documents D3 and D5:

D3 WO 98/37524 A1.

D5 WO 00/42581 A1.

II. A notice of appeal was received on 6 July 2011. The appeal fee was received on the same day. A statement of grounds of appeal was received on 7 September 2011. Claim sets according to a main and three auxiliary requests were filed, and oral proceedings were requested.

III. In the annex to its summons to oral proceedings, the board gave reasons for its preliminary opinion that claim 1 of all requests lacked clarity and support by the description (Article 84 EPC 1973) and that the amendments of claim 1 of auxiliary requests 1-3 did not satisfy the requirements of Article 123(2) EPC concerning original disclosure.

IV. In a letter dated 24 August 2016, the appellant submitted arguments as to why the claims were clear and supported by the description.

V. Oral proceedings were held on 5 October 2016 during which the appellant filed auxiliary requests 4-6. At the end of the oral proceedings, the board announced its decision.

VI. The appellant requests that the decision be set aside and a patent be granted based on a main request or one of auxiliary requests 1-3 filed with the grounds of appeal or 4-6 filed during oral proceedings. The further application documents on file are: description pages 1-94 as originally filed; drawing sheets 1-25 as originally filed.

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

"1. A service providing method wherein a communication apparatus (14) and a processing apparatus (11) communicate with each other in response to a service use request issued from said communication apparatus to provide a service to a user (A) of said communication apparatus, comprising the steps of: performing communication between a server apparatus (13) storing a program defining a process relating to said service and said communication apparatus (14) to judge if use of said program is permitted or not in response to said service use request; executing said program by said server apparatus (13) when use of said program is permitted; and performing communication between said server apparatus (13) and said processing apparatus (11) through said communication apparatus (14) in response to the execution of said program by said server apparatus to provide said service to said user, characterized in that among storage areas in said server apparatus (13), the server apparatus (13) stores said program relating to said service to be provided to a user (A) of said communication apparatus (14) in a storage area allocated in advance to said communication apparatus (14)."

VIII. Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the following passage is inserted before the characterising portion:

"; and while performing communication between said server apparatus (13) and said processing apparatus (11) through said communication apparatus (14), executing by said server apparatus (13) and said processing apparatus (11) a process relating to said service in collaboration with each other".

IX. Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in that the following paragraph is inserted after the first step (i.e. the step of performing communication):

"conducting by said processing apparatus (11) and said server apparatus (13) mutual authentication through said communication apparatus (14);"

X. Claim 1 of the third auxiliary request differs from claim 1 of the main request in that the following paragraph has been added at the end:

"wherein said communication apparatus (14) comprises an integrated circuit (21) and a communication circuit (20), and said processing apparatus (11) transfers said data with said integrated circuit (21) and used in service relating to the integrated circuit (21); the service providing method further comprising the steps of: transmitting by said integrated circuit (21) said use request of said program through said communication circuit to said server apparatus (13); when said integrated circuit (21) receives a use permission instruction, said processing apparatus (11) and said

server apparatus (13) conduct mutual authentication; after one another's legitimacy is confirmed, said processing apparatus and said server apparatus (13) communicate through said integrated circuit (21) and said communication circuit (20); and while said integrated circuit (21) relays said communication between said processing apparatus (11) and said server apparatus (13) conducted through said communication circuit (20), performing by said processing apparatus (11) and said server apparatus (13) a process relating to said service in collaboration with each other in response to the execution of said program by said server apparatus (13)."

XI. The sole claim (16) of the fourth auxiliary request reads:

"16. A communication method performing communication using a first communication apparatus (114) comprising an integrated circuit (121) and a communication circuit (120), a second communication apparatus (112) used in a service relating to said integrated circuit, and a third communication apparatus (113) storing a program defining a process relating to said integrated circuit (121) and executing the same, wherein after the first communication apparatus (114) and the second communication apparatus (112) have communicated, the method comprising the steps of: transmitting a use request of said program from said integrated circuit (121) to said third communication apparatus (113) through said communication circuit (120); conducting authentication between said integrated circuit (121) and said third communication apparatus (113) through said communication circuit (120); and conducting authentication between said second communication

apparatus (112) and said third communication apparatus (113) when the legitimacy of said integrated circuit (121) and said third communication apparatus (113) has been authenticated by the authentication thereof, and when said second communication apparatus (112) and said third communication apparatus (113) have authenticated one another's legitimacy by the authentication, executing by said third communication apparatus (113) said program relating to said use request, whereby said third communication apparatus (113) while communicating with the said second communication apparatus executes said service in collaboration with the said second communication apparatus in response to the execution of said program, characterized in that the authentication is mutual and in that the communication method further comprises a step of storing by said third communication apparatus (113) said program defining a process relating to said integrated circuit (121) in a storage area allocated in advance to said integrated circuit (121) among storage areas in said third communication apparatus (113)."

XII. The sole claim (16) of the fifth auxiliary request differs from claim 16 of the fourth auxiliary request in that the wording starting with "whereby said third communication apparatus" until the end of the claim is replaced by:

"whereby said second communication apparatus (112) and said third communication apparatus (113) communicate to be in collaboration with each other to thereby execute a process relating to the integrated circuit (121) in response to the execution of said program, characterized in that the authentication is mutual and in that the communication method further comprises a

step of storing by said third communication apparatus (113) said program defining a process relating to said integrated circuit (121) in a storage area allocated in advance to said integrated circuit (121) among storage areas in said third communication apparatus (113)."

XIII. The sole claim (1) of the sixth auxiliary request reads:

"1. A communication method performing communication using a first communication apparatus comprising an integrated circuit and a communication circuit, and a processing apparatus that transfers data with said integrated circuit and used in service relating to the integrated circuit, comprising the steps of:

transmitting by said integrated circuit a use request of said program through said communication circuit to a second communication apparatus storing a program defining a process relating to said service and executing the same;

executing by said second communication apparatus a program relating to said use request when it is judged that said use request is legitimate; and

while said integrated circuit relays communication between said processing apparatus and said second communication apparatus conducted through said communication circuit, performing by said processing apparatus and said second communication apparatus a process relating to said service in collaboration with each other in response to the execution of said program by said second communication apparatus,

wherein among storage areas in said second communication apparatus, the second communication apparatus stores said program relating to said service to be provided to a user of said first communication apparatus in a storage area allocated in advance to said first communication apparatus."

Reasons for the Decision

1. *Overview of the invention*

1.1 The invention relates to providing a service to a user of a "communication apparatus 14" (e.g. portable telephone 14 in figure 1 and in paragraph [64] of the A1 publication of the application) in the context of e-commerce, using an IC card 21 (not claimed) in the portable telephone ([2]-[3]; figure 1: 21). The service may involve "membership, electronic money, e-commerce, point accumulation, cash card, and credit card, and services relating to confirming and processing utilization rights of exiting a ticket barrier, entering and exiting, etc." ([82]) or "authentication of the person in question (individual), electronic money, e-commerce, and issuance of a ticket" ([87]). However, the nature of the service is not set out in the claims.

1.2 The essence of the method according to claim 1 of the *main request* and *auxiliary requests 1-3 and 6* can be summarised as follows:

(a) A "communication apparatus 14" (called "portable telephone apparatus 14" in the description) sends a

"service use request" to a "server apparatus 13" (also called "virtual IC storage area [providing] server apparatus 13" in figure 1, [76] and [158]) which stores a program relating to the "service use request".

- (b) In response to the service use request, server 13 and portable telephone 14 communicate with each other to "judge if use of said program is permitted or not in response to said service use request" (claim 1).
- (c) If the use of the program is permitted, it is executed on server 13 ([80]; [169]).
- (d) Then server 13 and a so-called "processing apparatus 11" (called IC R/W in figure 1) communicate with each other through portable telephone 14 to provide said service to the user ([86]-[87]).
- (e) Furthermore, server 13 stores the program in a storage area allocated in advance to portable telephone 14 ([102]-[103]) after the user has registered for the storage area at server 13 ([103]; [200]-[204]; not claimed) and for the program to be stored in that storage area (104; [214]-[230; also not claimed]).

1.3 Claim 1 of these requests relates to the *first embodiment* in the description ([62]-[243]). This can be seen from the reference numerals in claim 1 which relate to figure 1, illustrating the first embodiment (see [61], first sentence). Furthermore, the second embodiment, as illustrated in figure 18, does not

provide a connection between the portable telephone 114 and the server 113, as needed to perform steps (b) and (d) of claim 1.

1.4 The essence of the method according to claim 1 of *auxiliary requests 4 and 5* (relating to the *second embodiment*, [244]-[357]) can be summarised as follows:

- (a) A "first communication apparatus 114" (the "portable telephone apparatus 114" in figure 18) sends a "use request" for a program to a "third communication apparatus 113" (i.e. the server computer; also called "virtual IC storage area providing server apparatus 113" in figure 18) which stores the program.
- (b) The telephone 114 and the server 113 communicate for authentication. After successful authentication, a "second communication apparatus 112" (called "IC service providing apparatus 112" in figure 18) and the server 113 also communicate for authentication.
- (c) If the second authentication was successful, the program is executed on server 113.
- (d) In response to the execution, the server 113 communicates with the second communication apparatus 112 and executes "said service" in collaboration with the second communication apparatus 112.
- (e) Furthermore, server 113 stores the program in a storage area allocated in advance to portable telephone 114.

2. *Overview of the objections*

Claim 1 of all requests lacks clarity and support by the description (Article 84 EPC 1973).

Main request

3. *Clarity*

3.1 Claim 1 of the main request is identical to claim 1 of the refused main request which itself derived from a combination of original claims 1 and 2.

3.2 It is unclear what technical purpose *processing apparatus 11* set out in claim 1 serves. It is said in step (d) of the claim that communication between server 13 and processing apparatus 11 is performed through communication apparatus 14 (i.e. the portable telephone) in response to the execution of the requested program by server 13. It is however unclear which information is communicated, the more since, at this point, server 13 has already executed the requested program. It is further unclear which technical consequence this communication has. None is specified in the claim. It seems that processing apparatus 11 plays no part in achieving the objective of the claimed method, which seems to be that portable telephone 14 requests a program to be executed by server 13.

3.3 Therefore, claim 1 of the main request is unclear.

4. *Support by the description*

4.1 As stated above, claim 1 of the main request relates to the first embodiment which is disclosed in paragraphs [62]-[243] in the description. The first part of this disclosure ([62]-[72] and [83]-[153]) describes the *devices* used in the invention and their connections. The second part ([73]-[82] and [154]-[243]) describes the *procedures* used in the invention, entitled "example of the operation" ([73]) and "First" to "Fifth Operation Example[s]". It is in this second part that the board tried to find support for the method of claim 1 in order to understand the functioning of the claimed method (e.g. the role of processing apparatus 11).

4.2 However, none of these operation examples discloses the method of claim 1.

4.2.1 Example of the operation: [73]-[83] and figure 2

In this example, there is *no disclosure of step (b)* of performing communication between server 13 and communication apparatus 14 (portable telephone) to *judge* if use of the program is permitted or not, in response to the service use request. In fact, this passage does not disclose any judging between any parties, whether the program use is permitted or not.

Furthermore, the "virtual storage area use demand (service use demand of the present invention or a use demand)" in [76] does not correspond to the "service use request" of claim 1, since it does not specify the program chosen by the user. In contrast hereto, the "service use request" of the claim must contain the

chosen program, since otherwise step (b) of judging whether the program is permitted or not in response to the "service use request" could not be executed. It might be that the additional "application program selection instruction" (see step (3) in [78]) which is transmitted from portable telephone 14 to server 13 corresponds to the "service use request" of claim 1.

4.2.2 The First Operation Example: [154]-[171] and figure 13

The same objections apply to this example, i.e. there is also no disclosure of step (b) in [154]-[171].

4.2.3 The Second Operation Example: [172]-[196] and figure 14

Again, this example lacks any disclosure of step (b). Furthermore, the program is executed by IC 21 in portable telephone 14 (see [180]), rather than on server 13 as in step (c) of the claim. Thus there is also no disclosure of step (c) in this example.

4.2.4 The Third Operation Example: [197]-[213] and figure 15

This example is about the registration procedure for allocating a storage area on server 13 to portable phone 14. It neither discloses step (b) nor step (c).

4.2.5 The Fourth Operation Example: [214]-[230] and figure 16

This example concerns the procedure for registering a program in the storage area on server 13 allocated to portable telephone 14. It neither discloses step (b) nor step (c).

4.2.6 The Fifth Operation Example: [231]-[243] and figure 17

This example relates to the procedure for automatically registering a program in the storage area on server 13 allocated to portable telephone 14. It neither discloses step (b) nor step (c).

4.3 Therefore, claim 1 of the main request is not supported by the description.

Auxiliary requests 1-3

5. Since claim 1 of the auxiliary requests contains all features of claim 1 of the main request, the objections concerning lack of clarity and support by the descriptions apply equally to these auxiliary requests.

Fourth auxiliary request

6. The sole claim 16 of this request is based on claim 16 of the main request wherein the wording at the end starting from "whereby" is replaced by:

"whereby said third communication apparatus (113) while communicating with the said second communication apparatus executes said service in collaboration with the said second communication apparatus in response to the execution of said program, characterized in that the authentication is mutual and in that the communication method further comprises a step of storing by said third communication apparatus (113) said program defining a process relating to said integrated circuit (121) in a storage area allocated in advance to said

integrated circuit (121) among storage areas in said third communication apparatus (113)."

This wording is based on paragraph [260], last sentence (belonging to the second embodiment [244]-[357]).

7. However, as with the main request, it is unclear what technical purpose the second communication apparatus 112 (corresponding to the processing apparatus 11 in the main request/first embodiment) serves. It is said that the server 113 (third communication apparatus) executes said service in collaboration with the second communication apparatus 112 in response to the execution of said program. The collaboration is not further specified. It is furthermore unclear what is meant by "said service", since the program relating to the use request has already been executed by the server. What service should then be executed in addition?

Fifth auxiliary request

8. The sole claim 16 of this request is also based on claim 16 of the main request wherein the wording at the end starting with "whereby" is replaced by:

"whereby said second communication apparatus (112) and said third communication apparatus (113) communicate to be in collaboration with each other to thereby execute a process relating to the integrated circuit (121) in response to the execution of said program, characterized in that the authentication is mutual and in that the communication method further comprises a step of storing by said third

communication apparatus (113) said program defining a process relating to said integrated circuit (121) in a storage area allocated in advance to said integrated circuit (121) among storage areas in said third communication apparatus (113)."

This wording is based on paragraph [249], first sentence.

9. It is still unclear what technical purpose the second communication apparatus 112 serves. It is said that the second communication apparatus 112 and the server 113 (the third communication apparatus) communicate to be in collaboration with each other to thereby execute a process relating to the integrated circuit 121 in response to the execution of said program. The question again arises how a process should be executed by two computers in collaboration. This renders the claim unclear. The more, since the program is already executed.

Sixth auxiliary request

10. The sole claim 1 of this request relates to the first embodiment and is based on claim 7 as published (identical to originally filed claim 7). The following wording has been added at the end:

"wherein among storage areas in said second communication apparatus, the second communication apparatus stores said program relating to said service to be provided to a user of said first communication apparatus in a storage area allocated in advance to said first communication apparatus."

This wording is based on original claim 8.

11. The claim says in the paragraph before the cited wording that the processing apparatus (11) and the second communication apparatus (the server 13) perform a process relating to said service in collaboration with each other in response to the execution of said program by said second communication apparatus. This means that the same situation as with the main request is present here. Therefore, the same objections (see points 3.2 and 4.1-4.3) apply here.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



B. Atienza Vivancos

W. Sekretaruk

Decision electronically authenticated