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**Datasheet for the decision
of 19 June 2019**

Case Number: T 0403/16 - 3.4.03

Application Number: 08751167.1

Publication Number: 2149124

IPC: G07C9/00, G07F7/10

Language of the proceedings: EN

Title of invention:

APPARATUSES, SYSTEM AND METHOD FOR AUTHENTICATION

Patent Proprietor:

GenKey Netherlands B.V.

Opponent:

Safran Identity & Security

Headword:

Relevant legal provisions:

EPC Art. 101(2), 107, 111(1), 123(2)

Keyword:

Amendments - intermediate generalisation - added subject-matter (yes)

Decisions cited:

T 1341/04

Catchword:



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Case Number: T 0403/16 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 19 June 2019

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(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 11 December
2015 revoking European patent No. 2149124
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman G. Eliasson
Members: T. M. Häusser
G. Decker

Summary of Facts and Submissions

- I. The appeal of the proprietor concerns the decision of the opposition division revoking the European patent No. EP-B-2 149 124 for lack of clarity of the amendments (Article 101(3)(b) EPC).
- II. The opposition had been filed against the patent as a whole. Grounds of opposition were insufficiency of the disclosure, lack of novelty and lack of inventive step (Articles 100(a) and (b), 54 and 56 EPC).
- III. The oral proceedings took place without the duly summoned parties.

In writing the respondent (opponent) had requested that the appeal be dismissed.

The appellant (patent proprietor) had requested that the decision under appeal be set aside and is considered to have requested as a main request that the patent be maintained on the basis of the claims filed as "MAIN REQUEST" with the letter dated 24 September 2015 (see point 2.1 of the Reasons below).

On an auxiliary basis the appellant had requested that the decision be set aside and that the patent be maintained on the basis of the first or second auxiliary request, both filed with the letter dated 21 April 2016 setting out the grounds of appeal.

- IV. The wording of independent claim 1 of the various requests is as follows (board's labelling "(a)", "(b)", "(c)", "(d)", "(e)"):

Main request:

"1. A method for authenticating a candidate individual (101'), comprising the steps of:

obtaining candidate biometric data related to said candidate individual (101');

obtaining a first data item related to a first reference biometric data from a data carrier (108), wherein

(a) any significant part of said first reference biometric data is not readily available from said first data item;

obtaining a second data item related to said first reference biometric data from digital storage (106), wherein

(b) any significant part of said first reference biometric data is not readily available from said second data item,

(c) such that each of the first data item and second data item both reveal only a limited amount of information on the first reference biometric data,

(d) working out a second reference biometric data using said first data item and said second data item,

(e) by combining said first data item and said second data item resulting in said second reference biometric data; and

authenticating said candidate individual (101') when said candidate biometric data is determined to correspond to said first reference biometric data using said second reference biometric data and said candidate biometric data."

First auxiliary request:

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the following feature is added subsequent to feature (c):

"such that said limited amount of information of each of the first and second data item biometric data prevent to verify correspondence with an individual without knowing the other of first and second data item,"

Second auxiliary request:

"1. A method for authenticating a candidate individual (101') in a biometric template helper data system, comprising the steps of:

obtaining a first reference biometric data (X) from a reference individual 101, wherein said first reference biometric data (X) is a secure template derived from a biometric measurement (Z);

generating a first data item and a second data item using said first reference biometric data by splitting said first reference biometric data (X) into said first data item and said second data item;

storing said first data item on said data carrier (108); and

storing said second data item in said digital storage (106);

obtaining candidate biometric data (Y) related to said candidate individual (101') to be authenticated, wherein said candidate biometric data (Y) is a secure template derived from a biometric measurement (Z');

obtaining said first data item related to said first reference biometric data (X) from the data carrier (108), wherein any significant part of said first reference biometric data is not readily available from said first data item;

obtaining said second data item related to said first reference biometric data from digital storage (106), wherein any significant part of said first

reference biometric data is not readily available from said second data item;

working out a second reference biometric data (X') using said first data item and said second data item, by combining said first data item and said second data item resulting in said second reference biometric data (X'); and

authenticating said candidate individual (101') when said candidate biometric data (Y) is determined to correspond to said first reference biometric data (X) using said second reference biometric data (X') and said candidate biometric data (Y)."

- V. In relation to the basis for the amendments the parties put forth essentially the following:

The *respondent* argued that the subject-matter of features (c) and (e) of claim 1 of the main request extended beyond the content of the application as filed.

The *appellant* made no submissions in this respect.

Reasons for the Decision

1. Procedural issues

As announced in its letter dated 27 May 2019 the appellant did not attend the oral proceedings before the board. The duly summoned respondent did not attend the oral proceedings without advance notice.

In accordance with Rule 115(2) EPC and Article 15(3) RPBA, the oral proceedings were held without the parties. By their decision not to attend the oral proceedings, the parties have chosen not to make any

further submissions during such proceedings and are treated as relying only on their written case.

2. Main request

2.1 Appellant's main request

The board notes that the appellant requested in writing as a main request that the decision under appeal be set aside and "that the opposition is being rejected" (see the letter dated 21 April 2016, page 6, paragraph 1). This would normally be understood as a request for the maintenance of the patent as granted (see Article 101(2) EPC).

However, in the present case the appellant argued in relation to the main request on the basis of the claims of the sole request underlying the decision, i. e. the claims filed as "MAIN REQUEST" with the letter dated 24 September 2015. In particular, the appellant contested the examining division's decision as to lack of clarity of the claims and argued that features (c) and (e) added to granted claim 1 during the opposition proceedings were clear (see pages 4 to 6 of the letter dated 21 April 2016). These claims are therefore considered to form the basis of the main request as intended by the appellant. This was pointed out in the board's communication pursuant to Article 15(1) RPBA issued in preparation of the oral proceedings and was subsequently not denied by the appellant.

Hence, the board considers that it is the appellant's main request that the decision be set aside and the patent maintained on the basis of the claims filed as "MAIN REQUEST" with the letter dated 24 September 2015.

2.2 Amendments

2.2.1 In the decision under appeal the opposition division held that the amendments effected in relation to the claims of the main request fulfilled the requirements of Article 123(2) EPC. In particular, the amendments were based on paragraphs [0028], [0036], [0039], [0042], and [0043] of the patent and the added features (c) and (e) were not intrinsically linked to the functions E and D or to the ticketing scenario (see point 3 of the Reasons).

2.2.2 The respondent argued that the subject-matter of features (c) and (e) of claim 1 of the main request extended beyond the content of the application as filed. Feature (c) was closely tied to the construction of the function E, while feature (e) was presented in the context of ticketing and the function D. The omission of this context and of the function E constituted thus inadmissible intermediate generalisations.

The appellant made no submissions in this respect.

2.2.3 The board notes first that only the appellant was adversely affected by the decision under appeal and thus in a position to file an appeal against the decision (Article 107 EPC). Furthermore, re-opening the issue of compliance with Article 123(2) EPC cannot put the appellant in a worse position than if it had not filed the appeal and is therefore not contrary to the principle of the prohibition of *reformatio in peius* (see the decision T 1341/04, point 1 of the Reasons). This issue is therefore open for review by the board of appeal, even though in the decision under appeal the opposition division had reached a conclusion favourable for the appellant in this regard.

2.2.4 In the paragraph on page 7, lines 12-21, of the application as filed, which was pointed out by the respondent as a potential basis for feature (e) and corresponds to paragraph [0036] of the patent, the following is stated:

"Next M and K are combined using D resulting in X'."

The function D is thus used to combine the first data item K and the second data item M resulting in the calculated reference biometrical data X' and provides the rule for obtaining the result X' from the two input parameters K and M. The combination of the data items K and M is thus intrinsically linked to the function D.

Moreover, the regeneration function D may not be any arbitrary function, but has to be related to the generation function E and hence the reference biometrical data X in a specific way, essentially being the (possibly somewhat imperfect) inverse function of E. This is expressed in the following way on page 6, lines 28-30, of the application as filed:

"D is related to E in the sense that, using its inputs M and K it will output X' which contains a significant amount of information on X."

In this way a candidate individual 101' with candidate biometric data Y may be identified as the reference individual 101 by comparing the calculated reference biometrical data X' with the candidate biometric data Y. Without the above constraint on the regeneration function D such identification would not be possible.

Therefore the phrase cited above cannot serve as a valid basis for feature (e), in which it is claimed in broad terms that the first and second data items are combined without any indication of the function D and the nature of this function. Hence, feature (e) constitutes indeed an inadmissible intermediate generalisation in relation to the above disclosure in the application as filed.

There are no other parts of the application as filed from which feature (e) could be derived. In particular, some of the other cited paragraphs relate to detailed embodiments of the invention, in which the function D takes an even more specific form.

In view of the above, feature (e) is not directly and unambiguously derivable from the application as filed. Hence, the subject-matter of claim 1 of the main request extends beyond the application as filed, contrary to the requirements of Article 123(2) EPC.

3. First and second auxiliary requests

Claim 1 of the first and second auxiliary requests both contain features which are essentially identical (apart from an added reference sign) with feature (e). Hence, for the above reasons the subject-matter of claim 1 of the first and second auxiliary requests also extends beyond the application as filed, contrary to the requirements of Article 123(2) EPC.

4. Conclusion

Since the main request and the first and second auxiliary requests are not allowable, because the claimed

subject-matter extends beyond the application as filed,
the appeal is to be dismissed (Article 111(1) EPC).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Eliasson

Decision electronically authenticated