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**Datasheet for the decision
of 21 February 2023**

Case Number: T 3258/19 - 3.5.03

Application Number: 13871478.7

Publication Number: 2936859

IPC: H04W8/20, H04W12/04, H04W12/06

Language of the proceedings: EN

Title of invention:
SIM profile brokering system

Applicant:
Sprint Communications Company L.P.

Headword:
Replacing SIM identity data/SPRINT

Relevant legal provisions:
EPC Art. 123(2)
RPBA 2020 Art. 13(2)

Keyword:

Admittance of claim requests filed after summons - new main and first auxiliary requests (no): no exceptional circumstances - conclusions of T 1790/17 as to "exceptional circumstances" only partly followed
Added subject-matter - main request and 1st to 4th auxiliary requests (yes)

Decisions cited:

T 0135/17, T 1790/17, T 2613/18, T 1213/19



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Case Number: T 3258/19 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 21 February 2023

Appellant: Sprint Communications Company L.P.
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 24 July 2019
refusing European patent application
No. 13871478.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair K. Bengi-Akyürek
Members: J. Eraso Helguera
R. Romandini

Summary of Facts and Submissions

I. The appeal was lodged against the decision of the examining division to refuse the present European patent application for added subject-matter (Article 123(2) EPC) and for lack of inventive step (Article 56 EPC) with respect to a main request and three auxiliary requests.

II. Oral proceedings before the board were held on 21 February 2023.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of one of seven claim requests: a **replacement main request** and a **replacement first auxiliary request**, both filed in response to the board's communication under Article 15(1) RPBA 2020, a **main request** and **first to third auxiliary requests**, all four requests being subject to the appealed decision and being re-submitted with the statement setting out the grounds of appeal, and a **fourth auxiliary request** filed with the statement setting out the grounds of appeal.

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

III. Claim 1 of the **replacement main request** reads as follows:

"A method for receiving identity information for a mobile communication device (110), the method comprising:

establishing, by an application (114) of the mobile communication device, a secure wireless communication link (130) between the application and an identity server (120), wherein the application on the mobile communication device is configured to retrieve, for a single memory module on the mobile communication device, only identity information from the identity server over the secure wireless communication link, wherein the identity information is a device identifier and an authentication key;

receiving, by the single memory module (112a, 112b) on the mobile communication device, over the secure wireless communication link (130), at least one instance of the identity information (122a, 122b, 122c);

replacing identity information that had previously been provided to the memory module with the received identity information, wherein the memory module is one of a subscriber identity module (SIM), a universal integrated circuit card (UICC), a universal subscriber identity module (USIM), or a removable identity module (R-UIM)."

Claim 1 of the **replacement first auxiliary request** reads as follows:

"A method for receiving identity information for a mobile communication device (110), the method comprising:

establishing, by an application (114) of the mobile communication device, a secure wireless communication link (130) between the application and an identity server (120), wherein the application on the mobile communication device is configured to retrieve, for a single memory module on the mobile communication device, only identity information from the identity

server over the secure wireless communication link, wherein the identity information is a device identifier and an authentication key;

receiving, by the single memory module (112a, 112b) on the mobile communication device, over the secure wireless communication link (130), at least one instance of the identity information (122a, 122b, 122c);

accessing portions of the memory module that store identity information that had previously been provided to the memory module and replacing the identity information that had previously been provided to the memory module with the received identity information, wherein the memory module is one of a subscriber identity module (SIM), a universal integrated circuit card (UICC), a universal subscriber identity module (USIM), or a removable identity module (R-UIM);

wherein the secure wireless communication link restricts the application to accessing only the identity server within a secure network."

Claim 1 of the **main request** reads as follows:

"A method for receiving identity information for a mobile communication device (110), the method comprising:

establishing, by an application (114) of the mobile communication device, a wireless communication link (130) to an identity server (120), wherein the application permits over-the-air updateability of identity information on the mobile communication device, and wherein the identity information comprises a device identifier and an authentication key;

receiving, by a single memory module (112a, 112b) on the mobile communication device, over the wireless

communication link (130), at least one instance of identity information (122a, 122b, 122c);

replacing identity information that had previously been provided to the memory module with the received identity information, wherein the application permits access to the device identifier and authentication key which had previously been provided to the memory module, and wherein the memory module is one of a subscriber identity module (SIM), a universal integrated circuit card (UICC), a universal subscriber identity module (USIM), or a removable identity module (R-UIM)."

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

"A method for receiving identity information for a mobile communication device (110), the method comprising:

establishing, by an application (114) of the mobile communication device, a wireless communication link (130) to an identity server (120), wherein the application permits over-the-air updateability of identity information on the mobile communication device, and wherein the identity information comprises a device identifier and an authentication key, wherein the identity information is the only information that can be provided over the wireless communication link;

receiving, by a single memory module (112a, 112b) on the mobile communication device, over the wireless communication link (130), at least one instance of identity information (122a, 122b, 122c);

replacing identity information that had previously been provided to the memory module with the received identity information, wherein the application permits access to the device identifier and authentication key

which had previously been provided to the memory module, and wherein the memory module is one of a subscriber identity module (SIM), a universal integrated circuit card (UICC), a universal subscriber identity module (USIM), or a removable identity module (R-UIM)."

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

"A method for receiving identity information for a mobile communication device (110), the method comprising:

establishing, by an application (114) of the mobile communication device, a secure wireless communication link (130) to an identity server (120), wherein the application on the mobile communication device allows the retrieval of identity information over the secure wireless communication link from the identity server, and wherein the identity information comprises a device identifier and an authentication key;

receiving, by a single memory module (112a, 112b) on the mobile communication device, over the secure wireless communication link (130), at least one instance of identity information (122a, 122b, 122c);

replacing identity information that had previously been provided to the memory module with the received identity information, wherein the memory module is one of a subscriber identity module (SIM), a universal integrated circuit card (UICC), a universal subscriber identity module (USIM), or a removable identity module (R-UIM)."

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

"A method for receiving identity information for a mobile communication device (110), the method comprising:

establishing, by an application (114) of the mobile communication device, a secure wireless communication link (130) to an identity server (120), wherein the application on the mobile communication device allows the retrieval of only identity information over the secure wireless communication link from the identity server, and wherein the identity information comprises a device identifier and an authentication key;

receiving, by a single memory module (112a, 112b) on the mobile communication device, over the secure wireless communication link (130), at least one instance of identity information (122a, 122b, 122c);

replacing identity information that had previously been provided to the memory module with the received identity information, wherein the memory module is one of a subscriber identity module (SIM), a universal integrated circuit card (UICC), a universal subscriber identity module (USIM), or a removable identity module (R-UIM)."

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

"A method for receiving identity information for a mobile communication device (110), the method comprising:

establishing, by an application (114) of the mobile communication device, a secure wireless communication link (130) to an identity server (120), wherein the application on the mobile communication device allows

the retrieval of only identity information over the secure wireless communication link from the identity server, wherein the identity information is a device identifier and an authentication key;

receiving, by a single memory module (112a, 112b) on the mobile communication device, over the wireless communication link (130), at least one instance of identity information (122a, 122b, 122c);

replacing identity information that had previously been provided to the memory module with the received identity information, wherein the memory module is one of a subscriber identity module (SIM), a universal integrated circuit card (UICC), a universal subscriber identity module (USIM), or a removable identity module (R-UIM)."

Reasons for the Decision

1. REPLACEMENT MAIN AND FIRST AUXILIARY REQUESTS

Claim 1 of the **replacement main request** comprises the following limiting features (board's outline and emphasis of the amendments vis-à-vis claim 1 of the main request on file):

A method for receiving identity information for a mobile communication device, the method comprising:

- (a) establishing, by an application of the mobile communication device, a secure wireless communication link between the application and an identity server,
- (b) the application on the mobile communication device is configured to retrieve, for a single memory module on the mobile communication device,

- only identity information from the identity server over the secure wireless communication link,
- (c) the identity information is a device identifier and an authentication key;
 - (d) receiving, by the single memory module on the mobile communication device, over the secure wireless communication link, at least one instance of the identity information;
 - (e) replacing identity information that had previously been provided to the memory module with the received identity information,
 - (f) the memory module is one of a SIM, an UICC, an USIM, or an R-UIM.

Claim 1 of the **replacement first auxiliary request** comprises all the limiting features of claim 1 of the replacement main request and the following additional features (board's outline):

- (g) accessing portions of the memory module that store identity information that had previously been provided to the memory module,
- (h) the secure wireless communication link restricts the application to accessing only the identity server within a secure network.

1.1 Admittance into the appeal proceedings (Article 13(2) RPBA 2020)

1.1.1 The claims of the replacement main and first auxiliary requests were filed after notification of the summons to oral proceedings before the board.

1.1.2 Hence, the admittance of these requests is governed by Article 13(2) RPBA 2020. According to this provision any amendment to a party's appeal case is not taken

into account, unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned. Moreover, when applying Article 13(2) RPBA 2020, the board may, in the exercise of its discretion, also rely on criteria mentioned in Article 13(1) RPBA 2020, such as clear allowability.

1.1.3 The appellant submitted the following arguments in support of the admittance of the above replacement claim requests:

(a) Amendments had been made to the independent claims of the **replacement main request** as a reaction to added-matter objections provided in the summons. Those amendments further clarified subject-matter already in the previously submitted claims and further tied the claimed subject matter to passages of the description cited in the summons. They were an appropriate reaction to objections of the summons and did not present a "fresh case". Further, since the claims of the replacement main request were largely based on a previously submitted request and further clarified claimed subject-matter to provide additional consistency between the claims and the description/claims as filed, the request did not in any way increase the technical and procedural complexity of the case. To the contrary, the replacement main request would only serve to increase efficiency in discussions during oral proceedings. Additionally, in the summons, the board cited new paragraphs of the prior-art document used in the decision to allege that the skilled person would have arrived at the subject-matter of claim 1 without exercising any inventive skills.

- (b) Furthermore, amendments and arguments of the **replacement first auxiliary request** were made as a reaction to added-matter objections provided in the summons as well as new remarks concerning the alleged lack of inventive step made in the summons. The amended claims provided a further clarification to features of the claim in view of these newly cited paragraphs. The replacement first auxiliary request did not in any way increase the technical and procedural complexity of the case either. To the contrary, it would only serve to increase efficiency in discussions during oral proceedings.

- (c) The requests met the "exceptional circumstances" criterion within the meaning of Article 13(2) RPBA 2020 as interpreted in decision T 1790/17, Reasons 7 as well as T 135/17, Reasons 5.1.

1.1.4 The board is not persuaded by these arguments.

- (a) The fact that the board cited, in its preliminary opinion on inventive step, additional passages of a prior-art document which the examining division already considered in the appealed decision in assessing inventive step cannot be considered as a "new" objection. Even if it was, this fact cannot *per se* amount to "exceptional circumstances" within the meaning of Article 13(2) RPBA 2020, as this board, in the same composition, explained in T 2613/18, Reasons 4.2.4.

- (b) The circumstances of the case at hand are not the same as in the above decisions cited by the appellant.

- In **T 1790/17-3.5.01**, a new auxiliary request was filed as a direct reaction following the exchange of arguments during the oral proceedings. Further, the board considered that this request overcame the grounds on which the appealed decision was based, and remitted the case to the examining division for further prosecution.

At any rate, this board follows the conclusions of that decision only insofar as the purpose of the oral proceedings for the appellant is indeed to better explain its case and for the board to understand and clarify points which, perhaps, up to that point were not sufficiently clear (cf. catchword). However, the main function of a hearing cannot be to present and discuss newly filed claim requests, as apparently suggested by the decision at hand, even if they somehow "address the objections and concerns the Board had". Under the RPBA in force, the appellant must present its full case in writing, and in particular in *ex parte* proceedings, already with the statement of grounds of appeal. The *right to be heard* does not justify a derogation from this principle and the filing of claim requests belatedly. In fact, with respect to oral proceedings, the *right to be heard* relates only to the opportunity for an appellant in an *ex parte* case to present orally arguments relating to the requests already made in the written part of the underlying proceedings. If the board, moreover, has communicated a preliminary opinion based on the written submissions on file, the purpose of the oral proceedings for the party concerned will mainly be to explain why this opinion is wrong on the basis of the submissions and evidence already on file (see also the recent case T 1213/19,

Reasons 19). It cannot be, however, the purpose of a hearing to allow the applicant to try out a new case by presenting yet another amended set of claims somehow in a "trial-and-error" fashion for finally defining its actual "invention". In other words, during oral proceedings before a board, the applicant typically obtains merely yet another (maybe a last) opportunity to present its arguments with a view to eventually convince the board that the board's provisional findings are incorrect and that its preliminary opinion is thus to be overturned.

- The other cited decision, **T 135/17-3.5.03**, concerns an *inter partes* case in which the opponent did not object to the admittance of an amended set of claims of a second auxiliary request into the proceedings. Furthermore, the board did not have any objections against its allowability, neither *prima facie* nor following a substantive examination. The amendments did moreover not increase the technical and procedural complexity of the case.
- (c) In the present case, the board is not convinced that the amendments made to the replacement main and first auxiliary requests distinctly overcome the outstanding added-matter objections, without giving rise to new ones. In other words, the board does not consider these requests to be clearly allowable under at least Article 123(2) EPC:
- Firstly, it is not immediately apparent that the present application actually discloses that it is the "application" that *establishes* a secure wireless communication link *between the application*

and an identity server feature as required by feature (a). Instead, paragraph [0005] of the original application literally discloses (emphasis added) that

"the application is configured to use the cellular radio transceiver to establish a secure wireless communication link between the mobile communication device and an identity server",

which rather hints at the "radio transceiver" establishing the secure wireless communication link (cf. also paragraph [0033] as filed) between *the mobile communication device* (rather than the application) and an "identity server". Moreover, paragraph [0027] does not describe the establishment of the "secure, over-the-air communication link between the application and the identity server". In addition, original claim 3 merely indicates that the application is "configured to establish the wireless communication link to an identity server", without specifying between which entities this is done. Original claim 9, on the other hand, refers to "a secure wireless communication link between the identity server and *the mobile communication device*" (emphasis added).

- Secondly, it is not manifestly disclosed that the present application should be *configured to retrieve only* identity information from the identity server as per feature (b) of claim 1. Paragraph [0027] indicates that "the only information that the application may be allowed to retrieve over the secure communication link may be a device identifier and an authentication key".

However, this paragraph conveys the teaching that the application should be denied the retrieval of certain pieces of information, presumably by the "identity server", rather than the "application" itself being actively configured to enforce restrictions in respect of the information to be retrieved.

1.2 Accordingly, the board cannot see "exceptional circumstances", which have been justified with "cogent reasons", in the present case. Thus, neither the replacement main request nor the replacement first auxiliary request were admitted into the appeal proceedings (Article 13(2) RPBA 2020).

2. MAIN REQUEST

Claim 1 comprises the following limiting features (board's outline):

A method for receiving identity information for a mobile communication device, the method comprising:

- (i) establishing, by an application of the mobile communication device, a wireless communication link to an identity server,
- (j) the application permits over-the-air updateability of identity information on the mobile communication device,
- (k) the identity information comprises a device identifier and an authentication key;
- (l) receiving, by a single memory module on the mobile communication device, over the wireless communication link, at least one instance of identity information;

- (m) replacing identity information that had previously been provided to the memory module with the received identity information,
- (n) the application permits access to the device identifier and authentication key which had previously been provided to the memory module,
- (o) the memory module is one of a SIM, a UICC, a USIM, or an R-UIM.

2.1 *Claim 1 - added subject-matter (Article 123(2) EPC)*

- 2.1.1 In Reasons 15.1 and 15.2.1 of the appealed decision, the examining division indicated *inter alia* the following deficiencies in present claim 1:

Claim 1 had been amended by introducing features (i), (j) and (k), which allegedly had a basis in previous claims 2 and 6 (original claims 3 and 11) and paragraphs [0027] to [0029] of the application as published. These features did not include the limitation in original claim 3 and in paragraph [0027] that the application retrieves the identity information, which constituted an unallowable intermediate generalisation.

- 2.1.2 The appellant provided the following counter-arguments:

It was clear from features (i) and (l) that the application on the mobile communication device created a wireless communication link between the mobile communication device and the identity server. Furthermore, it was clear that the identity information was retrieved from the identity server over the wireless communication link and was received by a single memory module on the mobile communication device. Therefore, the skilled person would have

appreciated, with the benefit of the present disclosure, that the "application" which established the wireless communication link essentially acted as an intermediary between the mobile communication device and the identity server. Hence, the "application" would have retrieved the device identifier and authentication key from the identity server. This information was then received by the single memory module on the mobile communication device.

2.1.3 These arguments are not convincing, for the following reasons:

Both claim 3 and paragraph [0027] of the original application explicitly specify that the [identity retrieval] application retrieves the device identifier and the authentication key, i.e. the identity information according to feature (k). In contrast, claim 1 requires no involvement of the application in the retrieval of the identity information beyond the establishment of the wireless communication link in feature (i) and the "permissions" according to features (j) and (n).

Hence, this subject-matter encompasses embodiments that are not disclosed in the application as filed, i.e. embodiments in which the retrieval of the identity information is not carried out by the "application".

2.2 If follows that the main request is not allowable under Article 123(2) EPC.

3. FIRST TO FOURTH AUXILIARY REQUESTS

Claim 1 of the **first to fourth auxiliary requests** comprises *inter alia* features (i), (k), (l) and (m) of

claim 1 of the main request. Furthermore, claim 1 of the **second to fourth auxiliary requests** includes the following additional feature:

(p) the application on the mobile communication device allows the retrieval of identity information over the secure wireless communication link from the identity server.

3.1 *Claim 1 - added subject-matter (Article 123(2) EPC)*

3.1.1 The reasoning of point 2.1.3 above applies *mutatis mutandis* to claim 1 of each of the first to fourth auxiliary requests, given that claim 1 of those requests requires no involvement of the "application" in the actual retrieval of the identity information.

3.1.2 The appellant submitted, in the context of the fourth auxiliary request, that "allow(s) the retrieval" according to feature (p) was to be interpreted as "promote the retrieval" or "mediate the retrieval", both of them being literally disclosed in paragraph [0034] of the original application, rather than "permit the retrieval".

3.1.3 This argument is not convincing either. Firstly, "allow" cannot be considered to be the same as "promote" or "mediate" in general. Secondly, paragraph [0034] of the original application read in its entirety (cf. last sentence) still requires the application to "retrieve" instances of the identity information rather than merely "allow" their retrieval.

3.2 Hence, none of the first to fourth auxiliary requests is allowable under Article 123(2) EPC either.

4. Since there is no allowable claim request on file, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated