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**Datasheet for the decision
of 15 November 2021**

Case Number: T 1891/20 - 3.5.03

Application Number: 14824813.1

Publication Number: 3087767

IPC: H04W8/18

Language of the proceedings: EN

Title of invention:

Method for accessing a service and a corresponding device

Patent Proprietor:

Thales Dis France SA

Opponents:

IDEMIA France
Giesecke+Devrient Mobile Security GmbH
Giesecke & Devrient GmbH

Headword:

Switching subscriptions/THALES

Relevant legal provisions:

EPC Art. 54, 56, 104(1), 105(1)(a), 108, 128(4)
EPC R. 99(2), 144(d), 151
RPBA 2020 Art. 10(6), 12(6), 13(2), 16(1)

Keyword:

Admissibility of intervention - (yes): coordination of procedural acts by opponents and/or interveners is not vexatious or illegitimate

Admissibility of appeals - (yes): distinction between admissibility of an appeal vs. admittance of late-filed submissions

Abuse of procedure - (no): referring to evidence provided by other parties is no "abuse of procedure"

Inventive step - main request (no)

Admittance of claim request filed after summons - (no): no exceptional circumstances

Apportionment of costs - (no)

Exclusion of documents from file inspection - annexes 3 and 4 (yes): prejudicial to the parties' legitimate personal or economic interests

Decisions cited:

G 0003/97, G 0001/19, J 0014/19, T 0305/08, T 2069/15,
T 0752/16, T 2429/17, T 0247/20



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Case Number: T 1891/20 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 15 November 2021

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
10 September 2020 concerning maintenance of the
European Patent No. 3087767 in amended form.

Composition of the Board:

Chair K. Bengi-Akyürek
Members: J. Eraso Helguera
N. Obrovski

Summary of Facts and Submissions

I. This case concerns the appeals filed by both opponent 1 (IDEMIA France, "appellant I") and opponent 2 (Giesecke+Devrient Mobile Security GmbH, "appellant II") against the decision of the opposition division maintaining the patent in amended form in accordance with a main request filed during opposition proceedings. Furthermore, a notice of intervention was filed by Giesecke+Devrient GmbH ("intervener") thereafter.

II. In its decision, the opposition division cited *inter alia* the following prior-art documents:

E1: GSMA Association: "Remote Provisioning Architecture for Embedded UICC Technical Specification", Version 1.0, Official Document 12FAST.15, 17 December 2013;

E3: WO 2013/093182 A1.

III. Documents **E1^{***}**, **E17**, **E18**, **E18^{*}**, **E19**, **E19^{*}** and **E20** relating to telecommunication standards were cited *inter alia* in the appeal proceedings. Furthermore, the respondent referred to the following evidence:

Annex 1: Excerpt of the Commercial Register (Munich District Court, HRB 224694);

Annex 2: Excerpt of the Commercial Register (Munich District Court, HRB 4619);

Annex 3: Notarised spin-off and transfer agreement (GD MS & GD CT);

Annex 4: e-mail thread of a conversation between Mr. Cassage (Thales Dis) and Mr. Branzka (G+D) about cross licence agreement.

IV. Appellants I and II and the intervener requested that the decision under appeal be set aside and that the patent be revoked.

Appellant II and the intervener further requested a different apportionment of costs.

The final requests of the proprietor ("respondent") were

- that the appeals and the intervention be rejected as inadmissible or dismissed as unallowable (**main request**) or, in the alternative,
- that the patent be maintained on the basis of the claims of the **auxiliary request** filed with the reply to the board's communication under Article 15(1) RPBA 2020
- a different apportionment of costs
- the exclusion from file inspection of Annexes 3 and 4 to their reply to the notice of intervention
- a partial reimbursement of the appeal fee paid by them in view of the withdrawal of their initial appeal.

At the end of the oral proceedings before the board held on 15 November 2021, the board's decision was announced.

V. Claim 1 of the **main request**, i.e. the claims of the main request underlying the decision under appeal, reads as follows:

"A method (20) for accessing a service,

including, a device (12) comprising a chip, the chip comprising data storing means, the data storing means storing at least two subscriptions, a first subscription being active, at least one second subscription being non-active, the data storing means storing a subscription manager, the method includes the following ordered steps:

- the subscription manager receives, from a remote server, a request (22) for switching to the second subscription, as a subscription to be activated;
- the subscription manager including a first variable (23) relating to a next active subscription, the subscription manager sets the first variable to the second subscription;
- the subscription manager sends to the device operating system a message (210) for requesting the device operating system to re-launch an execution of the subscription manager and to read data;
- the device operating system sends to the subscription manager a message (212) including a command for re-launching an execution of the subscription manager;
- the subscription manager de-activates, based upon the first variable value, the first subscription;
- the subscription manager activates, based upon the first variable value, the second subscription; and
- the subscription manager sends to the device operating system data (214) relating to the second subscription, as a current active subscription."

Claim 1 of the **auxiliary request** reads as follows (board's underlining indicating amendments vis-à-vis claim 1 of the main request):

"A method (20) for accessing a service,
including, a device (12) comprising a chip, the chip comprising data storing means, the data storing

means storing at least two subscriptions, a first subscription being active, at least one second subscription being non-active, the data storing means storing a subscription manager, the method includes the following ordered steps:

- the subscription manager receives from a remote server, after the remote server has sent it, a request (22) for switching to the second subscription, as a subscription to be activated;
- the subscription manager including a first variable (23) relating to a next active subscription, the subscription manager sets the first variable to the second subscription;
- once the first variable is set, the subscription manager sends the device (12) operating system some data (26) as a message for requesting the device (12) operating system to read data;
- once the device (12) operating system has received and interpreted the data (26), the device (12) sends the chip (14) a command (28), such as "FETCH", as a system tool kit, STK, type command for receiving data
- once the chip (14) receives the command (28) for receiving data, the subscription manager sends to the device operating system a message (210) for requesting the device operating system to re-launch an execution of the subscription manager and to read data;
- the device operating system sends to the subscription manager a message (212) including a command for re-launching an execution of the subscription manager;
- the subscription manager de-activates, based upon the first variable value, the first subscription;
- the subscription manager activates, based upon the first variable value, the second subscription;
- the subscription manager sends to the device operating system data (214) relating to the second subscription, as a current active subscription; and

- the device stores the received data relating to the second subscription, as the current active subscription."

Reasons for the Decision

1. Admissibility of the intervention (Article 105 EPC)

1.1 The respondent requested that the intervention be dismissed, for the following reasons:

- i) During the licence negotiations following the appealed decision, the intervener claimed to be equivalent to appellant II, so that they would automatically inherit the rights of appellant II in the framework of a legal agreement concerning, *inter alia*, the patent under dispute. In fact, the main representative of appellant II in the cross-licence agreement was Mr. Branzka, which was listed in an e-mail of 25 January 2017 as Director of Patents/Licences for the intervener, while successive e-mails of the same thread defended the position of appellant II. The identity between both appellant II and intervener was reinforced by the fact that the notice of intervention was filed in the name of the intervener, but with the *same* address and the *same* representative as the notice of opposition of appellant II filed two years earlier. The position of the intervener was contradictory. On the one hand, they tried to defend that appellant II "does not qualify as a different party" from the intervener on a cross-licence agreement signed by the intervener but, on the other hand, tried to defend that the intervener and appellant II were different entities

that should have rights as different parties to the opposition proceedings.

ii) The intervener claimed that the notice of intervention found basis in the legal proceedings instituted against appellant II and the intervener before the German court. However, the respondent was forced to sue both appellant II, having the technological assets, and the intervener, their successor in title, for the sake of completeness of the legal demand and due to the financial operation carried out by the intervener. The intervener, by filing a notice of intervention, was taking advantage of this financial operation for their own benefit. The intervener's actions, not the respondent's, were the reason why proceedings were opened against both companies. In fact, the lawsuit was made for both companies in the *same* action by the same document on 29 July 2020, not by two *separate* actions.

1.2 The respondent concluded that the intervener should not be considered as a "third party" on account of their self-proclaimed identity in terms of patent licences, so that there was no reason to consider that they should be treated as *different* parties in the opposition proceedings. Furthermore, allowing this intervention would cause a serious and unfair balance as to the chances of each of the parties of the opposition proceedings, as clearly shown by the fact that appellant II had used, in these appeal proceedings, the new documents introduced by the intervener in the notice of intervention.

The respondent further submitted that the intervener was a company which belonged to the *same* group of

companies as appellant II and had shown an undeniable and very close connection thereto. In this context, the intervener claimed their right to intervene in a procedure which had already been closed, trying to introduce new evidence, which had been subsequently used by appellant II to submit arguments against a claim which had been examined without taking into account those documents. Moreover, appellant II had had the opportunity to file them in the opposition proceedings, and had deliberately withheld them to file them in the name of a company of the same group, with whom the IP staff is shared. If the appeal was settled with the patent being maintained, nothing would prevent the G+D group from creating another company and transferring to these new company some relevant assets, thus forcing the respondent to incorporate them in the infringement lawsuit, providing this new company the legal instrument to claim intervention in the opposition proceedings. Such behaviour should clearly be considered as an "abuse of procedure".

The respondent further stated that appellant II and the intervener, i.e. a non-appellant, had a *common representative*. The latter had made submissions in a *single* document which concerned both of these parties. This could lead to procedural problems, for example if the intervention was deemed inadmissible.

1.3 The board considers the intervention admissible for the following reasons:

1.3.1 A "third party" within the meaning of Article 105(1) EPC is a party which is different from the parties to the proceedings before the EPO. Opponents are parties to the opposition proceedings (Article 99(3) EPC) and to the subsequent appeal proceedings (Article 107 EPC).

Thus, a *third party* within the meaning of Article 105 EPC can only be a party which does not have the status of an "opponent".

- 1.3.2 The status of "opponent" is a procedural status and the basis on which it is obtained is a matter of *procedural* law. The question of whether an opponent's acts accord with the intentions or instructions of a third party has no bearing in this context (G 3/97, Reasons 2.1).
- 1.3.3 In the present case, the intervener did not have the status of an "opponent" in the opposition proceedings. In particular, the intervener is a legal entity which is *separate* from appellant II. This has not been disputed by the respondent.
- 1.3.4 In T 305/08, it was stated that "any third party" in Article 105(1) EPC cannot be given an interpretation other than that each party must be a *separate* legal entity, and that this also applies to an intervention filed by a legal entity belonging to the *same* group of companies as the opponent (Reasons 1.5.2). Considering the allegations that this would effectively allow an opponent to belatedly file further oppositions and new evidence (Reasons 1.5.5) and that the patent department of one company could file oppositions on behalf of the other companies (Reasons 1.5.6), it was concluded that such an intervention did not amount to a circumvention of the law by "abuse of due process" (Reasons 1.5.8). The board concurs with these findings.
- 1.3.5 The respondent's reference to appellant II's statements on the interpretation of certain terms in a cross-licence agreement has no bearing on the intervener's status as a *third party*. As pointed out above, the latter is a matter of *procedural* law only.

- 1.3.6 If a right is exercised for a purpose other than its intended legal purpose, this can constitute an "abuse of rights". This is in particular the case if no *legitimate interests* are pursued and if a right is primarily exercised to cause harm. "Abuse of rights" must be established beyond reasonable doubt; the burden of proof is on the party claiming any such *abuse of rights* (cf. J 14/19, Reasons 13.1).
- 1.3.7 The fact that appellant II (and appellant I, who has not been alleged to be part of the same group of companies) refer to documents introduced by the intervener (i.e. E17 to E19*) with the notice of intervention does not amount to an *abuse of rights*. It is neither vexatious nor illegitimate if opponents and/or interveners coordinate their actions within the limits of the applicable procedural framework. Rather, a party trying to increase their chances of success by referring to prior-art documents which have been introduced by another party is pursuing a "legitimate interest". In the present case, this did not lead to an unfair position either.
- 1.3.8 The respondent has not provided any proof of their allegation that appellant II had had the opportunity to file the new documents cited in the notice of intervention already in the opposition proceedings, but deliberately withheld them to file them later in the name of another company belonging to the same group of companies.
- 1.3.9 As to the respondent's objection to appellant II and the intervener having a *common representative*, the board refers to Rule 151 EPC, according to which parties may appoint a common representative. As such,

the appointment of a common representative for two *opponents* is not different from the appointment of a common representative for an *opponent* and an *intervener*. In both cases, the commonly represented parties may, if considered on their own, be in a different situation as to the admittance of their submissions. This, however, does not prevent them from appointing a common representative.

- 1.4 In view of the above, the intervention is admissible.
 - 1.5 The board additionally points out that the possible "procedural problems" referred to by the respondent remain insofar hypothetical as the board's conclusions on the merits of the case (see points 3 and 4 below) do not contain any reference to the new documents E17 to E19* cited in the notice of intervention.
2. *Admissibility of the appeals (Article 108 EPC and Rule 99(2) EPC)*
- 2.1 Under the heading "Inadmissibility of appeals", the respondent submitted that appellants I and II had included in their statements of grounds of appeal a series of new evidence: appellant II's statement of grounds of appeal included documents **E17, E18, E18***, **E19 and E19*** and appellant I showed their adherence to the new documents and arguments submitted in appellant II's statement of grounds of appeal, and further introduced document **E20**. These documents were not part of the opposition proceedings, were not considered by the opposition division in the decision under appeal and therefore should not be introduced into the appeal proceedings. Furthermore, there were some grounds for opposition invoked by appellants I and II that were not part of the decision under appeal and

that should be disregarded according to Article 12(6) RPBA 2020:

- i) Appellant II introduced a *fresh ground* by questioning the admissibility of the amendments introduced by the respondent during the first-instance oral proceedings (Article 123(2) EPC), since these amendments were not objected in those oral proceedings.
- ii) Appellant II introduced a *fresh ground* by questioning the feasibility of the opposed patent (Article 83 EPC). Section 4.1 of the decision under appeal contained a clear statement concerning this ground.
- iii) Appellants I and II introduced *fresh grounds* by questioning the amendments made (Article 123(2) EPC), the clarity of the opposed patent (Article 84 EPC), and the admissibility of the changes (Rule 80 EPC). Sections 3.2 and 5.1 of the decision under appeal contained a clear statement concerning this ground. As stated by the minutes (point 19), no objections concerning Article 123(2) *[sic]* EPC were raised by any of the opponents (now appellants). This was repeated again (point 21 of the minutes) when the chairman invited the opponents to express any objection other than Article 52(1) EPC (and explicitly mentions Article 123(2) EPC). The rest of the procedure (since the submission of the last main request) did not contain any discussion other than the one concerning novelty and inventive step. Clarity had not even been invoked.
- iv) Appellant II introduced a *fresh ground* by questioning the novelty (Article 54 EPC) of claim 1

over either of **E1** and **E17**. This ground had not been discussed in the decision under appeal either.

2.2 The respondent's arguments concern the board's discretion under Article 12(6) RPBA 2020 not to admit certain pieces of evidence and objections rather than the admissibility of the respective appeals as a whole under Article 108, third sentence, EPC and Rule 99(2) EPC. Questions of admittance of allegedly late-filed submissions and the admissibility of an appeal should not be mixed up (see e.g. T 2069/15, Reasons 4). With regard to the latter, the board does not see any convincing reasons why the appeals of appellants I and II should be considered inadmissible under Rule 99(2) EPC. Moreover, as to the application of Article 12(6) RPBA 2020, the pieces of evidence and the objections referred to by the respondent as "fresh grounds" do not have any impact on the board's considerations on the merits of the case (see points 3 and 4 below). Hence, their admittance does not have to be discussed.

3. Allowability of the MAIN REQUEST

Claim 1 of the **main request** comprises the following limiting features (outline used in the appealed decision):

(f1) A method for accessing a service,

(f2) including, a device comprising a chip, the chip comprising data storing means,

(f3) the data storing means storing at least two subscriptions, a first subscription being active, at least one second subscription being non-active,

- (f4) the data storing means storing a subscription manager, the method includes the following ordered steps:
- (f5) the subscription manager receives, from a remote server, a request for switching to the second subscription, as a subscription to be activated;
- (f6) the subscription manager including a first variable relating to a next active subscription, the subscription manager sets the first variable to the second subscription;
- (f7) the subscription manager sends to the device operating system a message for requesting the device operating system to re-launch an execution of the subscription manager and to read data;
- (f8) the device operating system sends to the subscription manager a message including a command for re-launching an execution of the subscription manager;
- (f9) the subscription manager de-activates, based upon the first variable value, the first subscription;
- (f10) the subscription manager activates, based upon the first variable value, the second subscription;
- (f11) the subscription manager sends to the device operating system data relating to the second subscription, as a current active subscription.

For illustration purposes, the board reproduces a modified version of Figure 2 of the opposed patent, annotated in accordance with the outline used:

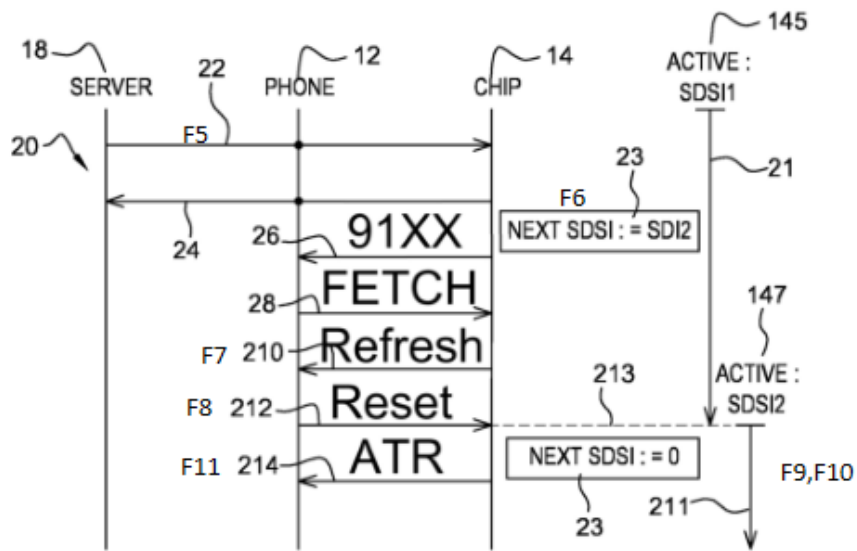


Fig. 2

3.1 Claim 1 - novelty in view of E3 (Article 54 EPC)

3.1.1 For illustration purposes, the board includes a modified version of Figure 5 of **E3** annotated in accordance with the outline used:

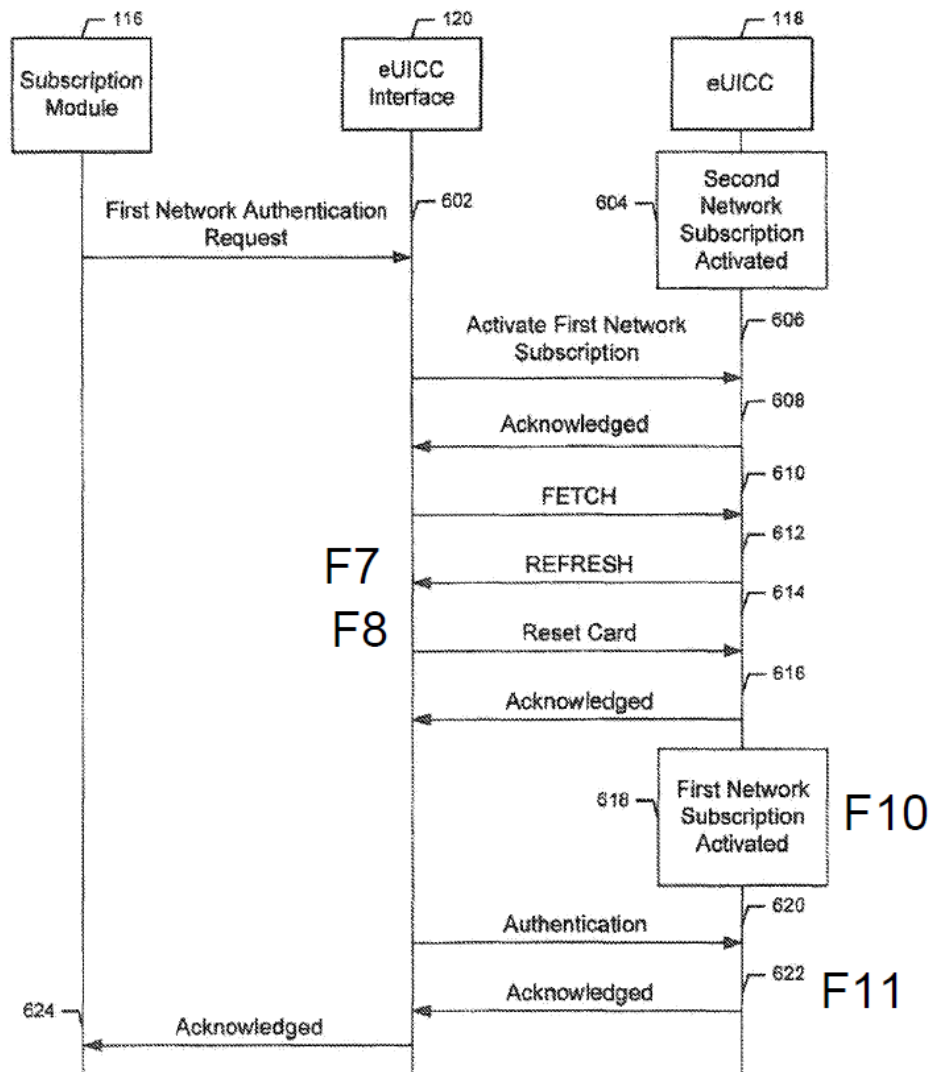


FIG. 5

3.1.2 Document **E3** discloses a method for accessing a service carried out by a device comprising a chip (Fig. 5: "eUICC 118"), the chip comprising data storing means storing at least two subscriptions, a first subscription being active (Fig. 5: "Second Network Subscription Activated 606"), at least one second subscription being non-active, the data storing means storing a subscription manager. This corresponds to

features **(f1)** to **(f4)**. The method according to E3 includes the following ordered steps:

- the eUICC Interface receives a first network authentication request from the network (Fig. 5: "First Network Authentication Request 602");
- the subscription manager receives, from the eUICC interface, a signal to activate a first network subscription (Fig. 5: "Activate First Network Subscription 606");
- the subscription manager includes a first variable relating to a next active subscription, the subscription manager sets the first variable to the second subscription (page 17, lines 26-28: "... the eUICC 118 may be configured to cause the second network subscription to be deactivated and the first network subscription to be activated ...") (feature **(f6)**);
- the subscription manager sends to the device operating system a message (Fig. 5: "REFRESH 612") for requesting the device operating system to re-launch an execution of the subscription manager and to read data (feature **(f7)**);
- the device operating system sends to the subscription manager a message including a command (Fig. 5: "Reset Card 614") for re-launching an execution of the subscription manager (feature **(f8)**);
- the subscription manager activates (Fig. 5: "First Network Subscription Activated 618"), based upon the first variable value, the second subscription (feature **(f10)**);
- the subscription manager de-activates (page 18, lines 6-7: "As is shown in box 618, the first network subscription is activated and the second network subscription is deactivated after

signals 606-618 ..."), based upon the first variable value, the first subscription (feature **(f9)**);

- the subscription manager sends to the device operating system data (Fig. 5: "Acknowledged 622") relating to the second subscription, as a current active subscription (feature **(f11)**).

3.1.3 Thus, the board concurs with the opposition division that the subject-matter of claim 1 differs from the disclosure of **E3** in feature **(f5)** and in that the step of feature **(f9)** is not disclosed to be performed *before* the step of feature **(f10)**.

3.1.4 Appellants I and II and the intervener argued that the "First Network Authentication Request 602" of E3 disclosed feature **(f5)** and that the statement on page 17, lines 26-28 of E3 ("... the eUICC 118 may be configured to cause the second network subscription to be deactivated and the first network subscription to be activated as is shown in signals 606-616 ...") specifically disclosed the step of feature **(f9)** being performed before the step of feature **(f10)**.

3.1.5 This is not convincing, for the following reasons:

First, the board notes that the "First Network Authentication Request 602", according to page 17, lines 23-34 of E3, "may have been received via the communications interface 114 and/or may have been received from a network operator". Disregarding the fact that a "server" is not explicitly mentioned, this request signal only causes a switch to the first network subscription when the second network subscription is currently activated. At any rate, the skilled reader would, at best, infer from the overall

teaching of E3, in particular from page 17, lines 20-28, that a sort of subscription switch *may* implicitly be triggered by such a "network authentication request". However, this is not sufficient to lead the skilled reader to *directly and unambiguously* derive feature (f5) from E3.

Second, the introductory statement on page 17, lines 26-28 explicitly refers ("as is shown in") to signals 606-616 in Figure 5. The subsequent paragraphs give a detailed explanation of those signals and the order in which they are exchanged, concluding on page 18, lines 6-7 that (emphasis added) "... the second network subscription is deactivated **after signals 606-618**". Signal 618 corresponds to the step "First Network Subscription Activated". In the board's view, the introductory statement on page 17, lines 26-28, refers to one and the same embodiment, as shown in Figure 5, and is not meant to imply any particular technical constraint with respect to the *order* of execution of the activation/deactivation steps. This specific information is "shown in" the next paragraphs. Deriving from the introductory statement that the second network subscription is deactivated *before* the first network subscription is activated would be at odds with the opposite statement on page 18, lines 6-7. For this reason alone, E3 cannot be considered to *directly and unambiguously* disclose the claimed order of features **(f9) and (f10)**.

- 3.1.6 The respondent submitted that E3 disclosed neither feature **(f9)** nor feature (f10), since no de-activation of the *first* network subscription was found. The only "de-activation" found was referred to the *second* network subscription, as it was precisely to "prepare the device" to fulfil the condition of feature (f3).

The same act could not be considered as disclosing the fulfilment of feature (f3) and then to disclose the feature (f8), and further when it was referred to a different element (i.e. the second network subscription). As a result, there was no reason to consider that document E3 disclosed feature (f9) *after* the disclosure of feature (f8). In fact, feature (f9) was not disclosed, either *after* or *before* feature (f8), and, in the absence of a de-activation, a subsequent activation as per feature (10) could not be present either. The excerpts cited by the opposition division (E3, page 17, lines 26-27 and page 18, lines 6-7) were previous to the "reset" steps, so they should not be relevant to assess the disclosure of feature (f9) in the order required by feature (f4).

3.1.7 This is not persuasive. Document E3, page 18, lines 6 and 7 reads (emphasis added):

*"As is shown in box 618, the **first** network **subscription** is **activated** and the **second** network **subscription** is **deactivated** after signals 606-618."*

Feature (f8) corresponds to the "Reset Card" of Fig. 5, step 614. Hence, E3 explicitly discloses features (f9) and (f10) after the performance of feature (f8), albeit not in the claimed order.

3.2 The subject-matter of claim 1 is therefore new (Article 54 EPC) in view of **E3**.

3.3 *Claim 1 - inventive step starting out from E3*
(Article 56 EPC)

3.3.1 The board concurs with the opposition division that the combination of the two differences identified between

the subject-matter of claim 1 and the disclosure of E3 (i.e. feature **(f5)** and the order of execution of the steps of features **(f9)** and **(f10)**) does not produce any apparent synergistic technical effect going beyond the sum of their individual technical effects. It follows that these two differences, at best, give rise to two different, unrelated partial technical problems which must be assessed independently. The respondent agreed to this view in their reply to the board's preliminary opinion (see page 15, fifth paragraph: "As agreed by the Opposition Division and the Board, these two features do not share a common technical effect, so they give rise to two partial technical problems.").

*Re **feature (f5)***

- 3.3.2 In point II.7.2.3.2 of the decision under appeal, the opposition division accepted the technical effect and the objective technical problem formulated by the opponents. The latter was enounced as follows: "how to increase the area of application of document E3" (see point II.7.2.1.1 of the decision under appeal).
- 3.3.3 The opposition division considered that in E3 the network merely sent normal authentication requests and/or calls notifications (paging) and it was up to the device, and not to the network, to intelligently select the correct subscription and to trigger a switch based on the received request. The teaching of E3 was therefore relying on a network which was not involved in the process of managing/selecting/switching subscriptions on a terminal. It was questionable that the skilled person - starting from E3 and faced with the alleged generic problem of expanding or improving its area of application and being aware of E1 - would have transferred to the network the management of the

subscription, which in E3 was only performed by the terminal.

- 3.3.4 However, the board does not see any technical effect resulting from **feature (f5)** other than explicitly triggering a subscription switch following a request from a "remote server" instead of implicitly triggering such a subscription switch following an authentication request from a "network operator" as done in **E3**. Moreover, in Figures 1 to 6 of E3, the subscription management system 102 is embodied as a mobile terminal. E3 mentions other alternatives on page 5, lines 23-29 (emphasis added):

*"The subscription management system 102 may be embodied as a desktop computer, laptop computer, ..., **one or more servers**, one or more network nodes, ..., **any combination thereof, and/or the like**. In an example embodiment, the subscription management system 102 is embodied as a mobile terminal, such as that illustrated in Figure 2."*

Furthermore, E3 states on page 13, lines 15-20, the following (emphasis added):

*"... In operation, the processor 110, **the subscription module 116** or the like, **may be configured to switch between subscriptions based on user requests, network requests**, data changes and/or the like. For example, in an instance in which the processor 110, the subscription module 116 or the like requests access to a subscription that is not involved with active communications, the subscription module 116 may*

then be configured to switch to another subscription."

It is also well-known that, in physical SIM cards, the Integrated Circuit Card Identifier, ICCID, is already embedded in the chip as of its marketing, without any network involvement. However, remote management of subscription profiles is an integral part of the eUICC specification. Hence, to the extent eUICCs are mentioned in E3, the network must at least be able to enable, disable and delete subscription profiles in such an eUICC. It was well-known at the opposed patent's priority date that remote management functions in the networks mentioned in E3 (GSM, UMTS, LTE, CDMA2000) required the intervention of one or more remote servers, usually under the control of the network operator(s) providing the subscription(s). Faced with the task of implementing a switch between available subscriptions when the remote management system includes remote components, it would have been straightforward to have a "remote server" send a "network request" specifically built for this purpose. Consequently, feature (f5) cannot contribute to inventive step.

- 3.3.5 The respondent argued that (i) the "network request" should not be understood by the skilled person as a request made by the network and (ii) the skilled person would have not considered that the eUICC of document E3 had remote abilities, since the whole disclosure of document E3 reinforced the concept that the subscription management was done *locally*. There were no requests coming from the network: there were only "authentication requests", which triggered an internal process of subscription management in the eUICC. This would have been incoherent from the teaching of E3,

because as seen from the network, both subscriptions were activated under the "principles of dual SIM". Hence, the skilled person would have been taught away to modify the disclosure of document E3 in this sense.

- 3.3.6 The board disagrees. E3 includes (i) an explicit teaching that the subscription management system may comprise "one or more servers" and that the switch between subscriptions may be based on network requests (as opposed to user requests) and (ii) an implicit teaching that eUICCs must allow *remote management*. As explained above, in view of these teachings, the contribution of feature (f5) is to be regarded as a mere straightforward implementation of an option explicitly hinted at in E3. The fact that E3 concerns "dual SIM" is irrelevant: the claim bears no limitation with respect to the number of networks to which the terminal may be simultaneously attached, and E3 still requires a switch of subscriptions involving activation of one subscription and deactivation of another one.

*Re execution order of **features (f9) and (f10)***

- 3.3.7 In point II.7.2.3.1 of the decision under appeal, the opposition division acknowledged the technical effect and the objective technical problem formulated by the opponents. The latter was framed as "how to implement the activation/deactivation in E3 in an economical way in a chip which has limited processing resources" (see point II.7.2.1.2 of the decision under appeal).
- 3.3.8 The respondent submitted that this problem was not mentioned in document E3 and that this circumstance did not seem to be a problem in document E3. According to the approach of document E3, it made no sense to state that the mobile phone faced a resources issue when

trying to manage two subscriptions at the same time, because document E3 was specially focused on managing two subscriptions and to listen to two different networks at the same time to receive the "authentication request". The skilled person would not have been prompted to look for a solution in the order of these steps, since this document did not mention that the order of these steps had any effect. The order of the steps was as irrelevant as not being mentioned in Figure 5: the de-activation step did not have any reference number in the description. It was just performed "after steps 606-618". The skilled person was taught "well, in fact, if it is not performed, the method is not affected".

3.3.9 The board agrees with the respondent in that no assumption can be made with respect to the processing power of the chip of E3 and in that the execution order of the steps of features **(f9)** and **(f10)** appears to be irrelevant and devoid of any particular technical effect. For this very reason, changing the order of execution in E3 so as to have the step of feature **(f9)** executed before the step of feature **(f10)** amounts to an arbitrary design alternative without any credible technical implication which could solve any realistic technical problem. It is however established jurisprudence of the Boards of Appeal that, if the invention does not solve a technical problem, it has no distinguishing features which could contribute to inventive step (see e.g. G 1/19, Reasons 49).

3.4 In conclusion, the **main request** is not allowable under Article 56 EPC.

4. Admittance of the AUXILIARY REQUEST

Claim 1 of the present auxiliary request comprises all the limiting features of claim 1 of the main request and the following additional limitations (board's outline and highlighting):

- (f5bis) the request of feature (f5) is received after the remote server has sent it;
- (f6bis) once the first variable is set, the subscription manager sends the device operating system some data as a message for requesting the device operating system to read data;
- (f6tris) once the device operating system has received and interpreted the data, the device sends the chip a command [, such as FETCH,] as a system tool kit, STK, type command for receiving data;
- (f7bis) step (f7) takes place once the chip receives the command for receiving data;
- (f12) the device stores the received data relating to the second subscription, as the current active subscription.

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

4.1.1 The claims of the auxiliary request were filed *after* notification of the summons to oral proceedings before the board. The above amendments to claim 1 were apparently made in response to the objections under Article 123(2) EPC mentioned in the board's preliminary opinion (cf. point 6.3 of that opinion).

- 4.1.2 The admittance of this auxiliary request is governed by Article 13(2) RPBA 2020, according to which any amendment to a party's appeal case is, in principle, not taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned. 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.
- 4.1.3 The respondent *inter alia* referred to T 2429/17, Reasons 2.2, and submitted that the objections raised by the board in the preliminary opinion had been *new* objections for the respondent, who had not had, until that moment, any chance to provide any reply to them. The respondent had immediately and specifically addressed those new objections by submitting a *single* auxiliary request, as a precautionary measure in case that the main request would not be allowed at the oral proceedings before the board. Concerning the submitted statements of grounds of appeal, the respondent did not know the position of the board with respect to the highly extensive list of objections raised by appellants I and II. Also, the decision under appeal had been favourable to the respondent. Therefore, filing one precautionary auxiliary request per objection would have been clearly against the principles of economy of process and conciseness. As a result, the respondent had preferred to wait until the board decided which of those objections were relevant to file a single targeted auxiliary request to address said objections.
- 4.1.4 These reasons are not considered cogent. First, this board, in a different composition, explained in T 752/16 (Reasons 3.4), that, as a matter of principle,

a party must expect a negative preliminary opinion from the board at any time before the decision of the board is announced. A proprietor should not withhold amendments in reaction to objections raised by an opponent until being confronted with a negative preliminary opinion of the board. Second, the arguments on patentability in the board's preliminary opinion addressed the same issues (i.e. under Articles 54 and 56 EPC) with respect to the same evidence (i.e. document E3) as the opposition division in its decision and the appellants in their respective statements of grounds of appeal. The respondent's statement that "... [t]heir arguments on patentability issued by the Appellants were not the same as the ones raised by the Board ..." does not explain which arguments are meant and why they would constitute a "new objection" which would not fall under objections previously raised by a party. In any case, as parties may refine their arguments within the previously established framework without this automatically constituting an amendment of their appeal case (cf. T 247/20, Reasons 1.3), the same principle applies all the more to a board taking up and refining arguments introduced by a party.

- 4.1.5 Moreover, the auxiliary request has not been demonstrated to be *prima facie* allowable. In particular, the respondent did not demonstrate how the amendments according to the auxiliary request should overcome the issue of inventive step starting out from E3. Rather to the contrary, the respondent stated the following in point 3.4.2 of their reply to the board's communication pursuant to Article 15(1) RPBA 2020 (board's highlighting):

"The inventive step of claim 1 of the auxiliary request finds basis in the same arguments as the

inventive step of the main request, so, for the sake of procedural economy, these arguments will not be repeated again in this section."

In Figure 5 of E3, the message "Acknowledged 608" triggers a "FETCH 610" command before the "REFRESH 612". This corresponds to features **(f6bis)**, **(f6bis tris)** and **(f7bis)** in claim 1. As regards feature **(f12)**, the eUICC interface 120 in the terminal at least temporarily stores the message "Acknowledged 622" (feature **(f11)**) received from the eUICC. Also, feature **(f5bis)** addresses issues with respect to added subject-matter rather than adding anything of substance to the inventive-step discussion. In line with the respondent's view, inventive step as regards the subject-matter of claim 1 of the *auxiliary request* must therefore indeed be assessed in the same way as inventive step for the subject-matter of claim 1 of the *main request*. Since the main request is not allowable under Article 56 EPC, the amendments in the auxiliary request cannot overcome, *prima facie*, the objection under Article 56 EPC.

- 4.2 Accordingly, the auxiliary request was not admitted into the appeal proceedings (Article 13(2) RPBA 2020).
5. As there is no allowable set of claims, the patent is to be revoked.
6. *Apportionment of costs (Article 104(1) EPC, Article 16 RPBA 2020)*
 - 6.1 Pursuant to Article 104(1) EPC, each party must bear the costs it has incurred unless a different apportionment of costs is justified for reasons of equity (see also Article 16(1) RPBA 2020).

6.2 Appellant II requested apportionment of costs on the following grounds:

- i) The claims of the main request that was maintained by the opposition division should not have been admitted into the opposition proceedings.
- ii) There would have been no need to file the appeal, had the respondent maintained their initial submissions with respect to **E1**. However, the respondent had then unexpectedly argued that the opposed patent was standard-essential and that it disclosed all the steps of Fig. 15 of **E1*****, which was identical to Fig. 14 of **E1**. This behaviour was at odds with the *principle of good faith*. In order to maintain legal security, appellant II had to file an appeal in order for the board to examine the two contradictory views of the respondent.

6.3 Appellant II and the intervener further submitted that different interpretations of a single disclosure showed a lack of good faith.

6.4 The board is not convinced, for the following reasons:

- i) The admittance by the opposition division of the main request does not constitute a *substantial procedural violation*, and even if it did, this would not necessarily entitle the appellant to a compensation beyond the reimbursement of the appeal fee under Rule 103(1)(a) EPC.
- ii) The fact that the respective Figures 14 are identical in **E1** and **E1***** does not mean that the disclosure of the documents is identical, especially if the NOTE which appears at the

beginning of page 49 of E1*** (but not in E1) is considered. It is further debatable whether the skilled person would read from E1, without the note, the same shortcomings which are made explicitly apparent in E1***. Moreover, there is no general obligation for a party not to amend their views on the interpretation of a claim or a prior-art document.

6.5 The respondent requested apportionment of costs on the following grounds:

- i) The appellants, despite the clarity of the opposition division's opinion (which had to deal with a multitude of objections raised by the opponents), now insisted on re-opening the debate before the board, with *new documents* and *fresh grounds*, which were not allowed and caused the respondent to invest time and effort responding to all of them. This should be considered as an "abuse of procedure", not by the *respondent*, as claimed by appellant II, but by the *appellants* instead.
- ii) Further, appellant II had surprisingly requested that their costs be reimbursed, while the respondent suffered the consequences of the attitude of the appellants. It was also noticeable that appellant I justified the request to expedite the proceedings and, in the same (and extensive) document, insisted on objecting to every action taken by the respondent, including grounds that were not even questioned or disputed by the appellants during the opposition proceedings. This acceleration of the proceedings had also been prejudicial for the respondent, which had been

forced to deal with their extensive statements of grounds of appeal within a short period.

6.6 This is not convincing either:

- i) As indicated in point 2.2 above, except for document **E20**, which is meant to illustrate the common technical knowledge, the new documents were filed by the *intervener*, not by the *appellants*. In any case, neither filing new evidence nor invoking fresh grounds on appeal constitutes *per se* an "abuse of procedure" within the meaning of Article 16(1) (e) RPBA 2020, and the board cannot identify any other particular circumstances that would justify the requested apportionment of costs.
- ii) The board sent copies of the statements of the grounds of appeal to the respondent with a four-month time limit for filing replies, as is customary in regular, non-accelerated proceedings. Moreover, the acceleration of the appeal proceedings pursuant to Article 10(6) RPBA 2020 did not affect the respondent's right to be heard.

6.7 In conclusion, the board refuses the requests for a different apportionment of costs.

7. *Exclusion of Annexes 3 and 4 from file inspection (Article 128(4) EPC)*

7.1 The respondent, in agreement with the other parties to the appeal proceedings, requested that **Annexes 3 and 4** to their reply to the notice of intervention be *excluded* from file inspection. **Annex 3** concerns contract documents related to the organisational structure of appellant II and the *intervener*. **Annex 4**

concerns an e-mail exchange related to licence negotiations under a non-disclosure agreement.

7.2 The minimum requirement under Article 128(4) EPC and Rule 144(d) EPC that "such inspection would not serve the purpose of informing the public about the European patent application or the European patent" is fulfilled with regard to Annexes 3 and 4.

7.3 Article 1(2)(a) of the Decision of the President of the EPO of the European Patent Office dated 12 July 2007 concerning documents excluded from file inspection further states that "documents or parts thereof ... shall be excluded from file inspection at the reasoned request of a party or his representative if their inspection would be prejudicial to the legitimate personal or economic interests of natural or legal persons". This further condition is fulfilled as well, since Annexes 3 and 4 concern bilateral contract documents and an e-mail exchange subject to a non-disclosure agreement. The parties' common interest in excluding these documents from file inspection is thus legitimate.

7.4 Consequently, **Annexes 3 and 4** to the respondent's reply to the notice of intervention are to be excluded from file inspection.

8. *Reimbursement of the appeal fee paid by the respondent (former appellant III)*

In view of the respondent's withdrawal of their initial appeal, the conditions for the requested reimbursement of the appeal fee are fulfilled.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The requests for apportionment of costs are refused.
4. The appeal fee paid by the respondent is reimbursed at 50%.
5. Annexes 3 and 4 to the respondent's reply to the notice of intervention are excluded from file inspection.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated