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D E C I S I O N
of 15 February 2000

Case Number: T 0721/98 - 3.5.1

Application Number: 89300117.2

Publication Number: 0328232

IPC: H04L 9/00

Language of the proceedings: EN

Title of invention:
Public key/signiture cryptosystem with enhanced digital signature certification

Patentee:
Fischer, Addison M.

Opponent:
Alcatel SEL AG Zentralbereich Patente und Lizenzen
GIESECKE & DEVRIENT GmbH

Headword:
-

Relevant legal provisions:
EPC Art.

Keyword:
"Article 123(2) EPC - satisfied (new claim 1 put forward on appeal)"
"Article 111(1) EPC - decision re appeals - remittal (yes)"

Decisions cited:
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Catchword:

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0721/98 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 15 February 2000

Appellant: (Proprietor of the patent)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 30 March 1998**

revoking European patent No. 0 328 232 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: R. S. Wibergh
S. C. Perryman

Summary of Facts and Submissions

I. This is an appeal by the proprietor of European Patent No. 0 328 232 against the decision of the Opposition Division to revoke the patent.

II. Respondent 1 had opposed the patent on the grounds mentioned in Article 100(a) EPC, Respondent 2 on the grounds mentioned in Article 100(a),(c) EPC.

III. According to the decision, amended claim 1 according to the then main request contained matter which extended beyond the content of the application as filed. This matter had been present also in claim 1 as granted. Thus, the requirements of Article 123(2) EPC were not met, which was a ground for opposition under Article 100(c) EPC. The same objection was made in respect of the three auxiliary requests before the Opposition Division.

IV. The patent proprietor (appellant) lodged an appeal against this decision, arguing that the decision was not justified and requesting that oral proceedings be held. A new claim 1 was filed.

V. In reply to the grounds of appeal, Respondent 1 noted that the decision concerned only the admissibility of the amendments. No comments were made on this issue. Oral proceedings were requested as an auxiliary measure.

VI. Respondent 2 raised a number of objections against the new claim 1, in particular under Article 123(2) EPC. Oral proceedings were requested as an auxiliary

measure.

VII. On 26 April 1999 the appellant filed a new claim 1. It read as follows (omitting the reference signs):

In a communication system having a plurality of terminal devices coupled to a channel over which users of said terminal devices may exchange messages, at least some of said users having a public key and an associated private key, a method for managing authority by digitally signing and digital signature certifying a digital message to be transmitted to an independent recipient comprising the steps of:

- generating at least a portion of said digital message;

- digitally signing at least said portion of said message with a user's private key;

- associating with said message as part of the digitally signed portion thereof, an authorizing digital certificate for the associated public key of the respective user, said authorizing digital certificate having a plurality of digital fields created by a certifier, said authorizing certificate being created by the steps of:

- specifying, in at least one of said digital fields, the public key of the certifier who digitally signs said authorizing digital certificate and

- including in other of said digital fields an

antecedent certificate of an antecedent certifier for said certifier, said antecedent certificate specifying the public key of said antecedent certifier who digitally signed his antecedent certificate,
characterized in that

- in said at least one of said digital fields, there is included also a specification of the authority which is vested in the certifier and which has been delegated to the respective user;

- in said other of said digital fields there is included also a specification of the authority which has been granted to said certifier from said antecedent certifier; and

- on the side of an independent recipient of said message, an analysis of the information in said plurality of digital files takes place for determining that the authority exercised by the respective user in signing the content of the message created by him was properly exercised by the user in accordance with the authority delegated by the certifier and that the certifier had been granted the authority to grant said delegated authority.

VIII. In a subsequent letter the respondent clarified that this claim should form the basis for further discussion.

IX. In a communication of the Board, the opinion was expressed that claim 1 had been unambiguously limited

to methods involving certification in terms of digital signature techniques. It therefore seemed that the sole reason for the revocation had been removed and that the case should be remitted to the Opposition Division for further prosecution on the basis of the current patent documents. The parties were asked to state whether under these circumstances they maintained their requests for oral proceedings.

X. In reply to this communication all three parties withdrew their requests for oral proceedings provided that the Board would decide in accordance with the views expressed in the communication.

Reasons for the Decision

1. The invention concerns the encryption of messages sent electronically over a communication channel. It is often required that a recipient of a message should be able to confirm that the sender is actually the person named in the text. To achieve this, "digital signature" techniques have been developed (see eg page 3, lines 12 to 15 of the opposed patent). The present invention is directed to a method for managing authority by digitally signing such a message.

2. Although several objections based on different grounds of opposition had been raised by the respondents, the Opposition Division decided only that claim 1 had been amended in such a way that the patent contained subject-matter extending beyond the content of the application as filed. The examination by the Board will

be correspondingly limited.

3. The Opposition Division held that in claim 1 as granted the "general formulation of the features of including sufficient digital information in the authorizing digital certificate for verifying by electronic analysis the authority and the authority to grant a delegated authority" had no support in the original application. Disclosed was according to the Opposition Division only certification in terms of digital signature techniques. In referring to the certificate as "containing sufficient digital information" for analysis, claim 1 had been generalised in a way which contravened Article 123(2) EPC.

4. In the present main claim the expression "by including sufficient digital information" has been deleted and the following feature added: "specifying... the public key of the certifier who digitally signs said authorizing digital certificate".

5. Due to these amendments the Opposition Division's objection that claim 1 is directed to more ways of certification than using digital signature techniques is, in the Board's judgment, no longer applicable. There is thus no need for the Board to decide whether the decision under appeal was justified or not.

6. Since the decision contained no further reasons for the revocation, the case is remitted to the first instance in order to continue the examination.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance for further prosecution.

The Registrar: The Chairman:

M. Kiehl P. K. J. van den Berg