

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of 7 June 2011**

Case Number: T 0036/08 - 3.4.03

Application Number: 98925685.4

Publication Number: 0993662

IPC: G07F 7/08

Language of the proceedings: EN

Title of invention:

Procedure for the control of applications stored in a
subscriber identity module

Patentee:

TeliaSonera Finland Oyj

Opponent:

Swisscom (Schweiz) AG

Headword:

-

Relevant legal provisions:

EPC R. 99(2), 101(1)

Relevant legal provisions (EPC 1973):

EPC Art. 84, 54

Keyword:

"Appeal of patent proprietor rejected as inadmissible"
"Novelty denied"

Decisions cited:

G 0004/93

Catchword:

-



Case Number: T 0036/08 - 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 7 June 2011

Appellant: Swisscom (Schweiz) AG
(Opponent) CH-3050 Bern (CH)

Representative: Weiland, Andreas
Patents & Technology Surveys SA
Rue de Terreaux 7
CH-2001 Neuchâtel (CH)

Appellant: TeliaSonera Finland Oyj
(Patent Proprietor) Teollisuuskatu 15
FI-00510 Helsinki (FI)

Representative: Simmelvuori, Markku Kalevi
Papula Oy
P.O. Box 981
FI-00101 Helsinki (FI)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
30 October 2007 concerning maintenance of
European patent No. 0993662 in amended form.

Composition of the Board:

Chairman: G. Eliasson
Members: V. L. P. Frank
P. Mühlens

Summary of Facts and Submissions

I. These are appeals by the patent proprietor and the opponent against the maintenance of EP 0 993 662 in amended form on the basis of the 1st auxiliary claim request filed during the oral proceedings before the opposition division (Article 102(3) EPC 1973).

The patent was opposed in its totality. Grounds of opposition were lack of novelty and inventive step (Article 100(a), 54 and 56 EPC 1973).

On appeal these objections were pursued together with an objection of lack of clarity (Article 84 EPC 1973) against claim 1 in the version maintained by the opposition division.

II. As announced with the letter dated 4 Mai 2011 the appellant proprietor was not represented at the oral proceedings before the board.

The appellant proprietor requested in writing that the decision under appeal be set aside and that the patent be maintained as granted.

The appellant opponent requested that the decision under appeal be set aside, that the patent be revoked and that the appeal of the appellant proprietor be rejected as inadmissible.

III. The independent claim of the patent as maintained by the opposition division reads (the differences with respect to the granted version of the claim are highlighted by the board):

"1. Procedure for the control of applications stored in a subscriber identity module in a data communication system comprising a data communication network (4), a terminal device (MS) connected to the data communication network, a subscriber identity module (SIM) connected to the terminal device and containing a stored application that makes use of the data communication network and is used by means of the terminal device, and an application control server (1) connected to the data communication network, characterized in that

a key list comprising ~~one or more~~ subscriber and application-specific keys stored in the subscriber identity module (SIM);

a key list corresponding to the key list stored in the subscriber identity module is stored in the application control server, and

the application stored in the subscriber identity module is activated and/or closed using the key list;

the procedure thereby providing centralised implementation of key control."

IV. The following prior art document was cited *inter alia* in the opposition procedure:

D6: WO 92 13322 A

V. In the decision under appeal the opposition division found that:

- None of the cited documents disclosed a key list stored in the application control server which corresponds to the key list stored in the subscriber identity module, thereby providing centralised implementation of key control. Thus, the application key control system could be totally separated from the telephone operator key control system and every use of an application could be controlled by the centralised application server. Document D6 was concerned by the internal customization of a multi application smart card and was silent about application servers.

VI. The grounds of appeal of the appellant proprietor reads under the heading "Grounds for the appeal":

"The patentee hereby respectfully appeals to the Interlocutory decision in the Opposition proceedings in which the main request was not allowed. The patentee argues that the invention disclosed in claim 1 of the main request comprises also an inventive step. Therefore, the main request should be allowed."

VII. The appellant opponent argued essentially as follows:

- The feature "the procedure thereby providing centralised implementation of key control" which was added to claim 1 during the oral proceedings before the opposition division rendered the claim unclear. This feature did not comprise any steps contributing to the centralized implementation of key control.
- Document D6 disclosed a "carte à puce (télécommunication en général)". Such cards covered

without doubts a subscriber identity module. This document further disclosed a centralized application server, since the software supplier transmitted the application and the corresponding keys to the card.

VIII. In response to the communication annexed to the summons to oral proceedings in which the board expressed its preliminary view that the appeal of the patent proprietor did not seem to comply with the requirements of Rule 99(2) EPC and would therefore be rejected as inadmissible pursuant to Rule 101(1) EPC, the appellant proprietor informed the board that he did not wish to attend the oral proceedings. No arguments were provided by the appellant proprietor on the admissibility of his appeal or on the substantive objections raised by the appellant opponent.

Reasons for the Decision

1. The appeal of the appellant opponent is admissible.
2. *Admissibility of the appeal of the appellant proprietor*
 - 2.1 Pursuant to Rule 99(2) EPC, the appellant shall indicate in the statement of grounds of appeal the reasons for setting aside the decision impugned and the facts and evidence on which the appeal is based.

According to Rule 101(1) EPC, if the appeal does not comply with Rule 99, paragraph 2, the board of appeal shall reject it as inadmissible, unless any deficiency has been remedied before the relevant period under Article 108 EPC has expired.

- 2.2 The statement of grounds of appeal of the appellant proprietor contains, under the heading "Ground for the appeal", merely his disagreement with the contested decision, but no reasoning (see point VI above).
- 2.3 The appellant proprietor did not submit reasons according to Rule 99(2) EPC within the period under Article 108 EPC. He did not contest the preliminary view of the board that his appeal should be rejected as inadmissible for lack of a reasoning for setting aside the impugned decision (cf the board's communication annexed to the summons to oral proceedings).
- 2.4 The board decides, for these reasons, to reject the appeal of the proprietor as inadmissible (Rule 101(1) EPC).
- 2.5 The patent proprietor is a party to the appeal as of right (Article 107 EPC). As party as of right he is however limited to defend the patent maintained by the opposition division. The proprietor's request to set aside the decision and to maintain the patent as granted is thus inadmissible (cf G 4/93, Headnote II).
3. *Claim 1 - Clarity (Article 84 EPC 1973)*
- 3.1 The appellant opponent argued that the feature "the procedure thereby providing centralised implementation of key control" added to claim 1 during the opposition proceedings rendered the claim unclear, as it did not comprise any steps contributing to the centralized implementation of key control.

3.2 The board does not share this view. It is true that the contested feature does not comprise any further steps contributing to a procedure for the control of applications stored in a subscriber identity module (SIM). It merely expresses the possibility of implementing a centralized implementation of key control. However, the board cannot recognize in the expression of this possibility a lack of clarity, since this possibility is already implemented by the key list stored in the SIM which allows a centralized key control. The added feature can be considered redundant, but not unclear.

3.3 The contested feature is not related to a centralized control of the applications stored in the subscriber identity module by an application control server, but simply relates to a centralized control of the keys.

3.4 The board considers, for these reasons, that the procedure of claim 1 is clear.

4. *Claim 1 - Novelty (Article 54 EPC 1973)*

4.1 As the opposition division pointed out, document D6 relates to the internal customization of a multi-application smart card ("carte à puce"). According to D6, a possible use of such cards is monetary, whereby a number of tokens are stored on the card for later consumption. In this context, the mention of a provider of such cards being a telecommunication enterprise ("telecommunications en general") shows that telephone pre-paid SIM cards are explicitly being considered. Document D6 further discloses a secure procedure for storing different applications on the card, so that

they do not interfere with each other (page 1, lines 3 to 6, 10 to 15 and 25 to 28). The terminal device (MS) of claim 1 can be a mobile station connected to a telephone network, eg the telephone of D6 (published patent, column 3, lines 41 to 45).

The board considers therefore that document D6 discloses the features of the preamble of claim 1.

4.2 D6 discloses exemplarily a banking application stored on the card (page 13, line 29 to page 14, line 10). The application communicates with the corresponding application server using eg a RSA encryption scheme (page 25, line 23 to page 26, line 4).

4.3 In the RSA encryption method a secret key is kept on the card and the corresponding public key is kept on the application server and vice-versa. This means that the card's secret key and the server's public key are stored on the card, while the server stores the card's public key and the server's secret key. Each one of these pairs forms a key list, so that corresponding key lists are stored on the card and on the server.

The board considers consequently that document D6 also discloses the two first characterizing features of claim 1, namely that:

a key list comprising subscriber and application-specific keys is stored in the subscriber identity module (SIM); and

a key list corresponding to the key list stored in the subscriber identity module is stored in the application control server.

- 4.4 Document D6 also discloses the third characterizing feature of claim 1, namely that the application stored in the subscriber identity module is activated and/or closed using the key list, since the application is activated by the user of the terminal device (eg his mobile telephone) using the keys stored in the SIM.
- 4.5 As already mentioned when discussing the clarity of claim 1, the last feature of the claim, ie "the procedure thereby providing centralised implementation of key control", merely expresses the possibility of implementing a centralized implementation of key control. This possibility is already disclosed in document D6, since the SIM allows a centralized control of the keys stored in it.
- 4.6 It seems worth mentioning that although the patent discloses a procedure for a centralized control of a plurality of applications stored in a SIM by a centralized application control server, claim 1 is not restricted to such a procedure, but also covers the conventional procedures exemplarily disclosed in document D6.
- 4.7 The board finds, for these reasons, that the procedure of claim 1 is not new within the meaning of Article 54 EPC 1973.
5. The patent must therefore be revoked (Article 101(3)(b) EPC).

Order

For these reasons it is decided that:

1. The appeal of the proprietor is rejected as inadmissible.
2. The decision under appeal is set aside.

The patent is revoked.

Registrar

Chair

S. Sánchez Chiquero

G. Eliasson