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**Datasheet for the decision
of 09 February 2012**

Case Number: T 1660/09 - 3.5.03

Application Number: 02003569.7

Publication Number: 1233635

IPC: H04W 8/24

Language of the proceedings: EN

Title of invention:

Dynamic service application, in a mobile communication device or a SIM card, for receiving and executing short text message dynamic service scripts, e.g. SMS

Applicant:

MICROSOFT CORPORATION

Opponent:

GIESECKE & DEVRIENT GmbH

Headword:

Short text message dynamic service scripts/MICROSOFT

Relevant legal provisions:

EPC Art. 100(a), 100(c), 56, 123(2), 114(2)
RPBA Art. 13(3)

Relevant legal provisions (EPC 1973):

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Keyword:

"Main request and auxiliary request 1a - added subject-matter (yes)"
"Auxiliary request 1b - added subject-matter (no), inventive step (yes)"
"Late-filed documents B1-B10 not admitted"

Decisions cited:

T 1002/92

Catchword:

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Case Number: T 1660/09 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 09 February 2012

Appellant: GIESECKE & DEVRIENT GmbH
(Opponent) Prinzregentenstraße 159
D-81677 München (DE)

Representative: -

Respondent: MICROSOFT CORPORATION
(Patent Proprietor) One Microsoft Way
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Representative: Grünecker, Kinkeldey
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
2 July 2009 concerning maintenance of the
European patent No. 1233635 in amended form.

Composition of the Board:

Chairman: A. S. Clelland
Members: T. Snell
R. Menapace

Summary of Facts and Submissions

- I. This appeal is against the interlocutory decision of the opposition division which found that European patent No. 1233635 in amended form, in accordance with the claims of the auxiliary request, met the requirements of the EPC.
- II. The opposition had been filed against the patent as a whole on the ground of lack of inventive step (Article 100(a) EPC in combination with Articles 52(1) and 56 EPC).

In the impugned decision, the opposition division held that claims 1 and 7 of the main request did not involve an inventive step with respect to the disclosure of the document:

E1: EP-A-0748135.

In addition to document E1, the following document mentioned in the impugned decision is relevant to the board's decision:

E4: W. Rankl et al, "Handbuch der Chipkarten", Hanser Verlag, 3rd Edition, 1999, pages 252 to 254.

In its reasoning with respect to inventive step, the opposition division considered that the feature "[the script elements are] generally represented by only one or two alphanumeric characters to provide script functionality with regard to specified objects", was, in view of the term "generally", entirely optional. It

had no limiting effect on the scope of protection and was therefore not relevant to inventive step.

The opposition division however held that the claims of the auxiliary request, in which the term "generally" had been deleted, complied with the EPC, in particular with respect to inventive step and Articles 123(2) and (3) EPC.

- III. The opponent (appellant) lodged an appeal against the decision. The appellant requested that the decision of the opposition division be set aside and the patent revoked in its entirety.

The appellant filed, together with the statement of grounds of appeal, ten new documents numbered B1 to B10 relating to a "STARSIM browser Suite". The appellant argued that the "STARSIM browser Suite" disclosed in documents B7 to B10 was relevant to inventive step in respect of the patent in suit. The appellant submitted that documents B1 to B6 provided evidence that the "STARSIM browser Suite" disclosed in documents B7 to B10 was on the market at the priority date of the present invention.

- IV. In a response to the notice of appeal, the patent proprietor (respondent) requested that the patent be maintained in the form upheld by the opposition division in its interlocutory decision. The respondent gave reasons questioning the public availability of documents B1 to B10 and requested, if the publication dates could not be proved, that the documents be disregarded.

Oral proceedings were conditionally requested by both parties.

- V. In a communication accompanying a summons to attend oral proceedings the board gave a preliminary opinion that, contrary to the view of the opposition division, claim 1 of the main request did not comply with Article 123(2) EPC. The board also indicated that it was minded to exercise its discretion not to admit late-filed documents B1 to B10 as they were, *prima facie*, not highly relevant to the decision and introduced a considerable degree of procedural complication.
- VI. In a response to the board's communication, the appellant agreed with the board as to non-compliance with, *inter alia*, Article 123(2) EPC. The appellant also considered that the subject-matter of claim 1 did not involve an inventive step with respect to document E1.
- VII. The respondent responded to the board's communication by filing claims of a new main and first to third auxiliary requests. The main request comprised the claims as originally granted, ie the term "generally" was reinserted into claims 1 and 7. The respondent commented that "the preliminary observations of the board [with respect to Articles 123(2) and (3) EPC] are therefore obsolete and do not require further arguments". The respondent also noted that the appellant had not submitted evidence that documents B1 to B10 had been made available to the public.
- VIII. In a further brief communication the board indicated that in view of the amended requests the main point at

issue was inventive step and that documents E1 and E4 were seen as the most relevant on file.

IX. Oral proceedings took place on 9 February 2012.

At the start of the oral proceedings the appellant submitted an affidavit from Mr Bernd Müller intended to provide support for its claim that documents B1 to B10 had been made available to the public.

Subsequently, the respondent agreed that a new ground of opposition based on Article 100(c) EPC be admitted to the proceedings. The respondent filed further auxiliary requests 1a and 1b in response to the new ground of opposition.

The appellant requested that the decision under appeal be set aside and the patent revoked.

The respondent requested that the patent be maintained on the basis of the claims of the "main request" filed on 5 January 2012 (which corresponds to the claims as granted) or, in the alternative, in amended form on the basis of auxiliary requests 1a or 1b filed during the oral proceedings, or the auxiliary requests "No. 1", "No. 2" and "No. 3", all as filed on 5 January 2012.

At the conclusion of the oral proceedings, after due deliberation, the board gave its decision.

X. Claim 1 of the **main request** (ie claim 1 of the patent as granted) reads as follows:

"A dynamic service method (100), comprising:

radiant transmission (104) of a short text message dynamic service script to a mobile digital communication device (10), said mobile digital communication device (10) comprising a subscriber identity module (12) or other chip card that is distinct from a base portion of said mobile digital communication device (10), wherein a dynamic service application is stored on said subscriber identity module (12) or said other chip card, said short text message dynamic service script including script elements that are generally represented by only one or two alphanumeric characters to provide script functionality with regard to specified objects; and interpretation and execution (110) of said short text message dynamic service script on said mobile digital communication device (10) by said dynamic service application."

Claim 7 of the main request reads as follows:

"A mobile digital communication device (10) adapted to receive radiant transmission of short text messages, said mobile digital communication device (10) comprising:
a subscriber identity module (12) or other chip card that is distinct from a base portion of said mobile digital communication device (10); wherein a dynamic service application is stored on said subscriber identity module (12) or said other chip card, said dynamic service application being adapted to receive radiant transmission of a short text message dynamic service script and is adapted to interpret and to execute said short text message dynamic service script

on said mobile digital communication device (10), said short text message dynamic service script including script elements that are generally represented by only one or two alphanumeric characters to provide script functionality with regard to specified objects."

- XI. Claims 1 and 7 of "**auxiliary request 1a**" differ from those of the main request in that the wording "said short text message dynamic service script including script elements that are generally represented by only one or two alphanumeric characters" is replaced by "said short text message dynamic service script consists of script elements, said script elements are generally represented by only one or two alphanumeric characters".
- XII. Claims 1 and 7 of "**auxiliary request 1b**" differ from those of the main request in that the wording "said short text message dynamic service script including script elements that are generally represented by only one or two alphanumeric characters" is replaced by "said short text message dynamic service script includes script elements, wherein the script elements of said short text message dynamic service script are generally represented by only one or two alphanumeric characters".
- XIII. In view of the board's decision, it is not necessary to reproduce the wording of the claims of the auxiliary requests "No. 1", "No. 2" and "No. 3" filed 5 January 2012.

Reasons for the decision

1. *Main request - Article 123(2) EPC*

1.1 Article 123(2) EPC relates to a new ground of opposition under Article 100(c) EPC which was admitted to these appeal proceedings with the respondent's consent (cf. the minutes of the oral proceedings).

1.2 *Meaning of "generally" in the application as filed*

Claim 1 includes the feature "said short text message dynamic service script including script elements that are generally represented by only one or two alphanumeric characters".

This feature is based on paragraph [0031] of the application as filed (referring to the published application EP-A-1233635). The relevant passage reads: "In this implementation, script elements are generally represented by only one or two alphanumeric characters to minimize the script size". The wording "In this implementation" relates to the script file listing set out in the description in paragraph [0030].

In the board's view, this passage in the description as filed would be understood by the skilled person as meaning that most of the script elements of the script are represented by one or two alphanumeric characters, ie "generally" means "most of" and the term "script elements" refers here to the complete set of script elements of the script. As an example, assume the script contains 100 script elements of which 90 are represented by either one or two alphanumeric

characters. This, in the board's view, falls within the scope of the original disclosure. However, a script in which only 10 script elements are represented by one or two alphanumeric characters would not. It is not necessary, or indeed possible, to give the term "generally" any more precise meaning than this.

1.3 *Scope of claim 1 of the main request*

The feature of claim 1 "said short text message dynamic service script including script elements that are generally represented by only one or two alphanumeric characters" (board's emphasis) is broader than the corresponding passage of the description referred to above. This is evident when considering that claim 1 embraces the second example given above, since here the term "script elements" need only mean the 10 script elements represented by one or two alphanumeric characters. In fact, due to the presence of the term "including", the term "generally" has no further practical effect on limiting the scope of protection.

Since claim 1 embraces embodiments not covered by the original disclosure, subject-matter has been added in contravention of Article 123(2) EPC.

1.4 It follows that claim 1 of the main request, and in consequence the main request as a whole, is not allowable.

2. *Auxiliary request 1a - Article 123(2) EPC*

2.1 Auxiliary request 1a was filed at the oral proceedings. The board has the discretion to disregard such late-file requests pursuant to Article 13(3) RPBA (Supplement to OJ EPO 1/2011, pages 39-49).

2.2 Claim 1 of auxiliary request 1a differs from claim 1 of the main request essentially in that the offending term "including" referred to above has been amended to "consists of". This means that a script only consists of "script elements", and the respondent argued that this was indeed the case, as was derivable from paragraphs [0029] and [0030] as filed.

However, in the board's view it is not directly and unambiguously derivable from these passages that a script only consists of script elements. For example, it is not clear whether or not text strings are script elements. The board notes that one of the passages referred to by the respondent reads "a typical script includes a file or variable with multiple successive statements that each may include one or more script elements" (board's emphasis), which could imply that script elements are one but not the only feature of a script. Therefore, claim 1 of this request does not, *prima facie*, comply with Article 123(2) EPC.

2.3 For this reason, the board decided to exercise its discretion under Article 13(3) RPBA not to admit auxiliary request 1a.

3. *Auxiliary request 1b*

3.1 *Articles 123(2) and (3) EPC*

3.1.1 Claim 1 of auxiliary request 1b differs from claim 1 as granted in that the feature "said short text message dynamic service script including script elements that are generally represented by only one or two alphanumeric characters" now reads: "said short text message dynamic service script includes script elements, wherein the script elements of said short text message dynamic service script are generally represented by only one or two alphanumeric characters". The second part of this clause ("wherein the script elements .." (board's emphasis)) in the board's view has to be understood as referring to the complete set of script elements and not merely to some script elements. Hence in the board's view this wording accurately reflects the original meaning and scope of paragraph [0031] of the description as filed.

3.1.2 The board concludes that claim 1 complies with Article 123(2) EPC. The same applies to independent claim 7.

3.1.3 As explained above at point 1.3, granted claim 1 is broader in scope than original paragraph [0031], and hence broader than claim 1 of auxiliary request 1b. Hence, claim 1 of auxiliary request 1b complies with Article 123(3) EPC.

3.2 *Reformatio in peius*

The appellant objected to claim 1 of auxiliary claim 1b on the ground of *reformatio in peius*, as claim 1 of

auxiliary claim 1b was allegedly broader in scope than claim 1 as maintained by the opposition division.

The relevant passage of claim 1 as maintained by the opposition division reads "said short text message dynamic service script including script elements that are represented by only one or two alphanumeric characters", which is the same as claim 1 as granted except that the word "generally" has been deleted.

However, as explained at point 1.3 above in connection with claim 1 of the main request (ie claim 1 as granted), due to the presence of the term "including", the term "generally" effectively does not limit the scope of protection any further. Claim 1 as maintained by the opposition division therefore has the same scope as claim 1 as granted, ie is broader in scope than claim 1 of auxiliary request 1b. Therefore, the filing of claim 1 of the auxiliary request 1b has not put the appellant in a more disadvantageous position than if the appeal had not been filed.

3.3 Points 3.1 and 3.2 apply, *mutatis mutandis*, to independent claim 7.

3.4 *Article 84 EPC and Guidelines C-III, 4.6 and 4.9*

The appellant argued that claim 1 of auxiliary request 1b did not meet the requirements of the Guidelines C-III, 4.6 and 4.9 in respect of the term "generally". However, these sections of the Guidelines refer to Article 84 EPC, which is not a ground of opposition. It follows that since the term "generally" was included in the granted independent claims, no objection to this

term on the grounds of Article 84 EPC is possible. The board is of course required to examine the amendments made during the opposition and appeal proceedings for compliance with Article 84 EPC. The board however does not consider that these amendments give rise to any new objection of lack of clarity.

3.5 *Inventive step*

3.5.1 The present invention, simply expressed, comprises the transmission of an application [program], in modern terminology an "app", to the SIM card of a mobile telephone by being included in a short text message (SMS). The "application" comprises a "dynamic service script", which the board understands to be a simple program written in an interpretable language. In accordance with the independent claims, the short text message dynamic service script includes "script elements, wherein the script elements of said short text message dynamic service script are generally represented by only one or two alphanumeric characters". The purpose of this feature is to minimize the script size (cf. col. 8, line 36 of the published application) and to save memory space on the SIM card (cf. column 10, lines 1 to 3 of the published application). As indicated above, the board understands the expression "generally represented" to mean that most of the script elements are represented by only one or two alphanumeric characters. Although the scope of the term "generally represented" does not have clear boundaries, in the board's view it is still a meaningful technical limitation. The board therefore does not agree with the appellant that it should be ignored in the examination of inventive step. The board also does not agree with

the opposition division that this feature of the independent claims is "entirely optional".

- 3.5.2 The opposition division considered that document E1 represents the closest prior art; the board agrees.

Document E1 discloses a method which makes use of SMS messaging to transmit ECS ("embedded command stream") messages to the SIM card of a mobile telephone (cf. col. 6, lines 27-29). An ECS message comprises a data stream headed by a command which is at least one of four types: write commands, read commands, attribute commands for lock or unlock instructions and run commands for instructions to run a program (cf. col. 6, lines 12-18). The basic ECS system is expandable to up to 255 commands of which write, read, lock/unlock and run are four examples (cf. col. 6, lines 35-37). This suggests to the board that the ECS commands consists of a single byte of information. In other words, these commands are transmitted in the form of a simple machine code and are therefore not "script elements" as understood by the board.

- 3.5.3 However, document E1 also mentions the possibility that the system can create external file objects within the SIM card, including "Application Data File Programs" (ADFP) containing functional data which can be executed by the SIM card processor (cf. col. 6, lines 40-46). The board regards ADFPs as dynamic service applications within the meaning of the present invention. The ADFPs can be downloaded or modified over the air (cf. col. 6, lines 51-54). The board assumes that these downloads proceed using the SMS-based ECS messages previously described, although this is not explicitly stated.

- 3.5.4 The subject-matter of independent claim 1 of auxiliary request 1b differs from the disclosure of document E1 essentially in that the dynamic service applications comprise a script whose script elements are generally represented by only one or two alphanumeric characters.
- 3.5.5 The board regards the problem to be solved as being to minimize both the size of an SMS-based dynamic service application and the memory requirements of the SIM card.
- 3.5.6 The appellant argued that the claimed solution was obvious in view of the disclosure of document E4.

Document E4 is an excerpt from a book entitled "Handbuch der Chipkarten", which the board considers as representing the common general knowledge of the skilled person at the priority date of the present patent.

It is stated in document E4 (cf. page 253, 2nd and 3rd paragraphs) that there are two ways to load program code into a chip card: The first and simplest way is to use the machine code of the chip card processor. The second way is to use an interpretable language such as Java or MEL [ie a conventional scripting language]. However, it is stated that machine code has the advantage that no additional program code is required in the SIM card for an interpreter (cf. page 253, lines 11-12).

- 3.5.7 The skilled person making use of the teaching of document E4 has to weigh up whether to use machine code or a conventional scripting language. Given that one

aspect of the problem to be solved involves minimizing memory requirements, document E4 teaches that machine code would be advantageous, since space is not required for the interpreter program. Furthermore, the skilled person would realise based on common knowledge that an application program written in machine code would generally be shorter than one written in a higher-level scripting language and therefore easier to transmit via SMS messaging. Therefore, in the light of document E4 and common knowledge the skilled person would be led away from using a scripting language for the SMS application of document E1.

3.5.8 The board notes further than no other document admitted to these proceedings discloses a scripting language, conventional or otherwise, in which script elements are generally represented by only one or two alphanumeric characters. The board is also not aware that any such scripting language belonged to the common general knowledge of the skilled person at the priority date of the patent. The skilled person therefore has no hint in the prior art that the problem can be solved by using a scripting language adapted to be minimized in size by having script elements generally represented by only one or two alphanumeric characters.

3.5.9 In this light, it would not, in the board's view, be obvious for the skilled person starting out from document E1 to either make use of a scripting language as such or perform the additional step of minimizing the size of the program by using script elements that are generally represented by only one or two alphanumeric characters. The board concludes that the

subject-matter of claim 1 of auxiliary request 1b involves an inventive step (Articles 52(1) and 56 EPC).

3.5.10 This conclusion applies, *mutatis mutandis*, to independent claim 7.

4. *Admissibility of documents B1 to B10*

4.1 The appellant filed documents B1 to B10 together with the statement of grounds. At the same time, the appellant offered two witnesses, *inter alia* Mr. Bernd Müller, although it was not indicated what the testimony of the named individuals might concern.

4.2 Since documents B1 to B10 were filed for the first time in these appeal proceedings, they were late-filed within the meaning of Rule 76(2)(c) EPC (formerly Rule 55(c) EPC 1973). The respondent requested that documents B1 to B10 be disregarded, which is at the discretion of the board pursuant to Article 114(2) EPC and Article 12(4) RPBA, the latter since these documents apparently could have been presented during the first instance proceedings.

4.3 In considering how the Boards of Appeal should exercise their discretion under Article 114(2) EPC, the board in decision T 1002/92 concluded as follows (cf. point 3.4 of the reasons for the decision): "... in proceedings before the Boards of Appeal, new facts, evidence and related arguments, which go beyond the "indication of facts, evidence and arguments" presented in the notice of opposition pursuant to Rule 55(c) EPC [1973] in support of the grounds of opposition on which the opposition is based, should only very exceptionally be

admitted into the proceedings in the appropriate exercise of the Board's discretion, if such material is *prima facie* highly relevant in the sense that it can reasonably be expected to change the eventual result and is thus highly likely to prejudice maintenance of the European patent; and having regard also to other relevant factors in the case, in particular whether the patentee objects to the admissibility of the new material and the reasons for any such objection, and the degree of procedural complication that its admission is likely to cause".

4.4 Considering the case law set out in T 1002/92 in relation to the present case: The admitting of documents B1 to B10 would have resulted in procedural complication as the availability to the public of these documents was disputed by the respondent. Remittal to the opposition division would probably have been necessary in order that the new material could be fully investigated. Furthermore, the respondent objected to this new material being introduced. Finally, there was no *prima facie* disclosure of a script, ie an interpretable programming language, in any of these documents. These documents therefore did not appear to be any more relevant than either E1 or E4.

4.5 The appellant submitted an affidavit ("Eidesstattliche Erklärung") at the beginning of the oral proceedings from Mr. Bernd Müller to support its claim that documents B1 to B9 (document B10 not being mentioned) were publicly available before the priority date of the patent. This affidavit however did not, *prima facie*, contain sufficient information to prove beyond all reasonable doubt that the documents were publicly

available, and further investigations would have been required which could not reasonably have been undertaken at the oral proceedings.

4.6 Although the author of the affidavit, Mr. Bernd Müller, was one of the witnesses offered in the statement of grounds, it was too late at the oral proceedings to consider the question of whether any taking of evidence from Mr. Müller could have been useful. In any case, as already noted, documents B1 to B10 did not appear to be relevant to the board's decision.

4.7 For these reasons, the board did not admit documents B1 to B10 to the appeal proceedings.

4.8 *Dependent claims*

No objection has been raised by the appellant in respect of any of the dependent claims. The board sees no reason to raise any objection either.

5. *"Auxiliary requests "No. 1", "No. 2" and "No. 3" filed on 5 January 2012*

As the claims of auxiliary request 1b are allowable, there is no need to consider any of these lower-ranked requests.

6. *Conclusion*

The board concludes that the patent is to be maintained on the basis of the claims of auxiliary request 1b and the description and drawings of the granted patent.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance with the order to maintain the patent on the basis of claims 1 to 12 as filed during the oral proceedings before the Board as Auxiliary Request 1b.

The Registrar:

The Chairman:

G. Rauh

A. S. Clelland