

Internal distribution code:

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

**Datasheet for the decision
of 16 October 2013**

Case Number: T 1531/10 - 3.5.03

Application Number: 99957131.8

Publication Number: 1068753

IPC: H04Q7/32

Language of the proceedings: EN

Title of invention:

COMMUNICATION METHOD AND APPARATUS

Patent Proprietor:

Aussie L.L.C. Pty Ltd

Opponents:

Inside Contactless, et al
Monitise Group Limited
NOKIA UK Limited
Vodafone Group Plc

Headword:

Remote communication apparatus/AUSSIE

Relevant legal provisions:

EPC Art. 84, 113(1), 123(2)
RPBA Art. 13(1)

Keyword:

Claims - clarity after amendment (no)
Amendments - added subject-matter (yes)
Late-filed request - admitted (no)
Right to be heard - violation (no)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1531/10 - 3.5.03

**D E C I S I O N
of Technical Board of Appeal 3.5.03
of 16 October 2013**

Appellant:
(Patent proprietor)

Aussie L.L.C. Pty Ltd
1st Floor,
190 Flinders Street
Adelaide 5000 (AU)

Representative:

Wegner, Hans
Bardehle Pagenberg PartnerschaftmbB
Patentanwälte, Rechtsanwälte
Postfach 86 06 20
81633 München (DE)

Respondent:
(Opponent 1)

Inside Contactless, et al
Bât. 11A Parc Club du Golf
13856 Aix en Provence (FR)

Representative:

Langley, Peter James
Origin Limited
Twisden Works
Twisden Road
London NW5 1DN (GB)

Respondent:
(Opponent 2)

Monitise Group Limited
Providian House
16-18 Monument Street
London
EC3R 8AJ (GB)

Representative:

Ertl, Nicholas Justin
Elkington and Fife LLP
Prospect House
8 Pembroke Road
Sevenoaks
Kent TN13 1XR (GB)

Respondent:
(Opponent 3)

NOKIA UK Limited
Nokia House, Summit Avenue,
Farnborough
Hampshire GU14 ONG (GB)

Representative: Ruuskanen, Juha-Pekka
Page White & Farrer
Bedford House
John Street
London
WC1N 2BF (GB)

Respondent: Vodafone Group PLC
(Opponent 4) Vodafone House
The Connection
Newbury
Berkshire RG14 2FN (GB)

Representative: Keston, David Arthur
Vodafone Group Services Ltd.
Group Legal (Patents)
Vodafone House
The Connection
Newbury
Berkshire RG14 2FN (GB)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 22 April 2010
revoking European patent No. 1068753 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: F. van der Voort
Members: T. Snell
R. Moufang

Summary of Facts and Submissions

- I. This appeal was lodged by the proprietor against the decision of the opposition division revoking European patent No. EP 1068753.
- II. Oppositions had been filed by four different opponents (OP1 to OP4). All opponents invoked the grounds of Articles 100(a) and (b) EPC, whereas OP3 and OP4 additionally invoked the ground of opposition under Article 100(c) EPC.
- III. The opposition division found that claim 1 of the main request (which had been amended during the opposition proceedings) complied with Articles 84, 123(2) and 100(b) EPC, but held that its subject-matter did not involve an inventive step (cf. Article 100(a) EPC). Claim 1 of the auxiliary request was held not to comply with Article 123(2) EPC.
- IV. In the statement of grounds of appeal, the appellant requested that the impugned decision be set aside and that the patent be maintained in accordance with the claims of either a main request or an auxiliary request.

In a response to the statement of grounds of appeal, OP3 (respondent III) implicitly requested that the appeal be dismissed.

The proprietor and respondent III conditionally requested oral proceedings.

- V. In a communication accompanying a summons to attend oral proceedings, the board gave a preliminary opinion raising matters concerning, *inter alia*, the clarity of

claim 1 of each of the requests (cf. Article 84 EPC).
In particular, the board commented as follows:

"6.2 Respondent III alleges that the feature of claim 1
"so that a further identification or
authentication process is available through the
network but not subject to approval from the
network provider" is unclear.

6.2.1 The opposition division held that this feature
was sufficiently clear. However, the board
presently has doubts that the clause "not subject
to approval from the network provider" clearly
defines the scope of protection. Apart from being
a "negative" feature (disclaimer), the term
"approval", or lack thereof, does not have a clear
technical meaning since it could, for example,
also relate to a purely commercial or legal
agreement between the service provider and the
sender of the interrogation signals."

- VI. In a response to the board's communication, the
appellant filed claims of first to fourth auxiliary
requests to replace the auxiliary request on file,
together with arguments.
- VII. A first oral proceedings took place on 21 June 2013.
During the oral proceedings initially the ground of
opposition under Article 100(b) EPC was extensively
discussed. In this respect, *inter alia*, the meaning of
the phrase "so that a further identification or
authentication process is available through the network
but not subject to approval from the network provider"
was discussed. Subsequently, the issues of novelty and
inventive step were discussed in relation to claim 1 of
the main request. Further, the admissibility of the

first to third auxiliary requests was discussed. The board indicated its view that the subject-matter of claim 1 of the main request did not involve an inventive step and that the first, second and third auxiliary requests should not be admitted into the proceedings.

After a short discussion with regard to the admissibility of the fourth auxiliary request, particularly having regard to prima facie compliance of claim 1 with Articles 84 and 123(2) EPC, the fourth auxiliary request was admitted into the proceedings.

The oral proceedings were closed without a decision being taken, the chairman announcing instead that the procedure be continued in writing.

- VIII. With a letter dated 27 June 2013, the appellant withdrew the main request and the first to third auxiliary requests and maintained only the fourth auxiliary request by way of a new main request.
- IX. In a communication accompanying a summons to a second oral proceedings, the board summarised the results of the first oral proceedings and indicated the main points for further discussion. As regards Article 84 EPC, the board referred in particular to the clarity of the terms "direction" and "redirection". The board subsequently commented as follows:

"The board considers that it should not be necessary to repeat the arguments presented in the first oral proceedings (see above). The discussion should rather be based only on any additional aspects relevant to the claims of the new main request."

X. Respondent III replied to the board's communication with a letter date 16 September 2013. In connection with Article 84 EPC, respondent III remarked that:

"Also, clarity issues mentioned in items 6.2.1 ... of the Annex to Summons to the Oral Proceeding [*sic*] in June 2013 are still present in the new main request".

XI. The second oral proceedings were held on 16 October 2013, attended by the proprietor and respondent III.

A discussion took place on the issue of clarity of claim 1 of the main request, *inter alia* regarding the expression "so that a further identification or authentication process is available through the network but not subject to approval from the network provider".

After deliberation the chairman informed the parties that claim 1 of the main request did not meet the requirement of clarity and that the main request was therefore not allowable. The appellant then submitted a new main request to replace the request on file.

The parties were heard on the issue as to whether the new main request should be admitted into the procedure. After deliberation the Chairman informed the parties that the new main request was not to be admitted.

The appellant thereupon requested that in the minutes it be recorded that the appellant's right to be heard was violated by not admitting the new main request into the procedure, since the appellant was taken by surprise in these oral proceedings when the board raised clarity objections under Article 84 EPC against the previous main request and considered this request to be not allowable.

The appellant (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained in amended form on the basis of claims 1 to 20 of the new main request as filed at these oral proceedings.

Respondent III (OP3) requested that the appeal be dismissed.

Respondents II (OP2) and IV (OP4) requested in writing that the appeal be dismissed.

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

XII. Claim 1 of the new main request as filed at the second oral proceedings reads as follows:

"A remote communication apparatus (1; 30)

a. adapted to receive an external interrogation signal from time to time with respect to the identification of a user of the apparatus and

b. including means (20; 21) to hold a subscriber identification module within the apparatus which can provide for that authentication of the user to the external interrogation signal from time to time,

characterized in that

c. the apparatus includes an intermediary processor connected to electrical contacts (32; 34) adapted to connect with an appropriate subscriber identification module,

- c1. the intermediary processor being configured to receive any external interrogation signals and providing active means to intercept any external interrogation signal and to effect a redirection of this in the event that the external interrogation signals contain information which appears to the intermediary processor not to be for the purpose of interrogating the existing subscriber identification module, the intermediary processor being further adapted,
- c2. in the case that the external interrogation signals are appropriate for seeking identification of and from a network providers subscriber identification module, to effect a direction of such incoming inquiry signals to the attached subscriber identification module whereby appropriate identification can be provided in reply, and,
- c3. in the event of an external interrogation signal other than from the network provider for identification or authentication purposes, as appropriate to intelligently switch such a further external interrogation signal to alternative memory means comprising an alternative active or passive authentication or identification means, so that a further identification or authentication process is available through the network but not subject to approval from the network provider through functionality installed in the SIM."

Reasons for the Decision

1. *Admissibility of the new main request*
 - 1.1 In accordance with Article 13(1) RPBA, "Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the

Board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy". In line with the established case law of the boards of appeal, one of the criteria for admitting further amendments to a claim at a late stage of the appeal proceedings, in the present case in the course of the oral proceedings, is whether or not the claim is clearly allowable.

In the board's judgement, claim 1 of the new main request is not clearly allowable for the reasons set out below:

1.2 *Article 84 EPC*

- 1.2.1 Claim 1 differs from claim 1 of the previous main request in that the words "through functionality installed in the SIM" is added, i.e. the final feature (c3.) of claim 1 reads:

"[the intermediary processor being further adapted] in the event of an external interrogation signal other than from the network provider for identification or authentication purposes, as appropriate to intelligently switch such a further external interrogation signal to alternative memory means comprising an alternative active or passive authentication or identification means, *so that a further identification or authentication process is available through the network but not subject to approval from the network provider through functionality installed in the SIM*" (board's italics).

- 1.2.2 In the board's view, the amended feature in italics (to be referred to hereinafter as "the SIM non-approval feature") includes a negative feature (disclaimer) which can be interpreted in different ways.
- 1.2.3 A first plausible interpretation in the board's view is that this feature merely reflects the technical effect achieved by the positive features of the claim, which in essence comprise an intermediate processor "upstream" of the SIM intercepting and diverting a further external interrogation signal away from the SIM to an alternative memory means. As the signal does not reach the SIM, it follows that it is processed without being subject to functionality installed in the SIM. Under this interpretation the feature in italics effectively does not limit the claim technically beyond the scope of protection defined by the positive features.
- 1.2.4 The appellant however expressly disagreed at the second oral proceedings with this interpretation of the claim. In the appellant's view, the SIM non-approval feature limited the claimed subject-matter in the sense that the intermediary processor not only avoided being subject to control by the SIM by dint of being situated upstream of the SIM, but additionally was programmed in such a way as to be independent of instructions comprised in the SIM. This would be entirely clear to the skilled person, since in the prior art any processor within a mobile phone was completely dependent on and controlled by functionality provided in the SIM, as was required by every GSM standard. The SIM non-approval feature therefore clearly limited the

scope of protection compared to a claim without this feature.

1.2.5 The board is aware from the discussion with respect to novelty and inventive step which took place during the first oral proceedings that the appellant attaches great importance to the SIM non-approval feature. It is therefore of paramount importance that the claim does not comprise ambiguity in this respect.

1.2.6 However, in the present case, the board finds that claim 1 is ambiguous, since it is unable to determine with any certainty which of the above interpretations should be applied. The board in particular notes that there is nothing in the description to resolve this ambiguity. In this respect, the appellant referred to paragraphs [0007] and [0008] of the patent specification (the text being the same as that appearing in the application as originally filed). These paragraphs read as follows:

"[0007] A first problem is that a mobile phone is only empowered to be connected to a network service provider for full communication services through a subscriber identification module (SIM). This not only carries data but is arranged to also run a program (for instance a GSM connect program) which has embedded information and generates data that is not available to any third party whereby data is communicated back to a service provider upon an appropriate interrogation signal being received. The security of this system is extremely important to the network service provider.

[0008] Further, much of the empowering software for the functions of a mobile phone is in the SIM so that if additional functionality is required (for third party

access or etc) this will need to be installed in the SIM which is under the control of the network service provider. As such, the basis of any commercial arrangement is therefore going to be subject to permission and costs applied by the network provider."

This part of the description discloses the prior art situation and essentially states that additional functionality would have been installed in the SIM. This however does not lead to the conclusion that in the intermediary processor of the present invention there is provided functionality "not subject to approval from the network provider through functionality in the SIM" in the sense understood by the appellant. Indeed, there is no suggestion here or elsewhere in the description that the intermediary processor should be programmed to be independent of SIM control, eg by ignoring instructions contained in the SIM. As to the appellant's argument that because the SIM controls all functions of a mobile phone the skilled person would implicitly understand here that the intermediary processor of claim 1 must be programmed to be independent of SIM control, the board notes that claim 1 is not restricted to a GSM telephone, or even to a mobile telephone in a general sense, but embraces remote communication apparatuses where the SIM does not exert the same level of control. Furthermore, not all processes in a GSM telephone apparently require SIM approval, eg calling an emergency number is possible independently of whether there is a valid SIM. Therefore, the board takes the view that the skilled person would not necessarily regard this additional programming limitation as implicit.

1.2.7 The board concludes that prima facie claim 1 of the new main request is not clear within the meaning of Article 84 EPC.

1.3 *Article 123(2) EPC*

1.3.1 Furthermore, the board can find no direct and unambiguous basis in the application as filed for the SIM non-approval feature. In this respect: (a) paragraphs [0007] and [0008] relied on by the appellant for support concern the prior art and not the invention; (b) claim 1 is not limited to a telephone apparatus, but to a "remote communications apparatus", so that reliance only on passages concerned with a (GSM) telephone system (ie paragraphs [0007] and [0008]) results in claim 1 defining an unallowable intermediate generalisation, and (c) the SIM non-approval feature, if given the limiting interpretation alleged by the appellant (see point 1.2.4 above), would neither be based on subject-matter explicitly disclosed in the application as filed nor on what would be, as the appellant alleges, implicit to the skilled person (ie the SIM controlling all processes in a mobile telephone), since according to the appellant's interpretation the intermediary processor would have to be reprogrammed in such a way as to become independent of instructions comprised in the SIM.

1.3.2 The board concludes that claim 1 as amended does not prima facie comply with Article 123(2) EPC either.

1.4 The appellant further argued that the request should be admitted for the following reasons:

(i) The appellant had been taken completely by surprise when the board raised an objection of lack of clarity

at the start of the second oral proceedings as the objection was not mentioned in the board's communication accompanying the summons to the second oral proceedings. Moreover, the board had stated in that communication that the discussion should be based only on any additional aspects relevant to the claims of the (previous) new main request, whereas the alleged unclear feature was already present in the earlier requests discussed at the first oral proceedings. Under these circumstances, the refusal to admit the new main request as filed in the second oral proceedings was an infringement of the appellant's right to be heard under Article 113(1) EPC.

(ii) The amendment was simple, clear, and clearly disclosed in the application as filed.

(iii) The appellant's case would not change as the amendment merely clarified the meaning that the appellant had in any case given to claim 1 of the previous main request.

1.5 Re (i): In response to the board's second communication, respondent III expressly drew attention in the letter dated 16 September 2013 to the objection of lack of clarity (cf. point X above) which was subsequently raised by the board at the beginning of the second oral proceedings (cf. point XI above). Therefore, in the board's view, the appellant had no reason to be surprised that the matter might be discussed and should have been fully prepared, particularly as the appellant was well aware that the meaning of the feature in question had been a subject of dispute in the first oral proceedings in connection with Article 100(b) EPC. The board's communication in any case cannot be taken to be a definitive and

exhaustive list of the points to be discussed since this in itself would deprive the parties of their right to be heard. Further, after the board raised the issue at the beginning of the second oral proceedings, the appellant was given ample time to present its arguments. The board also emphasises that it did not refuse to admit the subsequently filed new main request on the ground of its lateness alone but because of its prima facie non-compliance with Articles 84 and 123(2) EPC. The board notes that the appellant was heard on these matters. Under these circumstances the board considers that the appellant's right to present comments enshrined in Article 113(1) EPC has been fully respected, both in respect of the previous main request and the new main request.

Re (ii): It follows from above points 1.2 and 1.3 that the board does not agree with the appellant's assertion that the amendment is clearly disclosed in the application as filed and is clear.

Re (iii): This argument is not relevant to the board's reasoning, which is based on prima facie compliance with Articles 84 and 123(2) EPC.

1.6 For the above reasons, the board decided not to admit the new main request (Article 13(1) RPBA).

2. *Conclusion*

As there is no admissible request, it follows that the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Rauh

F. van der Voort

Decision electronically authenticated