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**Datasheet for the decision
of 2 February 2021**

Case Number: T 2416/16 - 3.4.03

Application Number: 04743917.9

Publication Number: 1646989

IPC: G07F7/10, H04M1/725

Language of the proceedings: EN

Title of invention:

DEVICE DELIVERING A SERVICE USING AN ASSOCIATED PORTABLE MEMORY, AND RELAYING MEANS FOR ALLOWING ACTIVATION OF AN APPLICATION OF THE PORTABLE MEMORY OF THE FIRST DEVICE BY A SECOND DEVICE

Applicant:

Gemalto SA

Headword:

Relevant legal provisions:

EPC 1973 Art. 54(1), 84
EPC Art. 123(2)

Keyword:

Novelty - main request (no)

Added subject-matter - all requests - yes

Clarity - second auxiliary request - (no)



Beschwerdekammern

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Case Number: T 2416/16 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 2 February 2021

Appellant:
(Applicant)

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Representative:

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Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted on 10 June 2016
refusing European patent application
No. 04743917.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman

G. Decker

Members:

M. Papastefanou

M. Ley

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division refusing European patent application No. 04 743 917.9 (published as WO 2005/006265 A1) on the ground that claim 1 of the sole request then on file lacked clarity (Article 84 EPC 1973) and novelty (Article 54(1) EPC 1973).

- II. Reference is made to the following document, cited in the impugned decision:

D1: US 2002/0173344 A1.

- III. The appellant (applicant) requested that the decision under appeal be set aside and that a patent be granted on the basis of the Main Request or one of the First and Second Auxiliary Requests, all filed with the statement of grounds of appeal. The Main Request corresponds to the sole request on which the decision under appeal is based.

- IV. After the board issued summons to oral proceedings and its preliminary opinion, the appellant informed the board that it would not attend the oral proceedings and requested a decision to be taken "based on all the arguments already submitted" (appellant's letter of 12 January 2021).

The board then cancelled the oral proceedings and issues its decision in writing.

- V. Claim 1 of the **Main Request** is worded as follows:

An electronic system, said system comprising a first device, said first device comprising:

- a portable object wherein an application is stored, said first device having access to said application,*
- a portable object reader for receiving said portable object,*

characterized in that said system comprises a second device external to said first device and connected thereto, and wherein said first device comprising relay means arranged for performing a communication between said portable object reader and the second device, so that said second device have access to said application of said portable object through the relaying function and the card reader and independently of the first device resources.

VI. Claim 1 of the **First Auxiliary Request** has the following wording:

An electronic system, said system comprising a first device and a portable object wherein an application is stored, said first device comprising a portable object reader for receiving said portable object and said first device including resources for activating said application, characterized in that said system comprises a second device external to said first device and connected thereto, and wherein said first device comprising relay means arranged for performing a communication between said portable object reader and the second device, so that said second device activates said application of said portable object through the relaying function and the card reader and independently of the first device resources as if said communication was realized without

*any intermediate,
wherein said first device is a handset, wherein said second device is a personal computer including a USB host, said handset comprising a USB HUB device, as relay means arranged for performing a communication between said portable object reader and said personal computer, said personal computer comprising a USB device driver and means for sending to said portable object at least one signal, through said handset USB HUB device and said portable object reader, so as to activate said application, and said portable object being a smart card, said smart card including a USB device and means for sending at least one signal to said personal computer through said handset USB HUB device and said portable object reader, so as to respond to said personal computer further to the execution of the activated application.*

VII. Claim 1 of the **Second Auxiliary Request** has the same wording as claim 1 of the First Auxiliary Request with the additional specification that the application stored in the portable object is a *web server application* (lines 2, 4 and 5) and that said application is activated *by quering the web server application present in the smart card* (lines 19 and 20).

VIII. Regarding the examining division's objection of lack of novelty over D1 in the decision under appeal, the appellant argued essentially that D1 did not disclose that the second device had access to the application on the portable object, independently of the resources of the first device.

The appellant never replied to the board's preliminary opinion. As far as they are relevant for this decision,

the appellant's arguments are dealt with in the reasons for the decision.

Reasons for the Decision

1. The appeal is admissible.
2. The claimed invention
 - 2.1 A first device comprises a portable object storing at least one application. An example could be a mobile phone comprising a SIM card with a web server application on it. The first device comprises resources for activating said application.

A second device can access the portable object of the first device and activate the application on it, independently of the first device's resources. As an example, a PC can connect to the mobile phone, via a USB connection, and activate the application on the SIM card without any other interaction with the mobile phone.

- 2.2 According to the application, advantages of the invention include extension of the functionalities of the first and second devices. For example, in the context of a web banking application, the PC (second device) can access the SIM card of the mobile phone (first device) and connect to a remote bank server via the Internet, without the PC itself having any network (Internet) connection capabilities. At the same time, a user, who wishes to carry out remotely banking operations, can use the PC's interface and processing capabilities and does not need to limit themselves to the limited capabilities of the mobile phone (page 1,

line 5 to page 2, line 2 of the application as published).

3. Main Request

3.1 Novelty (Article 54(1) EPC 1973)

3.1.1 In the impugned decision the examining division held that claim 1 (as it interpreted it, see point 15.1 of the decision) was not new in view of document D1, among others. The appellant did not contest the examining division's interpretation of claim 1 of the Main Request and neither does the board.

3.1.2 D1 describes a portable device (300), which, among others, comprises a telephone module (390) incorporating a portable object (SIM card) ("SIM 302-1" in Figure 3 and paragraph [0029]). In the board's view the device (300) must also comprise a portable object (card) reader since it would not function without such a reader. In order to be able to use/operate the incorporated SIM card, a card reader is necessary. Hence, the device (300) corresponds to the first device of claim 1.

3.1.3 The device (300) is docked in a docking station (800; see Figure 8 and paragraph [0066]). Among other parts, the docking station (800) comprises a CODEC (853) (code/decoder for e. g. audio data) and its own microphone(s) and speaker(s), *"allowing the audio input-output to be performed with elements of Docking Station 800, rather than integral elements of Device 300"* (paragraph [0067]). The board considers thus that docking station (800) corresponds to the second device of claim 1.

3.1.4 As D1 further explains, it is possible, when the device (300) is docked within the docking station (800), to use its telephone module (390) (paragraph [0069]).

In the board's view, using telephone module (390) of the device in this situation, implies that any communication/call is carried out via the docking station, since it is the microphone(s) and speaker(s) of the docking station (800) that are used.

3.1.5 According to claim 1 of the Main Request, the second device has access to an application on the portable object via the relay means.

3.1.6 In the statement of grounds of appeal, the appellant pointed out that D1 did not mention any application on the SIM card. Moreover, accessing data on the SIM card could not be considered as running an application on the SIM card (statement of grounds of appeal, page 5, bottom half).

3.1.7 The board notes at first that there is no indication in claim 1 of the Main Request that the application on the portable object (smart card) is activated or executed (run) by the second device. The claim defines only that *"the second device have [sic] access to said application of said portable object"*. Accessing or having access to the application does not necessarily indicate that the application is executed or activated in any way.

3.1.8 Hence, contrary to the appellant's assertion, the board holds that this occurs also in D1. The docking station (800) has access to the telephone module (390) of the device (300) in order to carry out a telephone communication (a telephone connection). In order to

carry out a telephone communication with the telephone module (390), the docking station (800) must access data stored on the SIM card of the telephone module. In the board's view, whether the stored data is encrypted information (see e. g. paragraph [0029]), or an application (that would carry out the telephone communication, for example) does not constitute a difference from a technical point of view. It suffices that data on the smart card (portable object) are accessed by the second device in order to anticipate the corresponding feature of claim 1.

3.1.9 Regarding the "relay means", claim 1 does not provide any details. The board understands that this functional definition in the claim refers to any means that would allow access to the application on the portable object by the second device. The board considers it unnecessary to identify a particular feature in D1 that would correspond to the claimed relay means, since it is the function of relaying that is important. Since the telephone module (390) in D1 can be used by the docking station to establish a telephone connection, there must be corresponding "relay means" that enable the docking station to access the data on the SIM card (see also point 15.2.3 of the contested decision).

3.1.10 The appellant argued that using the telephone module of the cell phone in order to make a telephone call and exchange data with a base station went "far beyond the relay function between the SIM card and the docking station." According to the appellant such an operation used "much more resources" than those required by a relay function such as that of claim 1 (statement of grounds of appeal, paragraph bridging pages 5 and 6).

3.1.11 The board does not agree. As previously mentioned, the claim does not provide any details as to the relay function/means. Moreover, the claim defines that it is the accessing by the second device of the application on the portable object (smart card) that is achieved *independently of the first device resources*. What occurs subsequently is irrelevant. Hence, what happens between the first and second devices and the portable object (smart card) during a possible subsequent telephone call does not affect the fact that the second device was able to access the data on the SIM card independently of the first device resources.

3.1.12 Even if the appellant's argument were followed, the board would still remain of the opinion that this feature is disclosed in D1. In D1, when the device (300) is docked within the docking station (800), the functions of many of its parts are taken over by corresponding parts of the docking station, such as I/O module, display, power supply etc. (paragraphs [0066] to [0069]). This indicates that many of the functions of the (first) device (300) are taken over by the docking station (second device). In the particular case of a telephone connection it is thus implicit that the docking station accesses the SIM card (reader) of the telephone module (390) directly via the connector (701) and without using any of the device's other resources (300). This is further corroborated by the passage in paragraph [0067] according to which the docking station (800) includes microphone(s) and speaker(s), *"allowing the audio input-output to be performed with elements of Docking Station 800, rather than integral elements of the device 300."*

3.1.13 The board thus concludes that D1 discloses all features of claim 1 of the Main Request, whose subject-matter is, therefore, not new within the meaning of Article 54(1) EPC 1973.

3.2 Added subject-matter (Article 123(2) EPC)

3.2.1 Dependent claim 10 defines that the smart card comprises means for *"sending at least one signal to said personal computer through said handset USB HUB device and said portable object reader, so as to respond to said personal computer further to the execution of the activated application"*.

3.2.2 This claim was first introduced with the appellant's (then applicant's) letter of 7 September 2015 (claim 10 in that claim set). In that letter the appellant pointed to page 6, lines 9 to 11, of the originally filed application as basis for this claim (page 2 of that letter).

3.2.3 Including the sentence preceding the passage cited by the appellant, the passage reads as follows: *"Then, the relaying function sends corresponding signals to the card, through the card reader. The same path is used for signals emanating from the card and destined to device B, that is through the card reader then through the relaying function"* (see application as published, page 6, lines 8 to 11).

3.2.4 There is no mention in this passage of the signals sent by the smart card responding to the execution of the activated application, as claim 10 defines. The board did not find any other passage in the originally filed application as a whole that could support this feature, either.

Thus, the board concludes that claim 10 of the Main Request contains subject-matter which extends beyond the originally filed application, contrary to the requirements of Article 123(2) EPC.

4. Auxiliary Requests

4.1 Claim 1 of both the First and the Second Auxiliary Request comprises the features of claim 10 of the Main Request (last lines of claim 1 in both requests).

Hence, for the same reasons as for claim 10 of the Main Request, claim 1 of the First and Second Auxiliary Requests contains subject-matter extending beyond the originally filed content of the application (Article 123(2) EPC).

4.2 Claim 1 of the Second Auxiliary Request defines that *"said first device is a handset, said portable object is a smart card and said second device is a personal computer... comprising... means for sending to said portable object at least one signal... so as to activate said application by querying the web server application present in the smart card..."* (underline by the board).

4.2.1 As a first remark, according to the above definition, there are two applications on the portable object (smart card), a web server application and "said application". In addition, the personal computer activates the latter by querying the former. The board finds that this definition is ambiguous, since the only application previously defined in the claim is the web server application (first two lines of claim 1) and it is not clear which application is meant by "said

application". Moreover, it is not clear how this "said application" is activated by querying the web server application. The board's opinion is, therefore, that claim 1 of the Second Auxiliary Request lacks clarity (Article 84 EPC 1973).

4.2.2 Secondly, assuming that "said application" refers to the web server application, there appears to be no basis in the application as filed for the second device activating the web server application on the smart card by quering it. The appellant has not provided any basis for this amendment, either. In the board's view, this feature constitutes added subject-matter which goes beyond the originally filed content of the application (Article 123(2) EPC).

5. Since none of the requests on file is allowable, the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Decker

Decision electronically authenticated