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**Datasheet for the decision  
of 7 March 2023**

**Case Number:** T 2204/18 - 3.4.02

**Application Number:** 12156831.5

**Publication Number:** 2492878

**IPC:** G07C9/00

**Language of the proceedings:** EN

**Title of invention:**

Methods and apparatus to control access

**Patent Proprietor:**

BlackBerry Limited

**Opponent:**

dormakaba Deutschland GmbH

**Headword:**

**Relevant legal provisions:**

EPC Art. 56

EPC R. 140

RPBA 2020 Art. 12(4)

**Keyword:**

Inventive step - main request (no)  
Late filed auxiliary request - admitted in first-instance proceedings (no) - admitted in appeal proceedings (no)  
Correction of error in decision - request (refused)  
Substantial procedural violation - (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

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Case Number: T 2204/18 - 3.4.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.02**  
**of 7 March 2023**

**Appellant:** BlackBerry Limited  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 12 July 2018  
revoking European patent No. 2492878 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** R. Bekkering  
**Members:** C. Kallinger  
B. Müller

## **Summary of Facts and Submissions**

I. The patent proprietor (appellant) appealed against the decision of the opposition revoking the European patent No. 2492878.

II. The proprietor requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the claims of the main request or one of auxiliary requests 1 to 3, all filed with the statement setting out the grounds of appeal of 9 November 2018.

In addition, the proprietor requested that the decision be corrected on the grounds that the proprietor's observations had been erroneously attributed to the opponent.

Finally, the proprietor argued that the opposition division had violated the proprietor's right to be heard which constituted a substantial procedural violation.

III. In its reply to the grounds of appeal, the opponent (respondent) requested that the appeal be dismissed and that the decision to revoke the patent be maintained. In particular, the opponent requested that the auxiliary requests be not admitted into the appeal proceedings.

IV. The parties were informed of the board's preliminary opinion in a communication pursuant to Article 15 (1) RPBA.

V. Oral proceedings before the board were held on 7 March 2023.

VI. The parties' final request were as set out above.

VII. The following documents are referred to in this decision:

D1 US 2007/0026801 A1

D4 US 2007/0219950 A1

VIII. Claim 1 of the main request reads as follows:

*A method comprising:*

*requesting from a mobile device (140) using close-proximity communication authorization to access a first physical area (102, 104, 106, 108, 110);*

*receiving at the mobile device (140) using close-proximity communication authorization to access the first physical area (102, 104, 106, 108, 110);*  
*storing the authorization and a time stamp of the authorization in an access history at the mobile device (140);*

*requesting from the mobile device (140) using close-proximity communication authorization to access a second physical area (102, 104, 106, 108, 110) inside the first physical area (102, 104, 106, 108, 110), the request to access the second physical area (102, 104, 106, 108, 110) comprising the access history comprising a list of access control systems (122, 124, 126, 128, 130) from which the mobile device (140) has received authorization and time stamps of the authorizations;*  
*and*

*receiving at the mobile device (140) using close-proximity communication authorization to access the second physical area (102, 104, 106, 108, 110), wherein*

*receipt of the authorization to access the second physical area (102, 104, 106, 108, 110) is dependent upon prior receipt of the authorization to access the first physical area (102, 104, 106, 108, 110) being determined from the access history;*

*wherein the mobile device (140) is a smartphone.*

- IX. Compared to claim 1 of the main request, the following feature has been added at the end of claim 1 of the first auxiliary request:

*"..., the access history being stored in a user data store (204) on a server within a secure network, the user data store (204) being accessible to the smartphone over a secure connection through a network (202)."*

- X. Compared to claim 1 of the first auxiliary request, the following feature has been added at the end of claim 1 of the second auxiliary request:

*"..., the user data store (204) further storing personal information relating to the user of the smartphone(140); the method further comprising transferring by the mobile device to the access control system (130) personal information relating to the user of the mobile device and wherein receipt of the authorization to access the second physical area (102, 104, 106, 108, 110) is dependent also on the access control system (130) using the personal information to verify the identity of the user of the smartphone."*

- XI. Compared to claim 1 of the main request, the following feature has been added at the end of claim 1 of the third auxiliary request:

"..., and each of the access control systems comprise a network interface (412) to communicate with a public or private network (202)."

## **Reasons for the Decision**

### 1. Main Request

#### 1.1 Admittance

The opponent argued that this request was filed during first instance opposition proceedings one day after the expiry of the time limit laid down in Rule 116(1) EPC. Therefore this request was late filed and should be "treated as such" (see reply to appeal, point 1).

As the opposition division confirmed that this request was filed after the time limit laid down in Rule 116(1) EPC (see decision, point 3.1, first sentence), the board is of the opinion that the opposition division was aware that this request was filed late. According to the decision (see decision, point 3.1, second sentence), the opposition division exercised its discretion in admitting this request to the opposition proceedings because the substance of the amendments was *prima facie* relevant and a fair response to the opponent's arguments and the division's opinion in the summons.

The board is of the opinion that these reasons show that the opposition division properly exercised its discretion (see Case law of the Boards of Appeal ("Case Law"), 10th edition 2022, V.A.3.4.1 b)).

Apart from that, a request that was admitted in the first instance opposition proceedings is part of the appeal proceedings (see Case Law, V.A.3.4.4).

In conclusion, the claims according to the main request are part of the appeal proceedings.

## 1.2 Inventive step - Article 56 EPC

Claim 1 relates to a method using a mobile device using close-proximity communication for controlling access to a physical area. Access authorisation to a second physical area within a first physical area is dependent on a user having obtained access to the first physical area. This is realised by storing and evaluating the access history (authorisation and timestamp) on the mobile device. Claim 1 defines that the mobile device is a smartphone.

1.2.1 In its decision, the opposition division argued that document D4 disclosed all the features of claim 1 except that the mobile device used for access control was a smartphone rather than an access card. In combination with the disclosure in document D1, which disclosed the use of a mobile phone for access control, claim 1 lacked an inventive step (see decision, point 3.3).

1.2.2 The proprietor agreed that document D4 did not disclose that the mobile device was a smartphone.

However, the method of claim 1 also differed in that claim 1 defined a series of steps which were explicitly performed by the claimed smartphone, whereas D4 did not attribute this functionality to the access card.



The invention provided a device that actively performed the claimed steps. This was reflected in the fact that the method claim explicitly recited the reading and writing of information to the smartphone. In contrast, the access control card in D4 was a passive device that could be interrogated by the access control system.

Furthermore, as D4 disclosed a dedicated access control card with a specific purpose and function, D4 did not contain any teaching to embed the access control functionality in a smartphone, which had more communication capabilities compared to a simple access control card.

Starting from document D4 as closest prior art and taking into account these differences, the claimed method solved the objective technical problem of further improving the security of the access protocol of D4.

The proprietor argued in particular that the problem as indicated in the decision, i.e. *"how to integrate the access card according to D4 in a single device"* (see decision, page 4, last paragraph) contained a pointer to the solution and was therefore subjective and chosen with hindsight.

In relation to the combination of documents D4 and D1, the proprietor argued that document D4 was aimed at improving access security in high security areas, such as airports, whereas D1 related to low security areas with transient users, such as a hotel. Therefore, the skilled person would not consider document D1 when trying to improve the security of the system of D4.

Furthermore, even if the skilled person were to combine the teachings of documents D4 and D1, they would not arrive at the claimed solution. In D4, an access control card was used to distribute information such as access rights or the access history throughout a system of networked and non-networked access points. The use of an access control card with such capabilities was therefore a purposeful decision which the skilled person would not reverse by replacing the card with a smartphone. This was all the more the case, as a smartphone was a personal device which, in contrast to a dedicated access control card, would not be returned when a user was no longer granted access to a secured area, for example at the end of employment.

Even if the skilled person were to replace the access control card of D4 with a smartphone as suggested by D1 (see paragraph [0024]), he would not "cherry-pick" this hint alone but would consider the whole teaching of D1. Therefore, in order to further improve the security, the skilled person would, for example, transmit a list of locked access codes for temporary storage on the mobile device as suggested in D1 (see paragraph [0030]).

In contrast to this, the claimed method did not rely on such an enhanced security protocol but granted access to a second physical area based on an access history stored on a smartphone. The appellant argued that the invention was a "concept" invention in which the inventors realised that a smartphone, together with the claimed security protocol, could actually be used to improve security in access control systems.

In summary, the subject-matter of claim 1 differed not only in the feature that the mobile device was a

smartphone, but also in that the claimed method was actively performed by the smartphone as part of the access control management, and in particular in that the memory of the smartphone was used to store the authorisation and an access history.

In conclusion, the skilled person would not have arrived at the claimed invention starting from document D4 and in view of document D1 without the benefit of hindsight.

- 1.2.3 The board is not convinced by the arguments of the proprietor but agrees with the opposition division and the opponent for the following reasons.

D4 relates to systems and methods for controlling access and discloses a mobile device in the form of an access card having a readable/writable memory and a CPU (see paragraph [0020]). In order to gain access, the card (100) is presented to an access control device (200) (see Figure 3 and the corresponding description). The board agrees with the opposition division's argument that the active presentation of an access card is not different from an active request from a mobile device to an access control device. D4 therefore discloses the first step of the claimed method.

D4 further discloses that an access history can be written to the user's access card (see paragraph [0018]). D4 therefore discloses the claimed steps of receiving and storing the authorisation and a timestamp of the authorisation in an access history at the mobile device.

In addition, D4 teaches using the stored access history to control access to further areas within a first area

by comparing the access history against predefined rules (see paragraphs [0018], [0034], [0039] and [0040] and Figure 3). Again, the board agrees with the opposition division's argument that the active presentation of an access card (now to a second access control device) is not different from an active request from a mobile device to an access control device. D4 therefore also discloses the steps of requesting access to a second physical area, receiving authorisation to access the second physical area on the mobile device, and that the authorisation to access depends on the authorisation to access the first physical area as determined from the access history.

The board therefore agrees with the opposition division's finding that claim 1 differs from the disclosure of D4 only in defining that the mobile device is a smartphone.

The board does not share the proprietor's view that the objective technical problem was to improve the security of the access protocol. The claimed method does not use any of the alleged additional capabilities of the smartphone.

Therefore, the board is of the opinion that the objective technical problem is to find an alternative to the smart card of document D4.

With respect to the disclosure of D1 and its combination with document D4, the board is of the opinion that document D1 also relates to electronic door locks (see paragraph [0002]) for controlling access to different parts of a building, for example airports (see paragraph [0011]). To grant access, D1 proposes the use of a mobile telephone having a memory

unit, an interface, a display unit and a keyboard (see paragraph [0028]). The telephone also has a near field communication system for sending and receiving access codes (see paragraph [0030]) and it can also use its memory to store and retrieve access codes (see paragraphs [0032] and [0033]). The D1 mobile phone thus has more advanced computing and connectivity capabilities than a feature phone and is therefore a smartphone.

D1 suggests the preferred use of a mobile telephone, explaining that it *"is thus possible to avoid an obligation on the user to carry, for example, apart from his or her mobile telephone a further mobile communications unit"* (see paragraph [0024]). D1 further explains that *"it is possible to dispense with conventional smartcards or other separate chipcards that are carried. In particular, if the mobile telephone 10 is equipped so that the afore-described establishing of contact and data exchange processes can take place automatically, a user-friendly system can be provided."* (see paragraph [0034]). It follows that the person skilled in the art, starting from D4 and looking for an alternative to the access control card used in document D4, learns from document D1 to use a smartphone as the mobile device.

The proprietor's arguments concerning the improvement of the security of the access protocol are not convincing because, as explained above, the differentiating feature does not have such a technical effect.

In addition, the board is of the opinion that the skilled person would replace the access control card with a smartphone in view of the explicit suggestion in

document D1 to use a smartphone and the advantages associated therewith. Since the use of the smartphone in D1 is not inextricably linked to other features of the security system of D1, such as the transmission and storage of locked access codes, the proprietor's arguments in this respect are not convincing.

In conclusion, the board is of the opinion that the patent as amended according to the main request does not meet the requirements of Article 52(1) EPC because the subject-matter of claim 1 of the main request lacks an inventive step starting from D4 in combination with D1.

## 2. Auxiliary requests - Admittance

### 2.1 First and second auxiliary request

2.1.1 During the first instance opposition proceedings, the opposition division did not admit these auxiliary requests into the proceedings.

2.1.2 The proprietor argued that the opposition division had erred in not admitting these requests

Rule 80 EPC allowed amendments to the European patent in opposition proceedings, provided that the amendments were occasioned by a ground for opposition. However, Rule 80 PEC did not provide for a time limit for such amendments. Therefore, the auxiliary requests should have been admitted by the opposition division.

Even if these requests were considered to have been filed late, this was not due to a deliberate misconduct but to a minor lack of diligence, if any. The

amendments did not constitute an abuse of procedure but were filed in response to a communication from the opposition division and were a reasonable attempt to overcome the objections.

The amended subject-matter was not complex and was filed 9 days before the oral proceedings so that the opponent and the opposition division could easily have dealt with it. Therefore, procedural economy did not weigh in favour of non-admittance.

Finally, the amendments did not go in an unexpected direction as they built on the previous amendment defining the mobile device as a smartphone. The amended subject-matter was new and inventive, but the opposition division did not properly consider the *prima facie* allowability of the amended subject-matter.

In conclusion, the first and second auxiliary requests should have been admitted into the opposition proceedings.

The proprietor therefore requested that the first and second auxiliary requests be admitted into the appeal proceedings.

- 2.1.3 The opponent argued that the first and second auxiliary requests were filed late and that the late filing was not justified.

The amendments were taken from the description and related, *inter alia*, to the storage of the access history on a server within a secure network which was accessible to the smartphone via a secure network. The amendments were therefore neither foreseeable nor easy to understand.

2.1.4 The board is not convinced by the proprietor's arguments but agrees with the opponent and the opposition division for the following reasons.

In its summons to oral proceedings the opposition division set the final date for making amendments to be 26 April 2018. The first and second auxiliary request were filed on 19 June 2018. They are therefore filed late and need not to be considered (Rule 116 EPC).

The opposition division based its discretionary decision not to admit these auxiliary requests into the opposition proceedings on the arguments that the requests were filed late and contained major amendments which were taken from the description and went in an unexpected direction (see decision, point 2, first paragraph). The opposition division further found that, in particular, the amendment that the access history was stored on a server in a secure network was not easily reconcilable with the previously claimed feature that the access history was stored on the mobile device (see decision, point 2, third paragraph). Finally, the opposition division was of the opinion that these requests did not have a promising chance of success and placed an undue burden on the other party, which could lead to a delay in the proceedings (see decision, point 4.1, last paragraph).

The board is of the opinion that the opposition division exercised its discretion according to the right principles and in a reasonable way and came to the conclusion, although not explicitly stated, that the first and second auxiliary requests were not clearly allowable. According to established case law there is therefore no reason to overturn the opposition



division's discretionary decision not to admit these auxiliary requests to the proceedings (see Case Law, V.A.3.4.1 b) ).

For the same reasons as those given by the opposition division, the board sees no reason to not exercise its power under Article 12(4) RPBA 2007 to hold inadmissible these requests which were not admitted in the first instance proceedings.

Consequently, the first and second auxiliary requests are not admitted into the appeal proceedings.

## 2.2 Third auxiliary request

2.2.1 The third auxiliary request corresponds to the auxiliary request submitted during the oral proceedings before the opposition division and labelled "11:00". During the first instance opposition proceedings, the opposition division did not admit this auxiliary request into the proceedings because it was filed late and was *prima facie* not allowable.

2.2.2 The proprietor argued that the decision not to admit this request was flawed because the opposition division had found that the subject-matter claimed in this request was not novel, whereas the subject-matter claimed in the main request on which this auxiliary request was based had already been found to be novel with respect to document D4.

This request was filed as a fair and appropriate response to the opposition division's negative opinion on the higher-ranking requests. The amendments continued to build on the use of the smartphone and therefore did not go in an unexpected direction but

were convergent. The opposition division should have examined their content at least for *prima facie* allowability, as timeliness was not a criterion *per se*. However, the very short duration of the oral proceedings showed that the opposition division did not properly consider this aspect.

In conclusion, the third auxiliary request should have been admitted into the opposition proceedings.

The proprietor therefore requested to admit the third auxiliary request to the appeal proceedings.

- 2.2.3 The opponent argued that the third auxiliary request was filed late and that the late filing was not justified.

In addition, the amendments did not relate to a smartphone but went into a different direction using features related to the stationary access control taken from the description.

Finally, the amendments did not contribute to the objective technical problem as solved by the invention.

- 2.2.4 The board is not convinced by the proprietor's arguments and agrees with the opponent and the opposition division for the following reasons.

First, the board is not convinced by the proprietor's argument that the opposition division (wrongly) considered the subject-matter of claim 1 of this auxiliary request to be lacking novelty, since the opposition division merely stated that the added features appeared to be disclosed in D4 (see decision, point 4.1, third paragraph).

The opposition division's discretionary decision not to admit this auxiliary request into the opposition proceedings was therefore based on the arguments that this late filed request contained amendments taken from the description which went in a different direction compared to the main request and that the request appeared *prima facie* not allowable (see decision, point 4.1, second and third paragraphs). In addition, this request placed an undue burden on the other party which could lead to a delay in the proceedings (see decision, point 4.1, last paragraph).

The board is of the opinion that the opposition division exercised its discretion in accordance with the right principles and in a reasonable way. According to established case law there is therefore no reason to overturn the opposition division's discretionary decision not to admit these auxiliary requests into the proceedings (see Case Law, V.A.3.4.1 b) ).

For the same reasons as those given by the opposition division, the board sees no reason to not exercise its power under Article 12(4) RPBA 2007 to hold inadmissible this request which was not admitted in the first instance proceedings.

As a consequence, the third auxiliary request is not admitted into the appeal proceedings.

3. Correction of the decision - Rule 140 EPC

The proprietor requested the correction of a number of allegedly evident mistakes in the decision. For

example, on page 6 of the decision, comments were wrongly attributed to the opponent.

According to Rule 140 EPC obvious mistakes in a decision may be corrected. However, the board notes that it is not competent to decide on a request for correction of a written decision which was taken by the opposition division (see Case Law, III.L.1.2).

Notwithstanding the above, the board is of the opinion that, as also stated by the proprietor (see letter dated 6 September 2018), it is evident from which party the respective arguments originated and that the board therefore was in a position to fully review the appealed decision.

4. Substantial procedural violation

4.1 The proprietor was of the opinion that, based on the totality of the circumstances, there had been a substantial procedural violation during the oral proceedings.

First, the opposition division applied in the process of the non-admittance of various auxiliary requests, without saying so, the criterion of economy to the proceedings, and therefore violated the proprietor's right to be heard.

Furthermore, the opposition division's failure to properly consider the amendments in the non-admitted auxiliary request at the oral proceedings violated the proprietor's right to defend the patent and constituted a substantial procedural violation.

The proprietor was of the opinion that the opposition division had decided *a priori* that the claims of the various requests were not allowable and that the patent should be revoked. As the oral proceedings were interrupted for a longer period of time at the beginning, in fact they lasted only one hour and fifty minutes, which was insufficient for the opposition division to analyse the case properly. The appellant had no opportunity to argue the case substantively. Moreover, the subject-matter of the application was not complex. The Opposition Division may have listened to the appellant, but it did not hear the appellant. The minutes of the oral proceedings were indicative of a lack of diligence.

- 4.2 The board is not convinced by the proprietor's arguments for the following reasons.

The minutes of the oral proceedings before the opposition division (see point 2) show that the proprietor was given the opportunity to present arguments as to whether the non-admitted requests should be considered.

Moreover, the arguments put forward by the proprietor in favour of considering those requests were also dealt with in contested decision (see point 2).

Similarly, the proprietor was given the opportunity to present arguments as to whether the current third auxiliary request should be considered (see minutes, point 4.1) and these arguments were also discussed in the decision (see point 4).

The board is therefore of the opinion that the proprietor's right to be heard has not been violated.

In addition, as discussed above, the board is of the opinion that the opposition division properly exercised its discretion in deciding not to consider, i.e. not to admit, the auxiliary requests. Not admitting requests submitted by the proprietor does not constitute a breach of the proprietor's right to be heard, provided that the proprietor has been given the opportunity to comment on their admittance (cf. Case Law of the Boards of Appeal of the EPO, 10th ed. 2022, section V.A.5.6, in particular R 9/11). As explained above, this was the case. Whether this was done in a perfunctory manner cannot be confirmed by the facts available from the minutes or the decision.

## Order

### **For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



L. Gabor

R. Bekkering

Decision electronically authenticated