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**D E C I S I O N**  
**of 15 July 1996**

**Case Number:** T 0719/95 - 3.5.1

**Application Number:** 87102400.6

**Publication Number:** 0233649

**IPC:** G06K 19/07

**Language of the proceedings:** EN

**Title of invention:**  
IC-Incorporated memory card

**Patentee:**  
KABUSHIKI KAISHA TOSHIBA

**Opponent:**  
GAO Gesellschaft für Automation und Organisation mbH

**Headword:**  
Toshiba/IC-Incorporated memory card

**Relevant legal provisions:**  
EPC Art. 111(1)

**Keyword:**  
"Remittal for further prosecution"  
"Relevant document cited in the Search Report not considered in the opposition proceedings and a new claim 1 requires reexamination"

**Decisions cited:**  
-

**Catchword:**  
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Case Number: T 0719/95 - 3.5.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.1  
of 15 July 1996

**Appellant:**  
(Opponent) GAO Gesellschaft für Automation und  
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**Representative:** Klunker . Schmitt-Nilson . Hirsch  
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**Respondent:**  
(Proprietor of the patent) KABUSHIKI KAISHA TOSHIBA  
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**Representative:** Henkel, Feiler, Hänzel & Partner  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 23 June 1995  
rejecting the opposition filed against European  
patent No. 0 233 649 pursuant to Article 102(2)  
EPC.

**Composition of the Board:**

**Chairman:** P. K. J. van den Berg  
**Members:** R. Randes  
M. Lewenton

## Summary of Facts and Submissions

I. European patent No. 0 233 649 was granted on the basis of European patent application 87 102 400.6, filed on 20 February 1987 and claiming priority from Japanese application 36665/86, dated 21 February 1986.

II. Claim 1 of the granted patent is worded as follows:

"A memory card for use in a card information-processing unit, to allow information contained in the card to be processed, comprising:

a card body (2) having a main surface (2a);  
at least one integrated circuit (4, 6) incorporated in the card body (2), and having a plurality of internal and external signal-connecting terminals (4a, 6a);

a plurality of electric signal-carrying members (8) electrically connected to respective terminals (4a, 6a) of the integrated circuit (4, 6), and having contact terminals (8a) for electrical connection to the card information-processing unit, the contact terminals (8a) being exposed [in a predetermined pattern] on the main surface (2a) of the card body (2); and

a protective cover (12) having a surface (12a) facing a main surface (2a) of the card body (2), and being slidably movable in two predetermined directions on the main surface (2a) of the card body (2), [the protective cover (12) being movable in one of the two directions, so that when the memory card is being used, the respective contact terminals (8a) may be exposed, and being movable in the other direction, so that when the memory card is not being used, the respective contact terminals (8a) may be covered];

characterizing by further comprising

short-circuiting means (24, 32, 38, 42, 46, 52) provided on [said] surface (12 a) of the protective cover (12), for electrically short-circuiting the respective contact terminals (8a) when the protective cover (12) [covers the respective contact terminals (8a)]."

The Board has put parts of the features of the cited claim within brackets (thus: [ ]) in order to simplify the indication of references to those parts later in the decision.

III. On 21 August 1992 the Appellants (then Opponents) filed an admissible opposition, requesting revocation of the patent on the ground that its subject-matter was not patentable within the terms of Articles 52 to 57. Of the prior art documents cited in the proceedings, only the following were considered relevant by the Opposition Division:

D1: JP-U-59-70262  
D2: JP-A-59-32085  
D4: EP-A-0 071 031

IV. By a decision dispatched on 23 June 1995, the Opposition Division rejected the opposition.

In the decision it was concluded that D1 disclosed an IC card as indicated in the preamble of Claim 1. Said card prevented accumulation of dirt on the contact terminals; however, D1 did not teach how to prevent electrostatic charging of the terminals. The teaching of both D2 and D4 disclosed separate ways of doing it, but the design of the cards disclosed in said documents was quite different from the one according to the preamble of the present invention; it was said that "in D2 as well as in

D4, the short-circuiting means are provided on or in the card body". The skilled person would, therefore, not be led to move the short-circuiting means to the slidable cover.

- V. On 22 August 1995 the Appellants filed a notice of appeal against the decision and paid the appeal fee. A written statement setting out the grounds of appeal was filed on 19 October 1995. In said statement the Appellants argued that the combination of documents D1 and D4 would lead the skilled person to the alleged invention. They requested revocation of the patent and conditionally oral proceedings were requested.
- VI. In a letter filed on 22 February 1996 the Respondents contested the argumentation of the Appellants and requested the dismissal of the appeal. An auxiliary request for oral proceedings was made.
- VII. In a communication annexed to the summons to attend oral proceedings on 9 July 1996 the Board gave its provisional view on the appealed decision. It expressed the opinion that when starting from the teaching of D1 disclosing a card having a slidable cover it appeared that the skilled person would then either have decided that D1 could not be combined with D4 at all [as had been suggested by the opposition division], or he would have arrived at the invention. In the Board's preliminary view the necessary modifications were so small that they did not necessarily involve an inventive step.

It was, moreover, noted that document

JP-A-59-41 091 (hereinafter D5),

which in the search report was cited together with D2 as a Y-document, had been mentioned neither by the Opposition nor by the Examining Division (although mentioned by the Applicants themselves in the letter filed on 8 June 1993 wherein it was alleged to disclose a card having a slidable cover like the card according to D1). This document D5 also appeared to disclose a card as identified by the preamble of claim 1. It was noted that in the figures of D5 (no translation of the Japanese text of the application document being available) the part of the cover adjacent to the terminals was referred to as 12b and it was noted that

"in the figures this part is drawn in such a way as to suggest that it is made of another material than the rest of the slider. The purpose of the device in D5 is according to the abstract to 'prevent a semiconductor circuit from damage due to careless impression of a high voltage'. The abstract does not indicate that short-circuiting is performed in D5, nor that the part 12b is made of a conductive material. It must however be considered what additions to D5 would have been within the reach of a skilled person considering to provide the described card with short-circuiting means. If D5 is taken as starting document instead of D1 the constructional changes regarded as unobvious by the opposition Division vanish; the modifications would in fact mainly concern the choice of material for already existing part 12b".

VIII. Together with a letter the Respondent filed a new claim 1 on 11 June 1996. This claim has been amended in relation to the granted claim in that in principle the whole subject-matter of granted claim 1 has been made

the precharacterizing part of the new claim. However, the following changes have been made in said precharacterizing part of the new claim in relation to the wording in the granted claim 1:

in the paragraph corresponding to the fourth paragraph of the old claim the expression "in a predetermined pattern" (within the marking brackets added by the Board) has been deleted.

in the fifth paragraph the wording within the brackets has been replaced by the wording

"between a closed position wherein the respective contact terminals (8a) are covered by the protective cover (12) and an exposed position wherein the respective contact terminals (8a) are exposed; urging means (14) for urging the protective cover (12) to the closed position; and"

In the last feature of the precharacterizing part of the new claim 1 (corresponding to the characterizing feature of granted claim 1) the last three reference signs within the first parentheses have been dropped, "said" within brackets has been changed to "the" and the wording within the brackets at the end of the characterizing feature of the granted claim 1 has been changed to

"is located in the closed position".

The characterizing part of claim 1 reads as follows:

"characterized in that

a first holding portion (16) is provided on the protective cover (12);

a second holding portion (18) is provided on the card body (2) so as to engage with the first holding portion (16) to restrict the protective cover (12) to move from the covered portion to the exposed position, when the protective cover (12) is moved to the closed position; the urging means (14) urges the protective cover (12) to the closed position so that when the memory card is not being used, the first holding portion (16) engages the second holding portion (18);

an engagement portion (20) is formed on the protective cover (12), so that the engagement portion can be brought to abutting engagement with an associated engagement member of the card information processing unit when the memory card is inserted therein and the protective cover (12) is moved to the exposed position against the restriction by the engagement between the first and second holding portions and against the urging means (14) in accordance with the insertion of the memory card into the card information processing unit; the short-circuiting means (32, 38) includes a short-circuiting member formed of an electroconductive spring member (34, 40) which has contact terminal portions (34b, 40b) for contacting with the contact terminals (8a) when the protective cover (12) is located in the closed position, and slidable on the protective cover (12) and the main surface (12a) in accordance with the movement of the protective cover (12)."

IX. According to the Respondents all of the new characterizing features of claim 1 can be derived from the description of the application.

The Respondents acknowledge in the letter that the conductive layer 12b shown in D5 referred to by the Board, is a conductive layer which short-circuits terminals 8 when the slider 12 is moved to cover terminals 8.

It is, however, said that the card of document D5 entirely differs from the present invention in that said card does not have members corresponding to the first and second holding portions 16 and 18. Therefore, the protective cover of D5 cannot be urged to engagement in the closed position in the sense of the invention by the urging force of a spring member. Therefore the protective cover of D5 could be easily removed from its closing position and expose the terminals when the user does not use the card. Moreover, the card according to D5 does not have short-circuiting means in the form of an electroconductive spring member which contributes to a secure short-circuiting of the terminals.

The Respondents request to maintain the European patent on the basis of the new claim 1 and published claims 2 to 10.

X. In a notification dispatched on 25 June 1996 the Registry on behalf of the Board informed the parties that the oral proceedings intended to be held on 9 July 1996 had been cancelled.

### Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. It appears to the Board - when regarding the content of Facts and Submissions above - that a totally new situation has arisen in comparison to that which the Opposition Division had to consider in making its decision.

The Respondents have, thus, made amendments to claim 1 introducing all new characterizing features from the description, i.e. the Opposition Division did not have the opportunity to evaluate these amendments. Moreover, the Respondents have apparently acknowledged the teaching of D5 as the closest prior art. However, as has been made clear above, said document was not considered at all during the proceedings before the Opposition Division.

Since the subject-matter of present claim 1 is entirely different and because a new "most relevant prior art document" has also been introduced into the proceedings it appears that the case requires a careful new examination.

3. In such circumstances, in order to preserve the opportunity for both parties to argue their case before two instances of the EPO, it would, therefore, appear appropriate to remit the case to the Opposition Division for further prosecution (Article 111(1) EPC).

4. Since the decision taken by the Board cannot be said to be negative in respect of either party, there is no need to appoint oral proceedings according to the conditional requests made.

**Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg

