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D E C I S I O N
of 23 October 1997

Case Number: T 0046/96 - 3.5.1

Application Number: 91904975.9

Publication Number: 0466916

IPC: H04N 7/167

Language of the proceedings: EN

Title of invention:

External Security Module for a Television Signal Decoder

Applicant:

Scientific-Atlanta, Inc.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 84

Keyword:

"Clarity and conciseness of claims (yes)"

Decisions cited:

-

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0046/96 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 23 October 1997

Appellant: Scientific-Atlanta, Inc.
One Technology Parkway South
Norcross
GA 30092-2967 (US)

Representative: Hogg, Jeffery Keith
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 17 August 1995
refusing European patent application
No. 91 904 975.9 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: A. S. Clelland
V. Di Cerbo

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division to refuse the application on the ground that the independent claims did not meet the requirement of Article 84 EPC because they lacked conciseness. It was stated in the decision that the applicant (appellant) had been given several opportunities to amend the set of claims in order to meet Article 84 EPC as to conciseness but did not appear to be prepared to restrict the number of independent claims to a reasonable number.
- II. The appellant lodged an appeal against this decision and paid the prescribed fee. A statement of grounds was subsequently filed, together with four new sets of claims, representing a main request and three auxiliary requests. A request for oral proceedings was also filed.
- III. Following two communications from the Board, oral proceedings were appointed for the 23 October 1997. In the course of the oral proceedings the appellant withdrew all existing requests and presented a single set of claims. He requested that the application be remitted to the examining division for further prosecution on the basis of this set of claims. The documents of the appellant's request are accordingly as follows:

Claims: 1 to 25 as filed at the oral proceedings.

Description: pages 1 to 11, 14, 16 to 23 as published; pages 12 and 12a as received on 7 June 1994; and pages 13, 15, 24 and 25 as received on 21 March 1997.

Drawings: sheets 1 to 9 as published.

IV. The request includes four independent claims, claims 1, 8, 18 and 21, directed respectively to a decoder, a method for descrambling signals in a decoder, a system for transmitting a working key comprising an encoder and a decoder, and a method for transmitting a working key between an encoder and a decoder. Claims 1 and 8 are the broadest claims and of substantially the same scope; claim 1 reads as follows (omitting reference numerals);

"A decoder comprising first and second processors, a fixed security element and a replaceable security module, the replaceable security module including one of the first processor and the second processor, the fixed security element including the other of the first processor and the second processor, wherein

the first processor processes a twice-encrypted key based on a first key to generate a partially-decrypted key; and

the second processor processes the partially-decrypted key based on a second key to generate a working key."

V. The appellant argued that the claims before the Board complied with the requirements of the EPC as to clarity and conciseness.

Reasons for the Decision

1. The appeal is admissible.
2. The only question before the Board is the clarity and conciseness of the claims. Although the examining division indicated in their decision that compliance with Article 84 EPC "would prepare the application for the grant procedure" (part 3 of the reasoning, last paragraph) which might suggest that they were satisfied that all the other requirements of the EPC had been met, the Board can find no evidence from the file that this was the case. Indeed, it appears from the first communication that an inventive step argument had been raised but had not been pursued in view of the conciseness objection under Article 84 EPC.
3. The invention relates to a coding and decoding system, in the preferred embodiment for conditional-access television, in which piracy is prevented by the use of double encryption and decryption together with a removable security module at the decoder end incorporating one of the decryption processors. Such an arrangement has the advantage that the removable module and the rest of the decoder can be matched to one another, so that copying the security module will only permit a pirate to decrypt using that particular decoder; cloning of the replaceable security module, e.g. a smart card, will not work with other decoders.
4. Since the invention, at least as represented by the Figure 7/8 embodiment, comprises both the encryption and decryption of the signal, the Board accepts that in accordance with Rule 29(2) EPC it is not appropriate to cover the subject-matter by a single independent claim; the situation is analogous to the example of a transmitter and receiver given in the Guidelines at

C-III, 3.3. The Board is therefore satisfied that the presence of four independent claims is reasonable, given the nature of the invention, so that the present independent claims meet the requirements of Article 84 EPC as to conciseness.

5. The Board notes that there is still some lack of clarity in the dependent claims; claim 3 for example, relates to the Figure 7/8 embodiment but includes a dependency on claim 2, which is directed to the Figure 10 embodiment. An analogous situation arises in respect of claim 4 as appended to claim 3. Other matters which may require attention are redundant matter in, for example claims 6 and 7. However, since as noted above the application has not yet been fully examined as to novelty and inventive step and since it may be necessary to amend the claims in the light of the prior art, the Board leaves the question of amendment of the appendant claims to the examining division.

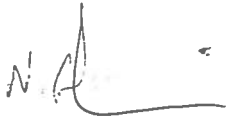
6. It is observed that in accordance with Rule 86(3) EPC an applicant may, of his own volition, amend once, any further amendment being only with the consent of the examining division. In view of the history of the present application the examining division would, in the Board's view, be entitled to refuse consent were the appellant to resile from his present request by introducing new independent claims, broadening the scope of the existing independent claims or amending the dependent claims, in a manner not necessitated by an objection from the examining division.

Order

For these reasons it is decided that:

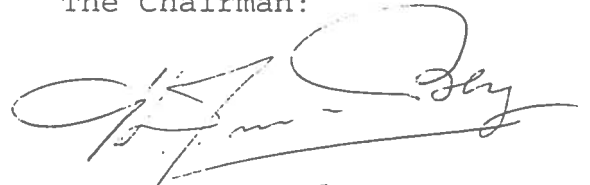
1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the claims filed at the oral proceedings before the Board.

The Registrar:



N. Maslin

The Chairman:



P. K. J. van den Berg

