BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS | BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE | CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Internal distribution code:
(A) [ ] Publication in OJ
(B) [ ] To Chairmen and Members
(C) [X] To Chairmen

D E C I S I O N
of 17 June 1998

Case Number: T 0415/96 - 3.5.1

Application Number: 88309363.5

Publication Number: 0311417

IPC: G06K 1/14

Language of the proceedings: EN

Title of invention:
Processing apparatus for a portable storage medium

Patentee:
Kabushiki Kaisha Toshiba

Opponent:
Giesecke & Devrient GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 56, 84

Keyword:
"Clarity (yes)"
"Inventive step (no)"

Decisions cited:
-

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0415/96 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 17 June 1998

Appellant: (Opponent)
Giesecke & Devrient GmbH
Prinzregentenstrasse 159
81677 München (DE)

Representative:
Klunker, Schmitt-Nilson, Hirsch
Winzererstrasse 106
80797 München (DE)

Respondent: (Proprietor of the patent)
Kabushiki Kaisha Toshiba
72, Horikawa-cho
Saiwai-ku
Kawasaki-shi
Kanagawa-ken 210 (JP)

Representative:
Batchellor, Kirk & Co.
2 Pear Tree Court
Farringdon Road
London EC1R ODS (GB)

Decision under appeal: **Interlocutory decision of the Opposition Division of the European Patent Office posted 22 February 1996 concerning maintenance of the European Patent No. 0 311 417 in amended form.**

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: A. S. Clelland
C. Holtz

Summary of Facts and Submissions

I. European patent No. 0 311 417 was opposed by the present appellant, *inter alia* on the ground that the subject-matter of the claims lacked an inventive step having regard to the disclosure of the following document:

E1: GB-A-2 132 136.

II. In its decision the Opposition Division found that an amended main claim was both novel and inventive. The patent was maintained in amended form.

III. The appellant appealed against this decision and requested cancellation of the decision and revocation of the patent; an auxiliary request was made for oral proceedings.

The respondent (proprietor) requested that the appeal be rejected and also made an auxiliary request for oral proceedings.

IV. In the statement of grounds of appeal the appellant argued that the amended claim 1 gave rise to objection under Articles 83 and 100(b) EPC, insufficient disclosure, and Articles 100(c) and 123(2) EPC, added subject-matter. The appellant also alleged that the subject-matter of claim 1 lacked novelty and an inventive step, Articles 52(1), 54, 56 and 100(a) EPC, citing inter alia the following documents, said to represent the common general knowledge in the art:

E4: ISO standard 3554, dated 1 June 1976

E5: ISO standard 2894, dated 1 December 1980

E6: Draft DIN version of ISO 4909, dated June 1977

These documents were cited for the first time in the statement of grounds.

V. Oral proceedings were held on 17 June 1998. At these proceedings the parties restricted themselves to a discussion of the clarity of claim 1 and the issue of inventive step.

VI. At the oral proceedings it was argued by the appellant that claim 1 lacked clarity and lacked an inventive step having regard to the disclosure of E1. The claim was unclear as to the relationship between "data relating to an entity" and "personalising data", and could be understood as requiring that all data be read out initially and "entity" data subsequently be selected. This interpretation did not accord with any embodiment disclosed in the originally filed application. As to inventive step, even on a narrow interpretation of claim 1 it would be obvious for the skilled person aware of the embodiment described at column 4, lines 85 to 96 of E1 to replace the known magnetic stripe with an EEPROM and to derive the subset of information used to emboss the card from the EEPROM memory.

VII. The patentee argued that claim 1 had been amended by incorporation of much of the subject-matter of granted claim 4, so that the claim was merely a limitation of the granted claim 1. The description clearly explained how data was selected and the skilled person, seeking to interpret claim 1, would understand that a sub-set of the "personalising data" was selected for embossing. It was clearly not necessary for a claim to specify every integer used in the specific embodiment, so that there was no need to specify the output controller shown in the drawings as a specific feature of claim 1.

As to inventive step, the interpretation of E1 put forward by the appellant was based on an *ex-post facto* analysis and stretched the disclosure of E1 considerably. E1 contained no suggestion that one might select information. The embodiment at column 4, lines 85 to 96 was very vaguely described and would not have led the skilled person to what was claimed without the exercise of inventive skill.

VIII. Claim 1 of the patent as maintained by the Opposition Division reads as follows:

"A processing apparatus for personalising a portable storage medium comprising an EEPROM (15) and at least one other recording portion consisting of either a planar surface whereon data can be visibly recorded and/or a magnetic recording portion (12),

said EEPROM (15) storing data including data to be recorded on the other recording portion or portions, and a portion of which data relates to an entity to which the portable storage medium will be issued,

said apparatus comprising

a visible recording means (25) to record personalising data visibly on the planar surface, and/or a magnetic recording means (26) to record said personalising data on the magnetic recording portion (12),

a memory reader (24) which is adapted to read said data recorded in the EEPROM and to select the data portion relating to the entity and to supply said data to the recording means (25,26) whereby said data portion is recorded on the planar surface and/or on the magnetic recording portion (12)."

Reasons for the Decision

1. *Late-filed grounds and documents (Article 114(2) EPC)*

1.1 The appellant's statement of grounds cites new documents and raises grounds of opposition which were not discussed in the opposition, namely Articles 83 and 100(b) EPC, insufficient disclosure, and Articles 100(c) and 123(2) EPC, added subject-matter.

1.2 Article 102(3) EPC confers jurisdiction on the Opposition Division, and hence the boards of appeal, to decide whether an amended patent meets the requirements of the EPC, whilst Article 114(1) EPC gives each board the power to examine the facts of its own motion. The right to raise new grounds of opposition is however restricted by the principles set out in Enlarged Board decisions G 9/91 and G 10/91 (OJ 1993, 408, 420); in the appeal procedure, which is a judicial procedure, the principle of ex officio examination should be applied more restrictively, which means that new grounds of opposition should normally no longer be allowed into the proceedings unless the patentee agrees to their introduction.

1.3 The patentee has not agreed to the introduction of any new grounds of opposition. Although the objections raised by the appellant arise from amendments made in the course of the opposition oral proceedings, it would have been possible for the appellant to raise the objections at the time the amendments were filed. On the other hand, it has become clear in the course of the present proceedings that the appellant's newly

introduced objections are in fact objections to the clarity of the amended claim. With this background, the Board concludes that the appellant should be permitted to raise issues of clarity arising from the amendments to claim 1.

1.4 The late filed documents E4 to E6 were said by the appellant to represent the common general knowledge of the skilled person. E4 is an international standard, ISO 3554, and relates to magnetic stripe encoding. E5, although also an international standard, ISO 2894, has nothing to say about storage and is exclusively concerned with embossing layout. E6 is a national version of an international standard, ISO 4909, and relates to magnetic stripe encoding. E4 and E6 are accordingly admitted to the proceedings as representing the common general knowledge in the art. E5 is not sufficiently relevant to be admitted.

2. *Clarity (Article 84 EPC)*

2.1 Claim 1 in the amended form maintained by the Opposition Division refers to a processing apparatus for personalising a portable storage medium comprising an EEPROM and at least one other recording portion consisting of either a planar surface on which data can be visibly recorded and/or a magnetic recording portion. The EEPROM stores data including data to be recorded on the other recording portion or portions. A portion of the data is said to relate to "an entity to which the portable storage medium will be issued". The apparatus itself is said to comprise visible and/or magnetic recording means to record "personalising data", and a memory reader "which is adapted to read said data recorded in the EEPROM and to select the data portion relating to the entity" (Board's underlining).

2.2 It was argued by the appellant that the underlined expression is ambiguous, the description making clear that only the data portion relating to the entity is read. The claim is said to imply that all data is read out and a subsequent selection made, which is broader than the disclosure of the originally filed application.

2.3 In the Board's view, the skilled person reading the claim in the light of the description would not understand it to require that all data is read out. The memory reader is said to be "adapted to read said data", meaning not that it must read all data, but that it can read any data. The skilled person would in the context understand the claim to refer not to separate reading and selecting steps but to a single processing step in which the data portion relating to the entity is selected and read out. There is no disclosure in the originally filed application or in the granted patent of any other process which would lead the reader to adopt a wider interpretation of the claim.

2.4 The Board accordingly concludes that claim 1 meets the requirement of Article 84 EPC as to clarity.

3. *The state of the art*

3.1 Before the priority date of the present application it was well known to provide cards, for example telephone cards, in which an integrated circuit or "chip" memory stores information about the value of the card. In a further development, so-called "smart" cards, information concerning the card and its owner is stored in the integrated circuit memory and a portion of this data made visible by embossing on the card's surface, e.g. the owner's name, the card number and its expiry date. Part of the data stored in memory may also be

made available on a magnetic stripe on the card. In the acknowledged prior art, cards are processed by first writing the requisite data into the card memory and thereafter, separately, carrying out the embossing and magnetic stripe writing steps. Since these steps are independent a mismatch between the stored and the subsequently written information can occur; moreover, since the information is available in an external memory there is a security risk.

3.2 The patent provides processing apparatus which can prevent a mismatch between the data stored in the card memory and that stored on the card surface, whilst nevertheless providing high security. In accordance with claim 1 a memory reader reads that portion of the data recorded in the integrated circuit memory which it is desired to provide on the card surface, either by embossing or encoded in a magnetic stripe, or both. Since the secure information is never stored in an external memory and since the externally visible or available information is derived from the stored information no mismatch can occur and security is enhanced.

4. *Inventive step*

4.1 It was common ground at the oral proceedings that the single most relevant document is E1 and that this document discloses processing apparatus for personalising a portable storage medium comprising a magnetic stripe and a further recording portion in the form of an embossed planar surface. The appellant drew attention to page 4 of E1, in particular lines 2 to 17 and 85 to 96. The former passage discloses that a card can be provided with two code numbers, one of which is embossed in the material of the card and the other of which is encoded in the magnetic stripe. The latter

passage states that in an alternative sequence of operations the encoding of the magnetic stripe is carried out before the embossing. The information needed for the embossed number is said to be magnetically encoded into the stripe and is used to control the embossing step directly, thus avoiding the need for a specific check of the number being embossed against the related code number in the stripe. The Board accordingly understands E1 to envisage a magnetic stripe including two code numbers, one forming part of the personalising data - using the terminology of claim 1 of the patent - whereby a memory reader selects from the totality of data on the magnetic stripe that data necessary for the subsequent embossing step.

4.2 The subject-matter of claim 1 of the patent accordingly differs from the disclosure of E1 only in that the storage medium used on the card is an EEPROM as opposed to a magnetic stripe. In both cases a selection from the stored data is made and recorded on the card surface by, for example, embossing. As noted at point 3.1 above, cards incorporating integrated circuit memories were well-known before the claimed priority date. In the Board's view, the skilled person would find it obvious to use an EEPROM in place of the magnetic stripe disclosed by E1. From the patentee's own introduction to the description, see in particular column 1, lines 14 to 23 of the published patent, it is clear that integrated circuit cards bring substantial advantages in terms of higher security and larger storage capacity. The skilled person, reading E1 in the light of the background art at the priority date of the patent, could therefore be expected to substitute an EEPROM for a magnetic stripe without the exercise of invention.

4.3 The subject-matter of claim 1 of the patent accordingly lacks an inventive step, Articles 52(1), 56 and 100(a) EPC.

5. There being no other requests, it follows that the patent must be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar: The Chairman:

M. Kiehl P. K. J. van den Berg