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Datasheet for the decision of 2 February 2012

Case Number: T 0621/08 - 3.4.03
Application Number: 98907003.2
Publication Number: 963580
IPC: G07F 7/10

Language of the proceedings: EN

Title of invention:
Multi-application IC card system

Patent Proprietor:
MONDEX INTERNATIONAL LIMITED

Opponent:
GIESECKE & DEVRIENT GmbH

Headword:
-

Relevant legal provisions (EPC 1973):
EPC Art. 54

Keyword:
"Novelty (yes)"

Decisions cited:
-

Catchword:
-
Case Number: T 0621/08 - 3.4.03

DECISION
of the Technical Board of Appeal 3.4.03
of 2 February 2012

Appellant:
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Representative:
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Respondent:
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Decision under appeal:
Decision of the Opposition Division of the
revoking European patent No. 963580 pursuant to
Article 101(3)(b) EPC.

Composition of the Board:
Chairman: G. Eliasson
Members: V. L. P. Frank
P. Mühlens
Summary of Facts and Submissions

I. This is an appeal by the patent proprietor against the decision of the opposition division to revoke the patent EP 0 963 580 (Article 101(2) EPC).

The patent was opposed in its totality. Grounds of opposition were lack of novelty and inventive step (Articles 100(a), 54 and 56 EPC 1973).

II. At oral proceedings before the board, the appellant proprietor requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the main request or on the basis of the first auxiliary request, both filed at the oral proceedings, or on the basis of the second or third auxiliary requests, both filed with letter of 30 December 2011.

The respondent opponent requested that the appeal be dismissed.

III. Independent claim 1 of the main request reads as follows:

"1. An IC card system comprising at least one IC card for storing multiple applications, an application to be loaded onto said card and means for determining whether said card is qualified to accept the loading of said application onto said card, wherein said IC card contains card personalization data, and said application is assigned application permissions data representing at least one set of IC cards upon which said
application may be loaded and wherein said determining means compares said card personalization data with said application permissions data and wherein said application is loaded onto said IC card in dependence on the result of said comparison, wherein card personalization data is data loaded onto said card at a card personalization bureau which configures the card for a card issuer to a specific user or class of users, and said determining means is provided on said card."

In claim 1 of the first auxiliary request the last paragraph was amended as follows (the differences with respect to claim 1 of the main request were highlighted by the board):

"wherein card personalization data is data loaded onto said card at a card personalization bureau which configures the card for a card issuer to a specific user or class of users by using data representative of a card issuer and data representative of a product class, and said determining means is provided on said card, and said permissions data set includes one or more card issuers and one or more product classes."

Each request contains further independent claims directed to a process for loading an application on an IC card, a process for deleting an application from an IC card and an IC card system.

The claims of the 2nd and 3rd auxiliary requests are of no relevance for this decision.
IV. The following document is cited in this decision:


V. In the decision under appeal, the opposition division found that:

- Document D9 disclosed an IC card system comprising a multi-application IC card and an application to be loaded onto said card. The IC card's determining means determined whether the card was qualified to accept the loading of the application or not on the basis of a comparison between the card personalization data and the application permissions data. The card personalization data corresponded to the application identifier (AID) and the "Nachladeschlüssel" of document D9 while the application permissions data were identical to the AID of the application to be loaded. The group of IC cards upon which said application could be loaded was the set of IC cards which had a preregistered AID and key corresponding to the application.

VI. The appellant proprietor argued essentially as follows:

- According to Rule 22(1) EPC, the transfer of a European patent application was registered on production of documents satisfying the European Patent Office that such a transfer had taken place. As far as the European Patent Office was concerned, the requirements to record the transfer had not been
met at the date on which the appeal was filed. Accordingly, the appeal was correctly filed in the name of Mondex International Limited.

- The problem addressed by the present invention was to provide IC cards in a system in which a card issuer defined personalization data for a card, which personalization data could then be matched against data included in the application permissions data assigned to an application to determine whether or not an application might be loaded onto a card. Thus, the data being compared did not relate to the application as such but to whether or not the card was of a type defined by the card issuer upon which the particular application was to be loaded. Document D9 described how a user could load a further application onto his or her smartcard by an application provider. It was clearly stated that the application provider had to obtain a secret reload code from the card issuer in order to do this. He was therefore unable to load the application without obtaining data from the end issuer. The Opposition Division equated the application identifier (AID) of document D9 with application permissions data in the present application. An application identifier was a standardized code associated with an application. It was not used to identify a particular card or set of cards, only to identify an application. Thus, use of this to determine whether or not an application might be loaded onto a particular card or set of cards was not possible unless those cards were already configured with matching data for the particular application. The arrangement of the present invention enabled any application to be
loaded onto a particular card or set of cards as defined by the end issuer via the personalization data.

- In addition to the subject matter of the main request, claim 1 of the first auxiliary request included a more specific definition of the permissions data and of the personalization data. Therefore, it more specifically drew out the matching process between the permissions data and personalization data, and the nature of that data. Such an arrangement presented a significant improvement over the system of D9 and gave a card issuer much greater control over which applications could be loaded to which categories of users.

VII. The respondent opponent argued essentially as follows:

- The appeal seemed to be inadmissible. Although the appeal was lodged in the name of Mondex International Limited and, auxiliarily, in the name of StepNexus Holdings, the proprietor had requested previously an assignment of rights to Bamboo Holdings of Ugland House and a subsequent change of name to StepNexus Holdings. It was thus questionable who the real proprietor of the patent was and who was entitled to lodge the appeal.

- The two features added to claim 1 of the main request were also disclosed in document D9, as this document disclosed that the card personalization data was loaded at a card personalization bureau and that the determination means was provided on the card. For these reasons, the finding of the
opposition division that the system of claim 1 was not novel over the disclosure of document D9 still applied.

- The features of claim 1 of the 1st auxiliary request were also disclosed in D9, since the application identifier (AID) was formed by the registered identifier (RID) and the proprietary application identifier extension (PIX). The RID however included a code for the application service provider which usually was the card issuer. On the other hand, the PIX included the application's serial and version numbers which identified the product class.

Reasons for the Decision

1. Admissibility of the appeal.

1.1 The respondent opponent objected on the admissibility of the appeal. The appeal was lodged on 28 March 2008 in the name of Mondex International Limited and, auxiliarily, in the name of StepNexus Holdings. Previously, however, the proprietor's representative had requested with the letter of 18 February 2008 an assignment of rights to Bamboo Holdings of Ugland House and a subsequent change of name to StepNexus Holdings. Thus it was questionable who the real proprietor of the patent was and who was entitled to lodge the appeal.

1.2 The transfer of a European patent application is governed by Rule 22 EPC. According to Rule 22(3) EPC the transfer shall have effect vis-à-vis the EPO only
at the date when and to the extent that documents providing evidence of such transfer have been produced.

1.3 With the communication of 5 March 2008 the EPO refused to register the requested transfer in the European Patent Register, since the assignment document had not been signed by Mondex International Limited. As the indicated deficiency in the request for transfer was never corrected, no transfer was registered and the original applicant, Mondex International Limited, remained the present assignee.

1.4 The board finds that the requirements of Article 107 EPC are fulfilled, as the appeal was lodged in the name of Mondex International Limited, who was the registered patent proprietor at the time of filing the notice of appeal, has since then not ceased of being a party to the proceedings and was undoubtedly a party adversely affected by the decision of the department of first instance revoking the patent.

The appeal of the patent proprietor is thus admissible.

2. Main request – Novelty (Article 54 EPC 1973)

2.1 It is common ground that document D9 discloses a multi-application IC card having means for determining whether the card is qualified to accept the loading of an application onto the card. It is also undisputed that the determination means are provided on the IC card, that the card contains card personalization data and that these data are loaded at a card personalization bureau (page 241, point 7.8, 2nd and 5th paragraph; page 242 and 243, REGISTER and CREATE FILE
commands; Figure 7.48; page 333, point CK3-Initialisation; page 334, point CK4-Personalization).

According to D9 the REGISTER command is used by the card issuer during card creation to allocate memory space on the IC card to an application. The memory allocation is required for preventing that one application uses more memory than the one allocated to it, overwriting other applications on the IC card. At the same time a card and application specific key is stored on the card. If at a later time the application is to be loaded onto the card, the determining means on the card compares this key with the application identifier (AID) to decide whether the card is qualified to load the application.

Document D9 differentiates between the initialization and personalization steps during the creation of an IC card. During the initialization step the data common to all cards are written onto the card, while during the personalization step the individual, user related data are written on it. According to D9, the reason for this two step approach is cost reduction, since personalization devices have a throughput of about 700 cards/hour, while initialization devices one of about 3500 cards/hour (page 333, last paragraph).

2.2 The appellant proprietor argued that the system of claim 1 of the main request differed from the system disclosed in D9 in two points.

Firstly, the card and application specific key generated by the REGISTER command of D9 was common to all cards foreseen for running a specific application.
It was thus not part of the card personalization data, but of the initialization data, since it was common to all cards from a set of cards.

Secondly, the application identifier (AID) of D9 could not be equated to the application permissions data of claim 1, since the former was a standardised code associated with the application and was not used to identify a particular card or set of cards onto which the application should be loaded. It only identified an application. The AID could not be used to determine whether or not an application could be loaded onto a particular set of cards unless those cards were already configured with matching data for the particular application. On the contrary, the present invention enabled any application to be loaded onto a particular card or set of cards as defined by the end issuer via the personalization data.

2.3 With respect to the first point raised by the appellant proprietor, the board considers that whether the data that are used for determining that the card is qualified to load a given application are written at a particular processing step, ie either during the initialization or the personalization step, is a distinction that does not make a difference when assessing the features of a product, an IC card system in the case of claim 1.

As to the second point, namely that the application identifier cannot be equated to the application permissions data according to the patent, the board considers that the name given to the data associated with the application is irrelevant. What matters is
that according to claim 1 the determining means decide whether the IC card is qualified to load a given application on the basis of a comparison between data stored on the IC card and data associated with the application. Such a comparison is made in document D9.

2.4 The board judges, for these reasons, that the system of claim 1 of the main request is not new over the system disclosed in document D9.

3. **1st auxiliary request**

3.1 Claim 1 of the 1st auxiliary request adds the following features to claim 1 of the main request:

(a) the personalization bureau configures the card by using data representative of a card issuer and data representative of a product class, and that

(b) the permissions data set includes one or more card issuers and one or more product classes.

3.2 Amendments

3.2.1 The respondent opponent objected that the wording used in claim 1, namely that the card personalization bureau configured the card for a card issuer to a specific user or class of users by using data representative of a card issuer and data representative of a product class, would contravene the requirements of Article 123(2) EPC, since such wording could include undisclosed subject-matter. However, no concrete example was given.
3.2.2 The board agrees with the appellant proprietor that the patent discloses that the personalization bureau uses the mentioned data in the configuring step of the card personalization data ([0029], [0034] - [0036], "issuer ID" and "product ID"). The board therefore considers the amendments permissible.

3.3 Novelty (Article 54 EPC 1973)

3.3.1 Feature (a):

According to document D9, the IC-card stores a set of data called "Historical Characters" which are sent to the terminal as part of the Answer to Reset (ATR) in response to the terminal's initial reset command. The historical characters may contain a multitude of data related to the IC-card and the operating system. The card issuer, the card's and the chip's serial number, the version of the ROM mask of the chip and the version of the operating system are examples of these data (page 197, in particular the 4th paragraph).

It follows that data representing the card issuer and the card's type, which is encoded in the card's serial number, are written on the card by the personalization bureau.

The board considers therefore that feature (a) mentioned above is disclosed in document D9.

3.3.2 Feature (b):

3.3.2.1 The respondent opponent argued that the application identifier (AID) disclosed in document D9 was
equivalent to the application permissions data specified in claim 1.

According to D9, the AID was formed by the registered identifier (RID) and the proprietary application identifier extension (PIX). The RID was constituted by a country code, the application's category and a code for the application service provider, while the PIX comprised for example the application's serial and version numbers (pages 137 and 138; Figure 5.15). As the application service provider was usually the card issuer, the RID portion of the AID contained the card issuer (see eg D9, page 332, "Datenübergabe", were it was stated that "The card issuer or the application service provider, respectively, have to provide all the application's data to the card personalization service", "Der Kartenherausgeber bzw. Anwendungsanbieter muß dem Kartenpersonalisierer alle seine Anwendung betreffenden Daten mitteilen."). On the other hand, the application's version number contained in the PIX portion of the AID defined a product class.

The AID of document D9 thus included the card issuer and the product class, ie feature (b).

3.3.2.2 The board considers however that according to D9 card issuer and application service provider is not necessarily the same entity. The statement in D9 referred to by the respondent opponent about card issuer and application service provider (page 332, "Datenübergabe") means that whoever is responsible for the application shall provide all the relevant data to the card personalization service, but not that card issuer and application service provider are identical.
3.3.2.3 Also the respondent's opponent argument that the application's serial or version number contained in the PIX should be considered as defining a product class is unconvincing. Claim 1 specifies that the card personalization bureau uses data representative of the product class for configuring the card personalization data. It makes however little sense that the personalization data includes an application's serial or version number, as would be the case if the product class is equated to the application's serial or version number. The board therefore considers that the serial or version number contained in the PIX portion of the AID cannot be considered to define a product class.

3.4 The board judges, for these reasons, that the system of claim 1 of the 1st auxiliary request is new over the disclosure of document D9, as D9 does not disclose that the permissions data set includes a card issuer or a product class.

4. The decision of the opposition division was based on the finding of lack of novelty over document D9. As the issue of inventive step has not yet been argued by the parties, the board considers it appropriate to remit the case to the department of first instance for further prosecution (Article 111(2) EPC). This was also the desire expressed by both parties.
Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution.

Registrar

Chair

S. Sánchez Chiquero G. Eliasson