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Datasheet for the decision
of 22 October 2013

Case Number: T 0215/09 - 3.4.03
Application Number: 99902687.5
Publication Number: 1053535
IPC: G07F7/10

Language of the proceedings: EN

Title of invention:
CONFIGURATION OF IC CARD

Patent Proprietor:
MONDEX INTERNATIONAL LIMITED

Opponent:
Giesecke & Devrient GmbH

Headword:

Relevant legal provisions:
EPC 1973 Art. 84
EPC Art. 123(2), 123(3)

Keyword:
Claims - clarity - main request (yes)
Amendments - added subject-matter (no) - broadening of claim (no)

Decisions cited:
Catchword:
DECISION of Technical Board of Appeal 3.4.03 of 22 October 2013

Appellant: MONDEX INTERNATIONAL LIMITED
(Patent Proprietor)
1st Floor,
47-53 Cannon Street
London EC4M 5SQ (GB)

Representative: Robson, Aidan John
Reddie & Grose LLP
16 Theobalds Road
London WC1X 8PL (GB)

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

Decision under appeal: Decision of the Opposition Division of the European Patent Office posted on 3 December 2008 revoking European patent No. 1053535 pursuant to Article 101(3)(b) EPC.

Composition of the Board:
Chairman: R. Bekkering
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 1 053 535 for the reasons of added subject-matter, extension of protection and lack of clarity (Article 123(2) and (3) EPC and Article 84 EPC 1973) (Article 101(3)(b) EPC).

II. The appellant proprietor requested in writing that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of claims 1 to 11 of the main request or on the basis of claims 1 to 11 of the first auxiliary request, both filed with the letter of 2 April 2009.

The respondent opponent requested at the oral proceedings that the appeal be dismissed.

III. The independent claims of the main request read as follows (amendments to the granted versions of these claims were marked by the board):

"1. A secure multiple application card system including an IC card comprising a microprocessor (710), a read-only memory (750) and an electronically erasable programmable read only memory (752), said system comprising:
means for manufacturing (101) said IC card and for storing at the time of manufacture in said read-only memory (750) an operating system and programming instructions including at least one primitive or codelet; and
means for personalizing (103) said IC card after the time of manufacture and for storing at the time of personalization in said electronically
erasable programmable read only memory (751) an address table (140) with memory addresses of at least one of said programming instructions, wherein additional programming instructions can be loaded onto the card at the time of personalization and stored in the electronically erasable programmable read only memory, and said additional programming instructions comprise updated versions of the previously stored programming instructions primitives or codelets and the address table includes addresses for the updated programming instructions primitives or codelets, and wherein the operating system will only access those programming instructions in accordance with addresses included in the address table."

"7. A process for providing a secure multiple application card system including an IC card comprising a microprocessor, a read-only memory and an electronically erasable programmable read only memory, said process comprising the steps of: manufacturing said IC card and for storing at the time of manufacture in said read-only memory an operating system and programming instructions including at least one primitive or codelet, and personalizing said IC card after said time of manufacture by storing in said electronically erasable programmable read-only memory an address table with memory addresses; and wherein the step of personalizing the IC card includes storing additional programming instructions in the electronically erasable programmable read only memory and said additional programming instructions comprise updated versions of said previously stored programming instructions.
primitives or codelets, and inserting including addresses for said additional programming instructions in said address table, thereby
wherein the operating system will only access those programming instructions in accordance with addresses stored in the address table."

IV. The appellant proprietor argued on the main request essentially as follows:

- The main request corresponded to the 1st auxiliary request in the opposition proceedings, with the reintroduction of "those" in the penultimate lines of claims 1 and 7, instead of the word "the". The 1st auxiliary request was refused by the opposition division for failing to fulfil the requirements of Article 84 EPC, i.e. for lacking clarity. The opposition division held that it was not possible to determine which programming instructions were referred to by "the programming instructions" of claims 1 and 7. It appeared that the opposition division interpreted the phrase "only accesses the programming instructions in accordance with addresses included in the address table" as describing the method by which the operating system accessed programming instructions, rather than describing which programming instructions were accessed. As a result the phrase "the programming instructions" was read in isolation and was interpreted to refer to previously defined programming instructions. However, that was not a correct interpretation.

- In English, the position of the word "only" in claims 1 and 7 was significant. The word "only" appearing in claims 1 and 7 clearly referred to
the programming instructions, not the way that the
operating system accessed programming
instructions. There was a clear difference in
meaning between:
(a) "only accesses the programming instructions in
accordance with addresses included in the address
table" and
(b) "accesses the programming instructions only in
accordance with addresses included in the address
table".

- The opposition division interpreted claim 1 as
including phrase (b) when in fact it included
phrase (a). The fact that the word "only" was
positioned preceding "programming instructions"
made it clear that the final phrase of claims 1
and 7 was a limitation of which programming
instructions could be accessed by the operating
system.

- It was therefore clear to a skilled person that
the phrase "only accesses the programming
instructions in accordance with addresses included
in the address table" meant that the operating
system accessed only those programming
instructions which had an address entered in the
address table. The operating system could not
access programming instructions which did not have
an address in accordance with an address in the
address table. Thus "the programming instructions"
appearing in the penultimate lines of claims 1 and
7 should not be read in isolation, but in
combination with the entire phrase "only accesses
the programming instructions in accordance with
addresses included in the address table". Hence it
was clear that "the programming instructions" was
not a reference to previously defined programming instructions at all.

- In the main request in appeal the word "the" was replaced by "those", in order to correspond exactly with the wording of the claims as filed and to further clarify the meaning of the phrase. The operating system accessed only those programming instructions having an address matching an address included in the address table.

The appellant proprietor further requested that the case be remitted to the department of first instance, as the issues of novelty, inventive step and sufficiency of disclosure had not yet been addressed by the opposition division.

V. The respondent opponent argued on the main request essentially as follows:

- The conclusion reached by the opposition division that the phrase "the operating instructions" or alternatively "those operating instructions" were unclear was correct. The independent claims referred to "programming instructions" and "additional programming instructions". Hence by referring to "the" or "those programming instructions" it was not clear whether the first, the second or both kinds of instructions were meant. Moreover, even according to the appellant two different interpretations of this feature were possible.

- The granted independent claims required the operating system to only access programming instructions in accordance with addresses included
in the address table. There were no restrictions on the type of programming instructions (primitive, codelet or other programming instructions) or on their storage location. Thus all kinds of programming instructions were accessed by the operating system only through addresses in the address table. Due to the reintroduction of the expression "those" only the programming instructions referred to in the claim were addressed in this manner, broadening thus the scope of the claim and infringing Article 123(3) EPC.

- The application as filed only disclosed that primitives or codeletes were accessed through their addresses in the address table. However, the claims of the main request did not contain this limitation and specified merely that "programming instructions" were accessed in this way. The claims of the main request thus contained subject-matter that had not been disclosed in the application as filed, infringing Article 123(2) EPC.

The respondent opponent also requested that the case be remitted to the department of first instance to address the remaining issues in this case.

VI. Oral proceedings were held on 22 October 2013. The appellant proprietor did not attend and was not represented at the oral proceedings, as announced in his letter of 2 October 2013.
Reasons for the Decision

1. The appeal is admissible.

2. **Main request**

2.1 Clarity

2.1.1 The IC card of claim 1 comprises a microprocessor, a read-only memory (ROM) and an electronically erasable programmable read-only memory (EEPROM).

At the time of manufacture an operating system and programming instructions are stored in the ROM. These programming instructions include at least one primitive or codelet.

After manufacture and during the personalizing step, an address table with memory addresses of at least one of said programming instructions is stored in the EEPROM. At this step additional programming instructions may also be stored in the EEPROM. These additional programming instructions comprise updated versions of the previously stored primitives and codelets, while the address table also includes the addresses of the updated versions.

2.1.2 Hence at this point the address table comprises addresses for:

(a) the initial programming instructions that are neither primitives or codelets stored in the ROM,

(b) the initial primitives and codelets stored in the ROM for which no update is provided,
(c) the additional programming instructions that are neither primitives or codelets stored in the EEPROM, and for
(d) the updated primitives and codelets stored in the EEPROM.

2.1.3 The last feature of the claim specifies that "the operating system will only access those programming instructions in accordance with addresses included in the address table".

2.1.4 The respondent opponent argued that this feature lacked clarity, since it was not specified in the claim whether the initial programming instructions or the additional programming instructions were referred to by the phrase "those programming instructions".

2.1.5 The appellant proprietor argued that the opposition division misinterpreted this feature, since it did not specify the method for accessing the programming instructions (ie in accordance with addresses included in the address table), but specified which programming instructions were accessed.

2.1.6 Article 84 EPC 1973 is not a ground for opposition listed in Article 100 EPC 1973. It is thus the established jurisprudence of the boards of appeal that the examination as to whether a claim is clear is limited to clarity issues arising from amendments made to the claims, but not to lack of clarity issues that were already present in the granted claims. Hence the board has to consider whether the introduction of the expression "those" in claim 1 renders the claimed secure multiple application card system unclear.
2.1.7 The board, however, does not consider that the expression "the operating system will only access those programming instructions in accordance with addresses included in the address table" used in claim 1 of the main request is less clear than the expression "the operating system will only access programming instructions in accordance with addresses included in the address table" of granted claim 1, since both expressions specify that access to the programming instructions is achieved through the address which is included in the address table. The so addressed programming instructions are "those programming instructions". The board cannot recognize under the present circumstances any distinction between which programming instructions are accessed and the method through which they are accessed, since accessing the address table necessarily restricts the programming instructions that can be accessed to those listed in the address table.

2.1.8 Hence the board considers that the contested feature specifies that the operating system only accesses those programming instructions that are listed in the address table. "Those" programming instructions include all the programming instructions listed in the address table, ie the initial programming instructions that are neither primitives nor codelets stored in the ROM, the initial primitives or codelets stored in the ROM for which no update is provided, additional programming instructions that are neither primitives nor codelets stored in the EEPROM and the updated primitives and codelets stored in the EEPROM (cf point 2.1.2 of this decision). However, this feature further specifies that the operating system only accesses the programing instructions listed in the address table and does not access programming instructions which are not listed
there, such as eg the initial primitives and codelets stored in the ROM that were replaced by the newer versions stored in the EEPROM during the personalization step. It is this feature that contributes to the security of the claimed secure multiple application card system.

2.1.9 The same objections of lack of clarity were also raised in connection with independent claim 7 which, although directed to a process for providing a secure multiple application card, comprises the same objected features as claim 1. The board considers that the same reasoning as put forward in connection to claim 1 applies to claim 7.

2.1.10 The board judges, for the above reasons, that claims 1 and 7 of the main request are clear (Article 84 EPC 1973).

2.2 Added subject-matter (Article 123(2) EPC)

2.2.1 The respondent opponent objected that the application as filed only disclosed that primitives or codelets were accessed through their address in the address table (cf page 5, lines 5-8 of the published application). Claim 1 of the main request was however not restricted to primitives or codelets, but referred in general to programming instructions.

2.2.2 The board however notes that claim 1 as filed referred to storing in the ROM programming instructions in general, while claim 4 as filed, which depends inter alia on claim 1, disclosed storing additional programming instructions in the EEPROM. Only claims 2, 3, 5 and 6 as filed specified that the programming instructions comprised primitives or codelets. Hence
the combination of claims 1 and 4 as filed encompassed all kinds of programming instructions being stored in the ROM and the EEPROM.

2.2.3 The board finds for these reasons that the appellant's main request fulfills in this respect the requirements of Article 123(2) EPC.

2.3 Extension of the scope of protection (Article 123(3) EPC)

2.3.1 The respondent opponent argued that the scope of protection of claim 1 was extended with respect to the granted version, since the introduction of the expression "those programming instructions" restricted the instructions accessed by the operating system to the ones referred to in the claim, namely the programming instructions stored in the ROM and the additional programming instructions stored in the EEPROM. However the granted version of claim 1 did not contain this restriction and required that all programming instructions accessed by the operating system had a corresponding entry in the address table.

2.3.2 The board however is not persuaded that the scope of the patent has been extended by the introduction of the expression "those" in the last feature of claim 1. In the discussion on clarity (cf point 2.1.8 of this decision) the board found that this feature prevented the operating system from accessing programming instructions whose addresses were not specified in the address table. Hence the scope of protection of the patent has not been modified by the introduction of the expression "those", since the last feature has not changed its meaning due to this introduction.
2.3.3 The board finds for these reasons that the amendments made to the patent do not extend the protection it confers (Article 123(3) EPC).

3. Further prosecution of the case

3.1 According to Article 111(1) EPC 1973, a board of appeal may exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

3.2 The appealed decision refused the patent for the reasons that the claim requests before the opposition division either were not clear (Article 84 EPC 1973), comprised added subject-matter (Article 123(2) EPC) or extended the scope of protection of the granted patent (Article 123(3) EPC). The other objections raised in the notice of opposition, ie insufficiency of disclosure, lack of novelty and/or inventive step, were not addressed in that decision.

3.3 The board thus considers it appropriate that the remaining objections against the maintenance of the patent be discussed before the opposition division, so that in the event of a further appeal, the parties can base their case on the reasoning delivered by the opposition division on these issues. This was also the express request of the parties.

3.4 The board decides for these reasons to remit the case to the department of first instance for further prosecution on the basis of claims 1 to 11 of the main request (Article 111(1) EPC 1973, 2nd sentence).
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 on the basis of claims 1 to 11 of the main request filed with letter of 2 April 2009.

The Registrar:

The Chairman:

S. Sánchez Chiquero

R. Bekkering

Decision electronically authenticated