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**Datasheet for the decision
of 7 April 2011**

Case Number: T 0928/07 - 3.4.03

Application Number: 99918276.9

Publication Number: 1182627

IPC: G07F 19/00

Language of the proceedings: EN

Title of invention:
Automatic teller's machine

Patentee:
Fujitsu Limited

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)

Relevant legal provisions (EPC 1973):
EPC Art. 56, 84

Keyword:
"Inventive step (yes) - mixture of technical and non-technical features (item 5 of the reasons)"

Decisions cited:
T 0424/03

Catchword:
-



Case Number: T 0928/07 - 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 7 April 2011

Appellant: FUJITSU LIMITED
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 16 January 2007
refusing European patent application
No. 99918276.9 pursuant to Article 97(1) EPC
1973.

Composition of the Board:

Chairman: G. Eliasson
Members: E. Wolff
T. Karamanli

Summary of Facts and Submissions

I. This is an appeal from the decision of the examining division to refuse European patent application 99918276 for the reason that claim 1 lacked clarity and therefore failed to meet the requirements of Art. 84 EPC 1973.

II. The examining division also expressed the view that even if the lack of clarity were resolved, the invention as claimed did not involve an inventive step taking into account the disclosure in the following document:

D1: US 5859419 A.

III. At the oral proceedings before the board, the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the sole request filed during the oral proceedings.

IV. Independent claim 1 of the request reads as follows:

"1. A system comprising an automatic teller machine and a cash card, the system comprising:

*the cash card (700, 800) having recording areas;
and*

the automatic teller machine configured to be operated by a customer, the automatic teller machine including:

*a display unit (103) for displaying a menu screen;
a display control unit (101A, 101B) for
controlling the display unit (103), and for making the
display unit (103) display a menu screen for enabling*

the customer to input information of a transactable account to be written into a cash card (700, 800);

a transaction unit (102) for carrying out transactions by accessing a host terminal (200) at a financial institution based on information of a plurality of transactable accounts registered in the cash card (700, 800); and

a register control unit (101D, 101E) for writing the information in one of the recording areas of the cash card (700, 800); characterised in that

the automatic teller machine further comprises selection means (101) for displaying selection buttons on the menu screen for enabling the customer to select either one of a registering button for registering a transactable account and a deleting button for deleting a transactable account, wherein

the cash card (700, 800) has a master-account recording area, where information (JM1, JI1) of a master account as one of said transactable accounts is intrinsically recorded within the recording areas, and account recording areas other than the master-account recording area for writing information of a transactable account other than the master-account, within the recording areas;

the register control unit (101D, 101E) is configured to write information of a transactable account, input by the customer, into one of the account recording areas in the cash card (700, 800), when the registering button is depressed, and

an account delete control unit is provided, which (101C) is arranged to delete a transactable account from the cash card (700, 800) and is configured to make the display unit (103) display input screen for enabling the customer to assign a transactable account

to be deleted by the customer's operation, when the deleting button is depressed, and to delete transactable account which is assigned by an input through the input screen, and which is configured to be incapable of deleting the master-account."

The remaining claims 2 to 5 are dependent claims.

V. In support of the request, the appellant argued essentially as follows.

The invention provided for a system in which a single cash card could be used for carrying out transactions in multiple accounts. This was true also of the system disclosed in the closest prior art document, document D1, but the claimed invention differed from the disclosure in document D1 in several respects.

Document D1 provided for a system in which information concerning several accounts was held on a card such as a cash card. The card not only permitted the performance of transactions with respect to the accounts stored on it, but it also recorded the transactions involving those accounts. Accounts could be added to the card by the user, but there is no hint that accounts could also be deleted by the user.

In contrast, the invention specifically provided for the addition deletion of accounts from the card under the control of the user. Only a so-called master account could not be deleted. This was to prevent the card being inadvertently rendered non-functional.

The main purpose of the card in document D1 was to provide a complete and uninterrupted payment record for each of the accounts held on the card. For this reason document D1 clearly taught away from the idea that the customer should be able to delete anything, let alone whole accounts from the card.

Because it was concerned with a problem different from that addressed by document D1, the solution to the problem which was provided by the claimed invention could not be obvious over the disclosure in the prior art document. The claimed invention additionally provided a solution to a further problem which only arose if deletion of accounts was contemplated. It was the necessity to protect the card from complete erasure of all accounts.

It had been assumed by the examining division that writing new records amounted to deletion of information on the card. However, a form of deletion which is the result simply of overwriting the existing data (e.g. replacing the previous account balance with the latest one), did not require the skilled person even to contemplate protecting the card against erasure of all account information.

For the foregoing reasons, the claimed invention had to be considered as involving an inventive over the disclosure in prior art document D1.

Reasons for the decision

1. The appeal is admissible.

2. Pages of the request

2.1 The appellant's sole request consists of the following pages:

Claims: Nos. 1 to 5 as received during the oral proceedings of 7 April 2011.

Description: pages 1, 2, 4-60 as originally filed, pages 3, 3a, 3b as received during the oral proceedings of 7 April 2011.

Drawings: sheets 1/17 - 17/17 as originally filed.

2.2 The decision of the examining division refers to pages 1 to 61 of the description. The appellant clarified that this was not correct. The page labelled "Proposed voluntary amendment" which followed page 60 of the description as originally filed (and which was apparently counted as page 61) did not form part of that description.

3. Clarity (Art. 84 EPC 1973)

3.1 The main objection of the examining division under this heading arose from it not being clear whether independent claim 1 related merely to an automated teller machine or to a system of an automatic teller machine and a cash card.

3.2 Claim 1 of the request to "[a] system comprising an automatic teller machine and a cash card" is now clear on this point.

3.3 The examining division also raised an objection to the word "delible", which could have been avoided by looking up the word in, for example, the on-line Oxford English Dictionary. Owing to the revised wording of claim 1 this somewhat misguided objection is now moot.

3.4 The board is satisfied that the objections raised by the examining division on the ground of lack of clarity have been overcome by the amendments made.

4. Amendments (Art. 123(2) EPC)

4.1 Compared to claim 1 as originally filed, the present wording of claim 1 emphasises in particular that the invention has the following features:

(a) The system comprises an automatic teller machine and a cash card,

(b) The card contains details a recording area, and includes details of a master account which can not be deleted, and

(c) The recording area of the card contains details of other accounts which can be deleted and added by the customer as the customer wishes.

4.2 Extensive changes were made to claim 1, including the addition of further text. The board is, nevertheless, satisfied that the new wording is taken, or at the very least directly and unambiguously derivable, from the description of the invention and/or text in the figures of the accompanying drawings.

4.3 In particular,

feature a) is readily derivable from the contents of the application read as a whole;

a basis for feature b) above, which is that, unlike all other accounts, the master account cannot be deleted, can be found in lines 48 to 50 of the description.

the actions of registering (adding) transactable accounts on and of deleting transactable accounts from the cash card as specified in feature c) are explicitly referred to *inter alia* in column 24, lines 13 to 20 and also in the text of the drawings in Fig. 15.

4.4 Other amendments made to the claim 1 and its dependent claims serve to bring the wording into line with the substantive amendments in claim 1. Minor amendments to the description serve the same purpose.

4.5 For the reasons stated the board is satisfied that the amendments do not introduce subject matter going beyond the content of the application as filed, and that the amendments therefore comply with the requirements of Art. 123(2) EPC.

5. Inventive step

5.1 The problem-solution approach to assess inventive step requires that the claimed invention be compared with the nearest prior art. The differences between the

prior art and the claimed invention determined by this comparison identify the objective problem solved by the invention. It must then be assessed whether the solution provided by the features which distinguish the invention from the prior art, is obvious in the light of, or involves an inventive step over, that prior art.

5.2 It is established case law of the boards of appeal that an invention be assessed with respect to the requirement of inventive step by taking account only of those distinguishing features which contribute to the technical character of the invention.

5.3 In the present case, it is document D1 that constitutes the closest prior art. It is common ground that document D1 discloses a system comprising an automatic teller machine having all features of the preamble of claim 1 (see, e.g., Figures 3 and 4 and the accompanying description).

5.4 The system of claim 1 differs from that of document D1 essentially in that, structurally, the card has a storage area where the indelible master account information is kept, and operationally, in that the claimed system permits a customer not only to add transactable accounts to the card but also to delete transactable accounts other than the master account from the card.

5.5 The examining division acknowledged, inter alia, that document D1 did not anticipate that the delete control unit was configured to be incapable of deleting the master-account information. The examining division nevertheless concluded that this distinction could not

confer an inventive step to the claimed invention as it was merely a non-technical feature. The examining division took the view that there was not even a technical motivation for this feature. Instead, it was, so the examining division stated (decision, page 7, paragraph 5), merely the administrative wish of a business expert suggesting that a bank account on the card is particularly important and said account data should not be lost. This feature therefore did not solve a technical problem.

5.6 The board does not share this view. Putting, for the time being, to one side any consideration of whether or not there is in document D1 a suggestion that account information could be deleted from the cash card, a system which allows accounts to be deleted by the user, will benefit from a safeguard against accidental erasure of all information, an event which would render the cash card useless. The board is not in any doubt

(a) that preventing a cash card from accidentally being rendered useless is a technical problem, and

(b) that the solution to this problem, which as claimed lies in providing an area of the card which stores the details of the master account such that it cannot subsequently be erased, is also technical in nature.

5.7 As regards the cash card itself, it is established case law of the boards of appeal that a computer-readable medium is a technical product and, thus, has technical character (cf. T 424/03, point 5.3 of the reasons). It follows that it must be beyond doubt that the claimed

system comprising an automatic teller machine and an cash card has technical character.

- 5.8 Claim 1 now states explicitly that it is transactable accounts which can be added to or deleted from the cash card, rather than using the more general and therefore broader wording "information of account" of the claim before the examining division.
- 5.9 Having established that the particular problem of preventing the card from being completely erased and its solution are both technical, as well as that the claimed system itself is also technical in nature, it now falls to be decided whether providing a system as claimed, which enables the user to add and delete accounts from his card, would have been obvious to the skilled person in the light of document D1.
- 5.10 Document D1 sets out to provide on the card a permanent record of transactions carried out with respect to any of the accounts held on the cards. Thus, "... , *the data in UFDC 201 is read-only as far as the user or the holder of UFDC 201 is concerned. And because the transaction data UFDC 201 is advantageously secure from user manipulation, that data may be used to satisfy any documentation requirements regarding such transactions*" (column 5, lines 25 to 28); and " ... *it is contemplated that enough memory is provided to store the financial data related to one calendar-year of use. At the end of the calendar-year the data in memory circuit 300 may be transferred to a new universal financial data card, allowing the old card to be stored away to preserve the historic financial data of the user*" (column 7, lines 13 to 18), and again "[o]ne

challenge in the design of an efficient universal financial data card involves the efficient storage of a large amount of data relating to multiple financial accounts from different financial institutions, as well as their growing financial transaction records" (column 13, lines 28 to 32).

- 5.11 Document D1 even permits new accounts to be added (Fig. 15 and the associated description in column 20, lines 10 to 15), but there is not even a hint that accounts could be deleted. The card in document D1 is intended to store extended financial records for an extended period, and the idea of deleting accounts from it runs completely counter to this aim. Thus, document D1 is not only silent as regards the possibility of deleting accounts, but its teaching is incompatible with that idea and, as argued by the appellant, document D1 therefore clearly teaches away from the idea of deleting accounts.
- 5.12 Since document D1 provides no hint at the possibility of deleting accounts, it also need not and does not address the need to safeguard the card against delete operations which would render it unusable.
6. For the foregoing reasons, the board concludes that a technical solution is provided by the claimed invention to a technical problem it sets out to solve, and that the solution adopted by the claimed invention would not have been obvious to the skilled person. It follows that the invention as claimed in claim 1 involves an inventive step within the meaning of Article 56 EPC 1973.

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 with the order to grant a patent in the following version:

Claims: Nos. 1 to 5 received during the oral proceedings of 7 April 2011.

Description: pages 1, 2, 4-60 as originally filed
pages 3, 3a, 3b as received during oral proceedings of 7 April 2011.

Drawings: sheets 1/17 - 17/17 as originally filed.

Registrar:

Chair:

S. Sánchez Chiquero

G. Eliasson