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**Datasheet for the decision
of 24 May 2011**

Case Number: T 1922/09 - 3.4.03

Application Number: 99202852.2

Publication Number: 1018711

IPC: G07F 7/10

Language of the proceedings: EN

Title of invention:

Dynamic currency conversion for card payment systems

Patentee:

Mainline Corporate Holdings Limited

Opponents:

- 01 NATIONAL WESTMINSTER BANK PLC
- 02 Euroconex Technologies Limited and Flexicom Ltd.
- 03 Retail Logic LTD
- 04 FEXCO Dynamic Currency Conversion Limited
- 05 Global Blue Holdings AB

Headword:

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Relevant legal provisions:

EPC Art. 123(2)
RPBA Art. 13

Relevant legal provisions (EPC 1973):

-

Keyword:

"Added subject-matter (yes) - main request, first and fourth auxiliary request"
"Late-filed requests not admitted - second and third auxiliary request"

Decisions cited:

-

Catchword:

-



Case Number: T 1922/09 - 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 24 May 2011

Appellant: Mainline Corporate Holdings Limited
(Patent Proprietor) Aille
Inverin
Co. Galway (IE)

Representative: Gates, Marie Christina Esther
Tomkins & Co.
5 Dartmouth Road
Dublin 6 (IE)

Respondents: NATIONAL WESTMINSTER BANK PLC
(Opponent 01) 135 Bishopsgate
London EC2P 2AP (GB)

Representative: Jenkins, Peter David
Page White & Farrer
Bedford House
John Street
London WC1N 2BF (GB)

(Opponent 02) Euroconex Technologies Limited
Arena House, Arena Road, Sandyford
Dublin 18 (IE)

and

Flexicom Ltd.
32 Lower Leeson Street
Dublin 2
IE

Representative: Gorman, Francis Fergus
F.F. Gorman & Co.
15 Clanwilliam Square
Dublin 2 (IE)

(Opponent 03) Retail Logic LTD
Nisaba House
Waterfront Business Park
Fleet Road
Fleet, Hampshire GU51 3TZ (GB)

Representative: Dunlop, Hugh Christopher
R.G.C. Jenkins & Co.
26 Caxton Street
London SW1H 0RJ (GB)

(Opponent 04) FEXCO Dynamic Currency Conversion Limited
Fexco Financial Services Centre
Iveragh Road
Killorglin
Kerry (IE)

Representative: Rees, David Christopher
Kilburn & Strode LLP
20 Red Lion Street
London WC1R 4PJ (GB)

(Opponent 05) Global Blue Holdings AB
Östergårdsgatan 7 Box 200
S-431 23 Mölndal (SE)

Representative: Harris, Ian Richard
D Young & Co LLP
120 Holborn
London EC1N 2DY (GB)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 21 July 2009
revoking European patent No. 1018711 pursuant
to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman: G. Eliasson
Members: R. Q. Bekkering
T. Bokor

Summary of Facts and Submissions

- I. This is an appeal against the revocation of EP 1 018 711 for added subject-matter and lack of an inventive step.
- II. Oral proceedings were held before the board. Respondent opponent 3 did not attend as announced.
- III. In the oral proceedings the appellant patent proprietor requested that the decision under appeal be set aside and the patent maintained on the basis of the following:

Main request:

Claims 1 and 8 filed during the oral proceedings before the board (labelled "Main Request", filed at 17:45 hrs);

First auxiliary request:

Claims 1 and 8 filed during the oral proceedings before the board (labelled "New Auxiliary Request", filed at 17:45 hrs);

Second auxiliary request:

Claims 1 and 8 filed during the oral proceedings before the board (labelled "New 1st Auxiliary Request", filed at 12:00 hrs);

Third auxiliary request:

Claims 1 and 8 filed during the oral proceedings before the board (labelled "New 2nd Auxiliary Request", filed at 12:00 hrs);

Fourth auxiliary request:

Claims 1 to 22 filed with letter dated 15 May 2009 (labelled "Main request").

IV. The respondents opponents 1, 2, 4 and 5 requested the dismissal of the appeal.

V. Claim 1 of the main request reads as follows:

"A data processing method performed in a data processing system for determining a preferred currency for association with a charge, debit or credit card transaction between a merchant and a charge, debit or credit card cardholder comprising the steps of; obtaining (30,205) the card number of the payment card from the cardholder, characterised in that the method comprises the further steps of identifying an issuer code (50) from said card number, determining the operating currency (61(1-n)) for said issuer code (60(1-n)) by comparing said issuer identifier code with entries in a table, wherein each entry in the table containing an issuer code (60(1-n)) or range of issuer codes and a corresponding currency code (61(1-n))., wherein said issuer codes are of different lengths and sufficient to distinguish between issuers, and

setting the currency (215,420) for association with the payment card transaction as the determined operating currency for the issuer code (60(1-n))."

VI. Claim 1 of the first auxiliary request reads as follows:

"A data processing method performed in a data processing system for determining a preferred currency for association with a charge, debit or credit card transaction between a merchant and a charge, debit or credit card cardholder comprising the steps of; obtaining (30,205) the card number of the payment card from the cardholder, characterised in that the method comprises the further steps of identifying an issuer code (50) from said card number, wherein said issuer codes are of different lengths and sufficient to distinguish between issuers, determining the operating currency (61(1-n)) for said issuer code (60(1-n)) by comparing said issuer identifier code with entries in a table, wherein each entry in the table contains an issuer code (60(1-n)) or range of issuer codes and a corresponding currency code (61(1-n)) and setting the currency (215,420) for association with the payment card transaction as the determined operating currency for the issuer code (60(1-n))."

VII. Claim 1 of the second auxiliary request reads as follows:

"A data processing method performed in a data processing system having at least one point-of-sale terminals and host means operable for communicating with the at least one point-of-sale terminal over a

communications network, the host means comprising an authorization host and/or a central payment router, the method being for determining the currency of a card at the point of sale -for association with a charge, debit or credit card transaction between a merchant and a charge, debit or credit card cardholder-, comprising the steps of;

obtaining (30,205) by data input means (71, 72) the card number of the payment card from the cardholder at one said point-of-sale terminal,

characterised in that the method comprises the further steps of

identifying an issuer code (50) from said card number, determining the operating currency (61(1-n)) for said issuer code (60(1-n)), by comparing said issuer code with entries in a table, wherein each entry in the table contains an issuer code (60(1-n)) or range of issuer codes and a corresponding currency code (61(1-n)),

setting the currency (215,420) for association with the card transaction as the determined operating currency for the issuer code (60(1-n)), and

executing the card transaction at the one said point-of-sale terminal such that the cardholders makes payment to the merchants in the preferred currencies."

VIII. Claim 1 of the third auxiliary request reads as follows:

"A data processing method performed in a data processing system having at least one point-of-sale terminals and host means operable for communicating with the at least one point-of-sale terminal over a communications network, the host means comprising an authorization host and/or a central payment router, the

method being for automatically determining the currency of a card at the point of sale for association with a charge, debit or credit card transaction between a merchant and a charge, debit or credit card cardholder to allow cardholders to view and/or make payments to merchants in the currency of the cardholder, comprising the steps of;

a point-of-sale terminal obtaining (30,205) the card number of the payment card from the cardholder with input means (71, 72),

the said point-of-sale terminal or said host means identifying an issuer code (50) from said card number, the said point-of-sale terminal or said host means automatically determining the operating currency (61(1-n)) for said issuer code (60(1-n)), by comparing said issuer code with entries in a table, wherein each entry in the table contains an issuer code (60(1 -n)) or range of issuer codes and a corresponding currency code (61(1-n)),

the said point-of-sale terminal or said host means setting the currency (215,420) for association with the card transaction between the cardholder and merchant as the determined operating currency for the identifier code (60(1 -n)), and

the said point-of-sale terminal executing the card transaction such that the cardholder makes payment to the merchant in the determined operating currency."

IX. Claim 1 of the fourth auxiliary request reads as follows:

"A data processing method performed in a data processing apparatus for determining preferred currencies for association with a charge, debit or

credit card transactions between merchants and charge, debit or credit card cardholders and for executing said transactions in said preferred currencies, said method being performed in relation to a multiplicity of charge, debit or credit cards issued by a plurality of different issuers, each card having a card number which identifies the respective account of the cardholder, each account having an associated operating currency for the card and each merchant having an associated merchant currency, at least some of the card currencies differing from at least some of said merchant currencies, said data processing apparatus comprising a plurality of point-of-sale terminals and host means operable for communicating with each other over a communication network, each point-of-sale terminal being associated with a respective said merchant and said host means having a database storing said card numbers said method comprising the steps of

- (a) each said point-of-sale terminal obtaining (30,205) for a respective said transaction the card number of the card from the cardholder,
- (b) said host means adapted to perform authentication processes utilising said stored card numbers in response to requests transmitted to said host means by said point-of-sale terminals over said communications network,

characterised in that said data processing apparatus includes a bank reference table having a plurality of entries each containing an issuer code or range of issuer codes and a corresponding currency code, said bank reference table being abbreviated relative to said database in

that said issuer codes are each constituted by only a portion of said card numbers and in that each said stored portion identifies the operating currency of a respective plurality of said cards and characterised in that the method further comprises the steps of said apparatus identifying an identifier code (50) from said card number, said identifier codes being portions only of said card numbers corresponding to the portions of said card numbers which constitute said issuer codes said apparatus determining the operating currency (61(1-n)) for said identifier code (60(1-n)), by comparing said identifier code with said entries in said bank reference table, said apparatus setting the currency (215,420) for association with the card transaction as the determined operating currency for the identifier code (60(1-n)), and said apparatus executing the transaction at the point-of-sale in said determined operating currency."

X. Independent claim 8 of all requests is directed to a corresponding data processing system (apparatus).

XI. Reference is made to the following documents:

OP3-D4: "Implementation of EN ISO/IEC 7812-1: 1995, Identification cards - Identification of issuers, Part 1. Numbering system", BSI British Standards Institution, 1995, pages 1 to 14

OP1-D7: WO 95/12169 A

OP1-D10: EP 0 843 292 A

PP-D1: "Dynamic Currency Conversion (DCC) at Point of Sale, Acquirer & Merchant Standards Manual", Payment Services/Compliance Management, Version 1.0, December 2004, Visa, pages 1 to 25.

XII. The appellant patent proprietor argued as follows:

Regarding the main and first auxiliary request, it was clear to the skilled person from the application as originally filed that the issuer codes according to the invention were not the Bank Identification Numbers (BIN) and could be of different lengths.

Regarding the second and third auxiliary request the appellant argued that the subject-matter of the respective claims 1 involved an inventive step, in particular as the skilled person knew at the priority date of the patent, as evidenced by PP-D1, that the BINs were unsuitable for determining the cardholder billing currency, and thus would have disregarded document OP1-D7.

Regarding the fourth auxiliary request the appellant submitted that the application as originally filed disclosed both an "issuer code" and an "identifier code".

XIII. The respondents opponents 1, 2, 4 and 5 essentially argued as follows:

The amendment to claim 1 of the main and first auxiliary request that the issuer codes were of

different lengths and sufficient to distinguish between issuers was not directly and unambiguously derivable from the application as originally filed.

Accordingly, claim 1 of both the main and first auxiliary request contained subject-matter extending beyond the content of the application as filed, contrary to Article 123(2) EPC.

The second and third auxiliary request were late filed and contained amendments with respect to subject-matter extensively discussed in the oral proceedings and found to lack an inventive step over documents OP1-D7 and OP1-D10. Hence, these requests were *prima facie* clearly inadequate to overcome the lack of inventive step objection, and should accordingly not be admitted into the proceedings.

Claim 1 according to the fourth auxiliary request contained a number of amendments contravening Article 123(2), Article 84 and/or Rule 80 EPC. In particular, the provision of two codes, an issuer code and an identifier code, was not derivable from the application as originally filed.

Reasons for the Decision

1. The appeal is admissible.
2. *Main and first auxiliary request of the appellant*
 - 2.1 *Admission of the requests*

The appellant's main and first auxiliary requests were only filed at an advanced stage of the oral proceedings before the board. However, as the issues they raised

could be dealt with without adjournment of the oral proceedings and as all respondents present expressly consented to the requests being admitted in order to expedite the proceedings, the board exercised its discretion to admit these requests into the proceedings (Article 13 RPBA).

2.2 *Amendments*

2.2.1 Claim 1 of the main request as amended contains the following feature:

"wherein said issuer codes are of different lengths and sufficient to distinguish between issuers".

2.2.2 According to the appellant, the basis for this amendment was provided by paragraph [0049] and figure 6 of the application as published.

According to paragraph [0049], "typically, payment card issuers are assigned a range of card numbers for issuing cards to customers. For example a small bank may be assigned the range 4555999033300000 to 45550999033399999, whereas a larger bank [sic] may be assigned 4555998800000000 to 4555998819999999. Accordingly, the identifier code is the portion of a card number, which distinguishes between issuers."

The appellant argued that it would be clear to the skilled person from this paragraph that for the small bank 11 digits and for the large bank 9 digits were necessary for distinguishing between issuers. Conversely, from figure 6, showing an example of a table containing issuer codes all having 5 digits, it

was apparent that under certain circumstances 5 digits could be sufficient for distinguishing between issuers.

- 2.2.3 It is, however, noted that neither in paragraph [0049], nor anywhere else in the application documents as originally filed, is the length of the issuer code, or indeed the fact that the issuer codes may be of different lengths, explicitly mentioned.

Moreover, it appears doubtful that the example given in the above paragraph was intended to make the point argued by the appellant. It would rather appear that this example was given merely to show the general structure of a card number consisting of a six digit issuer identification number followed by an individual account number. In fact, the immediately following sentence states that "*the identifier code is compared 51 with entries in a bank reference table (an example of which is shown in Figure 6), which contains a list of issuer identifier codes*" (paragraph [0050] of the application as published). In figure 6 all issuer codes have five digits. This is indeed what a skilled reader would generally expect since conventionally, in accordance with the corresponding ISO norm, the first six digits of the card number form the Issuer Identification Number (IIN) (also referred to as the Bank Identification Number (BIN)) consisting of a Major Industry Identifier (MII) (first digit) followed by an issuer identifier (fixed length five digits) (see also OP3-D4). In fact it is not apparent from the application as originally filed that where reference is made in the application to the "*issuer identifier code*", the "*issuer code*" or the "*identifier code*", anything other than the above mentioned conventional five digit

issuer identifier is meant. In this respect it is noted that figure 10 as originally filed contains the decision step "*is entry in BIN table?*", leaving no doubt to the skilled reader that also in this instance what is referred to as the "*issuer code*" is the conventional issuer identifier, ie the BIN (with the omission of the MII) (see [0082] of the application as published).

The appellant also argued that from the example of paragraph [0049] it was clear that only the consideration of the additional digits beyond the sixth digit allowed for distinguishing between any sublicensed issuers.

However, there is no mention anywhere in the application of any sublicensed issuers or indeed any indication of these sublicensed issuers dealing in any currency deviating from that of the main issuer. The need to distinguish between any sublicensed issuer, and therewith the need to consider any further digits of the card number, is thus not apparent from the application as filed. Even in the sole passage in the entire application as originally filed where mention is made of the possibility of an issuer having different associated currencies (ie an Irish bank where the associated currencies may be Irish Pounds or Euros), there is no mention of to what extent, or in fact whether at all the issuer identifier code referred to differs from the conventional five digit issuer identifier.

2.2.4 Accordingly, the above amendment is not directly and unambiguously derivable from the application as originally filed.

Hence, claim 1 according to the appellant's main request contains subject-matter which extends beyond the content of the application as filed, contrary to Article 123(2) EPC.

2.2.5 Claim 1 of the first auxiliary as amended also contains the above feature:

"wherein said issuer codes are of different lengths and sufficient to distinguish between issuers".

The fact that this feature is now inserted after the step of identifying an issuer code does not alter the finding above for the main request, that the amendment is not directly and unambiguously derivable from the application as originally filed.

Accordingly, also claim 1 according to the appellant's first auxiliary request contains subject-matter which extends beyond the content of the application as filed, contrary to Article 123(2) EPC.

2.2.6 The appellant offered a number of minor corrections to be made to claim 1 of the main request, comprising the deletion of the term "identifier" in line 10 and the deletion of the term "payment" in lines 6 and 14, and corresponding corrections to claim 8 of the main request and to claims 1 and 8 of the first auxiliary request.

These corrections, however, do not alter the finding of added subject-matter above.

2.2.7 The appellant's main and first auxiliary request are, therefore, not allowable.

3. *Second and third auxiliary request of the appellant*

3.1 *Admission of the requests*

3.1.1 The appellant's second and third auxiliary requests were filed during the oral proceedings before the board, initially as "*new first auxiliary request*" and "*new second auxiliary request*", together with a "*new main request*" which was later withdrawn.

3.1.2 As claim 1 of this "*new main request*" was considered to overcome at last *inter alia* a series of objections of added subject-matter, the board decided to exercise its discretion to admit this "*new main request*" into the proceeding despite its late filing (Article 13 RPBA).

Claim 1 of this "*new main request*" corresponded in fact to claim 1 as granted, with all references to "*identifier code*" being amended to "*issuer code*".

Thereupon the issue of inventive step of the subject-matter of claim 1 of this "*new main request*" was extensively discussed in the oral proceedings.

The board found with respect to the subject-matter of claim 1 of this "*new main request*" that it lacked an inventive step having regard to the prior art documents OP1-D10 and OP1-D7.

In particular, document OP1-D10, which was considered the closest prior art, disclosed a method of performing a card transaction using a point of sale (POS) terminal at the merchant's premises in the currency selected by the cardholder.

Following the announcement of this finding of lack of inventive step in the oral proceedings, the appellant withdrew the "*new main request*" as noted above.

- 3.1.3 The amendments made to claim 1 according to the present second and third auxiliary requests essentially add with respect to claim 1 of the above "*new main request*" that the data processing system has at least one point-of-sale terminal with data input means and an authorization host and/or a central payment router communicating over a communications network, and that the point-of-sale terminal executes the card transaction such that the cardholder makes a payment to the merchant in the (preferred) determined operating currency.

The provision of point-of-sale terminals, host means etc. as well as the step of executing the card transaction as claimed are, however, all entirely conventional for card transactions (and essentially known from OP1-D10), so that *prima facie* these amendments are clearly not suitable for overcoming the above lack of inventive step objection.

No arguments to the contrary were provided by the appellant.

Accordingly, the board exercises its discretion not to admit the second and third auxiliary request into the proceedings (Article 13 RPBA).

4. *Fourth auxiliary request of the appellant*

4.1 *Amendments*

4.1.1 Claim 1 as amended according to the fourth auxiliary request *inter alia* specifies "issuer codes" and "identifier codes".

In particular, according to claim 1 "said data processing apparatus includes a bank reference table having a plurality of entries each containing an issuer code or range of issuer codes and a corresponding currency code". Moreover, according to claim 1 "said issuer codes are each constituted by only a portion of said card numbers".

Furthermore, claim 1 specifies "said apparatus identifying an identifier code (50) from said card number, said identifier codes being portions only of said card numbers corresponding to the portions of said card numbers which constitute said issuer codes" and "said apparatus determining the operating currency (61(1-n)) for said identifier code (60(1-n)), by comparing said identifier code with said entries in said bank reference table".

There is, however, no basis in the application as originally filed for the identifier code not being the issuer code. In fact, as discussed above with respect to the appellant's main request, it is not apparent

from the application as originally filed that where reference is made to the "*issuer identifier code*", the "*issuer code*" or the "*identifier code*" in the application as originally filed anything other than the above mentioned conventional five digit issuer identifier is meant.

It is also noted in this respect that claims 1 and 2 as originally filed, on which present claim 1 is based, only define an "*issuer code*" and in fact originally filed claim 2 refers back to this code as "*said issuer identifier code*". Moreover original claim 1 specifies "*identifying an issuer code (50) from said card number*" rather than an "*identifying an identifier code (50) from said card number*" as in amended claim 1.

Accordingly, claim 1 according to the appellant's fourth auxiliary request contains subject-matter which extends beyond the content of the application as filed, contrary to Article 123(2) EPC.

The appellant's fourth auxiliary request is, therefore, not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

Registrar

Chair

S. Sánchez Chiquero

G. Eliasson