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**Datasheet for the decision  
of 16 December 2014**

**Case Number:** T 1038/10 - 3.4.03

**Application Number:** 02735917.3

**Publication Number:** 1430455

**IPC:** G07F19/00

**Language of the proceedings:** EN

**Title of invention:**

A SECURE ON-LINE PAYMENT SYSTEM

**Applicant:**

Mainline Corporate Holdings Limited

**Headword:**

**Relevant legal provisions:**

EPC Art. 123(2)  
EPC 1973 Art. 56, 84

**Keyword:**

Amendments - added subject-matter (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern  
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Case Number: T 1038/10 - 3.4.03

**D E C I S I O N  
of Technical Board of Appeal 3.4.03  
of 16 December 2014**

**Appellant:** Mainline Corporate Holdings Limited  
(Applicant) Tully  
Ballinahown,  
Galway (IE)

**Representative:** Mackett, Margaret Dawn  
Gevers Patents  
Intellectual Property House  
Holidaystraat 5  
1831 Diegem (BE)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted on 9 December 2009  
refusing European patent application No.  
02735917.3 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman** G. Eliasson  
**Members:** T. M. Häusser  
T. Bokor

## Summary of Facts and Submissions

I. The appeal of the applicant concerns the decision of the examining division refusing the European patent application No. 02735917 for added subject-matter (Article 123(2) EPC) and for lack of novelty and inventive step (Articles 54 and 56 EPC) in relation to the main request and first and second auxiliary requests then on file.

II. Reference is made to the following documents:

D1: US 6,188,994 B1,  
D2: WO 00/14648 A1.

III. Oral proceedings before the board took place in the absence of the appellant, of which the board had been informed beforehand.

The appellant had requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of claims 1-10 of the main request filed with the statement of the grounds of appeal dated 13 April 2010, or alternatively on the basis of the 1st or 2nd auxiliary request, also filed with the statement of the grounds of appeal.

IV. In a communication pursuant to Article 15(1) RPBA the board expressed its provisional opinion that claim 1 of all requests contained subject-matter going beyond the application as filed, contrary to the requirements of Article 123(2) EPC. Furthermore, the board stated the provisional opinion that the subject-matter of claim 1 of the main request and of claim 1 of the first auxiliary request lacked inventive step in view of documents D1 and D2 (Article 56 EPC 1973) and that

claim 1 of the second auxiliary request was not clear and not supported by the description (Article 84 EPC 1973).

- V. The wording of independent claim 1 of the respective requests is as follows (board's labelling "(i)", "(i)", "(ii)", and "(ii)"):

Main request:

"1. A system for processing an on-line payment transaction between a debit, credit or charge card holder and a merchant, the system having a connection to the Internet and a further connection via a local network to the terminal of a cardholder comprising:

receiving means for receiving a request from the cardholder to connect to a network, said request including a cardholder password,

authentication means for authenticating said cardholder request and providing access by said cardholder to the network,

receiving means for receiving a first transaction request associated with a transaction between a merchant and the cardholder at a transaction processor,

retrieval means for retrieving payment card details for the cardholder from a database,

- (i) authorising means for submitting a payment authorisation request to an authorization host for the retrieved payment card details, the authorisation request including a system merchant code associated with said transaction processor and the transaction value, wherein the system merchant code identifies a transaction processor account for crediting the amount of the transaction, and

- (ii) transaction means responsive to receipt of an authorisation from the authorisation host and adapted to forward a transaction request to the merchant, the request including card-holder information corresponding to an account of the transaction processor."

First auxiliary request:

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the following feature is added after the feature relating to the receiving means for receiving a first transaction request:

"wherein the merchant does not have an agreement with the transaction processor to use the system, such that the transaction processor does not possess the merchant's merchant code information,"

Second auxiliary request:

Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in that the feature

"merchant request means for submitting a message to the merchant asking them to provide their merchant details to allow processing of the transaction to proceed,"

is added before the feature relating to the retrieval means and in that features (i) and (ii) are replaced by the following features (i)' and (ii)', respectively:

- (i) ' authorising means for submitting a payment authorisation request to an authorization host for the retrieved payment card details, the authorisation request - in the event the merchant does not respond the message sent by said merchant request means - including a system merchant code associated with said transaction processor and the transaction value, wherein the system merchant code identifies a transaction processor account for crediting the amount of the transaction, and
- (ii) '' transaction means responsive to receipt of an authorisation from the authorisation host and adapted - in the event the merchant does not respond the message sent by said merchant request means - to forward a transaction request to the merchant, the request including cardholder information corresponding to an account of the transaction processor."

VI. The appellant argued essentially as follows in relation to the basis of the amendments:

The replacement of the phrase "adapted to forward a transaction request to the merchant, the request including a master cardholder account code" by the phrase "adapted to forward a transaction request to the merchant, the request including cardholder information corresponding to an account of the transaction processor" in the present independent claims was based on page 18, lines 1-4 of the description.

## **Reasons for the Decision**

1. The appeal is admissible.
2. Amendments
  - 2.1 Claim 1 of the main request relates to the embodiment of the invention which is described as the "second embodiment" in the description of the application on page 16, line 25 - page 19, line 6. In that embodiment there are two transactions of equal value: the first transaction is between the transaction processor scheme operator and the cardholder and the second transaction is between the transaction scheme operator and the merchant. The result of the combination of the two transaction is that an effective debit is made from the cardholder's account and the merchant is credited for the transaction amount (see the description of the application, page 18, first paragraph, and page 19, first paragraph).
  - 2.2 In particular, claim 1 of the main request comprises - apart from the feature mentioned below - the features of original claim 11 and certain features of the description.

In relation to claim 11 as originally filed, claim 1 of the main request has been amended in that the feature that the transaction request includes "a master cardholder account code" has been replaced by the feature that this request includes "cardholder information corresponding to an account of the transaction processor" (see feature (ii) of claim 1 of the main request cited under point V. above).

It has to be assessed whether this amendment is in accordance with the requirements of Article 123(2) EPC.

2.3 In the decision under appeal the examining division held that claim 1 of the first auxiliary request then on file, which corresponds to claim 1 of the present main request, contained subject-matter extending beyond the application as filed contrary to the requirements of Article 123(2) EPC (see points 1 and 5 of the Reasons of the decision). In particular, it was held that the feature that the transaction request included a master cardholder *account code* was an essential feature and had been deleted in the claim.

2.4 It is established case law that the relevant question to be decided in assessing whether an amendment adds subject-matter extending beyond the application as filed is whether the proposed amendments are directly and unambiguously derivable from the application as filed (see Case Law of the Boards of Appeal of the EPO, 7<sup>th</sup> edition, section II.E.1.7).

In the board's opinion this is how compliance of the amendments with Article 123(2) EPC has to be assessed in the present case.

2.5 Feature (ii) of claim 1 of the main request is concerned with the transaction between the transaction processor scheme operator and the merchant. According to that feature a transaction request including *cardholder information corresponding to an account of the transaction processor* is forwarded to the merchant. By indicating merely that the request includes the cardholder information it is left open in which manner the transaction is to be carried out. In particular, since the feature of original claim 11 that "the transaction



request contained the master cardholder account code" is omitted, the transaction need no longer be performed by way of a transfer of funds from that account. Rather, it is within the scope of claim 1 of the main request that the transfer of funds to the merchant is carried out subsequently without debiting said account, e. g. involving the transmission of a cheque or money order or the award of credit with the transaction processor operator to the merchant.

- 2.6 The appellant referred to page 18, lines 1-4 as a basis for the amendment, where it is indicated that in "order to pass settlement (from the transaction processor scheme operator to the merchant), the transaction processor provides cardholder information, card number and expiry date corresponding to an account of the transaction processor operator ... to the merchant".

In that passage it is thus stated that not only the cardholder information, but also the card number and the expiry date corresponding to an account of the transaction processor operator is transmitted to the merchant. These three pieces of information are not independent of each other, since all of them are needed in order to effect the transfer of funds as is well-known to the skilled person. It is therefore not considered to be directly and unambiguously derivable for the skilled person to single out one of these necessary pieces of information by indicating in feature (ii) that the transaction request includes merely the cardholder information corresponding to an account of the transaction processor.

Furthermore, neither the above passage nor any other part of the application documents provides any basis for the broadening of the scope of claim 1 of the main

request indicated above. On the contrary, it is stated in the above passage in definitive terms that the cardholder information, card number and expiry date are transferred to the merchant. This is not described as optional.

Moreover, it is not considered to be implicitly disclosed in the application documents that the transfer of funds could be performed in other ways than by debiting the transaction processor operator's account. This is especially the case since the claimed system is for processing an on-line payment transaction between debit, credit or charge card holder and a merchant, while such other ways may well involve traditional transfers of funds such as cheques and money orders as indicated above.

2.7 In view of the above, claim 1 of the main request is not directly and unambiguously derivable from the application as filed and is thus considered to contain subject-matter extending beyond the application as filed, contrary to the requirements of Article 123(2) EPC.

2.8 Claim 1 of the first auxiliary request differs from claim 1 of the main request in comprising an additional feature concerning the merchant not having an agreement with the transaction processor, which is unrelated to feature (ii) concerning the transaction between the transaction processor scheme operator and the merchant.

Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in comprising additional features related to merchant request means for submitting a message to the merchant and arranging certain means in the system to act depending on the

response to the message. This is also unrelated to the transaction between the transaction processor scheme operator and the merchant.

Claim 1 of the first auxiliary request and claim 1 of the second auxiliary request are therefore also considered to contain subject-matter extending beyond the application as filed, contrary to the requirements of Article 123(2) EPC.

2.9 As none of the requests is in accordance with the EPC the appeal is to be dismissed. It is therefore not necessary to consider whether the case should be remitted to the department of first instance.

3. Further deficiencies of the application

In a communication annexed to the summons to attend oral proceedings the board had also informed the appellant of its provisional opinion that the subject-matter of claim 1 of the main request and of claim 1 of the first auxiliary request lacked inventive step in view of documents D1 and D2 (Article 56 EPC 1973) and that claim 1 of the second auxiliary request was not clear and not supported by the description (Article 84 EPC 1973).

The appellant neither amended the claims nor provided any arguments in writing or at the oral proceedings in response to this provisional opinion. It is mentioned as an *obiter dictum* that the board sees no reason to revise its opinion expressed in the communication mentioned above concerning these further deficiencies of the application.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Eliasson

Decision electronically authenticated