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**Datasheet for the decision
of 17 March 2017**

Case Number: T 0519/12 - 3.4.01

Application Number: 08165790.0

Publication Number: 2124169

IPC: G06K19/02, G06K19/06,
G06K19/077

Language of the proceedings: EN

Title of invention:

Metal-containing transaction card and method of making the same

Applicant:

American Express Travel Related Services
Company Inc.

Headword:

Relevant legal provisions:

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

Keyword:

Inventive step - (no)
Amendments - added subject-matter (yes)

Decisions cited:

T 0939/92

Catchword:

It is expected from the skilled person that he would exercise his skills in the framework of technical Standards in force in his field of activity. No inventive activity can thus be derived from a feature that simply reflects the content of such a technical prescription (cf. point 3.5).



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Case Number: T 0519/12 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 17 March 2017

Appellant: American Express Travel Related Services
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 7 October 2011
refusing European patent application No.
08165790.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Assi
Members: P. Fontenay
R. Winkelhofer

Summary of Facts and Submissions

- I. The examining division refused European patent application No. 08 165 790.

In its decision, the examining division held that the subject-matter of independent claims 1 and 13 of the main request then pending was not inventive in the sense of Art. 56 EPC 1973 in view of document WO-A-2006/081385 (D1). The examining division further held that independent claims 1 and 13 of the first and second auxiliary requests then pending defined added subject-matter contrary to the requirements of Art. 123(2) EPC.

- II. The appellant (applicant) filed an appeal against the decision.

With the grounds of appeal, the appellant requested that the decision be set aside and that a patent be granted on the basis of an enclosed set of claims according to a main request or, alternatively, one of auxiliary requests I to VI.

- III. At the appellant's request, a summons to attend oral proceedings was issued.

- IV. In a communication pursuant to Art. 15(1) RPBA, the appellant was informed of the provisional opinion of the Board with regard to the appellant's requests.

The appellant was invited to indicate the basis in the original application documents for the amendments made to the independent claims of all requests. In this regard, it was reminded that support in the description should not only exist for the claimed features as such,

but also for the combination of features actually claimed.

With regard to inventive step, document D1 was considered to represent the closest prior art. Moreover, the appellant was asked to provide copies of standards concerning physical features of integrated circuit transaction cards.

V. In reply, the appellant did not make any submissions concerning the issues raised by the Board. The Board was only informed that the applicant's representative would not be attending the oral proceedings.

VI. The Board ordered, of its own motion, a copy of International Standard ISO/IEC 7816-2: 2007(e), second edition of 15 October 2007.

The appellant was informed by fax that the Board intended to refer to said standard insofar as aspects regarding the relative positioning of the microchip and embossing area were concerned. A copy of said document was annexed to the fax.

VII. Oral proceedings took place in the absence of the appellant.

VIII. Claim 1 of the main request reads:

*"1. A method of making a transaction card comprising:
cutting a first sheet of metal to create a card
body;
milling a first pocket on a second surface of the
transaction card;
milling a second pocket on a first surface of the
transaction card;*

embossing the transaction card within the first pocket to provide embossed characters on the first surface of the transaction card;

disposing an adhesive within the second pocket;
disposing a microchip within the second pocket;
cutting a second sheet of metal to create a back panel; and

bonding the back panel to the first pocket with an adhesive to provide a smooth surface on the second surface of the transaction card".

Claims 2 to 12 of the main request depend on claim 1.

Independent claim 13 of the main request reads:

"A transaction card comprising:
a titanium card body having a first surface and a second surface;
a first pocket disposed in the second surface;
embossed characters punched into the transaction card within the first pocket and providing embossed characters on the first surface;
a back panel disposed in the first pocket and bonded to the second surface;
a second pocket disposed in the first surface;
a microchip disposed in the second pocket."

Claims 14 to 18 of the main request depend on independent claim 13.

- IX. Claim 1 according to auxiliary request I differs from claim 1 of the main request in that it incorporates at the end of the claim the additional feature:
"wherein the first pocket to which the back panel is bonded is positioned below the location of a signature panel of the transaction card".

A similar amendment was introduced in independent claim 13 as to the transaction card.

- X. Claim 1 according to auxiliary request II differs from claim 1 of the main request in that it recites at the end of claim 1 the additional feature:

"wherein the first pocket to which the back panel is bonded is positioned below the location of a signature panel of the transaction card and the second pocket in which the microchip is disposed is positioned above the location of the signature panel".

A similar amendment was introduced in independent claim 13 as to the transaction card.

- XI. Claim 1 according to auxiliary request III differs from claim 1 of the main request in that the feature of *"bonding the back panel to the first pocket with an adhesive to provide a smooth surface on the second surface of the transaction card"* has been amended to read *"bonding the back panel to the first pocket with an adhesive"*. Moreover, the following additional limitation has been added at the end of the claim:

"wherein the method further comprises disposing indicia on the back panel and then pairing the back panel with the card and performing the bonding of the back panel to the first pocket".

Independent claim 13 differs from claim 13 of the main request in that the following wording *"wherein indicia are disposed on the back panel"* was added at the end of the claim.

- XII. Claims 1 and 13 according to auxiliary request IV differ from the corresponding independent claims of the main request in that they combine the amendments made with regard to auxiliary requests II and III.
- XIII. Auxiliary request V differs from auxiliary request III in that claims 13 to 18 as to the transaction card have been deleted.
- XIV. Auxiliary request VI differs from auxiliary request IV in that claims 13 to 18 as to the transaction card have been deleted.

Reasons for the Decision

1. *Applicable law*

It is noted that the revised version of the Convention (EPC 2000) does not apply to European patent applications pending at the time of its entry into force (13 December 2007), unless otherwise provided. In the present decision, where Articles or Rules of the former version of the EPC apply, their citation is followed by the indication "1973".

2. The appeal is admissible.

3. *Main request*

- 3.1 D1 reproduces the content of the present application insofar as the embodiments of Figures 1 to 14 are concerned. Concretely, document D1 discloses a transaction card made of metal and a method of manufacturing such a card. In this respect, the Board shares the view of the examining division that D1 illustrates the closest prior art.

3.2 The question arises whether the examining division also rightly considered that the method of claim 1 according to the main request differed from the manufacturing method disclosed in D1 in that it comprised the steps of:

- milling a second pocket on a first surface of the transaction card;
- disposing an adhesive within the second pocket; and
- disposing a microchip within the second pocket.

3.3 Paragraph [0100] in D1 explicitly refers to the presence of "*any other pocket*" that may be milled in one or more surfaces of a transaction card. Therefore, contrary to the view of the examining division, the feature of milling a second pocket **on the first surface** of the transaction card, that is on a surface different from the one receiving the first pocket, as mentioned above, is known from D1. Since, moreover, the part of the description relating to the embossing pocket also refers to a milling process, it follows that D1, as a whole, discloses milling both the embossing pocket and "*other pocket*" on said first surface.

Since said paragraph explicitly refers to a microchip transaction card, it is considered that the feature of disposing a microchip in an additional pocket is also disclosed in D1.

There is however no indication to be found in this paragraph or in the disclosure as a whole that the second pocket to be milled on the first surface is the one that would receive the microchip. For these reasons, a further selection is to be made between the two configurations identified above in paragraph [0100] which shall actually define the closest prior art.

3.4 The embodiment referring to the incorporation of a microchip as a card feature is considered to define the most promising starting point (closest prior art) when deciding on the inventive merits of the claimed invention since it reproduces the functionalities of the claimed transaction card.

It follows that the subject-matter of claim 13 differs from the card disclosed in D1 only in that the second pocket is disposed on the first surface of the card.

Similarly, the method of making the transaction card of claim 1 differs from the method disclosed in D1, in that the second pocket is milled on the first surface of the transaction card.

3.5 The presence of the second pocket for receiving the microchip on the first surface of the transaction card does not justify the presence of an inventive step since it results from requirements contained in said International Standard ISO/IEC 7816-2:2007(e). Specific reference is made to section 5 ("*Location of contacts relative to other technologies*") where it is specified that "*Embossing (ISO/IEC 7811.1) when present, shall be located on the same side as the contacts*". No inventive activity can be recognised with regard to this technical prescription. It is expected from the skilled person that he would exercise his skills in the framework of technical Standards in force in his field of activity. No inventive activity can thus be derived from a feature that simply reflects the content of such a technical prescription.

- 3.6 Consequently, the subject-matter of claims 1 and 13 of the main request does not involve an inventive step in the sense of Art. 56 EPC 1973.

The main request is thus not allowable.

4. *Auxiliary request I*

- 4.1 The appellant's view, according to which the amendment to claim 1 (cf. point IX above) permitted to avoid damage to a microchip during the milling process of the pocket (cf. point 45 in the statement of grounds), is not convincing.

In effect, there appears to be no need in the claimed method to dispose the microchip in the second pocket before milling the first pocket. It is stressed that claim 1 does not define any clear sequence with regard to the various operations being carried out. In this respect, the effect relied upon by the appellant appears not only artificial in that it would not reflect normal practice, but also at odd with the claim's wording which does not include the limitation relied upon by the appellant.

The problem addressed by the invention must thus be reformulated so as to apply to claim 1 in its generality and be technically sensible (cf. decision T 0939/92, OJ 1996, 309).

Applying the approach developed in T 0939/92 and having regard to the teaching of document D1, the technical problem solved by the claimed method would simply consist in selecting a location for said first pocket.

The claimed configuration does not then extend beyond an arbitrary selection of the position for said first pocket for which the presence of an inventive step is denied.

- 4.2 Consequently, the subject-matter of claim 1 of auxiliary request I does not involve an inventive step in the sense of Art. 56 EPC 1973. The same applies to claim 13.

Auxiliary request I is thus not allowable.

5. *Auxiliary request II*

- 5.1 The appellant puts forward that the features added to claim 1 of auxiliary request II (cf. point X above) derived from the statement on page 21, lines 24, 25 of the original application (cf. paragraph [0110] of the published application) in combination with the embodiment of Figures 14A to 14C from which it could be derived that the pocket 1410 in which the microchip is disposed was positioned above the location of the signature panel (cf. point 57 in the statement of grounds).

The passage and Figures relied upon by the appellant relate, however, to different embodiments which cannot be combined. As a matter of fact, the embodiment of Figure 14A to 14C indeed discloses a pocket for the microchip being positioned above the location of the signature panel but also a pocket for the back panel being positioned above said signature panel, contrary to the claim's wording. The original disclosure does not contain any clear indications that would support the claimed wording. Even when assuming that the "*inset fill panel*", disclosed with regard to the embodiment of

Figure 11, could define a back panel in the sense of claim 1, this embodiment does not contain any information regarding the relative positioning of said inset fill panel relative to the microchip panel. It therefore does not constitute a suitable basis for the amendments carried out.

- 5.2 Claim 1 of auxiliary request II is therefore considered to define added subject-matter contrary to Art. 123(2) EPC. The same applies to claim 13.

Auxiliary request II is thus not allowable.

6. *Auxiliary requests III to VI*

- 6.1 Claim 1 of auxiliary requests III to VI comprises *inter alia* the limitation that "*the method further comprises disposing indicia on the back panel and then pairing the back panel with the card and performing the bonding of the back panel to the first pocket*" (cf. points XI to XV above).

The appellant puts forward that said features derived from the statement on page 20, line 32 to page 21, line 1 of the original disclosure (cf. paragraph [0108] of the published application) or from original claim 1.

While it is acknowledged that the passage referred to by the appellant discloses the added features, it is also observed that said passage relates to a context different from the one corresponding to the independent claims of the main request. The passage cited by the applicant neither explicitly nor implicitly disclose the now claimed combination of features.

It is stressed that the wording of claim 1 implies that the back panel corresponds to the panel to be disposed in the embossing pocket. This understanding of the claim's wording reflects thus the configuration illustrated with regard to the embodiment of Figure 11 with a back panel, incidentally referred to as "*inset fill panel*". The inconsistent terminology between the claim and the disclosure would not as such constitute a problem under Art. 123(2) EPC insofar as the deriving technical teaching would indeed be supported by said embodiment. More fundamental, however, is the fact that the passage referred to by the appellant refers to the embodiment of Figures 14A to 14C with a back panel, indeed identified in this embodiment as "*back panel*", which fulfills functionalities different from those of Figure 11. In this regard, it is emphasized that the original disclosure does not contain any suggestion to provide the inset back panel of Figure 11 (incidentally defined as "*inset fill panel*") with indicia. Similarly, the embodiment of Figures 14A to 14C does not contain any suggestion to dispose the back panel in the first embossing pocket. It follows that the claimed methods according to claim 1 of auxiliary requests III to VI combine various embodiments of the disclosure in a way for which no basis can be found in the original disclosure.

6.2 Consequently, claims 1 of auxiliary requests III to VI define added subject-matter contrary to Art. 123(2) EPC.

Auxiliary requests III to VI are thus not allowable.

7. In conclusion, the appellant's request for the grant of a patent on the basis of the pending main request or auxiliary request I to VI is rejected.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



R. Schumacher

G. Assi

Decision electronically authenticated