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**Datasheet for the decision
of 22 May 2018**

Case Number: T 0914/12 - 3.5.01

Application Number: 04717846.2

Publication Number: 1610245

IPC: G06F17/60

Language of the proceedings: EN

Title of invention:

MOBILE TERMINAL DEVICE, MOBILE TERMINAL METHOD, MOBILE
TERMINAL PROGRAM, PROVIDING SERVER DEVICE, PROVIDING SERVER
METHOD, AND PROVIDING SERVER PROGRAM

Applicant:

Sony Corporation

Headword:

Mobile terminal device / SONY CORPORATION

Relevant legal provisions:

EPC Art. 56, 123(2)
RPBA Art. 12(4), 13(1)

Keyword:

Late-filed auxiliary requests - admitted (no) - converging
versions of claims (no)

Amendments - extension beyond the content of the application
as filed (yes) - broadening of claim (yes)

Inventive step - IC chip identification for electronic payment
(no - obvious combination of known features)

Decisions cited:

T 1685/07



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Case Number: T 0914/12 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 22 May 2018

Appellant: Sony Corporation
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Minato-ku
Tokyo 108-0075 (JP)

Representative: Müller Hoffmann & Partner
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 27 October 2011
refusing European patent application No.
04717846.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman W. Chandler
Members: N. Glaser
Y. Podbielski

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division to refuse European patent application No. 04717846.2 pursuant to Article 97(2) EPC on the ground of lack of inventive step (Article 56 EPC) in view of EP 0 950 968 (D1) and the skilled person's common general knowledge.
- II. In the statement setting out the grounds of appeal, dated 5 March 2012, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1-9 filed during the oral proceedings before the examining division (main request), or on the basis of auxiliary request 1 or 2 filed with the grounds of appeal.
- III. In a communication accompanying the summons to oral proceedings, the Board set out its preliminary opinion that the invention did not involve an inventive step (Article 56 EPC). The Board also communicated its objections under Article 123(2) EPC and suggested that the admission of the auxiliary requests into the proceedings would have to be discussed.
- IV. In a reply, dated 20 April 2018, the appellant filed a main request (which corresponded to the main request submitted with the grounds of appeal), and auxiliary requests 1-5, together with arguments in favour of inventive step.
- V. At the beginning of the oral proceedings, the appellant made auxiliary request 2 its main request. The Board discussed the admissibility of the main request and auxiliary requests 4 and 5 and decided not to admit them into the proceedings.

Thereafter, the appellant made auxiliary request 1 its new main request (hereinafter "new main request"), auxiliary request 3 its new auxiliary request 1 (hereinafter "new auxiliary request 1") and the main request its new auxiliary request 2 (hereinafter "new auxiliary request 2"), all filed with letter dated 20 April 2018. The appellant confirmed its requests that the decision under appeal be set aside and a patent be granted on the basis of the new main request, or the new auxiliary request 1 or 2.

The appellant filed a new auxiliary request 3 (hereinafter "new auxiliary request 3") which was not admitted into the proceedings.

After due consideration of the appellant's arguments the Chairman announced the decision.

VI. Independent claim 1 of the new main request reads as follows [with minor reformatting for ease of reading]:

"1. A mobile terminal device (7) being configured to communicate with an electronic money server (2) providing electronic money service,

the mobile terminal device (7) comprising:

information processing means (28) for processing electronic information, the electronic information including money information, the information processing means including an IC chip;

storing means (29a) for storing the electronic information;

*generating means for generating money information
storing means for storing money information to said
storing means (29a) of said connected information
processing device;*

*secret information receiving means (41) for
receiving from the electronic money server secret
information including key information;*

*ID information receiving means (41) for receiving
registering ID information from said electronic
money server (3);*

*means for downloading from the electronic money
server (2) a money information processing program
for enabling the information processing means (28)
to execute money information processing;*

*installing means (26a) for installing into the
storing means the money information processing
program downloaded from the electronic money server
(2),*

*wherein the installing means is adapted to send IC
chip identification information of the IC chip to
the electronic money server (2) and to install the
received registering ID information and secret
information including key information into said
storing means (29a),*

*wherein the money information processing program
enables the information processing means (28) to
perform a money-amount information receiving
function for receiving the secret information using
the secret information receiving means and
thereafter receiving from the electronic money*

server (2) or an electronic terminal device (8) changing information of the amount of money by using the secret information including key information installed in the storing means, and to perform a money information processing function for changing the amount of money of the money information stored in said money information storing means by using the received changing information of the amount of money,

further comprising:

display means for displaying registering ID information received by said receiving means and installed by the installing means;

wherein said money information processing program enables said information processing means to realize an ID sending function for sending, to the electronic terminal device (8) or the electronic money server (2), the registering ID information installed upon receiving the changing information of the amount of money from the electronic terminal device (8) or the electronic money server (2) by said money-amount information receiving function."

VII. Claim 1 of the first auxiliary request adds to the end of the first feature of the mobile terminal device the words *IC chip identification information being uniquely assigned to the IC chip.*

VIII. In claim 1 of the second auxiliary request the secret information in the fourth, eighth and ninth features of claim 1 of the main request is defined as *including*

registering ID information and the fifth feature of the ID information receiving means has been deleted.

IX. The appellant's arguments can be summarized as follows:

Admittance of requests into the proceedings

In the main request, filed as auxiliary request 2 with letter dated 20 April 2018, and auxiliary request 4, the feature "wherein said money information processing program enables said information processing means to realise an ID sending function for sending...the registering ID information installed upon receiving the changing information...by said money-amount information receiving function", which had formed part of claim 1 of the request considered by the examining division, had been deleted. According to the appellant, the scope of the invention is not substantially shifted by this deletion as the examining division had not taken the deleted feature into account in its decision. Other amendments to the set of claims were a direct response to the Board's communication.

As regards auxiliary request 5, it was made as a direct reaction to the Board's communication.

The appellant argued in favour of admitting new auxiliary request 3, which had been filed at the end of the oral proceedings before the Board, by emphasising that it was an immediate reaction to the objections raised by the Board.

New main and new auxiliary request 1: Article 56

It is an object of the present invention to provide a mobile terminal device in which information is easily

managed upon installation of a value processing function and in which the money function may be charged and a settlement may be performed in an easy manner.

The sending of the IC chip identification information to the electronic money server achieves an easy identification of a user account, a feature which is not known from the prior art D1.

D1 does not disclose a unique relationship between an electronic payment card (in the form of a mobile phone with an additional electronic money service function) and a terminal ID (in the form of an IC chip identification). Therefore an unambiguous identification of the electronic payment card in D1 is not possible.

D1 does not disclose the reception of changing information at the mobile terminal device from a electronic-money terminal. Instead the user of the mobile terminal device inputs the money values manually.

New auxiliary request 2 - Article 123(2)

The application as filed refers throughout to "secret information for security, such as key information". The use of the term "such as" implies that secret information may comprise further types of information such as registering ID information. Various parts of the application as filed refer to a simultaneous processing of the registering ID information and the key information. Assuming that both types of information are secret, the wording of claim 1 "secret information including registering ID information and

key information" is fully supported by the application as filed.

Reasons for the Decision

1. Background
 - 1.1 Figure 1 of the application shows a mobile phone 7 with an additional electronic money function unit 12 that serves as an electronic money card for payment in retail shops, trains and buses. The electronic money function, also called a *value processing function*, is transmitted to the mobile phone from an electronic money server 2, after unique identification of the mobile phone via its IC chip identification. Having installed the value processing function, the IC chip acts as value processing unit in wireless communication with an electronic money terminal 8, connected to the electronic money server 2, or via an Internet access function of the mobile phone with the electronic money server 2.
 - 1.2 The object of the invention is, according to page 6, lines 11 to 14, to provide a mobile terminal device in which information is easily managed upon installation of the electronic money function, and in which the money function may be charged and a settlement may be performed in an easy manner.
 - 1.3 The invention involves two independent processes: a (pre-)installation of a *value processing function* on the mobile phone, and a registration of a user at the electronic money server by using the *IC chip identification*, which is a prerequisite for using the electronic money service function, see Figure 14; page

39, line 17, to page 43, line 11.

- 1.4 During installation of the *value processing function* "key information" and an "electronic money ID" are stored on the mobile terminal device.

The "electronic money ID" or "registered/registering ID information" is issued by the install registration unit 57 of the server and sent to the mobile phone, after successful registration of a user, see page 41, lines 7 to 13, page 56, lines 16 to 21, and Figure 12, who sent via his mobile phone the IC chip identification to the install registering unit 57.

"Key information" on the other hand is said to identify the mobile terminal device to an electronic-money terminal, page 24, lines 13 to 25, which is understood, according to page 49, lines 4 to 16, to check whether the electronic money function unit 12 of the mobile phone is "regular". According to page 40, line 27, to page 41, line 13, "key information" is also sent to the mobile phone 7 by the install registering unit 57 of the electronic-money server 2 after successful registration of the mobile terminal device.

2. Admittance of requests

- 2.1 Under the provision of Article 12(2) RPBA the statement setting out the grounds of appeal shall contain a party's complete case. According to Articles 12(4) and 13(1) (3) RPBA, the Board has a discretion to disregard requests, facts and evidence filed with the statement setting out the grounds of appeal or thereafter.

- 2.2 It is worth noting that the admission of an amendment to a case remains at the Board's discretion under

Article 13(1) RPBA even if it has been submitted within the time period set in a communication under Article 15(1) RPBA, the purpose of which is generally to give guidance for the oral proceedings in order to focus on issues that the Board considers crucial for reaching its decision.

2.3 Auxiliary requests 2 and 4

Auxiliary requests 2 and 4 were filed with letter dated 20 April 2018. However, the amendment relevant for the decision whether or not to admit them into the proceedings was already present in auxiliary request 1 as filed with the statement setting out the grounds of appeal. Thus, Article 12(4) RPBA becomes relevant.

Auxiliary requests 2 and 4 are not admitted into the proceedings, because claim 1 in both requests has been broadened by deleting the feature *"wherein said money information processing program enables said information processing means to realise an ID sending function for sending ... the registering ID information installed upon receiving the changing information ... by said money-amount information receiving function"*. This broadening shifts the scope of the invention to subject-matter which has not been considered by the examining division. Any such attempt to amend the application could and should have been made during the examination proceedings. By broadening the scope of the claim considerably the appellant attempts to use the appeal proceedings as a continuation of the examination proceedings. This cannot be allowed as it contravenes the nature of the appeal proceedings, which focuses on the review of the decision taken by the department of first instance.

The appellant's argument that the deleted feature does not solve any problem and is not necessary to the invention is not convincing, because page 58, line 2, to page 60, line 1, explains that the "registering ID information", issued by the electronic-money server as "electronic money ID" is required as an identification of the user during the charging and settlement operation (which is referred to by the term "changing information" in the claim). That the examining division did not explicitly refer to the deleted feature in its decision does not alter this conclusion.

Furthermore, the deletion of "registering ID information" from the feature of receiving changing information alters the operation of the money information processing program in a way that contravenes Article 123(2) EPC. According to the original description, for instance, page 58, line 2, to page 60, line 1, the "registering ID information", called "electronic money ID" in the passage, is always required for value charging and settlement processing. The "key information" alone is not sufficient and it has also a different purpose which is to decide whether the electronic-money function is "regular".

2.4 Auxiliary request 5

Auxiliary request 5 was filed with letter dated 20 April 2018. Its admittance into the proceedings lies in the Board's discretion pursuant to Article 114(2) EPC and Article 13(1) RPBA. The criteria to be taken into account by the Board when exercising its discretion include the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. As is established case law of the Boards of Appeal, such procedural

economy implies that amended requests should at least be prima facie allowable to be admitted into the proceedings. Procedural economy also requires that amended requests are convergent in order to be admitted (see in this regard e.g. T 1685/07).

- 2.5 Auxiliary request 5, however, shifts the invention to a new technical problem which is "data encryption" in the communication between the mobile communication unit and the electronic money function unit of the mobile terminal device. Such a shift at this late stage in the proceedings can, in the Board's view, not be permitted.

The appellant argued that the request is in reaction to the communication, paragraph 7.4. It focuses on the two ways of exchanging information between the electronic-money terminal and the electronic-money function unit, as shown in Figure 1, namely via near field communication, and Internet. Claim 1 of this request now defines these two entities.

However, the Board cannot immediately see how this request overcomes the Article 56 EPC objection and does not admit the request into the proceedings.

- 2.6 New auxiliary request 3

New auxiliary request 3 was filed towards the end of the oral proceedings, after the Chairman had announced the Board's conclusions on the allowability of the new main request and the new auxiliary request 1. It was thus filed at a very late stage in the proceedings. The request shifts the invention to a new technical problem of having two separate units within the mobile terminal device, that is, an electronic-money function unit and

a phone function unit, which shifts the scope of protection.

The Board cannot immediately see how this request overcomes the Article 56 EPC objection and does not admit the request into the proceedings.

3. New main request - Article 56 EPC

3.1 D1 relates, as the invention does, to the provision of electronic money services involving a mobile user terminal (Figure 1: 100) communicating with a money server (service system 110), and is therefore considered as closest prior art.

3.2 The examining division considered the subject-matter of claim 1 to differ from D1 in that during installation of the *money information processing program* an IC chip identification is sent to the providing server instead of the user ID which is sent in the system of D1.

3.3 The Board agrees with the examining division that D1 includes a terminal ID (see paragraph [0818] and Figure 15) corresponding to the IC chip identification of the present application. Users need to be registered with the system in D1 and are stored as user data management information 4600, as shown in Figure 46, paragraphs [1320] to [1332], which registers for each user, a user ID, a terminal property and a payment card list. There is therefore a unique relationship between the terminal and the user.

The terminal property, as correctly observed by the examining division, is retrieved from an EEPROM of the mobile user terminal, see paragraphs [0818] and [1324], and is *inter alia* the model number or the serial number

of the mobile terminal device. The EEPROM of the mobile terminal can be replaced by a SIM card or a ferroelectric non-volatile memory, see paragraphs [2099] and [2103] to [2105]. This identification data is provided and employed during user registration and payment card registration (Figures 61 and 62; paragraphs [0639] to [0647]; Figure 65B; paragraphs [0648] to [0651]).

- 3.4 The appellant's argument that the IC chip identification of the present application achieves an easy identification of a user account is not convincing, because according to page 44, third paragraph, of the present application, the identification of a user, after registration, is not limited to the IC chip identification, but may as well be a password or an electronic money ID.

Furthermore, the charging of a money value or the settlement using a money value relies on the electronic money ID and the key information, according to page 57, line 11, to page 60, line 1, but not on the IC chip identification. Both, charging and settlement are not made in real-time: according to page 44, line 15, to page 46, line 23, transaction information is temporarily stored in the mobile phone 7 or in terminal 8; an update with the electronic money server appears to be made at a later stage.

- 3.5 The appellant's argument that there is a unique relationship between an electronic payment card (in the form of a mobile phone with an additional electronic money service function), and a terminal ID (in the form of an IC chip identification) is not convincing, because according to Figures 7 and 8 of the present application the user "YAMADA TARO", registered with a

single electronic money ID "12345678", is shown to have three different payment cards, registered as "547816", "347895" and "2547657".

3.6 The Board therefore considers that D1 discloses the use of an IC chip identification for the registration of a mobile terminal for a particular user, and therefore indirectly for the identification of a payment card, which corresponds to the money information processing program.

3.7 For the first time at the oral proceedings, the appellant argued that the above-mentioned object of the invention, namely to provide a mobile terminal device in which information is easily managed upon installing a value processing function and in which the electronic-money value may be charged and a settlement be performed in an easy manner, was achieved by a mobile terminal device which did not require user interaction during charging and settlement, in particular by means of the following features:

a) *"receiving from the electronic money server or an electronic terminal device changing information [emphasis added] of the amount of money by using the secret information including key information [emphasis added] installed in the storing means",*

b) *"to perform a money information processing function for changing the amount of money of the money information stored in said money information storing means by using the received changing information [emphasis added] of the amount of money",*

c) *"... to install the received registering ID information and secret information including key*

information [emphasis added] into said storing means",

d) "wherein said money information processing program enables said information processing means to realize an ID sending function for sending, to the electronic terminal device or the electronic money server, the registering ID information installed upon receiving the changing information [emphasis added] of the amount of money from the electronic terminal device or the electronic money server by said money-amount information receiving function."

The appellant contested that these features were known from D1, which allegedly always required user-interaction during charging and settlement.

- 3.8 Concerning the feature "secret information including key information" in differences a) and c), the Board notes that D1 employs "key information" for the identification of an installed and registered payment card at a merchant terminal in the form of a "certificate" which is issued to and received by the mobile terminal device after successful registration of the payment card, see D1, paragraph [0650]. Furthermore, the storage means of the mobile terminal device in D1 stores several types of information for a payment card, inter alia, card name and card ID information which may also be interpreted as "secret information including key information". This information is stored in the payment card list area 1713 of the mobile terminal device, paragraph [0872] and Figure 18, and in the available payment card list 2811 at a merchant terminal 103, paragraphs [1092] to [1093] and Figure 29, which refers to the payment cards a merchant can handle. Card name and card ID information have the same purpose as the feature

"secret information including key information" for during payment processing.

3.9 Concerning the feature "changing information" in differences a), b) and d), the appellant argued that this feature referred to a charging operation as well as to a settlement operation, page 58, line 2, to page 60, line 1. Contrary to the invention, the payment card settlement processing in D1, paragraphs [0660] to [0676] and Figure 68, the feature "changing information" is processed entirely at the mobile terminal device. Moreover, a user must enter information, such as the payment amount, at the mobile terminal device, whereas there is no such processing in the invention.

3.10 Firstly, the Board notes that the payment processing in D1 is not entirely processed at the mobile terminal device. In fact, it is the merchant who triggers the settlement operation by activating the payment card processing at the electronic money terminal, paragraph [0662], whereby the amount to be paid is displayed at the electronic money terminal.

Secondly, D1 discloses at paragraph [0666] and Figure 68: 6807 that the amount of money stored in the user terminal is changed as in alleged difference b).

Thirdly, although in the invention described in D1 the amount of money is entered by the user, D1 also discloses that automatic settlement processing, with no user-intervention was known in the art, see paragraphs [0008] to [0010]. The manual operation attempts to avoid a merchant cheating by charging a higher price than the authorized price, paragraph [0022].

The Board considers that the use of an automatic settlement processing to eliminate user or merchant interventions as in difference a) would have been an obvious alternative.

- 3.11 Concerning difference d), the appellant argued that the *registering ID information* corresponds to the *electronic money ID*, shown in Figure 8, page 44, sixth paragraph, and thus to the account number of the user.

The Board considers sending an ID - in whatever form - from the mobile terminal device to the electronic terminal device or to the electronic money server in alleged difference d) as having no further use other than the identification of the mobile terminal device. This point has been addressed in paragraphs 3.3 to 3.6 above.

- 3.12 Accordingly, the request is not allowable, because the subject-matter of claim 1 does not involve an inventive step (Article 56 EPC) over D1 in combination with common general knowledge.

4. New auxiliary request 1 - Article 56 EPC

- 4.1 Claim 1 of the new auxiliary request 1 is based on the main request with the additional feature "IC chip identification information being uniquely assigned to the IC chip".

- 4.2 The amendment does not alter the technical effect of an IC chip identification as a unique reference of a mobile phone, a feature which, as mentioned above, is known in D1, see paragraphs [0818] and [1324]. The EEPROM of the mobile terminal device, storing *inter alia* the model number or the serial number of the

mobile terminal device, can be replaced by a SIM card or a ferroelectric non-volatile memory, see paragraphs [2099] and [2103] to [2105]. This identification data is provided and employed during user registration and payment card registration (Figures 61 and 62; paragraphs [0639] to [0647]; Figure 65B; paragraphs [0648] to [0651]).

4.3 Accordingly, the request is not allowable, because the subject-matter of claim 1 does not involve an inventive step (Article 56 EPC) over D1 in combination with common general knowledge.

5. New auxiliary request 2 - Article 123(2) EPC

5.1 Claim 1 of the new auxiliary request 2 contains subject-matter extending beyond the content of the application as filed (Article 123(2) EPC).

5.2 The feature "secret information" is defined in claim 1 to include "registering ID information and key information" (emphasis added), whereas the original application, for instance, page 15, lines 1 to 10, page 41, third paragraph, bridging paragraph of page 56 to page 57, always refers to "key information" as a subset of the "secret information" which serves to check whether the installed electronic-money function is "regular". On the other hand, the term "registered ID information" is not disclosed in the application as filed as secret information, but refers to the feature "electronic-money ID", paragraph page 24, fourth paragraph, which serves to identify the user.

5.3 Accordingly, the request is not allowable, because it represents subject-matter extending beyond the content

of the application as filed contrary to Article 123(2)
EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



T. Buschek

W. Chandler

Decision electronically authenticated