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**Datasheet for the decision
of 23 November 2015**

Case Number: T 1983/14 - 3.5.01

Application Number: 05075144.5

Publication Number: 1560142

IPC: G06Q20/00

Language of the proceedings: EN

Title of invention:

Electronic point of sale apparatus for mobile telephone credit purchase and other products

Patent Proprietor:

January Patents Limited

Opponents:

Navarra Retail Systems Ltd.
An Post

Headword:

Purchase of mobile top-up/JANUARY PATENTS LTD.

Relevant legal provisions:

EPC 1973 Art. 87(1), 54(1), 54(2)
EPC Art. 123(2), 123(3)
EPC R. 115(2)
RPBA Art. 15(3)

Keyword:

Priority - basis in priority document (no) - validity of
priority date (no)

Novelty - public prior use (no)

Decisions cited:

G 0001/93, G 0002/98

Catchword:

Article 123(3) EPC prevents the removal, after grant, of a problematic, limiting feature. The problem described in G 1/93 was a violation of Article 123(2) EPC. In the present case, it is lack of novelty due to loss of priority. See point 5.3 of the reasons.



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent
Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89
2399-4465

Case Number: T 1983/14 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 23 November 2015

Appellant: January Patents Limited
(Patent Proprietor) CBE House,
IDA Business Park
Claremorris,
County Mayo (IE)

Representative: MacLachlan & Donaldson
2b Clonskeagh Square
Clonskeagh Road
Dublin 14 (IE)

Respondent 1: Navarra Retail Systems Ltd.
(Opponent 1) Unit 57, Parkwest Enterprise Centre, Lavery
Avenue, Parkwest
12 Dublin
Dublin (IE)

Respondent 2: An Post
(Opponent 2) General Post Office
O'Connell Street Lower
Dublin D1
Dublin (IE)

Representative: Moore, Barry
Hanna Moore + Curley
13 Lower Lad Lane
Dublin 2, D02 T668 (IE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 28 July 2014
revoking European patent No. 1560142 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman	W. Chandler
Members:	P. Scriven
	I. Beckedorf

Summary of Facts and Submissions

- I. This is an appeal by the patent proprietor (appellant) against the decision of the Opposition Division to revoke the European patent EP1560142.
- II. The Opposition Division considered that the subject-matter of claim 1 as granted was not entitled to the priority of the Irish patent application IEA S2004/0045 of 23 January 2004, because it was not possible directly and unambiguously to derive the feature
- "one software control module [...] operable to [...] invoice the purchase of the mobile telephone credit product and other products on the EPOS apparatus as one transaction"*
- from the priority document. As a consequence, the patent proprietor's own use of the invention during the priority period was prejudicial to novelty.
- III. In the statement setting out the grounds of appeal dated 5 December 2014, the appellant requested that the decision of the Opposition Division be set aside and that the patent be maintained as granted. Oral proceedings were requested unconditionally.
- IV. Respondent 1 (Opponent 1) did not reply to the statement of grounds.
- V. Respondent 2 (Opponent 2) requested, in the letter dated 6 March 2015, that the appeal be dismissed and that oral proceedings be held in the event that the Board did not agree with the conclusion that claim 1

lacked novelty.

- VI. In a communication pursuant to Article 15(1) RPBA, the Board set out the issues to be discussed at oral proceedings to be held on 23 November 2015. It appeared to the Board that the only contested issue was the validity of the priority claim. The Board tended to consider that the priority was not valid.
- VII. With letter dated 22 September 2015, the appellant filed first to fourth auxiliary requests.
- VIII. Oral proceedings before the board took place on 23 November. Respondent 1 was not represented.

The appellant requested that the decision under appeal be set aside and the patent be maintained as granted, or in amended form on the basis of one of the first to fourth auxiliary requests filed with letter dated 22 September 2015.

Respondent 2 requested that the appeal be dismissed.

For the course of the oral proceedings, reference is made to the minutes.

- IX. Claim 1 of the patent as granted (main request) reads:

"An electronic point of sale (EPOS) multi-task apparatus for the purchase of mobile telephone credit and other products in a retail environment, the other products being selected from the group comprising dry products, groceries, hospitality goods, fuel, cigarettes, fruit and vegetables; the apparatus being linkable to a main server over a network, the apparatus comprising a central processing unit and associated

memory, a user input device comprising a keyboard and a bar code scanning means, a printer, a releasable and lockable till drawer and an integrated chip and pin payment card reader, the apparatus having a plurality of software control modules for controlling separate ones of the multi task product purchase functions, with one software control module integrated into the EPOS multi-task apparatus and being operable to provide a product comprising a mobile telephone credit for a customer from one or more separate merchants, issue the mobile telephone credit product to the customer, invoice the purchase of the mobile telephone credit product and other products on the EPOS apparatus as one transaction, and print a customer receipt on the printer for the completed transaction, the software module (MPTSCM) for telephone credit comprises:

a top-up button or icon for mobile telephone credit;

means for displaying a list of available mobile telephone networks (1);

means for selecting a telephone network (2);

means for selecting a denomination for the selected telephone network (6, 9, 20, 24);

means for verifying the denomination selected (24);
and

means for adding the selected denomination to a customer's receipt (25); and

means for printing a "top-up voucher" having a unique identifier to enable a customer to input credit into their telephone account, the "top-up voucher" being printed on the printer with the customer receipt, whereby the completed transaction can be conducted by an operator through the EPOS apparatus."

- X. The first auxiliary request differs from the main request in that the wording *"one transaction"* in claim 1 is replaced by *"a completed transaction"*.
- XI. The second auxiliary request differs from the main request in that *"one transaction"* now reads *"one completed transaction"*.
- XII. Claim 1 of the third auxiliary request differs from the second auxiliary request by the addition of the text *"together on a customer's receipt and add the value of the mobile telephone credit to the total on the customer's receipt"* after *"one completed transaction"*, and by the replacement of *"and print a customer receipt"* by *"and print the customer's receipt"*.
- XIII. The fourth auxiliary request differs from the second auxiliary request by the addition of the text *"in which a "top up code" is printed onto a customer's receipt and the value of the "top up code" is added to the other products on the customer's receipt"* after *"one completed transaction"*, and by the replacement of *"and print a customer receipt"* by *"and print the customer's receipt"*.
- XIV. The appellant's arguments can be summarized as follows:

The patent was entitled to claim the priority of the Irish patent application, and, therefore, no prior use had been established. Consequently, the claims of the granted patent were novel.

The skilled person would consider the *"means for adding the value of the top-up to the total receipt"* as disclosed at page 4, lines 12-13 of the priority document to mean that the purchase of the mobile

telephone credit product and other products were invoiced as one transaction. There was only one payment transaction between the customer and the attendant, and the total receipt was the record of this transaction.

Furthermore, page 3, lines 3 to 4 of the priority document stated that dispensed fuel and dry retail products *"are capable of being invoiced together on the same EPOS apparatus"* and the passage bridging pages 7 and 8 stated that dry retail products and mobile phone top-ups are *"capable of being invoiced together"* on the same EPOS apparatus. Additionally, page 3, lines 15-16 of the priority document stated that any product available in the shop can be *"charged for together"* with a fuel purchase.

The skilled person would understand that the software modules in figures 1 to 5 were operable together, such that different products did not have to be invoiced separately in multiple transactions. This was exactly what the invention in the priority application sought to avoid, as discussed on page 2, lines 20 to 26.

XV. Respondent 2 argued that:

The skilled person, when reading the disclosure of the priority document, was given no direct and unambiguous teaching that a top-up of the mobile phone was invoiced in a single transaction with other products.

The first direct and unambiguous disclosure of this was in the material that was added to the European patent application at the times of filing, namely:

Page 2 paragraphs 1, 3 (partially), 4 and 5
Page 5 lines 15 (partially), 16 and 17

Page 9 paragraphs 1 and 2
Page 10 references to Figures 6-12 in lines 1 to 21
Page 14 in its entirety
Page 15 paragraphs 1 and 2
Figures 6-12.

The priority document described five separate software modules, each controlling a particular function. There was no disclosure of how these modules were integrated.

The passages cited by the appellant might, with the hindsight of the European patent application, be understood as hinting that the modules could be integrated, but this was not enough to establish priority. The case law of the Boards of Appeal required that there be direct and unambiguous disclosure.

The expressions "invoiced together" and "charged for together" on page 3 disclosed no more than that transactions could take place on the same machine. They did not disclose multiple products being invoiced as one transaction.

In the priority document, on page 11, lines 7 to 11, it was suggested that multiple transactions might appear on the same receipt. Thus, adding the top-up to the total receipt did not necessarily imply that there was only one transaction.

With regard to the auxiliary requests, if priority was lost due to a particular feature of a claim, that could not be remedied in opposition proceedings, because of the operation of Article 123(3) EPC.

Reasons for the Decision

1. *The invention*

1.1 The invention concerns an electronic point of sale (EPOS) apparatus capable of processing the purchase of mobile telephone credit ("top-up") and the purchase of other goods and services. The apparatus issues the "top-up" as a code printed on the customer's receipt ("top-up voucher" or "top-up code"), and invoices the purchase of the "top-up" and other products as one transaction.

2. *Non-attendance at the oral proceedings*

2.1 Despite having been duly summoned, respondent 1 did not appear at the oral proceedings before the Board. The Board continued the proceedings, in accordance with Rule 115(2) EPC and Article 15(3) RPBA.

3. *Priority*

3.1 The only contested issue is the validity of the priority, and, more precisely, whether the feature of claim 1 that the purchase of mobile top-up and other products are invoiced as "*one transaction*" is disclosed in the priority document.

3.2 At oral proceedings, both parties agreed that "*one transaction*" in claim 1 should be understood as a single payment transaction between a customer and a shop attendant. The appellant referred to Figure 12 of the patent as published, which shows a receipt for the

purchase of multiple items, including mobile top-up ("VODAFONE 20 EURS"), paid for in a single transaction of €27.17. The Board sees no reason to depart from this interpretation, since it is reasonable and within the scope of the claim.

- 3.3 Respondent 2 pointed out that the priority document did not explicitly mention that top-up of the mobile phone was invoiced in a single transaction with other products. Furthermore, the examples in figures 6 to 12, on which the appellant relied to explain the invention, were not present in the priority document. The Board agrees. However, explicit disclosure is not a requirement for establishing a right of priority in accordance with Article 87(1) EPC 1973. The test is whether the skilled person can derive the claimed subject-matter, directly and unambiguously, using common general knowledge, from the priority application as a whole (G 2/98, Headnote; OJ EPO 2001, 413).
- 3.4 The appellant indicated several passages in the priority document which, in its opinion, provided a basis for the "*one transaction*" feature in claim 1. Starting with the background of the invention on pages 1 and 2, the appellant argued that the whole point of the invention in the priority document was to avoid that products had to be invoiced separately, as multiple transactions.
- 3.5 The Board is not persuaded. The Board understands the priority document, in this introductory section, as proposing that the acts of topping-up and of payment for the topping up should not require two separate machines, but should rather both make use of only one physical EPOS apparatus, so that the attendant does not

have to move between different apparatuses (page 1, lines 13 to 25; page 2, lines 27 and 28).

- 3.6 In light of this aim, the passages on page 3, lines 3 and 4, and lines 15 and 16, could well be read as meaning that different products are invoiced on the same physical apparatus. The Board sees no implication as to the number of payment transactions.
- 3.7 The Board considers the most promising basis for "one transaction" to be the statement on page 4, lines 12 to 13 of the priority document:

"[a]lternatively, the top-up software control module has means for printing the top-up code onto a customers receipt and adding the value of the top-up to the total receipt".

Here, "adding [...] to the total receipt" could, indeed, refer to a running total, which is invoiced in one sum at the end. In other words, the statement on page 4 can be interpreted to cover the "one transaction" feature. That is, however, not enough. A basis must be direct and unambiguous. Thus, the question remains whether this statement is open to any other reasonable meaning.

- 3.8 In the Board's view, there is an ambiguity to be resolved. "[T]otal receipt" can be read as referring to the complete physical document provided to the customer, comprising the top-up code and the receipt of payment for the top-up. In other words, both the top-up code and the price paid for the top up are to be printed on the receipt. That is, indeed, an interpretation that accords with the statements on page 1 of the priority document (see point 3.5, above).

Thus, in the Board's opinion, there is no implication that the receipt is for other products than mobile top-up. Consequently, there is no direct and unambiguous implication that the purchase of other products is included in the same transaction.

- 3.9 For these reasons, the Board comes to the conclusion that the strict test of direct and unambiguous derivability, set out in G 2/98, is not satisfied. The subject-matter of claim 1 of the patent as granted is, therefore, not entitled to priority from IEA S2004/0045.

4. *Novelty*

- 4.1 Since the invention as defined in claim 1 of the patent as granted does not enjoy a right of priority, it is not novel in view of the admitted prior use (Article 54(1) and (2) EPC 1973).

5. *Auxiliary requests 1 to 4*

- 5.1 At oral proceedings, it was common ground that "a [...] *transaction*" in claim 1 according to the first auxiliary request implied that there was only one transaction. Thus, the first auxiliary request does not remedy the problem that led to the loss of priority in the main request.
- 5.2 The same holds for the second, third and fourth auxiliary requests. They all comprise the feature "*one transaction*" in claim 1.

5.3 The Board agrees with Respondent 2, that the problem with *"one transaction"* could not have been overcome by amendment. This is because Article 123(3) EPC prevents the removal, after grant, of a problematic, limiting feature. The problem described in G 1/93 was a violation of Article 123(2) EPC. In the present case, it is lack of novelty due to loss of priority.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



T. Buschek

W. Chandler

Decision electronically authenticated