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Datasheet for the decision
of 18 June 2020

Case Number: T 1990/15 - 3.5.05

Application Number: 04732017.1

Publication Number: 1623388

IPC: G07B15/00, G07F7/08

Language of the proceedings: EN

Title of invention:
VALUE HOLDING SYSTEM, VALUE HOLDING METHOD, VALUE HOLDING
PROGRAM, AND TRANSACTION SYSTEM

Applicant:
Panasonic Intellectual Property Corporation
of America

Headword:
Value holding apparatus/PANASONIC

Relevant legal provisions:
EPC Art. 123(2), 56

Keyword:
Added subject-matter - main request (yes)
Inventive step - (yes) - could-would approach

Case Number: T 1990/15 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 18 June 2020

Appellant: (Applicant)	Panasonic Intellectual Property Corporation of America 20000 Mariner Avenue, Suite 200 Torrance, CA 90503 (US)
Representative:	Grünecker Patent- und Rechtsanwälte PartG mbB Leopoldstraße 4 80802 München (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 7 July 2015 refusing European patent application No. 04732017.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair	A. Ritzka
Members:	E. Konak
	E. Mille

Summary of Facts and Submissions

I.   The appeal is against the decision of the examining
        division to refuse the application for lack of an
        inventive step (Article 56 EPC) of the then main
        request and then auxiliary requests 1 and 2 with regard
        to the following documents:

        D1: EP 0 950 968 A1
        D2: US 4 764 928
        D4: US 6 108 534
        D6: GB 2 328 310 A

II.   With its statement setting out the grounds of appeal,
        the appellant filed one new request to replace all
        requests on file. The appellant requested that the
        decision be set aside and that a patent be granted
        based on this request. It requested oral proceedings as
        an auxiliary measure.

III.   In its preliminary opinion issued in preparation for
        the oral proceedings, the board raised objections under
        Article 123(2) EPC. However, it informed the appellant
        that the claims seemed to meet the requirements of
        Article 56 EPC.

IV.   In reply to the summons to oral proceedings, the
        appellant filed a new main request and new auxiliary
        requests 1 to 4. It requested that the oral proceedings
        be cancelled if the board found either the main request
        or auxiliary request 1 to be allowable.

V.   Since the board found auxiliary request 1 to be
        allowable, it cancelled the scheduled oral proceedings
        and decided in writing.

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

        "A value holding apparatus (500) for holding value
        information comprising:

        an authentication unit (502) operable to authenticate a
        request apparatus (600);

        characterized by

        a receiving unit (501) operable to receive, from the
        request apparatus (600), an instruction to add or
        remove a value relating to a payment, the instruction
        including an identifier identifying the instruction and
        time information indicating a time relating to the
        instruction;

        a judging unit (505) operable to hold the identifier
        and time information included in an instruction
        previously received by the receiving unit (501), to
        judge whether or not the identifier included in an
        instruction currently received from the request
        apparatus (600) matches the identifier held by the
        judging unit (505), and to judge whether or not a
        difference between the time indicated by the time
        information included in the instruction currently
        received from the request apparatus (600) and a time
        indicated by the time information held by the judging
        unit (505) is within a predetermined range,

        a rejecting unit (505) operable to reject the
        instruction currently received from the request

apparatus (600) when the judging unit (505) judges that
the identifier included in the instruction currently
received from the request apparatus (600) matches the
identifier held by the judging unit (505) and the
difference between the time indicated by the time
information included in the instruction currently
received from the request apparatus (600) and the time
indicated by the time information held by the judging
unit (505) is within the predetermined range, and

a balance management unit (506) operable to add or
remove a value according to the instruction currently
received from the request apparatus (600) when the
judging unit (505) judges that the identifier included
in the instruction currently received from the request
apparatus (600) does not match the identifier held by
the judging unit (505) or when the difference between
the time information included in the instruction
currently received from the request apparatus (600) and
the time indicated by the time information held by the
judging unit (505) is not within the predetermined
range."

VII.   Claim 1 of auxiliary request 1 reads as follows (with
        text additions underlined and deletions struck through
        with respect to claim 1 of the main request):

        "A value holding apparatus (500) for holding value
        information comprising:

        an authentication unit (502) operable to authenticate a
        request apparatus (600);

        an encryption unit (503) operable to encrypt
        communication between the value holding apparatus and
        the request apparatus;

characterized by

a receiving unit (501) operable to receive, from the
request apparatus (600), an instruction to add or
remove a value relating to a payment, the instruction
including an identifier identifying the instruction and
time information indicating si time relating to the
instruction;

an information management unit ~~judging unit~~(505)
operable

    to hold the identifier and time information
    included in an instruction previously received by
    the receiving unit (501),

    to judge whether or not the identifier included in
    an instruction currently received from the request
    apparatus (600) matches the identifier held by the
    information management unit ~~judging unit~~ (505), ~~and~~

    to judge whether or not a difference between the
    time indicated by the time information included in
    the instruction currently received from the request
    apparatus (600) and a time indicated by the time
    information held by the information management unit
    ~~judging unit~~ (505) is within a predetermined range,
    and

    ~~a rejecting unit (505) operable~~ to reject the
    instruction currently received from the request
    apparatus (600) when the information management
    unit ~~judging unit~~ (505) judges that the identifier
    included in the instruction currently received from
    the request apparatus (600) matches the identifier

held by the <u>information management unit</u> ~~judging unit~~(505) and the difference between the time indicated by the time information included in the instruction currently received from the request apparatus (600) and the time indicated by the time information held by the <u>information management unit</u> ~~judging unit~~(505) is within the predetermined range, and

a balance management unit (506) operable to add or remove a value according to the instruction currently received from the request apparatus (600) when the <u>information management unit</u> ~~judging unit~~ (505) judges that the identifier included in the instruction currently received from the request apparatus (600) does not match the identifier held by the <u>information management unit</u> ~~judging unit~~ (505) or when the difference between the time indicated by the time information included in the instruction currently received from the request apparatus (600) and the time indicated by the time information held by the <u>information management unit</u> ~~judging unit~~ (505) is not within the predetermined range."

VIII.   The claims of auxiliary requests 2 to 4 are not relevant for the decision.

Reasons for the Decision

1.   Main request - Added subject-matter (Article 123(2) EPC)

1.1   Claim 1 of the main request is identical to claim 1 of the sole request filed with the statement setting out the grounds of appeal except that the reference signs

were amended to reflect those of the "second embodiment" disclosed on pages 39 to 42 of the description and in figures 8 to 11.

1.2   In its preliminary opinion issued in preparation for the oral proceeding, the board had raised, *inter alia,* the objection that although the passages cited in the appellant's statement setting out the ground of appeal suggested that the basis for claim 1 was the "second embodiment" (despite the use of reference signs of another, namely the "first embodiment"), this embodiment did not have two separate units, namely the "judging unit" and the "rejecting unit", but one sole unit called the "information management unit" for carrying out the functionality ascribed to the "judging unit" and the "rejecting unit" in claim 1.

1.3   The appellant argued in its letter of reply that the basis for the main request was not only the "second embodiment" but also claims 1, 3, 7 and 9 as originally filed. These claims used the terms "judging unit" and "rejecting unit". Therefore, it was not essential to define these two units as a single "information management unit".

1.4   However, as had been noted in the board's preliminary opinion, the application as filed was drafted in such a way that the only part of the description to support the claims as originally filed was an introductory section titled "Disclosure of the Invention". In particular, neither of the two embodiments in the detailed description ("first embodiment" and "second embodiment") supported the claims as originally filed. Combining features of an embodiment not supported by the claims as originally filed with the claims as

originally filed leads to subject-matter which extends
beyond the content of the application as filed.

1.5   Therefore, claim 1 of the main request does not meet
         the requirements of Article 123(2) EPC.

2.   Auxiliary request 1 - Added subject-matter (Article
         123(2) EPC)

2.1   In claim 1 of auxiliary request 1, the functionality of
         the "judging unit" and the "rejecting unit" of claim 1
         of the main request was amended, in line with the
         "second embodiment", to be performed by a single
         "information management unit" (505 in figure 9).

2.2   An additional unit of the "second embodiment", namely
         the "encryption unit" (503 in figure 9), was also added
         to the claimed apparatus.

2.3   Furthermore, dependent claim 4, which was not supported
         by the "second embodiment", was deleted and
         corresponding amendments were made in other claims
         whenever necessary.

2.4   Therefore, the board is satisfied that claim 1 of
         auxiliary request 1 meets the requirements of Article
         123(2) EPC.

3.   Auxiliary request 1 - Inventive step (Article 56 EPC)

3.1   The subject-matter of claim 1 of auxiliary request 1
         corresponds essentially to the subject-matter of claim
         1 of auxiliary request 2 on which the contested
         decision was based.

3.2 The reasoning of the contested decision for denying an inventive step to claim 1 of then auxiliary request 2 (sections B.2.2.1 and B.4.2.1 of the contested decision) can be summarised as follows.

D1 represents the closest prior art.

Claim 1 differs from the apparatus of D1 in that it defines specific criteria for checking the "validity" of a currently received payment instruction. It judges whether the identifier included in the currently received instruction matches the identifier of a previously received instruction, and whether the difference between the time information indicated in the currently received instruction and the time information in the previously received instruction is within a predetermined range.

The problem solved by claim 1 is how to avoid processing the same payment instruction twice.

Duplicate messages are a well-known problem in the art, and duplicate detection is a functionality routinely provided in message exchange systems, e.g. D2, D4 and D6.

The apparatus of D1 stores messages upon their receipt, and the stored messages have an identifier as well as time information. Thus, although D1 does not disclose matching identifiers and time information for duplicate detection, it provides the means to allow duplicate detection according to claim 1. Therefore, by applying a well-known approach to solve a well-known problem to the apparatus of D1, the skilled person would have arrived at claim 1.

3.3   The major flaw of this reasoning is that it entirely
        relies on speculation as to what the skilled person
        <u>could</u> have implemented on the basis of information
        available in the apparatus of D1 without convincingly
        demonstrating why the skilled person <u>would</u> have
        modified the apparatus of D1 in the claimed manner.
        This is especially striking given that the closest
        prior art itself does not address the problem of
        duplicate instruction detection and that all cited
        documents addressing this problem solve it based on an
        identifier alone. Thus, the combination of the closest
        prior art D1 with D2, D4 or D6 would not have led the
        skilled person to the solution in claim 1.

3.4   The contested decision argues that the statement in D2,
        column 1, lines 53 to 56, that "t*he identity code may
        be of any kind at all and may, for example, be part of
        the message itself*" would have prompted the skilled
        person to go through other fields of the message in D1
        to look for other suitable candidates that could be
        used for duplicate detection and would have led them to
        the use of time information. However, this statement
        suggests another field of the message may be
        substituted for the identifying code, not that another
        field should be used in addition to the identifying
        code, let alone that this additional field (time
        information in this case) should be regarded as
        matching even if it differs within a predetermined
        range.

3.5   Therefore, the reasons given in the contested decision
        to deny an inventive step in claim 1 are not
        convincing.

3.6   The distinguishing features of claim 1 of auxiliary
        request 1 provide at least an alternative solution to

the objective technical problem of detecting duplicate
instructions which is not rendered obvious by the prior
art available on file.

3.7   To conclude, the subject-matter of claim 1 of auxiliary
        request 1 meets the requirements of Article 56 EPC.

Order

For these reasons it is decided that:

1.   The decision under appeal is set aside.

2.   The case is remitted to the examining division with the
        order to grant a patent with claims 1 to 9 of auxiliary
        request 1 filed with the letter of 15 June 2020 and a
        description to be adapted.

The Registrar: The Chair:

A. Chavinier-Tomsic   A. Ritzka

Decision electronically authenticated