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**Datasheet for the decision
of 28 September 2020**

Case Number: T 2160/17 - 3.4.03

Application Number: 08252742.5

Publication Number: 2043064

IPC: G07F19/00

Language of the proceedings: EN

Title of invention:
Self-service terminal

Applicant:
NCR Corporation

Headword:

Relevant legal provisions:

EPC Art. 123(2)
EPC 1973 Art. 111(1)
RPBA 2020 Art. 11, 12(2)

Keyword:

Added subject matter - (no)
Remittal to the department of first instance - special reasons
for remitting the case - (yes)

Decisions cited:

Catchword:



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Case Number: T 2160/17 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 28 September 2020

Appellant: NCR Corporation
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Representative: Secerna LLP
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 30 June 2017
refusing European patent application No.
08252742.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Eliasson
Members: M. Papastefanou
C. Heath

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division refusing the European patent application No. 08 252 742.5 on the ground that the subject-matter of claim 1 of the sole request before it included subject matter going beyond the content of the application as originally filed (Article 123(2) EPC).
- II. The appellant (applicant) requested that the decision under appeal be set aside and that a patent be granted on the basis of the Main Request or the First Auxiliary Request, both requests filed with the statement of the grounds of appeal.
- III. Reference is made to the following document:
- D1: GB 2 381 111 A.
- IV. Claim 1 of the Main Request is worded as follows:
- A method of operating a self-service terminal (10), the self-service terminal (10) comprising*
- a plurality of customer interaction devices (18a-i),*
 - a control application (80) and*
 - a display (18i),*
- the control application (80) having a code issuing object (96);*
- the method comprising:*
- presenting, by the display (18i), fault information in the event one or more of the plurality of the customer interaction devices (18a-i) are not working correctly;*
 - performing, by an operator, a maintenance operation on the self-service terminal (10);*

- *receiving, by the control application (80), a notification that the maintenance operation has been performed on the self-service terminal (10);*
- *performing, by the control application, a compliance check on the self-service terminal (10) that the plurality of customer interaction devices (18a-i) are working correctly;*
- *generating, by the code issuing object (96), a completion code based upon the operations performed by the operator in the event that the compliance check is successful;*
- *issuing the completion code, by the code issuing object (96), to the operator by presenting the completion code on the display (18i) in the self-service terminal (10);*
- *transmitting, by the self-service terminal (10), the issued completion code to a remote management system (114);*
- *comparing, by the remote management system (114), the issued completion code transmitted from the self-service terminal (10) with an operator provided completion code, provided by the operator, and*
- *in the event of a match between the transmitted issued completion code and the operator provided completion code crediting the operator with a compliant maintenance operation;*

whereby the issued completion code is used as an access code to enable the operator to perform a maintenance operation at a next self-service terminal (110a-110n).

V. The wording of the claims of the First Auxiliary Request is not relevant for this decision.

VI. In a communication pursuant to Rule 100(2) EPC, the board presented its preliminary opinion, according to which the claims of the Main Request met the

requirements of Article 123(2) EPC and announced its intention to remit the case to the examining division for further prosecution.

- VII. In a communication dated 24 July 2020 the appellant informed the board that it agreed with the remittal.

Reasons for the Decision

1. The appeal is admissible.

2. The invention

The claimed invention relates to a method of operating a self-service terminal (ATM, vending machine, etc.) and, in particular, to the functions relating to performing maintenance on the self-service terminal.

- 2.1 When one or more of the customer interaction devices of a self-service terminal (e. g. display, keypad, receipt printer, etc. - see paragraphs [0032] to [0034] and Figure 2 of the application as published) do not work properly, relevant fault information is presented on the display of the terminal. An operator (a technician) then performs a maintenance operation on the terminal. The maintenance operation may be a repair of a malfunctioning device or periodic maintenance, replenishing of media (e. g. bank notes in an ATM, beverages in a vending machine, etc.).
- 2.2 When the maintenance operation is completed, a self-check (compliance check) is carried out on the terminal in order to verify that the customer interaction devices of the terminal work correctly.

If the test is successful, the terminal generates a completion code as a signal of a completed successful maintenance operation. The code is presented to the operator on the display of the self-service terminal. At the same time, the terminal transmits the code to a remote management system. The operator also provides the presented code to the remote management system, independently from the terminal, e. g. by email.

- 2.3 The remote management system compares the code received from the terminal and the one provided by the operator and if they match, it credits a completed compliant management operation to the specific operator.

The operator can use the issued completion code as an access code enabling them to perform a maintenance operation at another self-service terminal.

3. Main Request, added subject matter (Article 123(2) EPC)

- 3.1 The claims of the Main Request correspond to those of the sole request underlying the impugned decision with the only amendment that in the feature of claim 1 of the request underlying the decision "*performing, by the control application, a compliance check on the self-service terminal (10) that the plurality of customer interaction devices (18a-i) are operable*", the term "operable" has been replaced with the term "working correctly".

Basis for this amendment can be found in the passage on page 20, line 12 to page 21, line 2 of the originally filed application.

- 3.2 The examining division held that the last feature of claim 1 (*whereby the issued completion code is used as*

an access code to enable the operator to perform a maintenance operation at a next self-service terminal (110a-110n)) constituted an intermediate generalisation which did not comply with the requirements of Article 123(2) EPC.

3.3 Claim 1 as originally filed is worded as follows:

A method of operating a self-service terminal, the method comprising: receiving notification that a maintenance operation has been performed on the terminal; performing a compliance check on the terminal; and issuing a code in the event that the compliance check is successful.

Claim 10 as originally filed has the following wording:

A method according to claim 1, wherein the issued code is used as an access code to enable an operator to perform a maintenance operation at another self-service terminal.

3.4 The examining division, while acknowledging that the objected feature was disclosed in the originally filed claims, considered that with the addition of features related to the remote management system to claim 1, corresponding features relating to how the remote management system enabled access to an operator to perform maintenance at another self-service terminal using the code had to be added to the claim as well. These features were all functionally related to each other and adding some of them to the claim while omitting the rest resulted in an intermediate generalisation which had no basis in the application as originally filed (see point II of the impugned

decision).

- 3.5 The board does not share this opinion of the examining division.
- 3.5.1 Claim 1 defines a method comprising a series of steps. With respect to original claim 1, the method defined in claim 1 of the Main Request comprises the following additional steps:
- presenting a notification of a fault in the terminal
 - performing (by an operator) a maintenance operation on the terminal
 - generating a completion code (after notification of performance of the maintenance operation is received and compliance check is performed)
 - transmission of the issued code to a remote management system (after the code is issued to the operator)
 - comparing by the remote management system the received completion code with a code received from the operator and, if there is a match, crediting the operator with a compliant maintenance operation.
- 3.5.2 In the board's view, the role of the remote management system in the claimed method is limited to verifying that the operator has performed (completed) a compliant maintenance operation and to credit them accordingly.
- 3.5.3 It is true that the description explains how the remote management system operates in allowing the operator to access another terminal using the issued code (see page 4, line 20 to page 5, line 8 and page 23, line 28 to page 24, line 10 of the originally filed description).

- 3.5.4 The board considers, however, that the two operations (method steps) are unrelated from each other. There is no functional or structural relationship between the crediting of a compliant maintenance operation to the operator and the granting of access to another terminal using the issued code other than that they are both executed by the remote management system.

Neither the claim nor the description provide any details about this remote management system, which remains defined rather generically. Indeed, the only information provided in the application is that the remote management system *may perform centralized maintenance dispatch and management functions* (see page 3, lines 1 and 2 of the originally filed description).

In the board's view, the remote management system can be for example a computer, a server, a number of servers/computers or a computer network and the mere fact that the two defined method steps are carried out by such a system does not necessarily imply any functional or other relationship between them (see also *Case Law of the Boards of Appeal of the EPO*, 9th Edition, July 2019, II.E.1.9).

- 3.5.5 In the board's view, therefore, the fact that the remote management system has been introduced into claim 1 in relation to a specific method step does not require the introduction of corresponding features in relation to another, unrelated method step. The original claims 1 and 10 provide a general definition of the method, which, in the board's view, provides sufficient basis for the feature objected to in the impugned decision.

- 3.6 The board concludes, therefore, that claim 1 of the Main Request meets the requirements of Article 123(2) EPC.
4. Remittal
 - 4.1 Since claim 1 of the Main Request meets the requirements of Article 123(2) EPC, the sole ground of refusal is no longer pertinent.
 - 4.2 The decision under appeal does not address any other of the requirements of the EPC and EPC 1973, especially those under Article 52(1) EPC.
 - 4.2.1 The board noted that during the examination procedure, the examining division had raised objections for lack of inventive step with respect to D1 against the claims then on file. However, apart from a mere assertion of lack of inventive step in the division's communication of 25 April 2017 (see point 3) the last reasoned objection for lack of inventive step related to the claims filed on 9 June 2011 (see annex to the summons to the oral proceedings of 12 December 2016). The current version of the claims of the Main Request differs substantially from those claims.
 - 4.3 The board further notes that the appellant has not put forward any substantive arguments during appeal that relate to any patentability issues other than those related to Article 123(2) EPC.
 - 4.4 Against this background, after considering all the relevant circumstances of the case at hand, the board came to the conclusion that the issues relevant to patentability in the present case, including but not limited to the examination of novelty and inventive

step, could not be decided upon without undue burden.

- 4.5 Consequently, the board is convinced that there are special reasons within the meaning of Article 11, first sentence Rules of Procedure of the Boards of Appeal (RPBA 2020) of the European Patent Office, that apply and that it is therefore appropriate to remit the case to the examining division for further prosecution and examination of the other patentability requirements, in accordance with Article 111(1) EPC 1973.

In this way, the board will also be adhering to the principle that the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020)

- 4.6 Finally, the board took note of the fact that the substantive request of the appellant was the grant of the patent on the basis of the Main Request or the First Auxiliary Request on file and that oral proceedings were requested in case the Main Request were to be refused by the board (see page 1 of the statement of the grounds of appeal, third and fourth paragraphs).

The board, taking into account that it is still possible to arrive at a grant by way of a remittal to the first instance for further prosecution (i. e. the appellant's substantive request has not been refused), and, since the appellant explicitly agreed with the remittal of the case to the examining division (see appellant's letter of 24 July 2020), did not consider it appropriate or necessary to hold oral proceedings before issuing its decision.

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 for further prosecution on the basis of the Main Request.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Eliasson

Decision electronically authenticated