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**Datasheet for the decision  
of 8 August 2024**

**Case Number:** T 2316/18 - 3.5.01

**Application Number:** 15191240.9

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**IPC:** G06Q20/10, G07F19/00,  
G06Q30/02, G06Q30/06, G06Q40/00

**Language of the proceedings:** EN

**Title of invention:**  
DEVICE-TO-DEVICE CLAIM STAKING

**Applicant:**  
NCR Voyix Corporation

**Headword:**  
Use of a second ATM to complete a transaction if the first ATM fails/NCR

**Relevant legal provisions:**  
EPC Art. 56  
RPBA 2020 Art. 13(1), 13(2)

**Keyword:**  
Inventive step - using a second ATM to complete a transaction when the first ATM fails (no - no technical concept)  
Admittance - clarity objection raised by the Board (no - no exceptional circumstances)

**Decisions cited:**

G 0001/19, T 1670/07, T 2019/12, T 1408/18, T 0107/22



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Case Number: T 2316/18 - 3.5.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.01**  
**of 8 August 2024**

**Appellant:** NCR Voyix Corporation  
(Applicant) 864 Spring St. NW  
Atlanta, GA 30308-1007 (US)

**Representative:** Secerna LLP  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 17 April 2018  
refusing European patent application No.  
15191240.9 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** W. Chandler  
**Members:** R. Moser  
E. Mille

## **Summary of Facts and Submissions**

- I. This case concerns an appeal against the examining division's decision to refuse European patent application No. 15191240.9 on the grounds of non-compliance with Articles 84 and 123(2) EPC, as well as a lack of novelty under Article 54 EPC, in view of prior art documents D1 (US 2007/0145115 A1) or D2 (US 2007/0145114 A1).
- II. In the statement setting out the grounds of appeal, the appellant requested that the decision to refuse the application be set aside and that a patent be granted on the basis of the sole refused request.
- The appellant essentially argued that neither D1 nor D2 disclosed completing a transaction at an ATM different from the one where the transaction was initiated.
- III. In a communication under Rule 100(2) EPC, the Board set out its preliminary view of the case.
- The Board raised several clarity objections and tended to agree with the appellant that claim 1 was novel over the cited prior art. However, due to the broad scope of claim 1, the Board considered that the distinguishing features could be interpreted as business-related aspects, which could not form the basis for an inventive step.
- IV. In a response dated 28 July 2022, the appellant filed an amended set of claims to overcome the objections raised by the Board under Article 84 EPC.

- V. The Board scheduled oral proceedings for 2 November 2023.

In the communication accompanying the summons, the Board indicated it was inclined to admit the amended claims into the appeal proceedings. However, the Board remained of the opinion that the added features did not alter its assessment regarding the lack of an inventive step.

- VI. With letter of 30 March 2023, the appellant filed a first auxiliary request and submitted arguments for its admissibility. Further arguments in support of clarity and inventive step were submitted for both the main and the auxiliary request.

- VII. At the instigation of the Board the oral proceedings were rescheduled to 8 August 2024.

- VIII. Oral proceedings took place by videoconference on 8 August 2024.

The appellant's final requests were that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims of the main request filed with the letter dated 28 July 2022 or alternatively of the first auxiliary request submitted with the letter dated 30 March 2023 or a second auxiliary request submitted before the Board during the oral proceedings. At the end of the oral proceedings the Chairman announced the Board's decision.

- IX. Claim 1 of the main request reads as follows:

*A computer-implemented method (600) comprising:*

*monitoring a transaction initiated on an originating customer operated self-service terminal (111A) on a first channel (step 610);*

*claiming a resource of a second channel for processing at least a portion of the transaction on a different customer operated self-service terminal (111B) (step 620) selected based on resources that the portion of the transaction needs so that the transaction can be completed at the different customer operated self-service terminal (111B) using a resource that is either not present or not operational on the originating customer operated self-service terminal (111A);*  
*and*

*providing a teller terminal (116) in communication with the originating customer operated self-service terminal (111A) and with the different customer operated self-service terminal (111B);*

*the teller terminal (116) comprising a claim staking manager (117) operable to interact with a claim staking agent (112A) in the originating customer operated self-service terminal (111A) and with a claim staking agent (112B) in the different customer operated self-service terminal (111B);*

*the step of claiming further includes the teller terminal (116) being operable by a teller to perform operations on to claim the resource on demand and to route the portion of the transaction from the first channel to the second channel on demand (steps 621, 631).*

- X. In claim 1 of the first auxiliary request, the feature "the step of claiming further includes the teller

terminal (116) being operable by a teller to perform operations on to" is specified in more detail, namely as:

*the claim staking manager (117) notifying a transaction manager (115), the transaction manager (115) maintaining a listing of available customer operated self-service terminals, to ask the transaction manager (115) to identify the different customer operated self-service terminal (111B) having the resources necessary to complete the portion of the transaction initiated on the originating customer operated self-service terminal (111A); and*

*the claim staking manager (117) claim staking the resource on demand at the different customer operated self-service terminal (111B) through the claim staking agent (112B) and to route the portion of the transaction from the first channel to the second channel on demand (steps 621, 631) to complete the portion of the transaction initiated on the originating customer operated self-service terminal (111A);*

*the transaction manager (115) communicating with the claim staking agent (112B) in the different customer operated self-service terminal (111B) through a communication server (113) and instructing the claim staking agent (112B) in the different customer operated self-service terminal (111B) to give control to the teller via the claim staking manager (117) of the teller terminal (116).*

XI. Claim 1 of the second auxiliary request adds at the end of claim 1 of the first auxiliary request the following features:

*supplying credentialing information from the transaction manager (115) to the claim staking agent (112B).*

- XII. The appellant's arguments are dealt with in details in the reasons for the decision.

## **Reasons for the Decision**

### **Background**

1. The aim of the invention is to assist a customer operating a cash dispenser (ATM) conducting a transaction. If the ATM malfunctions and cannot complete the transaction, e.g. because the currency dispenser is empty or the printer is out of paper, a local or remote bank clerk ("teller") can take actions to assist the customer to complete the transaction at a different ATM - see paragraphs [0038] to [0042] of the published application.

### **Main request, inventive step (Article 56 EPC)**

2. The Board judges that claim 1 is not inventive over D2.

D2 discloses a system for assisting a customer to perform a transaction at a self-service terminal (SST) such as an ATM. The system includes a database for monitoring customer transactions and the operational state of each ATM (paragraphs [0025] to [0028]). This data is displayed to a teller on a graphical user interface as shown in Figure 8. For example, the teller can see whether the customer needs assistance, what type of assistance is needed, that receipt paper or cash is running low and the like (e.g. paragraphs



[0056] to [0062]). The database, in conjunction with software modules running on the teller terminal and each ATM, allows the teller to manage an ATM, such as completing a customer transaction at the ATM or instruct the ATM to send all information to the teller terminal for processing there (see paragraphs [0016], [0019], [0053] and [0063]).

3. D2 does not disclose to process or complete the transaction at a different ATM. For instance, it might be the case that the customer initiates a transaction at an ATM that has run out of paper or cash. According to D2, the teller, looking at the interface in Figure 8, would notice the problem and for example instruct the ATM to send all data for processing to the teller terminal or replenish the ATM. According to the invention, the teller can send (parts of) the transaction data to a second ATM that has the required resources, such as cash or paper. For instance, the teller can instruct the second ATM to print the receipt.
4. This difference boils down to the idea of using a second machine to complete a task if the first machine is malfunctioning.

The Board considers that it is a non-technical person, in this case a user (teller) interacting with the user interface as in Figure 8 of D2, who comes up with this idea. For example, the teller notices that ATM 1 has run out of paper and cannot print the receipt. However, ATM 2 has enough paper, so the teller wishes to print the receipt using ATM 2.

5. Following the Comvik approach, the user (teller) gives the skilled person the above-mentioned request (compare

to T 2019/12 - *Abgabe einer Order/Lacqua*, reasons, point 20). In doing so, the teller does not specify any particular technical means but merely expresses a desire to print a receipt at an ATM that has sufficient paper or instruct an ATM with enough cash to dispense it. The teller can formulate these requirements without needing to understand the technical workings of the ATMs or the teller terminal, such as the software, communication protocols, or potential security concerns. Likewise, the teller does not need to know how the user interface of the teller terminal technically receives transaction data or instructs the ATM to process it.

6. The Board judges that implementing these requirements is straightforward as it essentially involves programming software that enables the teller to perform the desired actions. In claim 1, this software is defined rather imposingly as "claim staking manager" on the teller terminal, interacting with a "claim staking agent" on the ATM. In light of the description, these terms refer to nothing more than software modules. The claimed implementation is therefore either unspecified or straightforward. The Board also does not recognise any effects beyond this implementation (see G 1/19, reasons, point 51).
7. The appellant argued that claim 1 differed from D2 by three features, all based on the same principle, namely the possibility to transfer a transaction from a first ATM to a second ATM. These were (see appellant's letter dated 30 March 2023, point 3 on page 2):

*(i) claiming a resource of a second channel for processing a transaction on a different customer operated self-service terminal selected based on*

*resources that the transaction needs so that the transaction can be completed at the different customer operated self-service terminal using a resource that is either not present or not operational on an originating customer operated self-service terminal*

*(ii) a teller terminal comprising a claim staking manager operable to interact with a claim staking agent in a self-service terminal*

*(iii) claiming a resource on demand or of routing a transaction from a first channel to a second channel on demand*

8. In the appellant's view, the Board in its assessment of inventive step had dismissed these distinguishing technical features. Following the problem-solution approach for mixed-type inventions set out in the Case Law of the Boards of Appeal, July 2022, I.D.9.2.3 and I.D.4.2, the correct technical problem was "in the event of a malfunction at a 1st self service terminal machine, how to enable an alternative functioning self service terminal machine to be identified based on functional resources and to implement a transaction at the alternative functioning self service terminal machine, as described in paragraphs 038 to 041" (*Ibid.*, point 3 on page 3).
  
9. As previously stated, the Board finds that the core idea of the invention - using a second ATM to complete a transaction when the first ATM lacks necessary resources, such as paper or cash - is not based on technical considerations. In line with the Comvik approach, this idea may thus appear in the formulation of the objective technical problem which, in this case, amounts to a statement of requirements or desired

functionality that any implementation must fulfil.

The implementation through unspecified software modules, such as a claim staking manager on the teller terminal interacting with a claim staking agent on the ATM, cannot serve as the basis for an inventive step.

The Board further notes that the fact that the teller is using a technical entity in the non-technical concept - specifically, the teller's wish to allow a customer to use a functioning ATM instead of a malfunctioning one for completing a transaction - does not make the concept itself technical.

10. The appellant further argued that the distinguishing features provided technical means to identify an alternative ATM (see *ibid.*, points 3 and 8: "to enable an alternative functioning self-service terminal machine to be identified based on functional resources").

This was supported by the system's operation, as illustrated in Figure 1 and described in paragraphs [0041] to [0043]. In particular, the sentence "The transaction manager 115 when notified by the teller through the claim staking manager ... may be asked to identify ATM 111 B as having the resources ... necessary to successfully conclude the transaction for the customer" suggested that the transaction manager identified the most suitable alternative ATM. This identification was achieved by the distinguishing technical features. The present case was therefore similar to T 1408/18 - *Online TAN-Verfahren/STAR FINANZ* (see Case Law of the Boards of Appeal, July 2022, I.D.9.2.7) where the Board found that using specific communication channels for executing a transaction went

beyond the understanding of the non-technical person.

11. The Board notes that the term "notified" in paragraph [0042] is ambiguous. It could imply that the teller requests the transaction manager to conclude the transaction at a specific ATM, such as one equipped with paper for printing a receipt (see paragraph [0045] and [0063]). This is similar to D2, where the teller, by viewing the user interface, "asks" the database which ATM has sufficient paper or is malfunctioning.

Moreover, the claim does not define specific communication channels or other technical means beyond generic software components for executing the teller's instructions (see paragraphs [0054] and [0071]). In line with the cited decision, the non-technical person simply expresses the desire to use a second ATM for assisting the customer in concluding a transaction. It is the lack of specific implementation details that leads the Board to conclude that claim 1 lacks an inventive step.

12. The appellant disagreed, arguing that even if the skilled person were motivated to extend the system of D2 to involve more than one ATM for processing a transaction, the technical implementation - specifically, instructing the transaction manager to identify the best alternative ATM - was neither disclosed in D2 nor obvious.

On the contrary, at the priority date of the application, there was a strong prejudice against transferring a transaction from one ATM to another (see paragraph [0047]). This idea represented a paradigm shift and, in itself, was patentable. The lack of detailed description on how to identify the most

appropriate alternative ATM should not be seen as detrimental to inventive step; rather, it was a matter of sufficiency of disclosure. In the appellant's view, however, automating such an identification process would have been straightforward for the skilled person.

13. The Board is not persuaded by these arguments. The means disclosed in D2, particularly the software on the ATM and the teller terminal interacting with the database to monitor transactions and the operational status of the ATMs, are sufficient to implement the non-technical concept underlying the invention. The Board finds no specific implementation challenges addressed by the claimed method. While practical difficulties may arise and require some ingenuity to resolve during implementation, neither the claim nor the description address such challenges or their solutions. As a result, these problems and their corresponding solutions are not part of the invention and cannot support an inventive step.

The Board also notes that even if a prejudice against the invention existed - such as the conservative nature of the financial industry - this would be a non-technical prejudice and, therefore, irrelevant in the assessment of inventive step (see T 1670/07 - *Shopping with mobile device/NOKIA*, reasons, point 16).

14. For the above reasons, claim 1 of the main request does not involve an inventive step (Article 56 EPC).

**Admittance of the first and second auxiliary requests,  
Article 13(1) and (2) RPBA**

15. The appellant argued that the first auxiliary request should be admitted into the appeal proceedings.

In the first place, the request was filed in response to the Board's clarity objection, raised for the first time in point 3 of the annex to the summons (see Case Law of the Boards of Appeal, July 2022, V.A.4). The Board's objection could not have been foreseen and thus it was the first opportunity to respond to it. Therefore, the filing of the first auxiliary request was justified and appropriate (*Ibid.*, III.B.2.4.4).

16. The amendments, specifically regarding the transaction manager and details on the interaction between the claim staking manager and claim staging agent, introduced a significant technical contribution that should not be overlooked by the Board. Failing to consider this would prevent the appellant from addressing the reasons for the dismissal of the appeal, thereby violating the right to be heard under Article 113 EPC.
17. Moreover, the Board had ample time to review the request, which was submitted seven months before the originally scheduled oral proceedings. The amendments did not introduce surprising new facts or complicate the case further. There was no abuse of procedure, nor any negative impact on procedural economy (*Ibid.*, III.C.6.3).
18. Finally, the appellant highlighted the intrinsic connection between clarity and the scope of protection. The amendment, prompted by the Board's clarity objection, resulted in a technical limitation and introduced three additional distinguishing features that had to be considered when assessing inventive step.

19. The Board judges that the appellant's arguments do not demonstrate exceptional circumstances as required by Article 13(2) RPBA.

Point 3 of the annex to the summons, which in the appellant's view raises a clarity objection, falls under the heading "Inventive step" and reads as follows:

*The amendments include method steps (e.g. 621 and 631 in Figure 6) and system features (e.g. 111A, 116 or 117 in Figure 1) and, although addressing the Board's objections, might introduce further clarity issues.*

*For example, the claim staking manager/agent of the teller/self-service terminal is not further used, e.g. for completing the transaction at a different self-service terminal as explained in paragraphs [0041] to [0044] of the published application. Consequently, the steps of claiming a resource and routing a portion of a transaction to the second channel must be interpreted broadly.*

20. The Board explicitly acknowledged that the amendments addressed its earlier clarity objections. Indeed, if the Board had concluded otherwise, it would not have been inclined to admit the main request into the appeal proceedings. The phrase "may introduce further clarity issues" was simply a precaution, indicating that the claim would also need to be reviewed for clarity if the objection regarding inventive step was overcome. This precaution is especially relevant as the claim is framed as a "method" claim, but effectively relates to a "use" claim.



21. The second paragraph of the above quotation refers to claim interpretation for assessing inventive step and does not represent a clarity objection. It cannot justify the introduction of additional limiting technical features. The appellant had ample opportunity to limit the claim in response to the objections raised during the first-instance proceedings. However, they did not amend the single broad request that the examining division had deemed prejudicial to novelty, even in the statement of grounds of appeal.
  
22. Under Article 13(2) RPBA, amendments to a party's appeal case after notification of a communication under Article 15(1) RPBA are, in principle, not taken into account. The Board is not obliged to assess such amendments before the oral proceedings and to issue a second communication. Therefore, even if a clarity objection had been raised in point 3 of the annex to the summons, the first opportunity for the Board to assess compliance with the EPC, particularly Article 84 EPC, would be at the oral proceedings. Submitting a claim request that includes a deficiency under Article 84 EPC, making it unallowable, does not justify filing further claim requests (see T 0107/22 - *Earphone user's activity states/SAMSUNG*, reasons, point 2).
  
23. In view of the above, the Board cannot identify any "exceptional circumstances" justifying the admittance of the first auxiliary request.  
  
As a result, the first auxiliary request was not admitted into the appeal proceedings (Article 13(2) RPBA).
  
24. During the oral proceedings, the appellant submitted a second auxiliary request, which builds on the first

auxiliary request and adds further limiting features.

In addition to introducing for the first time a new aspect related to security - specifically, "supplying credentialing information from the transaction manager (115) to the claim staking agent (112B)" - the justification for admitting this request must be even more stringent than for the first auxiliary request.

25. However, the appellant was unable to provide any new reasons why the features already present in the first auxiliary request should be admitted in the newly filed second auxiliary request. As the first auxiliary request was deemed inadmissible, it follows that the second auxiliary request is also inadmissible (Article 13(2) RPBA).

## Order

### **For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



T. Buschek

W. Chandler

Decision electronically authenticated