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**Datasheet for the decision
of 19 October 2012**

Case Number: T 1413/07 - 3.4.03

Application Number: 00930499.9

Publication Number: 1200926

IPC: G07F 19/00, G06K 5/00

Language of the proceedings: EN

Title of invention:
Cardless payment system

Applicant:
First USA Bank, N.A.

Headword:
-

Relevant legal provisions (EPC 1973):
EPC Art. 54, 56

Keyword:
"Novelty, inventive step (yes) - after amendment"

Decisions cited:
-

Catchword:
-



Case Number: T 1413/07 - 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 19 October 2012

Appellant: First USA Bank, N.A.
(Applicant) Three Christina Centre
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Representative: Ribeiro, James Michael
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 30 March 2007
refusing European patent application
No. 00930499.9 pursuant to Article 97(1)
EPC 1973.

Composition of the Board:

Chairman: P. Mühlens
Members: T. Häusser
R. Q. Bekkering

Summary of Facts and Submissions

I. The appeal concerns the decision of the examining division of 30 March 2007 to refuse European patent application No. 00 930 499 for lack of novelty (Article 54 EPC 1973) and lack of inventive step (Article 56 EPC 1973) in view of the following document:

D3: WO 98/37524 A1.

II. The appellant requested in writing that the decision under appeal be set aside and that a patent be granted in the following version:

- Claims 1-9 as filed with the letter dated 3 September 2012;
- Description pages 1, 2, 3, 4, and 7 as filed with the letter dated 4 October 2012, page 2a as filed with the letter dated 3 September 2012, and pages 5-6 as published;
- Drawings sheet 2/7 as filed with the letter dated 4 October 2012 and sheets 1/7 and 3/7 to 7/7 as published.

III. The wording of claim 1 of the sole request reads as follows (board's labelling):

"A method for completing a credit card transaction in which a user is not required to know a credit card number and is not required to have a credit card physically present during the credit card transaction, the method comprising the steps of:

- (i) assigning an alias to a credit card number, the credit card number also having an

- associated PIN;
- (ii) linking the alias with the credit card number and the PIN in a database;
- (iii) entering the alias and the PIN into a device upon initiation of a transaction without receipt of the credit card number;
- (iv) connecting the device to the database;
- (v) retrieving the credit card number from the database based on the alias;
- (vi) authenticating the transaction by retrieving the PIN in the database and comparing the retrieved PIN with the received PIN; and
- (vii) performing the transaction if authentication is successful."

IV. The appellant argued with respect to novelty and inventive step essentially as follows:

The subject-matter of claim 1 differed from the method disclosed in the closest state of the art D3 in comprising the steps of

- linking the alias with the credit card number and the PIN in a database; and
- entering the alias and the PIN into a device.

The problem addressed was to enable a transaction to be requested, authenticated and performed without requiring the client to be carrying any piece of equipment. The claimed solution was running counter to the teaching of D3 which required in all cases that the user must identify himself by means of a SIM card. Furthermore, linking the alias with the credit card number and the PIN in the same database provided a quick and seamless process.

Reasons for the Decision

1. Admissibility

The appeal is admissible.

2. Amendments

Claim 1 is based on original claim 1 and on the description as originally filed (page 3, lines 2-9).

Dependent claims 2 to 9 are based on original claim 2 and on the description as originally filed (page 1, lines 2-5 and 28-30; page 3, lines 2-15 and 24-28; page 4, lines 5-31).

The description has been brought into conformity with the amended claims without extending beyond the content of the application as filed.

Accordingly, the board is satisfied that the amendments comply with the requirements of Article 123(2) EPC.

3. Novelty

- 3.1 Document D3 discloses as its sixth embodiment (see page 23, line 25 - page 24, line 21; Figure 8) a method of transaction between a customer having a mobile device 1 and a salesperson having a terminal 2. The mobile device comprises a SIM card identifying the device in a mobile telecommunications network 5 and the terminal is connected to a telecommunications network 6. Both networks 5 and 6 are connected to a financial server 4'.

The salesperson enters the amount A to be paid and the customer's mobile telephone number into the terminal 2. These data together with the terminal identification POSID are sent via the network 6 to the financial server 4'. The financial server 4' is able to identify the customer and the customer account 41 from the mobile telephone number; furthermore, from the terminal identification the account to be credited 420, 420', 420'' can also be deduced. The financial server 4' sends a message containing the amount to be paid to the mobile device 1. The transaction is executed and the customer's account 41 is charged when the customer sends a confirmation message containing his identification to the financial server 4'.

It is also envisaged in document D3 that, instead of charging the customer's account 41, payment may also be effected by use of a credit card (page 17, second paragraph).

- 3.2 In the terms of claim 1 document D3 discloses a method for completing a credit card transaction (D3, page 17, second paragraph) in which a user is not required to know a credit card number and is not required to have a credit card physically present during the credit card transaction, the method comprising the steps of:
- (i)' assigning an alias (mobile telephone number) to a credit card number;
 - (ii)' linking the alias with the credit card number in a database (association between the mobile telephone number and the credit card number in the financial server 4');
 - (iii)' entering the alias into a device upon

initiation of a transaction without receipt of the credit card number (entering the mobile telephone number into the terminal 2);

- (iv) connecting the device to the database (connection of the terminal 2 with the financial server 4' via the network 6);
- (v) retrieving the credit card number from the database based on the alias (retrieval in the financial server 4' of the credit card number by use of the mobile telephone number); and
- (vii) performing the transaction if authentication is successful (execution of the transaction when the confirmation message of the customer is received)."

3.3 In relation to its sixth embodiment document D3 does not disclose the following features of claim 1:

- (i)'' the credit card number also having an associated PIN;
- (ii)'' linking the alias with the PIN in the database;
- (iii)'' entering the PIN into the device upon initiation of a transaction without receipt of the credit card number;
- (vi) authenticating the transaction by retrieving the PIN in the database and comparing the retrieved PIN with the received PIN.

The other embodiments of D3 are not closer to the subject-matter of claim 1 than the sixth embodiment. The subject-matter of claim 1 is therefore new over document D3.

3.4 The remaining state of the art documents on file are not closer to the subject-matter of claim 1 than document D3. Claims 2 to 9 are dependent on claim 1 providing further limitations of the method according to claim 1.

Accordingly, the subject-matter of claims 1 to 9 is new (Article 52(1) EPC and Article 54(1) EPC 1973).

4. Inventive step

4.1 Closest state of the art

In the decision under appeal the examining division regarded document D3 as the closest state of the art. This was not contested by the appellant. The sixth embodiment of D3 involves the use of an alias - the mobile telephone number - in order to eliminate the need for the physical presence of the credit card during the financial transaction. That corresponds to the way in which the claimed subject-matter achieves the object of the invention mentioned in the application, namely to enable a cardholder to use his card without having the card present at the time of purchase (see page 2, first paragraph of the description). The sixth embodiment is therefore structurally most similar to the claimed subject-matter and is regarded to represent the closest state of the art.

4.2 Objective technical problem

4.2.1 In the appealed decision it was considered that entering a PIN was a common equivalent to the measure of receiving and confirming an SMS. The examining division was thus apparently of the opinion that the technical problem consisted in providing an alternative solution to a known problem.

On the other hand, according to the appellant the problem addressed by the invention was to enable a transaction to be requested, authenticated and performed without requiring the customer to be carrying any special equipment.

4.2.2 The features of claim 1 which are not disclosed in document D3 in relation to the sixth embodiment are those relating to a PIN, namely features (i)', (ii)', (iii)', and (vi) mentioned above under point 3.3. The use of a PIN ensures that the method is secure. Furthermore, these features allow the customer to dispense with the mobile telephone since the alias and the PIN are entered into the same device. Instead of carrying the mobile telephone, the customer merely needs to remember the alias and the PIN. This is more convenient.

4.2.3 As mentioned above, the object of the invention mentioned in the application has already been achieved by the method according to the closest state of the art. Furthermore, in view of the above effects of the differing features, the technical problem cannot be regarded to be merely to provide an alternative

solution to a known problem. Such a formulation would not be ambitious enough.

It is therefore appropriate in the present case to reformulate the objective technical problem. The formulation of the appellant contains pointers to the solution in that it is specified that the customer should not carry any special equipment. This is to be avoided.

The objective technical problem is therefore regarded to be how to implement the method in a way which is more convenient to use but still secure.

4.3 Obviousness

4.3.1 In the decision under appeal the examining division held that the fifth embodiment of D3 disclosed the use of a PIN as a security measure, so that the skilled person would choose using the PIN in an analogous situation.

4.3.2 In the fifth embodiment of document D3 (see page 22, line 18 - page 23, line 24; Figure 7) the same components as in the sixth embodiment are used, namely the mobile device 1, the terminal 2, the financial server 4', and the networks 5 and 6. In order to initiate the transaction, the salesperson enters the amount A to be paid into the terminal 2. The amount A and the terminal identification POSID are sent via the network 6 to the financial server 4'. Furthermore, the customer sends to the financial server 4' - using his mobile device 1 - a message containing the amount A and the POSID, which had been communicated to him by the

salesperson. The message automatically contains the customer identification and preferably also a required PIN. From the information transmitted from the customer and the salesperson the financial server 4' is able to identify the customer, the customer account 41, and the account to be credited 420, 420', 420''. The financial server 4' compares the amount A and the POSID received from the terminal 2 with the corresponding data received from the mobile device 1. In case of agreement the transaction is executed by the financial server 4'.

4.3.3 Therefore, in the fifth embodiment the customer still has to carry his mobile telephone. In addition he has to remember the PIN. The fifth embodiment is therefore not more convenient for the customer than the sixth embodiment. The skilled person would therefore not consider the fifth embodiment when attempting to implement the method of the sixth embodiment in a way which is more convenient to use but still secure.

4.3.4 Furthermore, the fifth embodiment involves entering the PIN into the mobile device 1. Even if the skilled person were to consider incorporating the teaching of the fifth embodiment into the sixth embodiment he would therefore be led to have the PIN entered (by the customer) into the mobile device 1, e.g. as part of the confirmation message sent from the mobile device 1 to the financial server 4'. The PIN would thus not be entered into the same device as the alias, which is entered into the terminal 2 (by the salesperson). However, it follows from the wording of claim 1 (see point III., feature (iii)), which has been amended during the appeal proceedings, that the alias and the PIN are entered into the same device (to be performed

by the customer). Therefore, the combination of the teachings of the fifth and sixth embodiments of D3 would not lead the skilled person to the claimed subject-matter.

4.3.5 Accordingly, the subject-matter of claim 1 involves an inventive step over document D3.

4.3.6 None of the other documents of the state of the art on file contains a teaching that would lead the skilled person in an obvious way to the subject-matter of claim 1. Claims 2 to 9 are dependent on claim 1 providing further limitations of the method of claim 1.

The board is therefore satisfied that the subject-matter of claims 1 to 9 involves an inventive step under Article 56 EPC 1973.

5. Other requirements of the EPC and conclusion

In order to comply with the requirements of Article 84 EPC 1973 and Rule 27(1)(b) EPC 1973, the description has been brought into conformity with the amended claims and supplemented with an indication of the relevant content of the state of the art.

In view of the above the sole request is allowable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the order to grant a patent in the following version:
 - Claims 1-9 as filed with the letter dated 3 September 2012;
 - Description pages 1, 2, 3, 4, and 7 as filed with the letter dated 4 October 2012, page 2a as filed with the letter dated 3 September 2012, and pages 5-6 as published;
 - Drawings sheet 2/7 as filed with the letter dated 4 October 2012 and sheets 1/7 and 3/7 to 7/7 as published.

The Registrar:

The Chairman:

S. Sánchez Chiquero

P. Mühlens