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

DECISION
of Technical Board of Appeal 3.5.05
of 18 June 2020

Appellant: Panasonic Intellectual Property Corporation of America
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Representative: Grünecker Patent- und Rechtsanwälte PartG mbB
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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 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 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 the 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 information management unit 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 information management unit 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 information management unit 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 information management unit 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 information management unit 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 could have implemented on the basis of information available in the apparatus of D1 without convincingly demonstrating why the skilled person would 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 "the 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