

Citation: Financial Consulting & Trading International, Inc (Re), 2021 CACP 7  
Commissioner's Decision #1560  
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TOPIC: F-00 Novelty  
F-01 Anticipation  
O-00 Obviousness

SUJET: F-00 Nouveauté  
F-01 Antériorité  
O-00 Évidence

Application No. : 2623647  
Demande n° 2623647

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2623647, having been rejected under subsection 30(3) of the *Patent Rules* (SOR/96-423) as they read immediately before October 30, 2019, has subsequently been reviewed in accordance with paragraph 199(3)(c) of the *Patent Rules* (SOR/2019-251). The recommendation of the Patent Appeal Board and the decision of the Commissioner are to refuse the application.

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## **INTRODUCTION**

- [1] This recommendation concerns the review of rejected patent application number 2623647, which is entitled “Multiple financial institution automated teller machine apparatus, system and method for using same” and is owned by Financial Consulting & Trading International, Inc. The outstanding defects indicated by the Final Action (FA) are that the claims encompass previously disclosed subject matter, contrary to paragraph 28.2(1)(b) of the *Patent Act*, and define obvious subject matter, contrary to paragraph 28.3(b) of the *Patent Act*. The Patent Appeal Board (the Board) has reviewed the rejected application pursuant to paragraph 199(3)(c) of the *Patent Rules* (SOR/2019–251). As explained below, our recommendation is to refuse the application.

## **BACKGROUND**

### **The application**

- [2] Canadian patent application 2623647, based on a previously filed Patent Cooperation Treaty application, is considered to have a filing date of September 20, 2006 and has been open to public inspection since March 29, 2007.
- [3] The invention relates to automated teller machines (ATMs), particularly ATM systems permitting customers to transact business with multiple financial institutions using each financial institution’s display interface and branding.

### **Prosecution history**

- [4] On October 2, 2017, an FA was issued pursuant to subsection 30(4) of the *Patent Rules* (SOR/96–423) as they read immediately before October 30, 2019 (the former *Rules*). The FA indicated the application to be defective on two grounds: claims 1 to 16 (i.e. all claims on file) do not comply with paragraphs 28.2(1)(b) or 28.3(b) of the *Patent Act*.
- [5] In its April 3, 2018 response to the FA (RFA), the Applicant submitted arguments for allowance, but the Examiner was not persuaded to withdraw the rejection. Therefore, pursuant to subsection 30(6) of the former *Rules*, the application was forwarded to the Board for review on behalf of the Commissioner of Patents. On August 7, 2018, the

Board forwarded to the Applicant a copy of the Examiner's Summary of Reasons along with a letter acknowledging the rejection.

- [6] A Panel was formed to review the application; following our preliminary review, we sent a letter on August 11, 2020 presenting our analysis and rationale; that analysis and rationale included a purposive construction of the claims.
- [7] *Choueifaty v Canada (AG)* 2020 FC 837 [*Choueifaty*] issued on August 21, 2020, prompting a review of Patent Office practice, and the subsequent issuance of "Patentable subject matter under the *Patent Act*" (CIPO, November 2020) [*PN2020-04*]. One of the areas of practice addressed by *PN2020-04* is purposive construction; another is computer-implemented inventions. Therefore, the panel conducted a supplemental review, taking into consideration the guidance of *Choueifaty* and *PN2020-04*.
- [8] Following our supplemental review, we sent a letter on January 29, 2021 (the SR letter) explaining why, based on the record before us, we considered the subject matter of the claims to comply with paragraph 28.2(1)(b) but not paragraph 28.3(b) of the *Patent Act*. The SR letter also invited the Applicant to make submissions in response to the letter, and to participate in a hearing. We did not receive any response from the Applicant.
- [9] Accordingly, we undertook our final review based on the written record. As nothing has changed in the record since the mailing of the SR letter, we have maintained the rationale provided in that letter.

## **ISSUES**

- [10] This review addresses the issues of whether the claims define subject matter that:
- was previously disclosed, contravening paragraph 28.2(1)(b) of the *Patent Act*; and
  - would have been obvious, contravening paragraph 28.3(b) of the *Patent Act*.

## **LEGAL PRINCIPLES AND PATENT OFFICE PRACTICE**

### **Purposive construction**

- [11] Patent claims are interpreted according to the modern method of interpretation, requiring consideration of text, context and purpose, although the entire method is typically

referred to as “purposive construction” when applied to patent claims (*Free World Trust v Électro Santé Inc*, 2000 SCC 66 [*Free World Trust*]; *Whirlpool Corp v Camco Inc*, 2000 SCC 67 [*Whirlpool*]; see also *Bauer Hockey Ltd v Sport Maska Inc (CCM Hockey)*, 2020 FC 624 at paras 47–50 [*Bauer Hockey*]). The whole of the disclosure, including the specification and drawings, is considered when purposively construing a claim (*Whirlpool* at paras 49(f), 49(g), 52; see also *Bauer Hockey* at paras 54–59). In addition to interpreting the meaning of the terms of a claim, purposive construction distinguishes the essential elements of the claim from the non-essential elements. Whether or not an element is essential depends both on the intent expressed in or inferred from the claim, and on whether it would have been obvious to the skilled person that a variant has a material effect upon the way the invention works (*Free World Trust* at paras 55, 57, 59; see also *Bauer Hockey* at paras 52, 72).

- [12] *PN2020–04* also discusses the application of these principles, pointing out that all elements set out in a claim are presumed essential unless it is established otherwise or such presumption is contrary to the claim language.
- [13] Since the purposive construction of a claim takes into account what the skilled person would understand to be the nature of the invention, it is necessary to identify the skilled person and their relevant common general knowledge (CGK) (*Bauer Hockey* at paras 60–62).

## **Novelty**

- [14] Subsection 28.2(1) of the *Patent Act* requires claimed subject matter to be new:

The subject-matter defined by a claim in an application for a patent in Canada (the “pending application”) must not have been disclosed

- (a) before the one-year period immediately preceding the filing date or, if the claim date is before that period, before the claim date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant, in such a manner that the subject-matter became available to the public in Canada or elsewhere;
- (b) before the claim date by a person not mentioned in paragraph (a) in such a manner that the subject-matter became available to the public in Canada or elsewhere;

...

[15] In *Apotex Inc v Sanofi–Synthelabo Canada Inc*, 2008 SCC 61 [*Sanofi*] at paras 25–29, 49, the Supreme Court of Canada concluded that the issue of whether an invention is anticipated by the prior art requires that the Court have regard to two questions:

- Was the subject matter of the invention disclosed to the public by a single disclosure?
- If there has been such a disclosure, is the working of the invention enabled by that disclosure?

### **Obviousness**

[16] Section 28.3 of the *Patent Act* requires claimed subject matter to not be obvious:

The subject-matter defined by a claim in an application for a patent in Canada must be subject-matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to

(a) information disclosed more than one year before the filing date by the Applicant, or by a person who obtained knowledge, directly or indirectly, from the Applicant in such a manner that the information became available to the public in Canada or elsewhere; and

(b) information disclosed before the claim date by a person not mentioned in paragraph (a) in such a manner that the information became available to the public in Canada or elsewhere.

[17] In *Sanofi* at para 67, the Supreme Court of Canada stated that it is useful in an obviousness inquiry to use the following four-step approach:

- (1) (a) Identify the notional “person skilled in the art”;
- (b) Identify the relevant CGK of that person;
- (2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
- (3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

## ANALYSIS

### Purposive construction

[18] The SR letter indicated the following reference—which had been cited in the FA—to be relevant to the determination of the CGK; it had been cited in the FA:

- D1: US 6539361                      March 25, 2003                      Richards et al.

#### *The skilled person*

[19] The SR letter characterized the notional skilled person as a team comprising one or more banking professionals, as well as programmers and other technologists experienced with developing and providing the software, tools and infrastructure conventionally used in the operations of an ATM.

#### *The CGK*

[20] Based on the above identification of the skilled person, and on what the present application (paragraphs 3 to 9, 25, 27, 28 and 50; figure 1) and D1 (columns 1 to 3) describe as generally known or conventionally done in the field, the SR letter identified the CGK as including:

- the conventional uses of ATMs for customers and their conventional purposes for financial institutions, including:
  - the provision of promotional content and the charging of fees in different scenarios;
- the conventional functions and structures of ATMs, including:
  - the exchange of commands and data between an ATM and a financial institution;
  - the use of communication and security protocols to authenticate account users' access;
  - the presentation of screens, interfaces, branding and advertisements specific to the affiliated financial institution; and



- the enablement of customers to carry out transactions with financial institutions other than the one affiliated with the ATM; and
- the design, implementation, operation and maintenance of computer systems, networks and software, including:
  - the querying, updating, storing and retrieving of information in databases; and
  - computer network and internet technologies and protocols.

*The essential elements*

- [21] The application (paragraphs 5 to 7) states that ATMs are typically affiliated with only one financial institution, and if a customer of a second financial institution uses an ATM, they are exposed to the branding and features provided by the first institution, not the second. In addition, the second institution typically charges a further fee for transactions made via non-affiliated ATMs, partly to help offset any potential loss in market share due to their customer's exposure to the first institution's branding and ATM functions, partly to offset interchange and switching fees. The first institution may also levy a surcharge.
- [22] The application (paragraphs 9 to 12) proposes to allow customers to access the display screens of their own financial institution regardless of which institution is affiliated with the ATM. This is to be achieved by storing a database within the ATM with "protocols" for multiple financial institutions. A protocol controls the display screens provided to facilitate a financial transaction, to deliver promotional material, etc. The ATM uses the customer's card to identify the customer's financial institution, and then retrieves and employs the appropriate set of display screens.
- [23] Independent claims 1 and 9 are directed to ATMs and independent claims 10, 12 and 14 are directed to methods of performing transactions. Claims 12 and 14 recite methods of operation for ATMs, but claim 10 does not limit its scope to the involvement of an ATM. Claim 14 also refers to the execution of transactions in response to a user's commands, and the charging of a fee to a financial institution. All of the claims involve means for identifying a user device, a locally stored database with more than one protocol, and the selection of a protocol based on the identification. Claim 1 is provided below as a representative.

Claim 1. An automated teller machine comprising:

means for identifying a user device;

means for identifying a financial institution associated with the user device;

a database storing locally on the automated teller machine at least a first financial institution's protocol comprising first display interface components for facilitating a banking transaction with the first financial institution and a second financial institution's protocol comprising second display interface components for facilitating a banking transaction with the second financial institution; and

a controller operably coupled to the database, the user device identifying means, and the financial institution identifying means, the controller programmed to

(1) upon determining that the user device is associated with the first financial institution, retrieve the first display interface components from the local database, build a first display screen associated with the first financial institution, and execute the first financial institution's protocol, or

(2) upon determining that the user device is associated with the second financial institution, retrieve the second display interface components from the local database, build a second display screen associated with the second financial institution, and execute the second financial institution's protocol;

wherein the first financial institution's protocol comprises a first set of promotional components specifically associated with the first financial institution and wherein the second financial institution's protocol comprises a second set of promotional components specifically associated with the second financial institution.

[24] Generally speaking, within the context of this application, a "protocol" is the set of content to be provided to a user, and governs the interchange with the user by presenting certain screens and outputs, as well as specific input options, to the user. According to the description (paragraphs 29 to 31, 33, 35 to 37, 39, 45 and 46), a protocol generally comprises display interfaces and promotional content. The display interfaces comprise the graphic, text, video and audio content experienced by a user carrying out transactions, and the promotional content comprises further such content, intended for advertising, messaging, etc.

[25] As stated in the SR letter, we consider all the claimed elements as though they are essential.

## Novelty

- [26] It was submitted in the FA that claims 1 to 16 are anticipated by D1. The Applicant disagreed, submitting in the RFA that D1 does not disclose the local storage of multiple protocols for multiple financial institutions, where a protocol includes promotional content and is the same as the “protocols” of the claims.
- [27] D1 (abstract; columns 5, 7 and 8; figure 2) discloses an ATM with means for identifying a user device and associated financial institution (i.e. means for reading the customer’s card, and identifying the customer’s account and associated financial institution) and a controller (i.e. a device interface software portion) operably coupled to the various devices of the ATM and programmed to control them in response to a set of instructions. D1 (columns 5, 17, 18 and 23) discloses that each set of instructions (which take the form of HTML documents and JAVA scripts) is associated with a financial institution and is capable of providing display interface components for facilitating a banking transaction and presenting content of other intellectual significance (e.g. promotional content). In this regard, the sets of instructions disclosed in D1 are the same as the “protocols” of claim 1. D1, however, envisions these protocols as being accessed from remote host servers, not as being locally stored in a database in the ATM. D1 (columns 18, 19, 26 and 29) does disclose the local storage of applets and configuration data, even embodiments where some HTML documents are stored locally in case they cannot be downloaded from remote servers quickly enough, but does not explicitly disclose the claimed configuration of essential elements. That is, D1 does not disclose that the ATM locally stores a database of multiple protocols, and that upon identifying the customer’s account and financial institution, the associated protocol is selected and executed to facilitate banking transactions and provide content of certain intellectual significance to the customer.
- [28] As explained in the SR letter, since D1 does not disclose this specific configuration, there is no need to determine what of the working of the invention has been enabled by D1. Given that all the independent claims include this configuration of elements among their essential elements, our view is that the subject matter of the claims is not anticipated by D1, and that these claims comply with paragraph 28.2(1)(b) of the *Patent Act*.

## **Obviousness**

*Identify the notional person skilled in the art and the relevant CGK*

[29] As noted in the SR letter, we consider the above identifications of the notional skilled person and relevant CGK to be applicable for the purpose of assessing obviousness.

*Identify the inventive concept of the claim in question or if that cannot readily be done, construe it*

[30] When we construed claim 1 above, we treated all the claimed elements as essential; we do so here as well for the purpose of assessing obviousness.

*Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed*

[31] The FA submitted that since there was no difference between the claims and the disclosure of D1 (in light of its reasoning concerning anticipation), the claims are obvious. The RFA objected to this submission on the grounds that the previous requisition had not discussed any obviousness defect and that the FA effectively relied upon its anticipation analysis without providing a further obviousness analysis.

[32] We noted in the SR letter that where there is no difference between a claimed invention and a prior art disclosure (as the FA had considered to be the situation for this application), there can be no difference requiring any degree of invention.

[33] In any case, as explained above, we have identified a difference between the essential elements of the claims and the disclosure of D1. D1 does not disclose that the ATM locally stores a database of multiple protocols, where upon identifying the customer’s account and financial institution, the associated protocol is selected and executed to facilitate banking transactions and provide content of certain intellectual significance to the customer. In the disclosure of D1, these sets of instructions are accessed from remote host servers.

*Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention*

- [34] As stated above, D1 envisions these protocols as being accessed from remote host servers, not as being locally stored in a database in the ATM. As explained in the SR letter, however, our view is that it would be obvious to store the multiple protocols within a local database of the ATM.
- [35] D1 (columns 18, 19 and 29) discloses the local storage of configuration data and applets. D1 (column 26) also discusses the potential issue of a slow or interrupted network connection and proposes possible solutions, including alternatively accessing a locally stored file in such a scenario. Faced with the potential for an unreliable network connection, and knowing the necessity of the protocols for providing the appropriate display interfaces and promotional content, the skilled person would be motivated to seek a solution. An obvious solution—and one within their CGK to implement—would be to store any needed protocols locally at the ATM.
- [36] Although claim 1 also recites some other details pertaining to the intellectual significance of the information involved (e.g. some of the protocol's content is promotional content specifically associated with the relevant financial institution), such details have not been discussed because the meaning and appearance of the information presented by the ATM do not affect the functioning or operation of the physical ATM itself. The application suggests no specific technical adaptations necessary to store, communicate or display such promotional content as opposed to any other content. In any case, the provision of advertising and other promotional content from different sources is among the conventional operations of an ATM, as discussed above, and in D1 (columns 16 to 17).
- [37] As explained in the SR letter, our opinion is that this reasoning also applies to the remaining claims, which have similar sets of essential elements to that of claim 1.
- [38] Although claim 2 additionally refers to a display module, claim 8 specifies that the user device is associated with an account, claim 13 refers to the retrieving of the appropriate content from the database and claim 14 refers to the execution of transactions in response to the user's commands, these features are considered to be inherently part of the essential elements of the ATM of claim 1. Furthermore, these details are also disclosed by D1.

- [39] Claims 3 to 7, 11 and 16 recite further details concerning the meaning and appearance of a given protocol's content accessed in response to the result of the identification steps. As explained above, however, these details do not patentably distinguish the functioning of the physical ATM from the prior art.
- [40] Claims 15 and 16 also refer to the charging, or the non-charging of fees in certain scenarios. As discussed above, the charging of fees (by any of the institutions involved with the ATM or the transaction) in different scenarios is among the conventional operations of an ATM. The choice of conditions in which a fee would or would not be charged would be directed by business motivations rather than inventive ingenuity on the part of the skilled worker, and in the case of these claims, is part of the CGK. Accordingly, these details do not patentably distinguish the claimed inventions from the prior art.

*Conclusion on obviousness*

- [41] As explained in the SR letter, we consider that the subject matter of the claims would have been obvious to the skilled person in view of D1 and the CGK. Therefore, these claims do not comply with paragraph 28.3(b) of the *Patent Act*.

## **RECOMMENDATION OF THE BOARD**

[42] In view of the above, we recommend that the application be refused on the basis that claims 1 to 16 define obvious subject matter, and thus do not comply with paragraph 28.3(b) of the *Patent Act*.

Leigh Matheson

Liang Ji

Blair Kendall

Member

Member

Member

## **DECISION OF THE COMMISSIONER**

[43] I concur with the findings of the Board and its recommendation to refuse the application on the basis that claims 1 to 16 do not comply with paragraph 28.3(b) of the *Patent Act*.

[44] Accordingly, I refuse to grant a patent for this application. Under section 41 of the *Patent Act*, the Applicant has six months to appeal my decision to the Federal Court of Canada.

Virginie Ethier

Assistant Commissioner of Patents

Dated at Gatineau, Quebec

this 17<sup>th</sup> day of March, 2021