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D E C I S I O N
of 28 October 2005

Case Number: T 0844/03 - 3.4.03

Application Number: 92107643.6

Publication Number: 0512509

IPC: G07F 9/02

Language of the proceedings: EN

Title of invention:

Method and apparatus for selective distribution of discount coupons

Patentee:

Catalina Marketing International, Inc.

Opponent:

INFOMIL

Headword:

Discount coupons/CATALINA

Relevant legal provisions:

EPC Art. 123(2)(3), 100(c)
RPBA ART. 10b

Keyword:

"Added subject-matter (yes)"
"Extended scope of protection (yes)"
"Admissibility of belatedly filed claims (no)"

Decisions cited:

-

Catchword:

-



Case Number: T 0844/03 - 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 28 October 2005

Appellant: Catalina Marketing International, Inc.
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Respondent: INFOMIL
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Representative: Cabinet BARRE LAFORGUE & associés
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 5 June 2003
revoking European patent No. 0512509 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: R. G. O'Connell
Members: E. Wolff
T. Bokor

Summary of Facts and Submissions

I. This is an appeal against the revocation of European patent 0 512 509 on the ground of added subject matter (Article 100(c) EPC). Proposed amended claims were found to extend the protection conferred (Article 123(3) EPC) and to lack inventive step (Article 56 EPC) respectively.

II. Together with the statement setting out the grounds of appeal, the appellant proprietor submitted a new main request and first and second auxiliary requests.

Claim 1 of the main request reads as follows:

"1. A system for generating a printable discount coupon in a retail store, the system including:

one or more terminals (12) at customer check-out locations, each having means for reading (13) product codes on purchased items in a customer order;

a store controller (10) with which the one or more terminals (12) can communicate, the store controller having access to an item record file (14) containing price and other information for each product item;

means for storing (24) the terms and conditions of discount coupon deals for which a customer may qualify while in the store;

means for identifying triggering products in the customer order by accessing said item record file (14);
and

means (28) for printing the discount coupon for immediate distribution to the customer while the customer is still at one of the checkout locations, characterised by

the means for storing (24) further storing terms for redeeming a discount coupon associated with a discount coupon deal and conditions for offering the discount coupon deal including the item or items or product category to which the discount deal applies, the effective dates of the discount, and whether a triggering item has been purchased by said customer in a specified prior time period;

means for uniquely identifying each customer at one of said checkout locations by using a customer identifier unique to said customer comprising either a scanner for reading said identifier, or a scanner for reading a customer fingerprint or other unique identifier associated with a customer whereby customers may participate without taking any special action other than making normal purchase selections and being identified;

customer purchase file means (22) for storing data pertaining to the triggering products identified in the customer's purchases each time the customer visits the store and is uniquely identified, the stored triggering purchase data being for use in determining whether a discount coupon deal should be effective;

means (20) for automatically generating data defining a discount coupon if conditions of a discount deal have been met by the uniquely identified customer, said conditions including determining whether a triggering product currently purchased by the customer was previously purchased in said specified prior time period prior to the present time of purchase by said customer."

Claim 1 of the first auxiliary request adds at the end of the second paragraph of the characterising portion the following clause:

"and regardless of whether or not the customer presents a special identification card;".

Claim 1 of the second auxiliary request replaces this same paragraph as follows:

"means for uniquely identifying each customer at one of said checkout locations regardless of whether or not the customer presents an identification card issued by a retailer, said means comprising (1) a scanner for reading an identification code unique to said customer, or (2) a scanner for reading a customer fingerprint, or (3) a machine for reading a driver's licence, whereby customers may participate without taking any special action other than making normal purchase selections and being identified;".

III. A third auxiliary request faxed by the appellant was received at the EPO at 07:39 hours shortly before commencement of oral proceedings held before the board on 28 October 2005. This claim request was not admitted into the proceedings (point 2.8 below).

IV. During the oral proceedings, the appellant submitted a fourth auxiliary request, in which the characterising portion of claim 1 was replaced as follows:

"the means for storing (24) further storing terms for redeeming a discount coupon associated with a discount coupon deal and conditions for offering the discount coupon deal including the item or items or product category to which the discount deal applies, the effective dates of the discount, and whether a triggering item has been purchased by said customer in a specified prior time period;

means for uniquely identifying each customer at one of said checkout locations **regardless of whether the customer presents an identification card issued by a retailer, said means comprising (1) a scanner for reading an identification code unique to said customer, or (2) a scanner for reading a customer fingerprint or (3) a machine for reading a driver's licence**, whereby customers may participate without taking any special action other than making normal purchase selections and being identified;

customer purchase file means (22) for storing data pertaining to the triggering products identified in the customer's purchases each time the customer visits the store and is uniquely identified, the stored triggering

purchase data being for use in determining whether **present and future discount coupon deals** should be effective;

means (20) is provided being operable each time the uniquely identified customer completes a purchase transaction in the store, for automatically generating data defining the printable discount coupon but only if preselected conditions of a discount coupon deal pertaining to past and present purchases as stored in said customer purchase file means (22) have been met by the purchase activity of the uniquely identified customer whose order is being processed, as determined at the time of the purchase transaction by accessing said data pertaining to the triggering products in said customer purchaser file means".

V. The appellant proprietor requests that the decision under appeal be set aside and that the patent be maintained on the basis of:

- claims I to 20, filed as main request with letter of 29 September 2003, or alternatively

- claims I to 20, filed as first auxiliary request with letter of 29 September 2003, or alternatively

- claims 1 to 20, filed as second auxiliary request with letter of 29 September 2003, or alternatively

- claims 1 to 20, filed as third auxiliary request with fax of 27 October 2005 received 28 October 2005, or alternatively

- claims 1 to 3, filed as fourth auxiliary request during oral proceedings.

VI. The respondent opponent requested that the appeal be dismissed and that he be awarded his costs in relation to the oral proceedings. He argued essentially as follows:

The appellant proprietor's requests all contained significant modifications compared to the patent as granted. Claims 1 of the main request and the first and second auxiliary requests contravened the provisions of Article 123 EPC, Article 100(c) EPC, Article 83 EPC and Article 100(b) EPC. The third auxiliary request had not been filed in due time and hence should not be admitted into the proceedings. The fourth auxiliary request, too, should be considered not to have been filed in due time and, in any event, it did not satisfy the generally accepted criterion that requests filed at a late stage in the proceedings must *prima facie* overcome all outstanding objections.

In support of his request for apportionment of costs pursuant to Article 104 EPC the respondent opponent pointed out that the appellant proprietor had requested oral proceedings at a late stage of the proceedings after having received a response to the statement of grounds of appeal. The claims filed in support of the appeal were not an appropriate response to the grounds of the opposition. The request for oral proceedings by the appellant proprietor was rather a move to protract the procedure in order to benefit from a potential protection at least while the opposition procedure was still pending.

VII. The appellant proprietor argued essentially that the subject matter of the contested amendments was derivable directly and unambiguously for the person skilled in the art from the implicit disclosure of the application as filed when read as a whole.

The appellant proprietor requested that that the request for apportionment of costs be rejected. He contended that it was clear from previous submissions that oral proceedings were at least implicitly requested; the late explicit request was a mere confirmation of these earlier requests. The request for oral proceedings was fully equitable even in the given circumstances.

Reasons for the Decision

1. The appeal is admissible.
2. *Article 123(2) and (3) EPC*

The main request

- 2.1 Claim 1 of the main request omits the qualifying clause "*regardless of whether or not the customer presents a special identification card*" found in claim 1 as granted after "*means (13) for uniquely identifying each customer*" (granted patent, claim 1, column 13, lines 9 to 11).

The respondent argued that the opposition division was correct in its finding that the presence of this clause

implied that any arrangements in which presenting an identification card would be obligatory were excluded from the extent of protection. Since absent this clause such mandatory arrangements are not excluded, the board agrees that its omission from claim 1 of the main request contravenes Article 123(3) EPC.

- 2.2 As granted, claim 1 requires also that the means (20) for automatically generating data defining the printable discount coupons each time the uniquely identified customer completes a purchase transaction, take account of whether "*preselected conditions of a discount coupon deal pertaining to past and/or present purchases ... have been met*" (granted patent, claim 1, column 13, lines 34 to 39). This wording implies that decisions on whether the preselected conditions are met may be based on past purchases, on present purchases, or on a combination of both.

According to the description, a customer purchase file is maintained in which data relating to past purchases by the customer are stored. The decision whether a coupon should be issued is then based either on data relating to past purchases on their own or in combination with the current purchase. There is no basis in the application as filed for deciding upon issuing coupons solely on account of present purchases, that is to say, without at the same time taking into account past purchases. Hence, as submitted by the respondent opponent and in agreement with the conclusion of the opposition division on this point, the board sees the expression "*past and/or present purchases*" as introducing information that goes beyond

the content of the application as filed, contrary to the provisions of Article 123(2) EPC.

2.3 Claim 1 of the main request further introduces the requirement that the discount coupon is printed for immediate distribution to the customer "*while the customer is still at one of the checkout locations*". The respondent opponent has submitted that there is no basis in the application as filed for amending the claim to include this feature. Nor has the appellant proprietor pointed to anything in the application as filed which could refute this contention. Hence the board concludes that this amendment is prohibited by Article 123(2) EPC.

2.4 Claim 1 also specifies that "the means for uniquely identifying each customer" may comprise "a scanner for reading a customer finger print or other unique identifier associated with a customer". Additionally, "customer participation requires no special action other than the customer making purchase selections and being identified".

The respondent opponent submitted that the disclosure in the application as filed merely required each customer to be identifiable in some way. As particular examples were mentioned identification cards issued by retailers which may contain a unique identifying number associated with the customer in a form which can be easily read out at the checkout, machine-readable driver's licences, bank cards or even finger print scanning. The application as filed offered no basis for this new generalisation that the identifying means may comprise "a scanner for reading a customer fingerprint

or other unique identifier". In the judgement of the board, these amendments add subject matter and are accordingly prohibited by Article 123(2) EPC.

- 2.5 The respondent opponent also contended that the application as filed contained no equivalent to the step in the last paragraph of claim 1 of "determining whether a triggering product currently purchased by the customer was previously purchased in said specified prior time period prior to the present time of purchase by the customer". The board has not been persuaded otherwise by the appellant proprietor and therefore also judges this to be an amendment prohibited by Article 123(2) EPC.

The first auxiliary request

- 2.6 Although amended to overcome the objection referred to at point 2.1 above, claim 1 of the first auxiliary request fails to address the objections raised against claim 1 of the main request at points 2.2, 2.3, 2.4 and 2.5 above.

The second auxiliary request

- 2.7 According to claim 1 of the second auxiliary request, the means for uniquely identifying each customer include a scanner for reading a driver's licence instead of an "other unique identifier". However, the features objected to in respect of the main request at points 2.3 and 2.5 above are still present.

The third auxiliary request

2.8 Pursuant to Article 10b of the Rules of Procedure of the Boards of Appeal (RPBA) 2003 and the objections raised by the respondent opponent with reference to these rules and having regard to issues of permissibility of the amendments included in the third auxiliary claims request, the board exercised its discretion to refuse to admit these belatedly submitted claims into the proceedings.

The fourth auxiliary request

2.9 In order to allow the appellant to respond to the arguments put forward by the respondent, the board decided to give the appellant one last opportunity to submit a further claim request. However, claim 1 of the fourth auxiliary request includes formulations which are to be found neither in the application as filed nor in the claims as granted. Neither the respondent opponent nor the board could be expected at such a late stage in oral proceedings to compare such new phraseology with that previously used in order to determine the permissibility of the amendments under Article 123 EPC. A criterion used by the boards of appeal in exercising their discretion to admit belated claim requests is that of *prima facie* allowability. Claims whose amendments fail to meet even a threshold of *prima facie* permissibility under Article 123 EPC must fail the former test *a fortiori*; the fourth auxiliary request is accordingly not admitted into the proceedings.

3. For the foregoing reasons, in the board's judgement, none of the appellant's claim requests fully complies

with all the requirements that are set out in Article 123(2) and (3) EPC in respect of amendments.

4. *Costs*

The board sees no reason to award costs to the respondent opponent. The appellant proprietor has done no more than exercise his right to oral proceedings pursuant to Article 116(1) EPC.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for apportionment of costs is refused.

Registrar:

Chair:

S. Sánchez Chiquero

R. G. O'Connell