BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS	BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE	CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Datasheet for the decision
of 16 April 2009

Case Number: T 1027/06 - 3.5.01

Application Number: 01304126.4

Publication Number: 1158437

IPC: G06F 17/60

Language of the proceedings: EN

Title of invention:
Method and system for electronically selecting, modifying, and operating a motivation or recognition program

Applicant:
Maritz Inc.

Headword:
Reward programs / MARITZ

Relevant legal provisions:
EPC Art. 52(1)

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

Keyword:
"Inventive step (no)"

Decisions cited:
T 0154/04

Catchword:
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Boards of Appeal

Chambres de recours

Case Number: T 1027/06 **-** 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 16 April 2009

Appellant:	Maritz Inc. 1375 North Highway Drive Fenton, MO 63099 (US)
Representative:	Gill, David Alan W.P. Thompson & Co. 55 Drury Lane GB-London WC2B 5SQ (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted 8 December 2005 refusing European patent application No. 01304126.4 pursuant to Article 97(1) EPC 1973.**

Composition of the Board:

Chairman:	S. Steinbrener
Members:	R. R. K. Zimmermann
	G. Weiss

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Summary of Facts and Submissions

I.   European patent application number 01 304 126.4
        (publication number EP-A-1 158 437) claimed priority
        from 2000 and 2001 for a method and system for
        electronically selecting, modifying, and operating a
        motivation or recognition program.

II.   The application was refused by the examining division
        in oral proceedings held on 4 November 2005. According
        to the reasons of the decision given in writing by
        letter posted on 8 December 2005, the claimed invention
        was essentially an obvious computer implementation of a
        business model and did thus not meet the requirements
        of inventive step. The implementation did not involve
        more than standard network and web technologies, normal
        multitasking and multithreading methods for the
        concurrent execution of programs, and the use of
        conventional client-server architectures. As examples
        for such standard architectures, the examining division
        cited prior art documents WO-A-96/29668 (D1) and
        US-A-5 970 475 (D2).

III.   The appellant (applicant) lodged an appeal against the
        decision on 7 February 2006. On 12 April 2006, the
        appellant filed a statement setting out the grounds of
        appeal, including two sets of amended claims headed
        MAIN REQUEST and AUXILIARY REQUEST, respectively.

IV.   Together with summons to oral proceedings requested by
        the appellant as an auxiliary measure, the Board issued
        a preliminary opinion that expressed doubts about the
        patentability of the claimed invention on grounds of
        inventive step. The Board cited document D3:

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Ali Arsanjani, "Service Provider: A Domain Pattern and its Business Framework Implementation", Proceedings of Pattern Languages of Programs (PLoP'99), Monticello, Illinois, USA, August 15-18, 1999, pages 1 to 24 as an example of the prior art in the development and implementation of business applications and the services provided to customers in respect to the modification and customisation of such business applications.

V.   By letter dated 12 March 2009, the appellant filed a further set of amended claims headed AUXILIARY REQUEST 2.

VI.   At the oral proceedings held on 16 April 2009, the Board discussed the matter with the appellant. After deliberation, the Board announced its decision on the appeal.

       The appellant requested at the oral proceedings that the decision under appeal be aside and a patent be granted on the basis of claims 1 to 35 according to the main request or the first auxiliary request, both requests filed with letter dated 13 April 2006 or alternatively on the basis of claims 1 to 11 filed with letter dated 12 March 2009.

       The respective claims 1 of these requests have the following wording:

       Main request:
           "1. A supplier-provided method for allowing multiple customers of the supplier to each create an individual, modified motivation or recognition program

having participants, each program permitting the participants to earn awards on the basis of the participants' performance, each said program of a particular customer operating according to preferences selected by the particular customer, said method comprising the steps of:

allowing each customer to electronically access via a customer processor (104) a browsable catalog (110) of predefined programs stored in a supplier storage device (112);

allowing each customer to electronically select (202) via the customer processor one of the predefined programs stored in the supplier storage device;

allowing each customer to electronically modify (202) via the customer processor at least one component of the selected predefined program stored in the supplier storage device, wherein the modification of a component includes at least one of the following: selecting a rules structure, defining a program duration, selecting an award type, defining the number of participants, determining the value of an award, and modifying a communications campaign theme and components;

allowing each customer to electronically store via the customer processor the modified program in the supplier storage device for access by such customer;

allowing each customer to operate (208) the modified program; and

providing each customer's participants with access via a participant processor (106) and via a program processor of the supplier to the modified program stored in the supplier storage device, wherein the program processor (108) loads an image of code of the stored modified program and which is non-executable

outside of the program processor into a local memory
area of the program processor for execution by an image
of the operating software of the program processor."

First auxiliary request:

    " 1. A supplier-provided method for allowing
multiple customers of the supplier to each create an
individual, modified motivation or recognition program
having participants, each said program permitting the
participants to earn awards on the basis of the
participants' performance, each said program of a
particular customer operating according to preferences
selected by the particular customer, said method
comprising the steps of:

    allowing each customer to electronically access via
a customer processor (104) a browsable catalog (110) of
predefined programs stored in a supplier storage device
(112);

    allowing each customer to electronically select
(202) via the customer processor one of the predefined
programs stored in the supplier storage device;

    allowing each customer to electronically modify
(202) via the customer processor at least one component
of the selected predefined program stored in the
supplier storage device, and so as to allow
customisation of the selected predefined program
through the modification and set-up of the program;

    allowing each customer to electronically store via
the customer processor the modified program in the
supplier storage device for access by such customer;

    allowing each customer to operate (208) the
modified program; and

    providing each customer's participants with access
via a participant processor (106) and via a program

processor of the supplier to the modified program
stored in the supplier storage device, wherein the
program processor (108) loads an image of code of the
stored modified program and which is non-executable
outside of the program processor into a local memory
area of the program processor for execution by an image
of the operating software of the program process
[sic!]."

Second auxiliary request:
    "1. A method comprising:

    allowing multiple customers to each create an
individual, modified motivation or recognition program
having participants, said programs of said multiple
customers supplied by a program supplier, each said
program permitting the participants to access their
program via a participant processor and to earn awards
through the program in which they participate on the
basis of the participants' performance, each said
program of a particular customer operating according to
preferences selected by the particular customer;

    allowing a first customer via a first customer
processor (104) and allowing a second customer via a
second customer processor (104) to each electronically
access a browsable catalog (110) of predefined programs
stored in a storage device (112) connected to the
program processor, said storage device and said program
processor being remote from said customer processors
and remote from said participant processors, wherein
the first customer's access and program is independent
of the second customer's access and program;

    allowing the first customer and the second customer
to each electronically select (202) one of the
predefined programs stored in the storage device via

their customer processor, wherein the first customer's selection is independent of the second customer's selection;

allowing the first customer and the second customer to each electronically modify (202) their selected predefined program via their customer processor, wherein the first customer's modifications are independent of the second customer's modifications;

allowing the first customer to electronically store the first modified program in the storage device for access by the first customer via the first customer processor;

allowing the second customer to electronically store the second modified program in the storage device for access by the second customer via the second customer processor;

allowing the first customer to operate (208) the first modified program via the first customer processor;

allowing the second customer to operate (208) the second modified program via the second customer processor, wherein the operation of the first modified program is independent of the second modified program; and

providing the first customer's participants with access via their participant processor to the first modified program stored in the storage device, said first modified program executed by the program processor,

permitting the second customer's participants with access via their participant processor (106) to the second modified program stored in the storage device, said second modified program executed by the program processor wherein the execution by the program processor of the second modified program is independent

of the execution by the program processor of the first
modified program, and wherein access by the first
customer's participants to the first modified program
is independent of access by the second customer's
participants to the second modified program."

VII.   The arguments advanced by the appellant may be
        summarised as follows:

        The prior art in the field of motivation and
        recognition programs, as disclosed for example in
        document D1, offered only a relatively inflexible and
        restrictive way how the customer could shape and
        operate such programs. The present invention provided a
        novel and inventive tool for electronically creating
        and operating award programs in an efficient, reliable,
        and secure manner.

        The invention clearly involved technical means and
        processes, like the various processors and storage
        means as well as an operating software and business
        logic for executing the program code locally in the
        program processor in such a manner that the program
        code was not executable outside of the program
        processor. Although some aspects of the invention, like
        the selection of an award type or the definition of the
        number of participants seemed, on the face of it, to be
        rooted in a business method, they all interacted
        strongly with the technical features of the invention,
        providing the flexibility, efficiency, reliability and
        security the invention wanted to achieve in customising
        and operating award programs.

Taking account of this strong interaction, it would be clear that the non-technical aspects could and should not be ignored in assessing inventive step according to the case law as set out in the decision DUNS LICENSING ASSOCIATES (T 154/04 - Estimating sales activity / DUNS LICENSING ASSOCIATES, OJ EPO 2008, 46) for example.

In answering questions raised by the Board about the auxiliary requests and the meaning of some of the claim definitions, the appellant explained at the oral proceedings that the amendments submitted with the auxiliary requests should clarify the inventive concept of the invention but there was no intention to make any substantial changes. In particular, the definitions of "independent" operation, execution, and access in claim 1 of the second auxiliary request were only a clarification that the reward programs could be created, modified, operated, and accessed individually for each, and independently from any other, customer and participant.

The appellant also explained that the term "non-executable" was to be construed in the light of the description as published, column 9, line 17 ff., i.e. the term "non-executable" meant that the programs remained local to the program processor and were not distributed to the customer as standalone programs for example as in the prior art.

Reasons for the Decision

1.   The appeal although admissible is not allowable since
        on the basis of the present requests the requirements
        of inventive step as set out in Articles 52 (1) EPC and
        56 EPC 1973 are not met.

2.   The respective claims 1 of the present requests define
        a method for allowing customers to create and operate
        an individual motivation or recognition program. As
        pointed out in the description at column 1
        paragraph 0002 ff., such motivation and recognition
        programs provided companies or resellers with a method
        for attracting, retaining, rewarding, and recognising
        employees, members, volunteers, contractors,
        distribution-channel personal, and consumers (called
        "participants"). The programs were available to
        customers as either standard off-the-shell programs, or
        as customised programs to suit the particular needs of
        a business.

        For example, the enterprise Maritz Inc. provided such
        programs for customers off-line by conversing with the
        customer and then designing, implementing, and
        operating a program for that customer based on the
        expressed needs of the customer. For the customer who
        preferred a do-it-yourself approach, some systems
        offered software that run on a personal computer and
        allowed the customer to design, set up, and/or operate
        a program according to customer-selected preferences.

        However, there was a need for a system which allowed
        customers, via a customer processor connected to a
        global computer network, to select a program from a

plurality of predefined programs and to modify and
operate the selected, predefined program.

3.   In fact, "motivation and recognition programs" are
        common instruments in personnel management and
        marketing for fostering interests and raising
        motivation within a target group of people, e.g.
        employees, customers, etc, by rewarding desired
        behaviour in the target group in the framework of a
        dedicated incentive scheme or reward program. Offering,
        as "(program) supplier" like Maritz Inc., the set-up
        and execution of customised motivation and recognition
        programs as a service to its customers on the basis of
        remuneration is apparently part of a business model.
        The above-cited passages make clear that the invention
        is directed to automating such a business model and its
        processes using a "global computer network",
        essentially the Internet and World Wide Web (see e.g.
        description, col.1, para. 0004, col. 7 f., para. 0030,
        col. 9, para. 0034, and col. 20, para. 0076).

4.   As explained in DUNS LICENSING ASSOCIATES (supra),
        point 15 f. of the Reasons for the Decision, the non-
        technical aspects of an invention to the extent that
        they do not interact with technical features to produce
        a technical effect should not be given any weight in
        establishing novelty or inventive step even if such
        aspects embody novel and innovative concepts.

5.   In the present case, such non-technical aspects result
        from the business related nature of motivation and
        recognition programs and certainly from the specific
        business model of selling as a service provider
        individually set up reward programs to customers. In

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fact, the present claims refer to an important extent
to business processes involved in such a business model.
These non-technical aspects underlying the claim
definitions can be summarised as follows, borrowing
wording from the claims (numbering added for
convenience of reference):

A method provided by the program supplier and
comprising the following steps:

(1) for each of the multiple customers of the supplier
an individual, modified motivation or recognition
program having participants is created, each said
program permitting the participants to earn awards on
the basis of the participants' performance, each said
program of a particular customer operating according to
preferences selected by the particular customer,

(2) each customer accesses a catalogue of predefined
programs;

(3) each customer selects one of the predefined
programs;

(4) each customer modifies at least one component of
the selected predefined program so as to allow
customisation of the selected predefined program
through the modification and set-up of the program,

(5) wherein the modification of a component includes at
least one of the following: selecting a rules structure,
defining a program duration, selecting an award type,
defining the number of participants, determining the

value of an award, and modifying a communications
campaign theme and components;

(6) each customer accesses and operates the modified
program; and

(7) each customer's participant has access to the
modified program.

6.   The Board notes that the second auxiliary request words
      the claims differently from the other requests by
      distinguishing activities of a first and a second
      customer (participant); there is however no change in
      substance implied as confirmed by the appellant in the
      oral proceedings (see point VII above).

7.   The method steps (1) to (7) above have the character of
      business processes, the execution of which does
      actually not require the use of any specific technical
      means; conversing with the customers (and participants
      of the reward program) would be sufficient as indicated
      in the description, col. 1, lines 27-31 (see also
      col. 7, lines 54-58).

8.   Technical aspects of the invention only surface when
      considering the object of the invention to integrate
      the business model into a globally accessible
      information system (see point 3 above). The features of
      the claimed invention (all requests) related to the
      technical implementation of such a information system
      are as follows (numbering added for convenience of
      reference):

(A) (implicitly) implementing "motivation and
recognition programs" in software;

(B) providing an information system, essentially a
client/server system comprising at the server
("supplier") site a database ("supplier storage device")
and a server processor ("program processor") running an
operating software and a business logic layer for
executing the programs locally under the control of the
supplier and connected via the Internet and World Wide
Web (see point 3 above) to client processors ("customer
processors", "participant processors") remotely located
at the customer's and participant's sites (see
description, col. 9; paragraph 0032 f.);

(C) storing the predefined programs in the supplier
storage device;

(D) loading an image of code of the stored modified
program into a local memory area of the program
processor for executing the program by an image of the
operating software of the program processor;

(E) executing the business processes (1) to (7)
electronically, i.e. essentially by means of the said
information system.

9.   The feature that an image of code of the stored
        modified program "is non-executable outside of the
        program processor" (claims 1 of the main request and
        first auxiliary request) sounds like a technical
        definition but actually lacks any clear technical
        meaning. In the light of paragraph 0033 of the
        description (see also point VII above) this feature

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should be understood to mean simply that the program
code is kept under lock by the program supplier, i.e.
it is not made available to the customers or
participants, for example it is not sold as a
standalone program to the customers. The feature,
therefore, phrases rather a general business constraint
or requirement than a technical feature of the claimed
invention and can thus be excluded from further
consideration.

10.   Features (A) to (E) all have to do with the
       implementation of a specific business model including
       business processes (1) to (7) on a globally accessible
       information system. The claimed implementation, however,
       is obvious. Implementing business processes in software
       as business applications (feature A) and using a Web-
       based client/server system for running such
       applications (feature B) are notorious facets of doing
       e-business. This includes also the implementation of
       business processes in a business logic layer, an
       example of which is disclosed in document D3, section 2
       and in particular subsection 2.3 at p. 3 of the
       document. The same holds for feature D: it applies to
       routine procedures used in concurrent computing as
       correctly stated in the decision under appeal. Finally,
       feature E is a direct consequence of implementing and
       executing the business processes (1) to (7) on an
       information system and do thus not imply any inventive
       activities, at least not on the conceptual level at
       which the invention is claimed.

11.   Contrary to the appellant's submissions, the Board
       judges that the business processes (1) to (7) if
       implemented as claimed would not interact with the

information system in a manner that results necessarily
in a technical effect, contributing to the technical
solution of a technical problem. The circumstance that
these processes are executed automatically on a
information system does not imply that they form part
of a particular solution of a technical problem. In the
context of the invention, they rather play the role of
the specification of business requirements to be met in
the technical implementation of the information system.
Not providing a technical contribution to the prior art,
however, means that such processes cannot claim
relevance for the assessment of inventive step.

12.   Therefore, the claimed invention is to be considered
obvious in the light of the prior art in information
technologies and does thus not meet the requirements of
inventive step. This applies to all requests.
Accordingly, on the basis of the present requests the
appeal is not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

S. Sánchez Chiquero   S. Steinbrener

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