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**Datasheet for the decision
of 20 October 2009**

Case Number: T 1928/06 - 3.5.01

Application Number: 02718310.2

Publication Number: 1374128

IPC: G06F 17/60

Language of the proceedings: EN

Title of invention:
Profile Management System

Applicant:
BRITISH TELECOMMUNICATIONS public limited company

Headword:
Profile management/BRITISH TELECOMMUNICATIONS

Relevant legal provisions:

-

Relevant legal provisions (EPC 1973):

EPC Art. 56

Keyword:

-

Decisions cited:

T 0641/00

Catchword:

-



Case Number: T 1928/06 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 20 October 2009

Appellant: BRITISH TELECOMMUNICATIONS public limited
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Representative: Lofting, Coreena Fiona Anne
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 5 July 2006
refusing European patent application
No. 02718310.2 pursuant to
Article 97(1) EPC 1973.

Composition of the Board:

Chairman: S. Steinbrener
Members: S. Wibergh
P. Schmitz

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division to refuse European patent application No. 02 718 310.2.
- II. The following document will be referred to:
D1: WO-A-99/28838.
- III. According to the decision appealed, the method of independent claim 8 of the main request and that of independent claim 7 of the sole auxiliary request did not involve an inventive step since it was a mere automation of a non-technical activity for generating a user profile on a general-purpose computer system.
- IV. Claim 8 of the main request read:
- "A method of generating a user profile in a computer-based information management system, the user profile comprising interests deemed to be relevant to a user, the method comprising the steps of:
- (a) classifying a user as a type of entity; and
 - (b) accessing mappings between entity type and interests in order to identify interests corresponding to the classified user;
- characterised by:
- (c) automatically retrieving a template from a template store, the template store comprising one or more templates each comprising a plurality of interests arranged in a hierarchy; and
 - (d) automatically generating a user profile from the retrieved template in accordance with the identified interests by filtering interests not identified from

the retrieved template, wherein the generated user profile comprises a plurality of interests arranged in a hierarchy".

- V. Claim 7 of the *auxiliary request* added a final feature to claim 8 of the main request:

"... and supports hierarchical relationships between interests such that interests in the hierarchy inherit characteristics from interests above them in the hierarchy".

- VI. In the statement setting out the grounds of appeal dated 15 November 2006, the appellant refiled the claims on which the decision under appeal was based and argued essentially in the following way:

The analysis by the examining division was flawed since it did not include the steps of i) determining what is the closest prior art, then ii) determining the difference between the invention and the prior art, then iii) determining what problem is solved on account of this difference. Instead, the examining division had attempted to divide the individual steps of the claim into technical and non-technical aspects before carrying out steps i) to iii) (grounds, p. 9,10).

The closest prior art was that disclosed in D1, but the examining division had started out from clearly less relevant prior art, viz a general-purpose computer system. In relation to D1 the technical problem solved by the invention was "how to generate user profiles in a computer-based information management system in such a way as to remove the need for individual users to

individually create or update their respective user profiles" (p. 7). This problem was also solved in respect of the general-purpose computer taken as starting point by the examining division (p. 9).

The examining division seemed to have considered the technical character of a method in which a user profile was *used* rather than generated (p. 9).

- VII. In a communication, the Board issued a summons to oral proceedings and set out its provisional opinion on the appeal. Noting that the examining division had split up the claim features in a non-technical and a technical part, the Board stated that this was in principle legitimate and that the classification made appeared reasonable. Even if the template store were a technical means, which was doubtful since it was a data collection, it appeared obvious to generate a profile from a template rather than creating each profile from scratch. That this should be done automatically exploiting available sources of information could be regarded as an obviously desirable feature.

With regard to the auxiliary request, the Board found the formulation "interests in the hierarchy inherit characteristics from interests above them in the hierarchy" obscure. If the meaning was that, for example, a certain user might regard "programming" as "work" rather than "leisure", the feature seemed merely to define the intended (non-technical) semantic context and thus could not contribute to an inventive step.

VIII. Oral proceedings, which the appellant had announced it would not attend, were held on 20 October 2009 in the appellant's absence. The Board verified the appellant's requests. The appellant had requested in writing that the decision under appeal be set aside and a patent be granted on the basis of the claims of the main request or of the auxiliary request as filed with the statement setting out the grounds of appeal dated 15 November 2006. In the event that these requests could not be granted, it was requested that the decision under appeal be reversed and the application be remitted to the examining division for further examination.

IX. At the end of the oral proceedings the Board announced its decision.

Reasons for the Decision

The main request

1. Inventive step

1.1 The examining division argued that the subject-matter of claim 8 was a straight-forward implementation of a non-technical activity. The claim was found to comprise the following non-technical features:

A method of generating a user profile in an information management system, the user profile comprising interests deemed to be relevant to a user, the method comprising the steps of:

(a) classifying a user as a type of entity;

- (b) accessing mappings between entity type and interests in order to identify interests corresponding to the classified user;
- (c) retrieving a template from a template store, the template store comprising one or more templates each comprising a plurality of interests arranged in a hierarchy; and
- (d) generating a user profile from the retrieved template in accordance with the identified interests by filtering interests not identified from the retrieved template, wherein the generated user profile comprises a plurality of interests arranged in a hierarchy.

The only technical features implied by claim 8 were processing means performing the aforementioned steps automatically and a computer template store for storing the templates. Taking a general-purpose computer system with a database as closest prior art, the examining division saw the technical problem in the automation of the method for generating a user profile as defined by the non-technical features. This was an obvious programming task.

- 1.2 The Board fully agrees with the examining division's assessment.
- 1.3 As to the appellant's arguments in the statement setting out the grounds of appeal (see point VI above), the following is noted:
 - 1.3.1 In dividing the claim into technical and non-technical features the examining division merely followed the standard examination technique for subject-matter referring to an aim to be achieved in a non-technical

field (see T 641/00 "Two identities/COMVIK",
OJ EPO 2003,352).

- 1.3.2 The examining division was free to start out from a (notorious) general-purpose computer system. As the appellant itself recognises (grounds of appeal, p. 2), an invention must satisfy the requirements of inventive step over *any* prior art. Thus, the examining division was not in any way obliged to choose D1 as the "closest" prior art. In any case, selecting as starting point prior art that comes "closer" to the invention in terms of its non-technical features (here: D1 anticipating aforementioned steps (a) and (b) of the claimed method, as the appellant asserts) would not improve the prospects of patentability since these only depend on the technical aspects of an invention, which remain unchanged by such selection.
- 1.3.3 It is not evident to the Board that the examining division regarded claim 8 as referring to the *use* of a user profile rather than to its *generation*. In fact, the decision refers to both ("A technical purpose for *generating or using* the user profiles can not be derived from the original application as a whole"; decision under appeal, point 1; italics added).
- 1.4 Thus, the subject-matter of claim 8 does not involve an inventive step (Article 56 EPC 1973).

The auxiliary requests

2. Inventive step

According to the auxiliary request the user profile "supports hierarchical relationships between interests such that interests in the hierarchy inherit characteristics from interests above them in the hierarchy". Since this feature apparently aims to define the meaning of the data in the user profile it cannot contribute to an inventive step. The auxiliary request is therefore also refused (Article 56 EPC 1973).

3. Remittal

As the Board considers the appeal not to be allowable, there is no room for setting the decision under appeal aside and remitting the case to the department of first instance for further prosecution. Hence, this request is also refused.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

T. Buschek

S. Steinbrener