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Datasheet for the decision
of 1 December 2011

Case Number:	T 1438/07 - 3.5.01
Application Number:	05001746.6
Publication Number:	1526435
IPC:	G06F 17/60, G07F 19/00, G06F 1/00
Language of the proceedings:	EN

Title of invention:
Methods and systems for transaction record delivery using
thresholds and multi-stage protocol

Applicant:
Intertrust Technologies Corp.

Opponent:
-

Headword:
Managing a transaction II / INTERTRUST TECHNOLOGIES

Relevant legal provisions:
EPC Art. 52(1)

Relevant legal provisions (EPC 1973):
EPC Art. 56, 111(1)

Keyword:
"Request for remittal - rejected"
"Inventive step - all requests (no)"

Decisions cited:
G 0010/93, T 0449/10, T 1436/07

Catchword:
-

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Case Number: T 1438/07 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 1 December 2011

Appellant: (Applicant)	Intertrust Technologies Corp. 4750 Patrick Henry Drive Santa Clara, CA 95054 (US)
Representative:	Williams, Michael Ian Cleveland 40-43 Chancery Lane London WC2A 1JQ (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted 2 March 2007 refusing European patent application No. 05001746.6 pursuant to Article 97(1) EPC 1973.**

Composition of the Board:

Chairman: S. Wibergh
Members: R. R. K. Zimmermann
               D. Prietzel-Funk

Summary of Facts and Submissions

I.   European patent application number 05001746.6,
        publication number EP 1 526 435 A, is a divisional
        application of application number 00955281.1 (cf
        T 0449/10; there is also a further divisional
        application number 05001745.8, cf T 1436/07). It
        relates to systems and methods for communications
        between computer systems involved in a transaction.

II.   The examining division refused the application for lack
        of inventive step in a written decision issued on
        2 March 2007. According to the reasons given in the
        decision, the method claimed was essentially a business
        method implemented in an obvious manner on a computer
        system. The decision does not refer to and does not
        take into account any specific piece of prior art in
        giving the reasoning for lack of inventive step.

III.   The appellant (applicant) lodged an appeal against the
        decision on 2 May 2007. By letter dated and received at
        the EPO on 11 July 2007, the appellant filed a
        statement setting out the grounds of appeal, including
        three sets of claims as main request and first and
        second auxiliary requests.

IV.   In a communication annexed to the summons to oral
        proceedings, the Board objected that the claimed
        invention was an obvious computer-implementation of a
        business scheme concerning the management of financial
        transactions between a clearinghouse and its customers.
        It argued that it was not possible to identify any
        direct causal link between the claimed method and the
        improved security control of computer communications,

an advantage alleged to be the technical achievement of
the claimed invention. The data format claimed was
determined by business requirements and not linked to
any specific technical effect. Accordingly, the
technical contribution provided by the invention over
the prior art and the inventive merits involved were
identified in the communication as the central issue to
be discussed in the forthcoming oral proceedings.

The appellant replied to the communication of the Board
in a letter dated 31 October 2011, filing amended
claims as new auxiliary requests in preparation of the
forthcoming oral proceedings.

V.   Oral proceedings took place before the Board on
        1 December 2011. The appellant requested that the
        decision under appeal be set aside and the case be
        remitted to the department of first instance for
        further prosecution, or, that the decision under appeal
        be set aside and a patent be granted on the basis of
        claims 1 to 6 as originally filed, alternatively based
        on the first to third auxiliary requests filed with
        letter dated 31 October 2011.

        The wording of respective claim 1 of the requests
        maintained in the oral proceedings is as follows
        (brackets ^{1}<>, ^{2}<> etc. are added for convenience of
        reference):

        Main request
              1. A method ^{1}<> for managing the transmission of
              ^{2}<transactional audit> records from a first
              computer system (104) to a clearinghouse ^{3}<> (106),
              the method including:

maintaining a first count of the number of [2]<audit> records accumulated at the first computer system (104);

accumulating a predefined number of [2]<audit> records at the first computer system;

generating [4]<an> [2]<audit> record at the first computer system (104); [5]<>

incrementing the first count;

comparing the first count with a first predefined threshold value;

transmitting at least the predefined number of [2]<audit> records to the clearinghouse [3]<> (106);

receiving a first acknowledgement from the clearinghouse [3]<> (106); [6]<>

decrementing the first count.

Claim 1 of the first auxiliary request differs from claim 1 above as follows:

Insertion [1]<> reads: ", when carried out using a computer program,".

Passage [2]<...> is deleted.

Insertion [3]<> reads: " computer system".

Passage [4]<...> reads: "a".

Insertion [5]<> reads: " storing the generated record in secure, tamper-resistant storage;".

Insertion [6]<> reads: "and".

Claim 1 of the second auxiliary request reads as follows:

1. A method [7]<for> managing records on a first computer when carried out using a transaction processing application (112) on a computer system,

the application (112) defining a plurality of
thresholds (514) each comprising:
a type definition of (412);
at least one trigger (401); and
state information (406), including:
value information;
a count; and
a last acknowledgement;
the method comprising:
[8]<generating> a record at the first computer system
(104);
storing the generated record in secure, tamper-
resistant storage;
incrementing the count value of a threshold;
[9]<>
evaluating the trigger (401) of the or each
threshold (514);
if the trigger (401) is satisfied:
sending the records to a clearinghouse computer
(106);
receiving a first acknowledgement (712) from the
clearinghouse computer (106);
decrementing the count information in the
acknowledgement state information;
wherein the or each trigger (401) includes:
a conditional expression (402); and
an action (404) which is triggered when the
expression is satisfied[10]<>.

Claim 1 of the third auxiliary request differs
therefrom as follows:

Passage [7]<...> is deleted.
Passage [8]<...> reads: "operating".

Insertion [9]<> reads: "indicating a record of the
type defined by the type definition of the
threshold;"

Insertion [10]<> reads: ", wherein the method further
includes:

receiving a signal from the clearinghouse computer
(106), the signal including a time indicator (711);
at a time specified by said time indicator (711),
sending a request to the clearinghouse computer
(106) to transmit one or more acknowledgements
relating to received records".

VI.   In the oral proceedings, the appellant objected to the
        intention of the Board to reject the request for
        remittal of the case to the examining division and to
        decide the appeal on substantive issues. The appellant
        argued that the examining division had refused the
        application for reasons of excluded subject matter
        under Article 52(2) EPC only, which reasoning was
        clearly wrong. The objection of lack of inventive step
        was raised in the decision under appeal only in passing
        as an additional point. If the Board now decided on
        inventive step, the appellant would suffer a loss of
        instance and the fundamental right to be heard would be
        seriously disregarded. A negative decision would be
        final and cause substantial damages to the appellant.
        Nor would it be in compliance with the case law as set
        out by the Enlarged Board of Appeal in the decision
        G 10/93 – Scope of examination in ex-parte
        appeal/SIEMENS (published in OJ EPO 1995, 172) at
        par. 4 f. of the Reasons.

VII.   Concerning patentability of the invention, the
        appellant cited various decisions of the Boards of

Appeal, concluding therefrom that the claimed method
was not a method of doing business excluded from
patentability. The invention related to managing
communications, which was clearly and unequivocally a
technical area of subject matter. The computer context
of the invention was an important consideration and
could not be simply ignored as the examining division
did. The invention addressed a technical problem,
namely to provide a secure method of deferring the
transfer of data records from one computer to another.
The solution adopted by the invention was to accumulate
computer records, maintain a count of them, transmit
them in batches from a distant computer, receive
acknowledgements, and reconcile acknowledgements and
records. The invention enhanced performance and fault
tolerance of communications between computers.

Reasons for the Decision

1.   The appeal, although admissible, is not successful
        since none of the appellant's requests is allowable.

2.   Remittal to the examining division

2.1   The Board has decided to reject the request for
        remittal of the case to the examining division.

2.2   Pursuant to Article 111(1) EPC 1973, a board must
        decide, after assessment of the due circumstances of
        the case, whether it will rule on the case itself or
        remit the matter for further prosecution to the
        examining division (cf. G 10/93, par. 5 of the Reasons).
        However, there is *ipso iure* no obligation for a board

to remit a case, even if so requested by the parties.
The decision is a matter of discretion. In exercising
its legal power of discretion, a board must take the
relevant circumstances of the case into account. In ex
parte proceedings, the boards of appeal are restricted
neither to examination of the grounds for the contested
decision nor to the facts and evidence on which the
decision is based (see G 10/93, par.3 of the Reasons).
The power of discretion encompasses also the subset of
'loss of instance' where a board considers a
requirement of the EPC not to be met which has not been
taken into consideration by the examining division
before, and confirms the impugned decision on the basis
of the 'new' ground. Although such a circumstance may
justify remittal, the imperative of procedural
efficiency has still to be taken into account and
justifies in the present case a final decision of the
Board.

2.3   Nevertheless, for reasons of completeness the Board
        notes that the allegedly 'new' ground argued by the
        appellant is in fact not new, since the objection of
        lack of inventive step has already been raised and
        considered in the impugned decision. Contrary to the
        appellant's reading of the decision as being
        exclusively based on a statutory exclusion of subject
        matter from patentability under Article 52(2) EPC 1973,
        the ground for refusing the application is actually
        lack of inventive step. The introductory paragraph of
        the Reasons for the decision reads as follows:

        Claim 1 relates to a business method since it does
        not contain any subject-matter not falling under

the exclusions of Article 52(2)(c) EPC which would contribute to the state of the art.

It is true that, read in isolation, this statement may be understood in the way that the subject matter of claim 1 is a business method excluded from patentability. However, the decision also acknowledges that the method claimed is implemented on and executed by means of a computer system ("Ignoring for the moment …", see 1.1). Therefore, the introductory paragraph should be construed to mean that the business method *per se* "does not contain any subject-matter ... which would contribute to the state of the art". The statement should thus be regarded as part of an inventive-step argument leading to the conclusion in 1.5 that "the subject-matter defined in claim 1 does not satisfy Article 56 EPC". Considering and deciding the appeal on the basis of inventive step hence does not create the type of 'loss of instance' situation argued by the appellant.

2.4   Considering that there are no other particular circumstances apparent from the submissions which may outweigh the drawbacks of further procedural delays if the case were remitted, the Board has decided to reject the appellant's request for remittal.

3.   Lack of inventive step

3.1   The invention to which the main request and the first, second and third auxiliary requests relate does not meet the requirement of inventive step as set out in Articles 52(1) EPC and 56 EPC 1973.

3.2   Claim 1 of the main request is directed to a method for managing the transmission of transactional audit records from a first (consumer's) computer system to a clearinghouse.

The term "audit records" is not self-explaining; according to the European patent application, page 10, paragraph 0059 f., audit records 122 are created "detailing, among other things, the price the consumer paid for the content, the identity of the clearinghouse 106 to which the audit records should be sent for processing, and the like. … audit records 122 may reference one or more clearinghouse information (CHInfo) objects 510 and/or budgets 512... ". A CHInfo object 510 "identifies the clearinghouse associated with the content, the forms of payment accepted by the clearinghouse, and a list of thresholds that control the delivery of payment or audit records to the clearinghouse" (*ibid.*).

A "threshold" is a data construct as shown in figure 4, "specifying age, record count, financial value, average age, age-weighted value, and other predefined characteristics" (cf. application, page 3, paragraph 0013).

Apparently, none of these data and functions serves any specific technical purpose, or provides for a technical effect. The method claimed relates rather to the exchange of purely business-related data between the consumer and the clearinghouse. The only arguably technical aspect results from an implicit understanding of the invention that the data exchange takes place via the Internet under computer program control (cf.

application, e.g. page 2, paragraph 0003 and page 5, paragraph 0024).

3.3   The further features of claim 1 do not change this picture: accumulating and transmitting a number of audit records to the clearinghouse, book-keeping, and processing the audit records according to business criteria implemented by means of the threshold objects are not part of a technical solution of a technical problem. The general idea to use computer and computer networks to implement business and financial methods had been a well-known approach long before the priority date of the present application. The present method, therefore, lacks any technical contribution over the prior art which could be considered to involve an inventive step.

3.4   The claims according to the auxiliary requests do not give a markedly different picture of the patentability of the invention.

In the first auxiliary request the term "audit" has been deleted. However, a novel scheme of processing and communicating unspecified data ("records") over a computer network does not automatically qualify as a technical invention. According to the constant case law of the boards of appeal, features may contribute positively to inventive step only to the extent that they contribute in a direct and causal manner to the technical solution of a technical problem. Exchanging records between the first computer and a clearinghouse computer, incrementing and decrementing counts, etc do not serve any such technical purpose.

The circumstance that such functions are computer-
implemented and that records are stored in a "secure,
tamper-resistant storage" renders the claimed method
(as a whole) potentially patentable; in the absence of
any inventive implementation features, however, this
technical contribution does not involve an inventive
step. The use of computers and computer networks to
process and to exchange data is common practice. The
desire to store certain information at a safe place is,
if not related to a specific technical purpose,
irrelevant to inventive step. Using a digital storage,
and any digital storage is to some extent secure and
tamper-resistant, is in the present general context
only an obvious implementation feature.

3.5   The second and third auxiliary requests introduce
        "thresholds" into claim 1, each comprising a type
        definition, at least one trigger, and state information
        including value information, a count, and a last
        acknowledgement.

        Figure 4 illustrates this data structure and the
        associated functionality. The application, page 10 ff.,
        starting with paragraph 0062 ff. explains the meaning
        of the data encoded in such threshold objects. These
        threshold objects specify the last date and time the
        consumer's system communicated with the clearinghouse
        (ibid., paragraph 0062), the monetary value of the
        records (ibid., paragraph 0067), and other predefined
        characteristics indicating the status of the purchasing
        process. The triggers implement a logical scheme how to
        decide purchasing requests on evaluation of the
        business risk. None of these aspects of the claimed
        invention serves a technical purpose.

The circumstance that a method for managing business
transactions online requires a clearly and logically
organised business scheme if the business process is to
be executed automatically by a computer system does not
change the business character of such a method or the
activities involved: Creating a business scheme
defining the business process in a form that is
appropriate to be used by a programmer as a starting
point to design and implement the software system
requires only knowledge in business matters plus some
common sense and capacity of abstract thinking. Such
aspects and features of the claimed method can not
contribute to inventive step. There are no technical
features in claim 1 which go beyond the normal use of
common computer means and programming techniques.

3.6   Claim 1 of the third auxiliary request cites three
        additional steps of the claimed method, none of which
        leads to a more positive assessment of inventive step.

        First, claim 1 defines a step of "indicating a record
        of the type defined by the type definition of the
        threshold". It might be arguable whether this feature
        is unambiguously disclosed in the application as filed.
        In any case, however, this feature does not serve any
        meaningful technical purpose. As follows e.g. from
        Table 1 at page 11 of the application, the type
        definitions are rather determined by the kind of
        business operations implemented. To notify the business
        partner about the type of business operation the
        communication concerns is a business matter, and thus
        irrelevant to inventive step.

Furthermore, claim 1 defines the steps of "receiving a signal from the clearinghouse computer... including a time indicator" and "sending a request to the clearinghouse computer" at the time specified by the time indicator.

The idea behind the time indicator becomes clear from paragraph 0077 at page 13 of the application, namely to inform the consumer's system when the clearinghouse is again able to communicate with the consumer if for any reason the clearinghouse is temporarily unreachable. It is general custom and practice, and only courteous between business partners, to inform the other side about opening (or closing) times. Except for using common electronic means for this purpose, there is no technical aspect involved in this feature.

The last step in the method claimed, sending a request to the clearinghouse at the time specified by the clearinghouse, apparently serves to exchange data between the business partners "whenever communication is convenient" (cf. application, page 3, paragraph 0013). The claimed solution is an obvious variant of the common pull technique for communications control where clients are responsible for accessing (polling) and requesting a server to send information from the server to the client. The skilled person would consider this last step in claim 1 as a matter of common practice and general technical knowledge.

3.7   In summary, none of the present requests is related to an invention which complies with the requirement of inventive step. The few technical aspects and features

present in the claims are obvious in the light of
common computer and communications control techniques.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

T. Buschek   S. Wibergh

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