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**Datasheet for the decision
of 3 July 2008**

Case Number: T 1515/07 - 3.5.01

Application Number: 03012947.2

Publication Number: 1484684

IPC: G06F 11/34

Language of the proceedings: EN

Title of invention:

Method and computer system for providing a cost estimate for sizing a computer system

Applicant:

SAP AG

Opponent:

-

Headword:

Cost estimate/SAP

Relevant legal provisions:

EPC Art. 92(1)
EPC R. 63, 103(1)(a)

Relevant legal provisions (EPC 1973):

EPC Art. 21(1)
EPC R. 45

Keyword:

"No search"
"Substantial procedural violation (yes)"

Decisions cited:

T 1242/04, T 0690/06

Catchword:

See points 6-8 of the Reasons.



Case Number: T 1515/07 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 3 July 2008

Appellant:

SAP AG
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69190 Walldorf (DE)

Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 12 April 2007
refusing European application No. 03012947.2
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. 03012947.2.

II. The following document will be referred to in the present decision:

D1: HyPerformix, Inc.: "Optimizer Model for SAP"
(<http://www.hyperformix.com/whitepapers/Optimizer%20Model%20for%20SAP.pdf>).

III. Claim 1 of the main request submitted during the oral proceedings before the examining division on 20 March 2007 reads:

"A computer-implemented method of providing a cost estimate for a data processing system by means of a computer system (100;300), the method comprising the steps of:

- selecting of an application program (Ai) of a set of application programs via a user interface means (102, 302), each application program having a number of objects (BOij) stored in a database (104,304),
- entering of data being descriptive of a load profile via the user interface,
- retrieving a set of sizing coefficients for each object of the selected one of the application programs from a database,
- estimating the hardware requirements for the data processing system for each one of the objects of the selected one of the application programs by entering of the sizing coefficients and the load profile into a

single linear sizing model (106;306) of the computer system,

- entering of the hardware requirements for each one of the objects of the selected one of the application programs into a cost estimator component (308) of the computer system to provide a cost estimation for the data processing systems costs for each one of the program objects of the selected one of the application programs,

- calculating of the total hardware requirement by adding of the hardware requirements,

- calculating of the total cost estimate by adding of the cost estimations."

IV. According to the decision appealed, the invention set out in claim 1 differs from the prior art document D1 in that:

"(i) the coefficients are stored in a database

(ii) the prior art does not address the cost determination, only sizing aspects

(iii) the total hardware requirements are calculated

(iv) the sizing model is a linear model

(v) a single model is used for all objects (on a per object basis)".

The examining division held that features (ii) and (iii) together solved a first objective technical problem, namely how to derive from the hardware requirements of the individual objects the total hardware requirements and the corresponding cost of the whole system.

Features (i), (iv) and (v) together solved a second objective technical problem, namely how to provide a high quality cost estimate with minimum computational

complexity. Both solutions were regarded as obvious for the skilled person.

An amended claim according to an auxiliary request was held to be unclear (Article 84 EPC 1973).

With respect to the question whether an additional search should be carried out, as requested by the appellant at the beginning of the oral proceedings, the examining division stated that "since during Oral Proceedings a decision could be reached and since it is in the public interest to have the matter decided as expeditiously as possible, the examining division did not consider it necessary to carry out a search at this stage of the proceedings" (point 2.3.1).

- V. In the statement setting out the grounds of appeal, dated 10 August 2007, the appellant argued in the following way:

In the appealed decision, the examining division acknowledged that the invention as claimed was the solution to an objective technical problem. It further acknowledged that the solution to the technical problem was not part of the common general knowledge. In the decision T 1242/04 (point 9.2), the deciding board expressed the view that an additional search in the documented prior art was necessary "if the claim features do not form part of the common general knowledge and the Appellant also does not acknowledge them to be known". Thus, since in the present case the examining division acknowledged that the claim features did solve a technical problem, in keeping with T 1242/04 an additional search should be carried out.

In decision T 690/06, the deciding board stated that "following the principles set out in the decision T 1242/04, point 8, the Board considers that as long as no search has been performed an Examining Division should normally not refuse an application for lack of inventive step if the invention as claimed contains at least one technical feature which is /not/ notorious. The term notorious should be interpreted narrowly". Thus, the response of the examining division was in direct conflict with the opinion of the board. No search was carried out and the examining division acknowledged that the invention as claimed contained at least one technical feature, so an additional search should have been carried out.

The declaration under Rule 45 EPC 1973 should therefore be withdrawn in accordance with the Guidelines for Examination, part C-VI 8.5. The examining division implicitly removed this declaration when inventive step was considered with regard to a non-notorious item of prior art. This was consistent with T 690/06. In the decision under appeal, the examining division stated that the arguments presented in preparation of the oral proceedings did not refute the objections that the technical elements of the claimed subject matter were of a trivial nature, so a search did not need to be carried out. However, during the oral proceedings the examining division stated that the claimed subject matter was the solution to an objective technical problem, thus acknowledging that the claimed subject matter provided non-obvious technical features. Therefore, an additional search had to be carried out. Further, the request for an additional search made in

preparation for the oral proceedings still stood during the oral proceedings. It had not been withdrawn. Since the next logical step in the patent examination procedure was the undertaking of an additional search, a search should have been carried out. Thus, a substantial procedural violation had taken place and the appeal fee should be refunded.

The examining division's refusal to carry out an additional search resulted in the appellant being put at a procedural disadvantage. The examining division accepted during the oral proceedings that the subject-matter of the invention as claimed was of a technical nature, and subsequently considered inventive step without conducting a search for prior art. Such a procedure would put the appellant at a disadvantage since should the appellant have successfully overcome the examining division's objections regarding inventive step, the appellant could then expect the search to be carried out. Following the progression of the application to a stage where a search was carried out, it was possible that further items of relevant prior art could be determined during the search. Based on these cited items of prior art, further novelty or inventive step objections could result. The appellant would then be faced with making further arguments in order to overcome these objections. Thus, the examination process would be lengthened, and additionally a greater burden upon the resources of the appellant would result.

- VI. The appellant requests that the decision under appeal be set aside, the declaration under Rule 45 EPC 1973 be removed, the case be remitted to the examining division

for an additional search to be carried out, the appeal fee be reimbursed, and, as an auxiliary measure, that oral proceedings be appointed.

Reasons for the Decision

1. The present application was refused by the examining division for lack of inventive step over document D1, said to be the closest prior art. This document, which is mentioned in the application as filed, was given to the examining division by the appellant in the oral proceedings. Only prior art provided by the appellant was available since the search division had issued a declaration under Rule 45 EPC 1973 (now corresponding to Rule 63 EPC) and the examining division did not carry out an additional search.
2. The examining division, employing the usual problem-and-solution approach, identified five differences between the invention and D1 (see point IV above). These features were said to solve two different technical problems in an obvious way, with the consequence that the invention did not involve an inventive step.
3. The only issue that the appellant addresses in the statement setting out the grounds of appeal is the examining division's choice not to carry out an additional search. In the appellant's view, the examining division committed a substantial procedural violation by not searching an invention which it itself acknowledged to constitute a technical solution to a technical problem.

4. The relevant jurisprudence in this case are the two decisions relied on by the appellant, namely T 1242/04 - Provision of product-specific data/MAN (OJ EPO 2007, 421) and T 690/06 - Financial records/AUKOL (not published in OJ EPO). These decisions state in particular the following:

T 1242/04 (point 9.2)

"/An additional search/ ... is necessary, however, if the claim features do not form part of the common general knowledge and the appellant also does not acknowledge them to be known."

T 690/06 (point 12)

"... the Board found in decision T 1242/04 that it is not always necessary for the examining division to carry out an additional search if such search is not expedient under the prevailing circumstances. It must therefore be assumed that the examining division has an, albeit limited, discretion in this respect. In the present case, the examining division did not consider an additional search expedient in view of their (incorrect) inclusion of technical features in the business method which as such did not require a search. However, whether or not such inclusion is justified is a matter of judgment on a substantive issue rather than a question of non-observance of procedural rules. Although this kind of incorrect judgment will normally also have procedural consequences, these consequences are not reducible to a procedural violation, ie an incorrect conduct of the procedure."

5. According to these decisions an examining division need not carry out an additional search if the technical features of the claims are notoriously well known. In the field of computer-implemented inventions, such features often relate to a conventional computer system.

6. The present case, however, is different in that the examining division, starting from the prior art acknowledged by the applicant in the description and submitted at the oral proceedings, identified a combination of technical features not known from this prior art, but considered obvious for a skilled person. The examining division did not find these features notorious, nor is the Board inclined to do so. In other words, the case was in the examining division's view a perfectly normal one, where the invention differed from the closest prior art by certain technical features and any objection based on lack of inventive step required substantive evidence and argument.

In such normal circumstances an additional search must be carried out if a search under Rule 63 EPC is missing. It is true that the case law allows discretion in this respect, but this discretion is limited to the special cases of notoriously known features or those explicitly accepted by the applicant as known. In all other cases, an additional search should be performed (see T 690/06, point 2 of the Reasons). In particular, as long as no search has been performed an examining division should normally not refuse an application for lack of inventive step if the invention as claimed contains at least one technical feature which is not notorious (see T 690/06, point 8 of the Reasons). According to the

examining division's own judgment, the present case does not fall under the above exceptions.

The examining division instead considered that it was not "necessary" to carry out a search because a decision could be reached anyway. However, the general acceptance of this argument would lead to the conclusion that substantive examination serves as a basis for the search and not vice versa, a finding that decision T 1242/04 explicitly warns against (see point 8.3 of the Reasons).

7. The examining division further motivated its choice not to carry out an additional search by the appellant's not having repeated its request for a search in the further course of the oral proceedings, as well as expedience. Neither reason is valid. An express request for a search is not foreseen (cf Article 92(1) EPC), and expedience is no justification for leaving out an obligatory procedural step.
8. Under these circumstances the examining division must be held to have committed a substantial procedural violation in the sense of Rule 103(1)(a) EPC by not performing an additional search that was manifestly necessary. It is therefore equitable to reimburse the appeal fee.
9. The Board thus remits the present case to the examining division for further prosecution, starting with an additional search. It is emphasized that in taking this decision, the Board has made no assessment of any substantive issues of the case.

10. The appellant has also requested the Board to remove the declaration established by the search division pursuant to Rule 45 EPC 1973. This is however beyond the Board's powers (cf Article 21(1) EPC 1973).
11. Oral proceedings before the Board are not necessary since the appellant's other requests have been allowed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

T. Buschek

S. Steinbrener