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**Datasheet for the decision
of 11 July 2013**

Case Number: T 1670/07 - 3.5.01

Application Number: 00960904.1

Publication Number: 1216450

IPC: G06F17/60

Language of the proceedings: EN

Title of invention:

METHOD AND SYSTEM OF SHOPPING WITH A MOBILE DEVICE TO PURCHASE
GOODS AND/OR SERVICES

Applicant:

Nokia Siemens Networks Oy

Headword:

Shopping with mobile device/NOKIA

Relevant legal provisions:

EPC 1973 Art. 56

Keyword:

Inventive step - selection of multiple vendors for shopping
order (no - not technical) - provision of shopping itinerary
based on user profile (no - not technical) - interaction with
technical elements (no - "technical leakage fallacy") - user
action has technical character (no - "broken technical chain
fallacy") - no motivation to modify prior art (no - "non-
technical prejudice fallacy")

Decisions cited:

G 0001/04, T 0603/89, T 0026/86, T 0158/88, T 1741/08,
T 0362/90, T 0115/85, T 0382/96, R 0011/08

Catchword:

See points 9 to 11 and 16 of the Reasons.



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Chambres de recours**

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Case Number: T 1670/07 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 11 July 2013

Appellant: Nokia Siemens Networks Oy
(Applicant) Karaportti 3
02610 Espoo (FI)

Representative: TBK
Bavariaring 4-6
80336 München (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 18 April 2007
refusing European patent application No.
00960904.1 pursuant to Article 97(1) EPC 1973.**

Composition of the Board:

Chairman: S. Wibergh
Members: W. Chandler
P. Schmitz

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division to refuse the European patent application No. 00960904.1. It concerns planning a shopping trip in advance using a mobile device.
- II. The examining division decided that method claim 1 of the main, first and second auxiliary request filed on 7 February 2007 did not involve an inventive step (Article 56 EPC 1973) over WO-A-99/30257 (D1) and the skilled person's common general knowledge.
- III. In the statement of grounds of appeal dated 28 August 2007, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main or first or second auxiliary request filed therewith (and corresponding essentially to the refused ones). The appellant also requested that should the main request be rejected, the subject matter of each of the dependent claims be considered. The same was requested if the first or second auxiliary requests were rejected.
- IV. The Board summonsed the appellant to oral proceedings. In the accompanying annex, the Board summarised the issues to be discussed at the oral proceedings. It tended to view the requests to consider the dependent claims as not admissible and tended to agree with the examining division's decision that none of the other requests were allowable.
- V. At the oral proceedings, the appellant confirmed his requests as contained in the statement setting out the grounds of appeal. Additionally, he requested that a patent be granted based on the third or fourth

auxiliary request filed during the oral proceedings before the Board.

VI. Claim 1 of the main request reads as follows:

"A method of facilitating shopping with a mobile wireless communications device (12) to obtain a plurality of purchased goods and/or services from a group of vendors (14) located at a shopping location (16) comprising:

communicating from the mobile wireless communications device with at least one server (18) a selection of two or more goods and/or services to be purchased by a user of the mobile wireless communications device on or before the user shops at the shopping location;

the at least one server, in response to information stored therein regarding vendors located at the shopping location and the goods and/or services offered by the vendors and the selection of the plurality of goods and/or services to be purchased by the user, causing at least an identification of the vendors from which available ones of the two or more goods and/or services may be purchased and the available ones of the two or more goods and/or services to be transmitted to the mobile wireless communications device; and

the mobile wireless communications device providing to the user an identification of the available ones of the goods and/or services to be purchased and an itinerary (120) of the user setting forth at least a choice of an order in which the user visits the identified vendors to obtain the goods and/or services to be purchased wherein the itinerary is a function of at least one profile of the user."

Claim 1 of the first auxiliary request reads as follows:

"A method of facilitating shopping with a mobile wireless communications device (12) to obtain a plurality of purchased goods and/or services from a group of vendors (14) located at a shopping location (16) by a user of the mobile wireless communications device (12), the mobile wireless communications device (12) including at least one profile of the user, the method comprising:

receiving at one or more servers (18) a communication from the mobile wireless communications device, the communication including a user selection of two or more goods and/or services to be purchased by the user of the mobile wireless communications device on or before the user shops at the shopping location, the one or more servers (18) including information stored therein regarding vendors at the shopping location and information regarding goods and/or services offered by the vendors;

in response to the user selection of the two or more goods and/or services and the information regarding vendors located at the shopping location and the goods and/or services offered by the vendors, determining, at the one or more servers (18), a list of two or more vendors at the shopping location (16) that provide ones of the two or more goods and/or services;

transmitting, from the one or more servers (18) to the mobile wireless communications device (12), the list of the two or more vendors; and

at the mobile wireless communications device (12), determining an itinerary (120) based on the received list of two or more vendors and on at least one profile of the user; and

displaying the itinerary (120) to the user, where the itinerary reflects a choice in an order of visiting the

two or more vendors, the choice being based at least on the profile."

Claim 1 of the second auxiliary request reads as follows:

"A method of facilitating shopping with a mobile wireless communications device (12) to obtain two or more goods and/or services from two or more vendors of a group of vendors (14) located at a shopping location (16) by a user of the mobile wireless communications device (12), the mobile wireless communications device (12) including at least one profile of the user, the method comprising:

receiving at one or more servers (18) a communication from the mobile wireless communications device (12), the communication including a user selection of two or more goods and/or services to be purchased by the user of the mobile wireless communications device (12), the one or more servers (18) including information stored therein regarding the plurality of vendors at the shopping location (16) and information regarding goods and/or services offered by the plurality of vendors;

determining a list of two or more vendors at the shopping location (16), where a first vendor of the two or more vendors provides a first of the two or more goods and/or services and a second vendor of the two or more vendors provides a second of the two or more goods and/or services;

transmitting from the one or more servers (18) to the mobile wireless communications device (12) the list of two or more vendors;

at the mobile wireless communications device (12), determining an itinerary (120) for the user based on the received List of the two or more vendors and at least one profile of the user; and

displaying the itinerary (120) to the user, where the itinerary includes the first vendor and the second vendor and reflects a choice in an order of visiting the two or more vendors where the choice is based at least on the profile."

Claim 1 of the third auxiliary request adds to claim 1 of the main request in the second feature that the server identifies the vendors additionally in response to "at least one profile of the user" and at the end of the claim that "the at least one profile specifies that the itinerary (120) is one of:

a shortest distance of travel between the identified vendors (14);

a fastest itinerary of travel between the identified vendors."

Claim 1 of the fourth auxiliary request adds to claim 1 of the main request at the end of the first feature "wherein the mobile wireless communication device is not proximate to the shopping location such that the mobile wireless communication device is not sensed by low power RF communication system installed in the shopping location", a new third feature of "sensing a position of the mobile wireless communication device by the low power RF communication system", and at the end of the claim that the itinerary is "based upon the position of the mobile wireless communication device."

Reasons for the Decision

1. The application acknowledges systems that show on a mobile device available products as a shopper moves around in a shop. In addition, D1 describes a system for finding a *single* vendor in advance that can fulfil

a customer's order, possibly including more than one item, based on their relative locations, e.g. the nearest one.

2. The invention is essentially that the shopper enters two or more desired goods/services into the mobile device before going shopping and the device displays a shopping itinerary showing an order (sequence) in which the shopper can visit a *group of* vendors to obtain them. The itinerary is a function of a user profile, e.g. requiring shortest distance between vendors, or goods at cheapest purchase price.

Main request

3. The Board cannot see any prejudicial error in the examining division's conclusion that the subject-matter of claim 1 of the main request does not involve an inventive step (Article 56 EPC 1973).
4. It is common ground that claim 1 of the main request differs from D1 in that the user can obtain goods from a plurality of vendors located at the shopping location and in that the user is provided with an itinerary with the choice of an order to visit the identified vendors, the itinerary being a function of a profile of the user.
5. The examining division considered that obtaining goods from a plurality of vendors was not technical and was not relevant for assessing inventive step (point 2.1 of the decision). The problem was seen to be how to provide a technical means to optimise an itinerary (point 2.4). By including the feature of the itinerary in the problem, it appears that the division must have considered that it did not contribute to inventive

- step, i.e. was also non-technical. The solution of the provision of the choice of an order of visiting vendors and making the itinerary a function of a user profile were considered to be obvious (point 2.6).
6. However, the Board goes further than the examining division and does not consider that the features of providing a choice of an order of visiting vendors and making the itinerary a function of the user profile have any technical effect either. In the Board's view, the overall effect of the method, namely to produce an ordered list of shops, is not technical.
 7. The appellant considers that the selection of a group of vendors at a shopping location contributes to the technical character of the invention. Decision G 1/04 is referred to as noting that a non-technical feature may interact with technical elements so as to produce a technical effect. This decision refers to T 603/89 - Marker/BEATTIE OJ EPO 1992,230 as the basis for this statement.
 8. This decision in turn cites T 26/86 - X-ray apparatus/ KOCH & STERZEL OJ EPO 1988,19 as an example where the mix of technical (X-ray apparatus) and non-technical features (computer program) as a whole produces a technical effect (extending of the life of an X-ray tube). It also gives the counterexample of T 158/88 Character form/SIEMENS OJ EPO 1991,566 where the technical features (displaying characters on a screen) and non-technical features (processing data according to the specific selection criteria) produce an effect (replacing data representing a specific character form by data representing the same character in a different form) that differs only in the information displayed, and is not technical. In T 603/89 itself, the technical

features (physical marker that is placed on keyboard of an instrument) and non-technical features (displaying numbers and notes) produce an effect (improvement of a teaching method) that is an improvement of a method for performing a mental act and thus also not technical.

9. In the present case, the appellant argues that the alleged non-technical feature of the information regarding the group of vendors "interacts with technical elements, in the form of the server 18, to produce a technical effect in the selection of vendors and the transmission of processed information regarding that selection to the mobile wireless communications device". However, in the Board's view, this is an instance of the well known argument that could be termed the "technical leakage fallacy", in which the intrinsic technical nature of the implementation leaks back into the intrinsically non-technical nature of the problem. In this case, the "selection of vendors" is not a technical effect and the mere "interaction" with technical elements is not enough to make the whole process technical as required by the jurisprudence. Similarly, the transmission of the selection is no more than the dissemination of information, which is in itself also not technical. These effects are more like those in T 158/88 and T 603/89 than in T 26/86 (supra). Technical considerations only come into play once the relevant features are implemented.
10. The appellant also argued that the difference of identifying a group of vendors rather than a single vendor as in D1 implied a problem of logistics, which was not a business method. However, the Board considers that a logistic or navigation system that actually involves navigation to a particular place might have some technical element, but the present invention does

not as it does not involve any physical elements, but simply indicates possible choices. Moreover, in the Board's view, producing an itinerary is not technical as it involves only standard human behavioural concepts such as going to the bank and then going to the supermarket. The appellant replied that the physical act of going to the locations conferred technical character on these thoughts.

11. Here again, the Board sees something of a well known argument that could be termed the "broken technical chain fallacy" after decision T 1741/08 - GUI layout/SAP. This decision dealt with the fairly common situation that arises in connection with graphic user interfaces (GUIs) where a technical effect might result from the user's reaction to information. The decision essentially concluded (see point 2.1.6) that a chain of effects from providing information to its use in a technical process is broken by the intervention of a user. In other words, the possible final technical effect brought about by the action of a user cannot be used to establish an overall technical effect because it is conditional on the mental activities of the user. This applies to the present case because any possible technical effect depends on the user's reaction to the itinerary.

12. The appellant also argued that according to T 362/90 - Schaltanzeige für eine Gangschaltung/WABCO, providing a status indication about the state of a system was a technical effect. It is true that T 115/85 - Computer-related invention/IBM OJ EPO 1990,030 states that giving visual indications automatically about conditions prevailing in an apparatus or system is basically a technical problem. In that case the system was the input/output device of a text processor.

T 362/90 cites this decision in support of the technical character of a simultaneous optical display of a current and ideal gear selection based on conditions in a gearbox. In the Board's view, the display of an optimal shopping itinerary is different because there is no comparable technical system since shopping is intrinsically non-technical. The availability of goods in a shop and information on shopping lists are not comparable with the status of a technical system. Furthermore, although the system of the invention has a server and a mobile device that are undoubtably technical, the invention is not displaying information about the status of these devices themselves, but only non-technical information that they process.

13. In summary, therefore, the Board is of the opinion that a technical effect may arise from either the provision of data about a technical process, regardless of the presence of a user or its subsequent use, or from the provision of data (including data that on its own is excluded, e.g. produced by means of an algorithm) that is applied directly in a technical process. In the Board's view, neither applies to the present case.
14. Thus, in the Board's view, the appellant's formulation of the problem as "the provision of a technique which has greater flexibility and can provide results tailored to a user's preferences" is not a technical problem and is also far too general because it does not correctly take into account non-technical aspects. In the Board's view, the problem is the much more specific one of how to modify the prior art to implement the non-technical aspects, in this case how to plan a shopping trip (itinerary) that includes orders from different vendors.

15. Concerning the implementation, the Board first notes that it is essentially only claimed in functional terms and that there are no details of how it is actually done. The only technical features of the solution are the hardware elements themselves and the specification of which elements perform the various steps. The elements of a mobile wireless communications device and a server are conventional and moreover known from D1. The only assignment of function that is specified is that the server determines the vendors as function of the orders and the location. Since D1 determines the vendor for a single order at the server, it would be obvious to consider determining multiple vendors in the case of multiple orders.

16. At the oral proceedings, the appellant stressed that the system of D1 only identified one facility whereas the invention identified a group of vendors and gave navigation information about how to visit them. If the system of D1 were to be used to order several items, it would only return information on a single vendor that could supply all the items. There might be no single vendor capable of doing this, or the vendor might be a long way away from the customer. The invention would be able to find more than one vendor that together could fulfil the order. Thus the invention solved the problem of reducing the number of failed attempts to fulfil an order. In the Board's view, this is another example of a standard argument, which could be termed the "non-technical prejudice fallacy". The argument essentially invokes non-technical aspects as a reason for not modifying the prior art, whereas these features cannot in fact contribute to inventive step. The question is not whether the skilled person would consider providing these features because that has already been decided in

formulating the technical problem. The question is simply how it would be done. As mentioned above, in this case, the "how" comprises conventional hardware carrying out the tasks in an obvious way. In particular, there is no technical reason why the skilled person would not have considered modifying the various parts of the system of D1, at least to the extent claimed, to solve the problem posed.

17. It follows from the above, that in the Board's view, the appellant's analysis of why the repeated selection of vendors according to D1 is not equivalent to the claimed solution is moot.
18. Accordingly the Board judges that claim 1 of the main request does not involve an inventive step (Article 56 EPC 1973).

Subject-matter of the dependent claims

19. The appellant requested that, should the main request be rejected, the subject matter of each of the dependent claims be considered. The main request consists of claim 1 with 13 claims dependent on it, and the further independent claims 15 and 18 with dependent claims referring to them, making a total of 29 claims.
20. According to the principle of party disposition, it is the applicant who sets the framework of the procedure. He must present his requests and the EPO can only decide upon the European patent application in the text submitted to it, or agreed by him (Article 113(2) EPC). From this principle it follows that it is the applicant's obligation to formulate his requests in such a way that the EPO is put in a position to decide on them without any further investigations about what

the applicant's petition is. This means that the exact wording of the claims must be clear and, at the same time, it must be immediately clear for which claims grant of a patent is sought. In decision T 382/96 (see point 5.2 of the reasons), the Board stated that the applicant is responsible for determining the content of the patent and cannot, by presenting a large number of requests, still less incomplete variants of requests, shift this responsibility de facto to the Board.

21. In the present case, the appellant's request was that the subject matter of the dependent claims be considered. When assessing the formal and substantive requirements for the grant of a patent, the individual features of the claims must be examined and not subject matter to which the claims might be directed. It is the appellant's task to formulate the wording of a claim, or set of claims, in order to get protection for the subject matter it wants to be covered. So for this reason already, the request is not precise.

22. However, even if one accepted that what was meant were the individual features of each of the dependent claims, this would not yet result in an unambiguous wording of the respective claims. For example, 13 claims are dependent on claim 1. The dependencies are partly related to all previous claims, partly to a single or selected preceding claims. It is not up to the Board to go through the set of claims, to draft for all possible combinations alternatives of claims, to examine one after the other individually and at the end propose a set of claims which would be allowable. As set out above, this would go against the principle of party disposition. It would shift the responsibility for the claim formulation to the Board and result in a "fishing around" for patentable subject matter rather

than presenting a clearly perceived invention (see R 11/08 - Fundamental violation of Article 113 EPC and procedural defect under Rule 104(b) EPC/PANASONIC, point 15 of the reasons). Furthermore, the Enlarged Board concluded at point 12 of the reasons in R 11/08, that unless in written form, requests cannot be checked for their exact text so, without that possibility, they are not clearly ascertainable. Moreover, apart from claim 1, the main request consists of two further independent claims with claims dependent on them. It is not clear at all how these claims form part of the appellant's request, whether they are claimed in combination or separately from each other. Thus the set of claims cannot be clearly identified.

23. Also the appellant's further submissions give no hint what the invention was to be since the appellant did not file any substantial arguments with respect to the features of the dependent claims. Apparently, the appellant did not have any concrete idea either since the only argument given was that the remaining (i.e. the dependent) claims defined subject matter that was non-obvious by their dependency on claim 1, 15 or 18 (see page 11, second paragraph of the statement of grounds of appeal). This all indicates that the appellant indeed wanted to shift the responsibility for the claim formulation to the Board, which cannot be accepted. Therefore, the Board considers this request as inadmissible. The same applies for the requests that the subject matter of the dependent claims be considered if the first or second auxiliary requests were rejected.

First and second auxiliary requests

24. Claim 1 of the request actually named as the first auxiliary request essentially adds the aspects that it is the mobile device that stores the user profile and determines the itinerary.
25. In the Board's view, these are routine design choices that the skilled person would consider, depending on the circumstances, such as reducing data transmission as stated by the examining division at points 3.5 to 3.7 of the decision.
26. The appellant argued that in D1 the mobile device only functioned as an ordering device and did not perform any calculations so that there was no incentive to provide the features. However, the Board considers that the skilled person does not need an explicit incentive to consider such limited and routine design choices. Also the Board notes that the description mentions both possibilities at page 14, lines 3 to 8 and does not indicate any specific advantage for the claimed one.
27. Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request by the explicit specification of first and second vendors and the deletion of the feature of receiving the user selection on or before shopping. The appellant agreed that this claim essentially only clarified the fact that there was a plurality of vendors. Thus the Board agrees with the examining division at point 4 of the decision that this does not change the assessment of inventive step.

Third and fourth auxiliary requests

28. The third and fourth auxiliary requests were filed during the oral proceedings before the Board. Article 13(1) RPBA gives the Board a discretion to admit such amendments based inter alia on the complexity of the new subject-matter, the current state of the proceedings and the need for procedural economy. Additional criteria for admitting late filed requests have been developed by the jurisprudence with respect to Rule 137(3) EPC which include clear allowability, overcoming existing objections, not introducing further objections, no shift or divergence of subject-matter (see the Case Law of the Boards of Appeal 6th edition, 2010, VII.E.16.3.3, 16.4.1 and 16.5).

29. The Board first notes that in the present case there is no clear justification for the late filing of the third and fourth auxiliary requests.

30. Claim 1 of the third auxiliary request adds some characteristics of the itinerary from claim 2 and the feature that the identification of vendors at the server is a function of the user profile. This was said to be supported at page 14, lines 3 to 8 of the application as filed. This passage states that "...the personal profile(s) is utilised...to select the desired criteria for the itinerary in the shopping location 16 of obtaining from the whole host of possible available goods and/or services and vendors thereof, those goods and/or services which are to be purchased from particular vendors". In the Board's view, this passage is not saying that the profile specifies which vendors are to be used. Rather it is making the general statement that the profile contains the criteria for determining which goods are to be purchased from which

ones ("particular vendors") of the available vendors. These criteria are given in the previous and subsequent passages and specification of preferred vendors is not mentioned. Thus, in the Board's view, even if it might be an obvious and/or desirable thing to do, the application does not directly and unambiguously disclose the feature. At the very least, the basis of this feature in the original disclosure is, on the face of it, problematic, and is thus not straightforward. Consequently, these amendments raise new issues under Article 123(2) EPC and should not be admitted at this late stage.

31. Claim 1 of the fourth auxiliary request adds features relating to the use of a low power RF communication system in the shopping location. The appellant stated that an itinerary is overlaid on the map when the user gets closer to the location and that these features solved the problem that an order may be placed even when the user's location is not known. This problem is completely different to the ones discussed up to this point in the proceedings. It contains a large shift in the essence of the invention which necessitates extensive discussion of the prior art which has not been examined so far under this aspect (and might even necessitate an additional search). This cannot be reasonably expected to be done without adjournment of the oral proceedings (Article 13(3) RPBA).
32. Accordingly, the Board does not admit the third and fourth auxiliary request into the proceedings.
33. At the end of the oral proceedings, the appellant filed an objection under Rule 106 EPC. He considered that his right to be heard was violated because he had had no possibility to argue on his requests that the subject

matter of the dependent claims be considered. The appellant agreed that he had been heard on the admissibility of these requests but not on the allowability. Since the Board decided that these requests were not admissible because they were not sufficiently clear and did not base its decision on the allowability of these requests, the Board finds that the appellant's right to be heard was not violated. Thus this objection is dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



T. Buschek

S. Wibergh

Decision electronically authenticated