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**Datasheet for the decision
of 31 July 2012**

Case Number: T 1798/07 - 3.4.03

Application Number: 02078832.9

Publication Number: 1293923

IPC: G07F 19/00, G06F 17/60

Language of the proceedings: EN

Title of invention:
Arrangement and method for tele-commerce with client profiles

Applicant:
Koninklijke KPN N.V.

Headword:
-

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

Keyword:
"Inventive step (no)"

Decisions cited:
T 0641/00

Catchword:
-



Case Number: T 1798/07 - 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 31 July 2012

Appellant: Koninklijke KPN N.V.
(Applicant) Stationsplein 7
NL-9726 AE Groningen (NL)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 6 June 2007
refusing European patent application
No. 02078832.9 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: V. L. P. Frank
Members: R. Q. Bekkering
T. Bokor

Summary of Facts and Submissions

- I. This is an appeal against the refusal of application 02 078 832 for lack of an inventive step, Article 56 EPC 1973.
- II. In the decision under appeal it was held that the technical skeleton disclosed in the wording of claim 1 did not amount to more than four networked standard general-purpose computers. No written evidence was required to prove that standard general-purpose computers connected so as to form a network were well-known before the priority date of the application. The only features of claim 1 that might be considered as being novel were business and/or administrative method steps. The subject matter of claim 1, thus, comprised a mixture of technical and non-technical features. However, those non-technical (business related software) features did not interact with the well-known hardware so that the technical contribution of claim 1 amounted to zero contrary to the requirements of Article 56 EPC.
- III. With the statement setting out the grounds of appeal the appellant requested:
1. Main request: to set aside the decision of the Examining Division that the annexed claims in accordance with the main request did not form a technical invention in view of any prior art four computer networked arrangement, to refer the case back to the Examining Division and to order the Examining Division to assess the novelty and

inventive step in view of the documents referred to in the European search report;

2. Auxiliary request: if the Board of Appeal rejected the main request, to either grant a European patent on the annexed claims in accordance with the auxiliary request or to refer these claims back to the Examining Division;
 3. To conduct oral proceedings in case the Board of Appeal considered to reject the main request.
- IV. Reference is made to the following prior art:

D7: US 5 878 141 A.

- V. A summons to oral proceedings was issued by the board on 13 March 2012, provided with an annex in which a provisional opinion of the board on the matter was given.

In particular, the appellant was informed that, although the board agreed that the claimed technical implementation involved more than a four computer networked arrangement, referring back the case to the examining division was not considered appropriate for reasons of procedural economy and that accordingly it would appear that the main request should be rejected.

Moreover, assuming that the appellant also implicitly requested that the board granted a patent on the claims of the main request, it was noted that it appeared that the subject-matter of claim 1 of the main request lacked an inventive step both over common general

knowledge of a person skilled in the art and over document D7.

Furthermore, it was noted that the subject-matter of claim 1 of the auxiliary request also appeared to lack an inventive step in the sense of Article 56 EPC 1973 on the basis of the same prior art.

No arguments were provided by the appellant in response to the board's observations. The appellant merely informed the board that the applicant would not attend the scheduled oral proceedings and requested a decision on the file as it stood.

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

"A system comprising a transaction operator processor (1) for supporting a transaction, the transaction including at least receiving an instruction from a communication device (7(j)) of a client, and arranging for an automatic payment transaction associated with said transaction from a client account to a merchant account, and at least one payment provider processor (15(p)) arranged to carry out a payment, wherein said system also comprises at least one client service provider processor (5(i)) provided with a memory storing client profile data necessary for said transaction, said client profile data being pre-stored before said transaction, and said at least one client service provider processor (5(i)) being arranged to communicate said client profile data to said transaction operator processor (1) during said transaction, said transaction operator processor (1) being arranged to perform said transaction upon receipt

of and while using said client profile data and to route transaction payment data to the at least one payment provider processor (15(p))."

VII. Claim 1 of the auxiliary request reads as follows:

"A system comprising a transaction operator processor (1) and at least one communication device (7(j)) of a client, the transaction operator processor (1) being arranged for supporting a transaction, the transaction including at least receiving an instruction from said communication device (7(j)) of a client, and the system being arranged for an automatic payment transaction associated with said transaction from a client account to a merchant account, the system comprising a memory storing client profile data in relation to said client of said at least one communication device (7(j)), said client profile data being pre-stored before said transaction, characterized in that said system also comprises:

- at least one client service provider processor (5(i)) provided with said memory storing said client profile data necessary for said transaction,*
 - at least one merchant processor (11(k)), and*
 - at least one payment provider processor (15p)),*
- said system being arranged to support said automatic payment transaction as follows:*
- said at least one merchant processor (11(k)) being arranged to receive an order from said communication device (7(j)) of a client and upon receiving said order to send a transaction request to said transaction operator processor (1);*
 - said transaction operator processor (1) being arranged upon receiving said transaction request to*

request said at least one client service provider processor (5(i)) to communicate said client profile data to said transaction operator processor (1), to perform said transaction while using said client profile data and to route transaction payment data to the at least one payment provider processor (15(p)) based on said client profile data."

VIII. The appellant submitted with the statement setting out the grounds of appeal in substance the following arguments:

The examining division argued incorrectly by simply stating that all new features were non-technical and could be applied without a further technical effect on an existing network of four general-purpose computers. The features of pre-storing the client profile data in the memory of the at least one client service provider processor, making these available from the at least one client service provider processor to the transaction operator processor during a transaction and using these data during the transaction, resulted in the claimed technical advantage of enhancing speed of the system and thus contributed to inventive step.

The subject-matter of claim 1 according to the auxiliary request involved an inventive step in particular over document D7 in that D7 failed to disclose a client service provider processor, merchant processor and payment provider processor. In particular, in D7 the transaction operator processor did not receive the client profile data from a client service provider processor (absent in D7) but collected the data from its own memory.

Reasons for the Decision

1. The appeal is admissible.

2. *Main request*

2.1 *Decision under appeal*

According to the decision under appeal the technical skeleton disclosed in the wording of claim 1 did not amount to more than four networked standard general-purpose computers, well-known before the priority date of the application.

The appellant argued in the statement setting out the grounds of appeal that the features of pre-storing the client profile data in the memory of the at least one client service provider processor, making these available from the at least one client service provider processor to the transaction operator processor during a transaction and using these data during the transaction, resulted in the claimed technical advantage of enhancing speed of the system.

The board agrees. Accordingly, the corresponding features in claim 1 should be taken into consideration in the assessment of inventive step as part of the technical implementation of the underlying business method (following T 0641/00, OJ 2003, 352) over and above the four networked standard general-purpose computers considered in the decision under appeal.

2.2 *Procedural issues*

The appellant's main request is that the case be referred back to the examining division in this case.

Remittal lies within the discretion of the board (Article 111(1) EPC). Remitting the case to the examining division under these circumstances, however, is not considered appropriate by the board for reasons of procedural economy. Accordingly, the appellant's main request in this respect is rejected.

The board notes that the appellant's main request does not include a request for the grant of a patent by the board. It is, however, assumed that this is implicitly requested by the appellant.

It is noted that this assumption, advanced in the annex to the summons to oral proceedings, was not disputed in the appellant's reply.

2.3 *Inventive step*

- 2.3.1 According to established jurisprudence, an invention consisting of a mixture of technical and non-technical features and having technical character as a whole is to be assessed with respect to the requirement of inventive step by taking account of all those features, which contribute to said technical character whereas features making no such contribution cannot support the presence of inventive step. Where the claim refers to an aim to be achieved in a non-technical field, eg in the field of business methods as in the present case, this aim may legitimately appear in the formulation of

the problem as part of the framework of the technical problem that is to be solved, in particular as a constraint that has to be met (cf T 0641/00).

Thus, in the present case all steps of the underlying business method providing a transaction between a client and a merchant are part of the information provided to the technician in charge of the technical implementation and do as such not contribute to inventive step. The technical problem to be solved, thus, is to implement technically the underlying business method.

As noted above, using pre-stored client profile data enhances the speed of the transaction in that the client need not enter this data repeatedly. Accordingly, the corresponding features in claim 1 should be taken into consideration in the assessment of inventive step as part of the technical implementation of the underlying business method. However, pre-storing data which otherwise would have to be entered over and over into the system is a common measure in general. Accordingly, a person skilled in the art would include this measure without the exercise of inventive skills.

For the rest, the technical implementation of the underlying business method as defined in claim 1 of the main request merely involves four networked standard general-purpose computers, well-known before the priority date of the application.

Accordingly, the subject-matter of claim 1 of the main request is obvious to a person skilled in the art and,

therefore, lacks an inventive step in the sense of Article 56 EPC 1973.

2.3.2 In addition to the above, reference is made to document D7.

Document D7 discloses, in the terms of claim 1 of the main request, a system comprising transaction operator means (transaction processing unit 12) for supporting a transaction, the transaction including at least receiving an instruction from a communication device (18-23) of a client, and arranging for an automatic payment transaction associated with said transaction from a client account to a merchant account, and at least one payment provider means (eg credit card provider means) arranged to carry out a payment, wherein said system also comprises at least one client service provider means (transaction processing unit 12) provided with a memory storing client profile data (purchaser database 16) necessary for said transaction, said client profile data being pre-stored before said transaction, and said at least one client service provider means being arranged to communicate said client profile data to said transaction operator means during said transaction, said transaction operator means being arranged to perform said transaction upon receipt of and while using said client profile data and to route transaction payment data to the at least one payment provider means (cf figure 1 and corresponding description).

The only difference between the subject-matter of claim 1 and D7 is that processors are defined as the above means providing the respective functionalities.

Accordingly, the objective problem to be solved relative to D7 is to provide suitable means.

The provision of processors is, however, obvious to a skilled person faced with the above problem.

- 2.3.3 No arguments were submitted by the appellant in response to the board's observations provided in the annex to the summons to oral proceedings, which essentially correspond to the above.

In the statement setting out the grounds of appeal the appellant argued that document D7 failed in particular to provide a client service provider processor. However, as argued in the annex to the summons to oral proceedings, the transaction processing unit 12 of D7 also constitutes a client service provider means, claim 1 encompassing a unit comprising both a transaction operator and a client service provider processor.

- 2.3.4 Accordingly, the subject-matter of claim 1 of the main request also lacks an inventive step over D7 (Article 56 EPC 1973).

3. *Auxiliary request*

3.1 *Inventive step*

3.1.1 Claim 1 according to the auxiliary request essentially includes the following additional features with respect to claim 1 of the main request:

at least one merchant processor (11(k)), and

said at least one merchant processor (11(k)) being arranged to receive an order from said communication device (7(j)) of a client and upon receiving said order to send a transaction request to said transaction operator processor (1).

3.1.2 Having regard to the above additional features, and insofar as these are not implied by document D7 and thus distinguishing, the objective problem to be solved relative to D7 is to provide suitable means on the merchant's side.

The provision of a merchant processor, such as eg a terminal at the merchant's premises, is common in electronic transaction systems. Moreover, it is common (eg in conventional credit card transactions) that the transaction request is sent by the merchant to the transaction processing unit in the system.

Again, no arguments were submitted by the appellant in response to the board's observations provided in the annex to the summons to oral proceedings, which essentially correspond to the above.

Accordingly, the subject-matter of claim 1 of the auxiliary request is obvious to a person skilled in the art and, therefore, also lacks an inventive step in the sense of Article 56 EPC 1973.

Hence, the appellant's auxiliary requests is not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

Registrar:

Chair:

S. Sánchez Chiquero

V. L. P. Frank