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**Datasheet for the decision
of 11 November 2009**

Case Number: T 1616/08 - 3.5.01

Application Number: 99105948.6

Publication Number: 0927945

IPC: G06F 17/60

Language of the proceedings: EN

Title of invention:

Method and system for placing a purchase order via a communications network

Patentee:

Amazon.Com, Inc.

Opponents:

Gesellschaft für Informatik e.V.
Fleurop-Interflora European Business Company AG
Förderverein für eine Freie Informationelle Infrastruktur e.V.
(FFII e.V.)

Headword:

Gift order/AMAZON

Relevant legal provisions:

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Relevant legal provisions (EPC 1973):

EPC Art. 100(a)(b)(c), 111(1)(2), 56

Keyword:

"Added subject-matter (no)"
"Remittal - third auxiliary request"
"Inventive step - main request and first and second auxiliary requests (no)"

Decisions cited:

T 0208/84

Catchword:

-



Case Number: T 1616/08 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 11 November 2009

Appellant: Amazon.Com, Inc.
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Representative: -

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Representative: -

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 28 July 2008
revoking European patent No. 0927945 pursuant
to Article 102(1) EPC 1973.**

Composition of the Board:

Chairman: S. Wibergh
Members: K. Bumés
 P. Schmitz
 W. Chandler
 G. Weiss

Summary of Facts and Submissions

- I. This is an appeal of the patent proprietor against the decision of the opposition division to revoke European patent No. 0 927 945.

- II. The opposition division decided on a main request, which was for the patent-in-suit as granted, and six auxiliary requests. With respect to the main request the opposition division held in particular that the invention as defined in the claims could be carried out by the person skilled in the art but that claims 1 and 7 contained subject-matter extending beyond the application as filed. It was furthermore of the opinion that the subject-matter of these claims was new but did not involve an inventive step. The versions of claim 1 according to auxiliary requests 1-3, filed with letter dated 6 November 2007, were also found to contain subject-matter extending beyond the application as filed, whereas claim 1 of auxiliary requests 4-6, filed during the oral proceedings, had been amended in such a way as to extend the protection conferred.

- III. In the statement setting out the grounds of appeal, the appellant requested that the decision under appeal be set aside and that the Board decide on the allowability of the requests on file.

- IV. The respondents did not file any substantive replies.

- V. Oral proceedings, attended by the appellant and respondent 3, were held on 11 November 2009. In the course of the proceedings the appellant withdrew its auxiliary requests 4-6 and requested that the decision

under appeal be set aside and a patent be maintained as granted or in amended form on the basis of the claims according to auxiliary requests 1 to 3 filed with letter dated 6 November 2007.

Respondent 3 requested that the appeal be dismissed.

VI. Claim 1 *as granted* reads:

"A method in a computer system for ordering a gift for delivery from a gift giver to a recipient, the method comprising:

receiving (1401, 1404) from the gift giver an indication that the gift is to be delivered to the recipient and an electronic mail address of the recipient; and

sending (1409) to a gift delivery computer system an indication of the gift and the received electronic mail address,

wherein the gift delivery computer system coordinates delivery of the gift by:

sending (1501b) an electronic mail message addressed to the electronic mail address of the recipient, the electronic mail address */sic, obviously "message" is intended/* requesting that the recipient provide delivery information including a postal address for the gift; and

upon receiving the delivery information, electronically initiating (1701-1708) delivery of the gift in accordance with the received delivery information".

Claim 7 is for a computer-readable medium containing instructions corresponding to the method.

VII. According to *auxiliary request 1* filed with letter dated 6 November 2007, the method additionally comprises the initial steps of:

"selecting by the gift giver an item displayed on a website during a browser session;
adding the item to a shopping cart;
buying the item as a gift".

VIII. According to *auxiliary request 2* filed with letter dated 6 November 2007, the following final step is added to claim 1 of the preceding request:

"wherein when the recipient does respond to the electronic mail message, the delivery information is automatically extracted from the electronic mail message /sic, obviously "the recipient's reply message" is intended/".

IX. According to *auxiliary request 3* filed with letter dated 6 November 2007, claim 1 reads:

"A method in a client computer system for ordering a gift for delivery from a gift giver to a recipient, the method comprising:
receiving from a server system a client identifier of the client system;
persistently storing the client identifier at the client system;
displaying information identifying an item and displaying an indication of a single action that is to be performed to order the identified item;
selecting by the gift giver the displayed item on a website during a browser session by the indicated

single action and sending to a server system the single action order to order the identified item and automatically sending the client identifier whereby the gift giver does not input identification information when ordering the item; wherein said single action results in buying the item as a gift, receiving (1401, 1404) from the gift giver an indication that the gift is to be delivered to the recipient and an electronic mail address of the recipient; and sending (1409) to a gift delivery computer system an indication of the gift and the received electronic mail address, wherein the gift delivery computer system coordinates delivery of the gift by: sending (1501b) an electronic mail message addressed to the electronic mail address of the recipient, the electronic mail address */sic, obviously "mail message" is intended/* requesting that the recipient provide delivery information including a postal address for the gift; and upon receiving the delivery information, electronically initiating (1701-1708) delivery of the gift in accordance with the received delivery information, wherein when the recipient does respond to the electronic mail message, the delivery information is automatically extracted from the electronic mail message */sic, obviously "from the recipient's reply message" is intended/*.

Reasons for the Decision

1. The invention

The invention relates to a computer method for ordering a gift from a gift giver (purchaser) to a recipient. As explained in the description (paragraphs [0001] to [0007] of the patent specification), the World Wide Web has been widely used for conducting electronic commerce. Many web servers have been developed through which vendors can advertise and sell products. These can include items (eg music) that are delivered electronically to the purchaser over the Internet and items (eg books) that are delivered through conventional distribution channels. The selection of the various items from the electronic catalogues is generally based on the "shopping cart" model, meaning that when the purchaser selects an item from the electronic catalogue the server metaphorically adds that item to a shopping cart. Usually, when the purchaser has finished selecting the items to be purchased, the server prompts the purchaser for information to complete the ordering of the items. This information may include the shipping address.

The stated object of the present invention is to provide a mechanism for giving a gift to an identified recipient (paragraph [0044] of the patent specification). When information is displayed describing the item, the system displays an instruction to identify the recipient and then to select a "give" button to effect the giving of the item to the identified recipient (cf fig. 9A and 9B). The gift giver enters identifying information of the recipient,

such as his e-mail address. It is thus not necessary that the exact address of the recipient is known at the time the order is received.

The appellant's main request

2. The appellant's main request is for maintenance of the patent as granted. Claims 1 and 7 will now be considered.

3. Article 100(c) EPC 1973

- 3.1 The opposition division decided that the pre-grant addition of the claim feature "postal address" ("requesting that the recipient provide delivery information *including a postal address*") had introduced subject-matter absent from the application as filed, contrary to Article 123(2) EPC. Claim 1 of the application as filed only mentioned "delivery information" and "sufficient delivery information". It was argued (cf the decision under appeal, p. 8) that even if a postal address might be important with respect to delivery information it would not automatically be considered as "sufficient delivery information". "Sufficient delivery information" did not always include a postal address, for example if the gift was a money transfer. Furthermore, it was not possible to deduce from fig. 18 of the patent specification (corresponding to fig. 19 of the patent application), showing a verification of the delivery information, that a postal address was always given.

The decision further indicates that one of the respondents had argued that "sufficient delivery

information" was not limited to a postal address but could be, for example, the time of delivery. Therefore, the introduction of the expression "postal address" was an undisclosed selection among different possibilities.

3.2 The Board regards the addition of the feature "postal address" as allowable for the following reasons. Firstly, the determination "whether the delivery address is a valid U.S. Postal Service address" (cf paragraph [0040] and fig. 19 of the patent application) *only* makes sense if a postal address is what the vendor has asked for. The feature is therefore implicitly disclosed, as the appellant has always argued.

Secondly, it is true that the description mentions electronic deliveries (of music, not money; see paragraph [0004] of the patent application), but only under the heading "Background of the invention". Clearly such a vague hint - if it can at all be called a hint - cannot invalidate the disclosure of the delivery by post, or reduce it to an undisclosed selection.

Thirdly, the claim context must be considered, and the context is that the system (vendor) sends an e-mail to the gift recipient asking for his address. The feature is thus not concerned with the information the recipient actually gives, but with the information the vendor asks for. As already noted, the patent must be understood as disclosing that the system asks for a postal address. Whether or not the recipient replies by adding further indications, such as a suitable time of delivery (a possibility which the application also does not mention), is therefore irrelevant.

Thus, the feature that the request includes a postal address has a basis in the application as filed.

3.3 The opposition division decided that the further objections under Article 100(c) EPC 1973 raised by the respondents against claims 1 (and 7) were not valid. No arguments against this finding have been presented in the appeal proceedings, and the Board cannot see *prima facie* that it would be wrong. It is therefore concluded that the subject-matter of claims 1 and 7 does not extend beyond the content of the application (or the parent application) as filed.

4. Article 100(a) EPC 1973

4.1 The opposition division argued that the invention was obvious for a technically skilled person desiring to implement on a notoriously known computer system the claimed solution to the administrative problem of "how to be sure that the person entering the postal address in the database knows the correct address" (decision, p. 9).

4.2 The Board agrees that the subject-matter of claim 1 is obvious. The problem underlying the invention is that at the time the order for the delivery is received the exact address of the recipient may not be known (cf point 1 above). Simply asking the recipient for his address is a non-technical step. Equally non-technical is the idea of having the vendor - rather than the purchaser - contact the recipient. Technical is therefore only the computer system itself and the means for communicating with the recipient, namely e-mail.

But these technical means were well known at the priority date, and the invention simply uses them in a straightforward, conventional manner.

- 4.3 The Board does not deny that, as the appellant has pointed out, the claimed system is new (over the notorious prior art) and involves technical considerations. This is however not enough. Novelty is not denied and technical considerations do not necessarily have inventive quality. The only relevant criterion for inventive step is the one stated in Article 56 EPC 1973, namely whether the invention is obvious to a person skilled in the art. Since in accordance with established jurisprudence this "art" cannot be a field of business or administration, only elements of the solution falling within the competence of a technically skilled person (here: a programmer or computer scientist) can be taken into account.
- 4.4 The appellant has furthermore argued that if inventions are denied patent protection only because they involve software, also devices such as anti-lock braking systems would be unpatentable. The Board does not see this risk since the Boards of Appeal have from early on acknowledged the patentability of inventions which include software *contributing to a technical effect* (see eg T 208/84 "Computer-related invention/VICOM", OJ EPO 1987,14). Computer-implemented business methods, on the other hand, normally involve no such contribution (beyond the implementation itself).
- 4.5 It follows that the subject-matter of claim 1 does not involve an inventive step.

The appellant's auxiliary request 1

5. Article 111(1) EPC 1973

The opposition division refused auxiliary requests 1-3 under Article 123(2) EPC for the same reason as the main request. These claims have therefore not been examined with respect to all requirements of the EPC. Pursuant to Article 111(1) EPC 1973, the Board may either go on examining the auxiliary requests or remit the case to the opposition division. In reply to the Board's question during the oral proceedings, the appellant declared that it preferred a remittal whereas respondent 3 preferred the Board to continue the examination.

As to auxiliary request 1, it is noted that it involves only relatively small amendments to the claims. It will therefore be examined by the Board.

6. Article 56 EPC 1973

Compared with the main request, claim 1 of auxiliary request 1 further specifies that the gift giver selects an item displayed on a website during a browser session, and that the item is added to a shopping cart and bought as a gift. The Board notes that web commerce involving a "shopping cart" is acknowledged as known in the description (paragraphs [0004] and [0006] of the patent specification). Its use in the context of computerized gift giving must be regarded as an obvious choice. Thus the subject-matter of claim 1 does not involve an inventive step.

The appellant's auxiliary request 2

7. Article 111(1) EPC 1973

Also according to auxiliary request 2 the amendments to claim 1 are relatively small, and the Board will decide on the request.

8. Article 100(b) with 83 EPC 1973

The opposition division decided that the objection under Article 100(b) EPC 1973 raised by respondent 1 against claim 2 of the main request was not valid. This objection concerned the feature relating to the automatic extraction of delivery information, which is now included in claim 1 of auxiliary request 2. No arguments against the opposition division's finding have been presented in the appeal proceedings and the Board cannot see *prima facie* that it would be wrong.

9. Article 56 EPC 1973

The mere wish to automate process steps that have previously been performed manually is usually regarded as obvious. The automation details may naturally be inventive, but in the present case the problem of how to extract the delivery information is left entirely to the skilled person. Thus an inventive step is neither involved in the idea to extract information automatically, nor in its implementation. The subject-matter of claim 1 is therefore obvious.

The appellant's auxiliary request 3

10. Article 111(1) EPC 1973

Claim 1 of this request has been substantially amended. It now includes the features relating to the single-action ordering of items described with reference to fig. 1-8 of the patent. Since these features were not included in the claims of the (divisional) application as filed, they cannot be assumed to have been searched. Nor do they clearly relate solely to a business concept, so that merely notorious prior art cannot be assumed to suffice to examine the invention for inventive step. Under these circumstances the Board decides to remit the case to the opposition division for further prosecution.

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 on the basis of the claims of auxiliary request 3.

The Registrar:

The Chairman:

T. Buschek

S. Wibergh