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**Datasheet for the decision
of 20 November 2013**

Case Number: T 1213/09 - 3.4.01
Application Number: 01995976.6
Publication Number: 1470525
IPC: G06K15/00, G07F19/00, G07G1/00,
G06F17/60, G07G5/00
Language of the proceedings: EN

Title of invention:
METHOD AND SYSTEM FOR PROVIDING REBATES

Applicant:
Catalina Marketing Corporation

Headword:

Relevant legal provisions:
EPC 1973 Art. 54(1), 54(2), 56, 84
EPC R. 43(2)

Keyword:
Clarity - all requests (no)
Novelty - main request (no), first auxiliary request (no)
Inventive step - second auxiliary request (no), third
auxiliary request (no)

Decisions cited:

Catchword:



**Beschwerdekammern
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Chambres de recours**

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Case Number: T 1213/09 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 20 November 2013

Appellant: Catalina Marketing Corporation
(Applicant) 200 Carillon Parkway
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Representative: Potter, Julian Mark
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 23 December 2008 refusing European patent application No. 01995976.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: G. Assi
Members: T. Zinke
M. Vogel

Summary of Facts and Submissions

I. The appeal filed on 20 February 2009 lies from the decision of the Examining Division, posted on 23 December 2008, refusing European patent application No. 01 995 976.6 published with the publication No. 1 470 525. The appeal fee was paid on the same day. The statement setting out the grounds of appeal was filed on 4 May 2009.

II. In the decision under appeal, the Examining Division stated that the subject-matter of independent claims 1 and 16 according to the then pending main, first and second auxiliary requests did not fulfil the requirements of Article 123(2) EPC because of the added wording "*human readable*". Further, it was held that the subject-matter of all claims of the main, first and second auxiliary requests did not fulfil the requirements of Article 56 EPC 1973, respectively, citing, inter alia, documents

D1: EP-A-0 511 463;

D4: FR-A-2 765 988.

The Examining Division found that the independent claims of all requests comprised a mixture of both technical and non-technical features. The technical features were derivable, e.g. from document D1, whereas the non-technical features defined a method of doing business. The skilled person (a computer specialist) would use commonplace programming skills and computer knowledge in order to implement a process according to business requirements. Moreover, no surprising technical effect could be established by printing all the information for a user on a document and electronically communicating information to a clearing

house. The additional features as claimed in the first and second auxiliary request of determining a total rebate amount for a plurality of products and of entering customer information, so as to produce a customer-specific rebate form, respectively, were also considered to be administrative requirements, which could be solved by a person skilled in the art without inventive activity.

- III. In the notice of appeal the appellant (applicant) requested that the decision under appeal be set aside. With the statement of grounds the appellant withdrew the requests underlying the decision under appeal and filed as new requests a set of claims 1 to 25 according to a main request, a set of claims 1 to 25 according to a first auxiliary request, a set of claims 1 to 25 according to a second auxiliary request and a set of claims 1 to 25 according to a third auxiliary request.
- IV. In the statement of grounds the appellant removed the objected term "*human readable*" from the claims.

Further, the appellant submitted that neither the invention nor the contribution to the art related to a business idea. Rather, a new and useful technical system and method for the creation and distribution of rebate forms were disclosed providing reduced resource/energy usage and a fraud-prevention technology. The claimed invention should thus be qualified as a combination invention for a much more efficient and effective rebate system. With regard to inventive step of such a combination invention, a "*surprising effect*" was not a necessary condition to be met. The decisive criterion was whether the state of the art would (not could) lead a skilled person to the claimed combination of possibly known features.

With regard to document D1, the appellant explained that it did not disclose a rebate program or a system and method for creating and processing rebate forms. It also did not disclose retrieving rebate information and formatting a rebate form for printing on the same strip of paper as the cash register receipt.

In addition, no prior art disclosed that the information printed on the rebate form includes a verification code, nor that it is machine readable.

With regard to the first auxiliary request, the appellant further mentioned that there was no motivation in the prior art to summarize a plurality of rebates into a single rebate form, because they would have to be sent to different manufacturers for redeeming different rebates.

The provision of a data entry terminal and of customer-specific rebate forms, as additionally claimed in the independent claims of the second auxiliary request was not disclosed in the prior art and provided an advance with regard to the speed of processing of the rebate forms at the clearinghouse.

In the independent claims of the third auxiliary request, it was additionally claimed that the rebate form is printed on the same strip of paper as the cash register receipt, this feature not being disclosed in the prior art and resulting in saving resources due to less printing.

V. With a communication of 27 June 2013 the appellant was summonsed to oral proceedings to take place on

20 November 2013. With a communication of 9 July 2013 the Board drew attention to the issues to be discussed.

VI. The appellant did not attend the oral proceedings as announced by letter of 13 November 2013.

VII. Independent claim 1 of the main request reads as follows:

*"1. A computer-implemented method of producing rebate forms, the method comprising steps of:
detecting (s204), using a scanner (106) during a purchase transaction in which a product is being purchased, an identification code of said product at a point-of-sale (102, 110);
accessing (s206), during said transaction, based upon said identification code, predetermined program information in a database (118-122) for one or more predetermined programs;
using a controller (100), determining (s208, s210) from the predetermined program information whether said product has an associated predetermined program; and
if the determination in the previous step is positive, printing (s232) a document using a printer (108) at the point-of-sale during or immediately after said purchase transaction, the document thereby containing printed information relating to the predetermined program associated with said product,
characterised by the predetermined program(s) being rebate programs, by the document being a rebate form that is machine readable at a clearinghouse;
by the method including, prior to said printing step,
retrieving (s226) rebate information from a rebate information database (120), and,
formatting (230) the rebate form for printing; and*

after the printing step, electronically communicating the verification code to the clearing house, and by said printed information including each of (1) a rebate form and (2) said verification code, the rebate form incorporating proof of purchase for said product, and wherein said verification code is in machine readable form."

Independent claim 16 claims a corresponding apparatus for producing rebate forms and claims 2 to 15 and 17 to 25 are dependent claims.

Independent claim 1 of the first auxiliary request reads:

"1. A computer-implemented method of producing rebate forms, the method comprising steps of: detecting (s204), using a scanner (106) during a purchase transaction in which a product is being purchased, an identification code of said product at a point-of-sale (102, 110); accessing (s206), during said transaction, based upon said identification code, predetermined program information in a database (118-122) for one or more predetermined programs; using a controller (100), determining (s208, s210) from the predetermined program information whether said product has an associated predetermined program; and if the determination in the previous step is positive, printing (s232) a document using a printer (108) at the point-of-sale during or immediately after said purchase transaction, the document thereby containing printed information relating to the predetermined program associated with said product,

characterised by the predetermined program(s) being rebate programs, by the document being a rebate form that is machine readable at a clearinghouse; by the method including, prior to said printing step, retrieving (s226) rebate information from a rebate information database (120), and, formatting (230) the rebate form for printing; and after the printing step, electronically communicating the verification code to the clearing house, and by said printed information including each of (1) a rebate form and (2) said verification code, the rebate form incorporating proof of purchase for said product, wherein said product is a first product, and the rebate form comprises a total rebate amount for a plurality of products including said first product; and wherein said verification code is in machine readable form."

Independent claim 16 claims a corresponding apparatus for producing rebate forms and claims 2 to 15 and 17 to 25 are dependent claims.

Independent claim 1 of the second auxiliary request reads:

"1. A computer-implemented method of producing rebate forms, the method comprising steps of: detecting (s204), using a scanner (106) during a purchase transaction in which a product is being purchased, an identification code of said product at a point-of-sale (102, 110); accessing (s206), during said transaction, based upon said identification code, predetermined program information in a database (118-122) for one or more predetermined programs;

using a controller (100), determining (s208, s210) from the predetermined program information whether said product has an associated predetermined program; and if the determination in the previous step is positive, printing (s232) a document using a printer (108) at the point-of-sale during or immediately after said purchase transaction, the document thereby containing printed information relating to the predetermined program associated with said product, characterised by the predetermined program(s) being rebate programs, by the document being a rebate form that is machine readable at a clearinghouse; providing a data entry terminal; by the method including, prior to said printing step, retrieving (s226) rebate information from a rebate information database (120), and, receiving from a customer via the data entry terminal the customer's name and mailing address information; formatting (230) the rebate form for printing; and after the printing step, electronically communicating the verification code to the clearing house, and by said printed information including each of (1) a rebate form, (2) said verification code and (3) said customer's name and mailing address information, the rebate form incorporating proof of purchase for said product, wherein said product is a first product, and the rebate form comprises a total rebate amount for a plurality of products including said first product; and wherein said verification code is in machine readable form."

Independent claim 16 claims a corresponding apparatus for producing rebate forms and claims 2 to 15 and 17 to 25 are dependent claims.

Independent claim 1 of the third auxiliary request reads:

*"1. A computer-implemented method of producing rebate forms, the method comprising steps of:
detecting (s204), using a scanner (106) during a purchase transaction in which a product is being purchased, an identification code of said product at a point-of-sale (102, 110);
accessing (s206), during said transaction, based upon said identification code, predetermined program information in a database (118-122) for one or more predetermined programs;
using a controller (100), determining (s208, s210) from the predetermined program information whether said product has an associated predetermined program; and
if the determination in the previous step is positive, printing (s232) a document using a printer (108) at the point-of-sale during or immediately after said purchase transaction, the document thereby containing printed information relating to the predetermined program associated with said product,
characterised by the predetermined program(s) being rebate programs, by the document being a rebate form that is machine readable at a clearinghouse;
providing a data entry terminal;
by the method including, prior to said printing step,
retrieving (s226) rebate information from a rebate information database (120), and,
receiving from a customer via the data entry terminal the customer's name and mailing address information;
formatting (230) the rebate form for printing on the same strip of paper as a cash register receipt; and*

after the printing step, electronically communicating the verification code to the clearing house, and by said printed information including each of (1) a rebate form, (2) said verification code and (3) said customer's name and mailing address information, the rebate form incorporating proof of purchase for said product, wherein said product is a first product, and the rebate form comprises a total rebate amount for a plurality of products including said first product, and wherein said verification code is in machine readable form."

Independent claim 16 claims a corresponding apparatus for producing rebate forms and claims 2 to 15 and 17 to 25 are dependent claims.

Reasons for the Decision

1. The appeal is admissible.
2. Article 84 EPC 1973, Rule 43(2) EPC
 - 2.1 In claim 20 of each of the requests, features of independent claim 1 relating to printing of the rebate form are removed and replaced with features of making the rebate form electronically available. Hence, claim 20 of all requests is a second independent claim in the same category ("*method*"), which is not allowed according to Rule 43(2) EPC, since none of the exceptions of this Rule applies. Hence, none of the requests complies with Rule 43(2) EPC.
 - 2.2 In independent claims 1 and 16 of the main and auxiliary requests a plurality of terms is used to describe what is actually printed. Four different terms

are used: a) *"document"*, b) *"printed information"*, c) *"rebate form"*, and d) *"verification code"*. For instance, in line 13 of claim 1 of the main request it is specified that the *"document"* contains *"printed information"*, in line 16 of claim 1 of the main request it is specified that the *"document"* is the *"rebate form"*, and in lines 23 - 24 it is stated that the *"printed information"* includes each of a *"rebate form"* and a *"verification code"*. According to the Board's view a single printed pattern as e.g. a bar-code or a QR-code (which is not disclosed, however) would cover all four terms. This is in contradiction to Article 84 EPC 1973 that demands a concise formulation of the claims.

2.3 According to the Board's view, an interpretation of the terms *"machine readable"*, *"clearinghouse"* and *"rebate form incorporating proof-of-purchase for said product"* is of major importance for evaluating the technical merits of the claimed subject-matter. Hence, in the following the Board will provide its understanding.

2.3.1 With regard to the term *"machine readable"*, it is the Board's understanding that any printed pattern is *"machine readable"*. In particular, letters and numbers are machine readable by optical pattern recognition (OCR).

2.3.2 According to the wording of claim 1 of all the requests the *"clearinghouse"* is defined as an entity to which the verification code is electronically communicated. In addition, the rebate form should be machine readable at the clearinghouse. Since no further structural restrictions are specified for the *"clearinghouse"*, it has to be interpreted as an entity adapted to perform those functions only. According to the Board's

understanding, there is no basis in the independent claims that the "*clearinghouse*" is "*remote*" or "*external*" from the shop where the products are bought. The function of a "*clearinghouse*" is fulfilled by any entity of a network (even in-store) that verifies a rebate before redeeming it by using a machine readable rebate form (or a machine readable verification code) and an electronically communicated verification code. That the "*clearinghouse*" might be located within the premises of the retailer is also considered as an alternative in the application (cf. page 5, line 4).

The interpretation of the term "*clearinghouse*" as expressed by the appellant in the statement setting out the grounds of appeal seems to include that the "*rebate forms*" have to be filled out by the customer and afterwards have to be sent to an external "*clearinghouse*", where the "*rebate forms*" were handled manually in order to redeem the rebates. However, according to the Board's functional interpretation - as explained above - such steps are not inherent in the term "*clearinghouse*" and should have been claimed expressively, if the appellant intended to rely on these features when distinguishing the claimed subject-matter from the state of the art.

- 2.3.3 The Board interprets the term "*the rebate form incorporating proof of purchase for said product*" as referring to the features of the claim stating that the rebate form is only printed when the purchased product has an associated predetermined rebate program. This means in particular that any printed "*pattern*" (e.g. a particular bar-code or QR-code) that is only printed when the purchased product has an associated predetermined rebate program qualifies as such a "*rebate form*".

Hence, the Board cannot identify a difference (from the claim wording) between the outer appearance of a "rebate form" and a "discount certificate" that would be printed if such rebate programs existed.

3. Main request

3.1 Novelty (Article 54(1), (2) EPC 1973)

Document D4

Document D4 discloses:

- a computer implemented method of producing rebate forms (title, abstract);
- detecting, using a scanner during a purchase transaction in which a product is purchased, an identification code of said product at a point-of-sale (page 9, lines 11 to 12, 16 to 19);
- accessing, during said transaction, based upon said identification code, predetermined program information in a database for one or more predetermined programs, using a controller, determining from the predetermined program information whether said product has an associated predetermined program (page 12, line 37 to page 13, line 8);
- if the determination in the previous step is positive, printing a document using a printer at the point-of-sale during or immediately after said purchase transaction, the document thereby containing printed information relating to the predetermined program associated with said product (page 14, lines 1 to 35, page 15, line 38 to page 16, line 2);

- the document being a rebate form that is machine readable at a clearinghouse ("*billet*", e.g. page 28, line 12 to 17);
- prior to said printing step retrieving rebate information from a rebate information database (page 12, line 37 to page 13, line 8);
- formatting the rebate form for printing (page 28, lines 2 to 4);
- after the printing step, electronically communicating the verification code to the clearing house (page 22, lines 12 to 24 "*le numéro identifiant le billet*" corresponds to the "*verification code*", which is copied from a "*fichier LOG 11*" in a "*fichier BILLET 19*", the "*fichier BILLET 19*" being used when redeeming the rebate, cf. e.g. page 29, line 38 to page 30, line 26);
- said printed information including each of a rebate form and said verification code, the rebate form incorporating proof of purchase for said product (page 28, lines 2 to 4 and lines 12 to 17);
- wherein said verification code is in machine readable form (page 28, lines 12 to 17, page 29, line 38 to page 30, line 4).

Hence, relying on the interpretation of the terms as discussed above, the subject-matter of claim 1 of the main request is not novel with regard to document D4. The same applies to the corresponding apparatus claim 16 *mutatis mutandis*.

3.1.1 Document D1

The Board agrees with the findings of the examining division as expressed in section 2.4.1 of the decision

under appeal. However, using the interpretation of the terms as explained above, also the features mentioned as distinguishing features in section 2.4.2 of the decision under appeal are effectively disclosed in document D1. The *"printed discount certificate"* has *"a bar code that can be read at the checkout counter"* (cf. col. 7, lines 4 to 6 of D1) and, therefore, is *"machine readable"*. Further, it is clear from col. 8, lines 22 to 36 of D1 that *"input data relating to redemption"* can only be recognized if the bar code is checked against another *"code"*, hence, the personal computer 20 must know the code, which, consequently, qualifies as the *"verification code"* of claim 1. Since the personal computer 20 is aware of this code, it is also evident that this code has to be communicated to it somehow *"electronically"*. The personal computer 20 acts as *"clearinghouse"*.

Hence, the subject-matter of claim 1 of the main request is not novel with regard to document D1. The same applies to the corresponding apparatus claim 16 *mutatis mutandis*.

3.2 Therefore, the main request is not allowable.

4. First auxiliary request

4.1 Novelty (Article 54 EPC)

4.1.1 Since document D4 (cf. e.g. page 17, lines 6 to 11) already discloses that the rebate can comprise a rebate for a plurality of products, also the subject-matter of claim 1 and, *mutatis mutandis*, claim 16 of the first auxiliary request lack novelty with regard to document D4.

4.1.2 Document D1 (cf. col. 5, lines 40 to 45) already discloses that the rebate can be printed for a plurality of products. Hence, also the subject-matters of claim 1 and, *mutatis mutandis*, claim 16 of the first auxiliary request lack novelty with regard to document D1.

4.2 Therefore, the first auxiliary request is not allowable.

5. Second Auxiliary Request

5.1 Inventive Step (Article 56 EPC)

5.1.1 Document D4 already discloses a card reader as a data entry terminal for customer's information (page 19, line 29 to page 21, line 25).

5.1.2 In document D4 it is not disclosed that the customer's mailing address information is received via the data entry terminal and that the printed information includes the customer's name and mailing address.

5.1.3 Starting from document D4 as closest prior art the distinguishing feature of claim 1 has the technical effect of providing a personalized rebate form.

5.1.4 When a client uses a "*carte de fidélité du magasin*" ("*loyalty card*"), to which he/she subscribed (page 21, lines 18 to 21 of document D4), it is evident that his address was input by a data entry terminal in the store system as well. It is a straightforward possibility for a person skilled in the art to print the customer's name and address on the rebate form, if a personalized rebate form should be provided.

5.1.5 As expressed in section 2. above, the alleged advance of processing speed of a personalized rebate form in an *"external clearing house"*, is of no relevance, since there is no evidence that such an *"external"* processing of the rebate form is provided at all.

5.1.6 Hence, the subject-matters of claim 1 and, *mutatis mutandis*, claim 16 of the second auxiliary request lack an inventive step taking into account the disclosure of document D4 in combination with common general knowledge of a person skilled in the art.

5.2 Therefore, the second auxiliary request is not allowable.

6. Third Auxiliary Request

6.1 Inventive step (Article 56 EPC)

6.1.1 The additional feature of the third auxiliary request (as compared to the second auxiliary request) that the rebate form is formatted for printing *"on the same strip of paper as a cash register receipt"*, is already disclosed in document D4, page 24, lines 26 to 29.

6.1.2 Hence, the subject-matters of claim 1 and, *mutatis mutandis*, claim 16 of the third auxiliary request lack an inventive step considering a combination of document D4 and common general knowledge.

6.2 Therefore, the third auxiliary request is not allowable.

7. The reasons for the present decision are all mentioned in the Board's communication of 9 July 2013. The

appellant, however, failed to make any submissions in reply. The Board has no reason to take another view.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



R. Schumacher

G. Assi

Decision electronically authenticated