

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of 8 March 2013**

Case Number: T 2086/09 - 3.5.01

Application Number: 03009625.9

Publication Number: 1365337

IPC: G06F 17/60

Language of the proceedings: EN

Title of invention:
Lean inventory management

Applicant:
SAP AG

Opponent:
-

Headword:
-

Relevant legal provisions (EPC 1973):
EPC R. 45, 67

Keyword:
"Additional search (yes)"

Decisions cited:
T 0690/06, T 1515/07

Catchword:
-



Case Number: T 2086/09 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 8 March 2013

Appellant:
(Applicant)

SAP AG
Dietmar-Hopp-Allee 16
69190 Walldorf (DE)

Representative:

Müller-Boré & Partner
Patentanwälte
Grafinger Straße 2
81671 München (DE)

Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted 7 May 2009
refusing European patent application
No. 03009625.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: S. Wibergh
Members: R. R. K. Zimmermann
A. Pignatelli

Summary of Facts and Submissions

- I. European patent application number 03 009 625.9 (publication number EP 1 365 337 A2) concerns data management in an inventory management system. In a declaration under Rule 45 EPC 1973, the search division informed the applicant that a meaningful search into the prior art was not possible since the claims related to and were formulated in terms of subject matter excluded from patentability "or merely specified commonplace features relating to its technological implementation".
- II. On the basis of claims according to a main request and three auxiliary requests the application was refused for lack of inventive step in a decision posted on 7 May 2009. Claim 1 of the main request as filed on 26 July 2005 reads as follows:

"1. A method for managing data items in an inventory management system including a structure in which the data items and the set of attributes associated with the data items can be represented, the structure comprising a stock table, wherein each data item can be identified either by a combination of a globally unique identifier (GUID) and a globally unique parent identifier or using a globally unique node identifier, the method comprising:
maintaining a set of data items representing stock items in the stock table;
wherein at least one stock item is described by two or more values, each value being expressed in a different unit of measurement;

receiving a change request for a change of one of the values for the stock item;
identifying the stock item either by the combination of a globally unique identifier (GUID) and [sic] a globally unique parent identifier or using a globally unique node identifier;
determining, based on the change request and a defined relationship between the different units of measurement, change quantities for the other values for the stock item; and
updating the two or more values for the stock item based on the change request and the determined change quantities."

III. The reasons given for the refusal of the application, as far as they are relevant to the present appeal decision, may be summarised as follows. The problem addressed by the subject-matter of claim 1 was of commercial or administrative nature and the solution proposed a mere administrative mechanism similar to what would be implemented by the owner of a stock, namely using a paper catalogue to record the stock with different units of measure and organising the information in a hierarchical system by using different chapters and sub-chapters and assigning unique identifiers to all items of the stock.

The only technical problem solved was the computer implementation of that administrative mechanism, which invoked a database to store the stock data, a mechanism to request a change of a data item representing a certain stock, a mechanism to identify and retrieve the particular data item representing the stock, and a

mechanism to update the value of a particular data field such as a quantity.

The technical features of this implementation followed directly from a specification of the administrative mechanism or were related to well-known implementation choices. In particular, the use of globally unique identifiers followed directly from administrative considerations. The implementation of such a feature in a database system was a matter of routine work for the skilled person.

As reasons for refusing the additional search requested by the applicant, the decision indicates essentially that it was not necessary to provide any evidence of an obviously known networked computer system with generic applications such as data processing, database management, and user interface.

- IV. The applicant (appellant) lodged an appeal against the decision and paid the appeal fee on 7 July 2009. With the notice of appeal it submitted claims according to a main request and three auxiliary requests. Claim 1 on the main request was identical with the previous one (see point II above). A statement setting out the grounds of appeal was filed on 10 September 2009.

- V. Oral proceedings were held before the Board on 8 March 2013. The appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance with the order to carry out a search and grant a patent on the basis of claims 1 to 34 according to the main request or one of the auxiliary requests 1 to 3 all filed with the notice

of appeal dated 7 July 2009. The appellant furthermore requested reimbursement of the appeal fee.

- VI. In support of its request for an additional search the appellant cited decisions T 690/06 - Financial records/AUKOL (not published in OJ EPO) and T 1515/07 - Cost estimate/SAP (not published in OJ EPO), submitting that the discretion of the examining division not to carry out an additional search was limited to the special case of notorious features. In the present application, the claimed subject matter included a specific combination of technical features going beyond the common knowledge of networked computer systems and the generic applications cited by the examining division and could thus not be regarded as notorious in the light of the case law. Not carrying out a search under these circumstances amounted to a substantial procedural violation justifying the reimbursement of the appeal fee.

Reasons for the Decision

1. The admissible appeal is allowable in so far as reversal of the decision of appeal is requested since the examination proceedings have to be continued on the basis of an additional search that still has to be carried out.
2. The Board in a different composition has held in the decision T 690/06 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. The Board concluded in that previous case that the decision under appeal should be set aside and the case be remitted to the examining division for an additional search to be carried out and continuation of the proceedings. Notorious prior art in this context was held to mean prior art which could not reasonably be contested to have been generally known (see points 8 to 10 and 13 of the reasons).
3. Claim 1 of the main request contains the feature that a stock item is identified either by the combination of a globally unique identifier (GUID) and a globally unique parent identifier or using a globally unique node identifier. The Board cannot see that this feature is "notorious" in a narrow sense, as required by the jurisprudence. The claim is limited to methods involving two different identifiers, and moreover two particular kinds of identifiers. In the decision under appeal the examining division mainly discusses "unique identifiers" (eg p. 6, top and point 1.4; point 1.6; p. 10, paragraph e). This appears to amount to a simplification of the claimed invention to something which might indeed be notorious.
 4. Already for this reason the Board concludes that the decision under appeal should be set aside and the case be remitted to the examining division for an additional search to be carried out and continuation of the proceedings.
 5. The appellant's request for reimbursement of the appeal fee can however not be allowed. It was essentially an

error of judgement on the side of the examining division which led to the refusal of the appellant's request for an additional search in the prior art and, in the end, to a decision on inventive step without having conducted any such prior art search at all. Such a deficiency which does not result from the non-observance of procedural rules is not a valid basis for a reimbursement of the appeal fee under Rule 67 EPC 1973.

6. Since the case is remitted to the examining division on the basis of the main request there is no need to consider the auxiliary requests. In any case a search should always be carried out having due regard also to the description (cf Article 92 EPC).

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. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

T. Buschek

S. Wibergh