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**Datasheet for the decision
of 18 October 2018**

Case Number: T 0658/12 - 3.5.01

Application Number: 07008777.0

Publication Number: 1860607

IPC: G06Q30/00

Language of the proceedings: EN

Title of invention:

Network order system and network server

Applicant:

FUJIFILM Corporation

Headword:

Network order system and network server/FUJIFILM

Relevant legal provisions:

EPC Art. 56, 111(1)
EPC R. 103(1)(a), 111(2)

Keyword:

Remittal - examination of novelty and inventive step (yes -
technical features not assessed)
Substantial procedural violation - features incorrectly
assessed as non-technical (no - error of judgement)

Decisions cited:

T 0641/00, T 0240/04, T 1242/04, T 0690/06, T 1074/10



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Case Number: T 0658/12 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 18 October 2018

Appellant: FUJIFILM Corporation
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 18 November
2011 refusing European patent application No.
07008777.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman W. Chandler
Members: M. Höhn
Y. Podbielski

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division to refuse European patent application No. 07008777.0 pursuant to Article 97(2) EPC.
- II. The appellant requested that the appealed decision be set aside and that a patent be granted on the basis of the main request or one of the first to third auxiliary requests, all submitted with the statement setting out the grounds of appeal. Furthermore, the appellant requested reimbursement of the appeal fee, because of a substantial procedural violation. Oral proceedings were requested as an auxiliary measure. The request for oral proceedings was withdrawn with letter dated 5 December 2017.
- III. Claim 1 according to the main request reads:
- "1. A network order system (10) comprising:
plural order entry channels (14a, 14b) through each of which an order is placed by a customer and each of which sends order information and customer information of the order;
plural first retailer systems (18a) each of which does not manage the customer information;
plural second retailer systems (18b) each of which manages the customer information;
a network server (12) for receiving and managing the order information, or both the order information and the customer information and having a first database (12a);
a communication network for connecting the order entry channels (14a, 14b), the first retailer systems (18a), the second retailer systems (18b), and the network server (12);

wherein each of the first retailer systems (18a) has means for transmitting the identification information of the first retailer systems, together with the order information and the customer information from the order entry channel to the network server (12); wherein each of the second retailer systems (18b) has a second database (19), means for performing an authentication process of the order entry channel (14b), means for receiving the customer information from the order entry channel when the order entry channel passes the authentication, means for storing and managing the customer information in the second database (19), and means for transmitting the identification information of the second retailer system (18b), together with the order information from the order entry channel (14b) to the network server (12); and wherein said network server (12) comprises means for judging whether the order entry channel has been authenticated by a retailer system (18) or not, means (30b) for performing an authentication process of the order entry channel (14a) when the order entry channel is judged as unauthenticated, means for receiving the order information, or both the order information and the customer information from the order entry channel (14a), as well as receiving identification information of one of the second retailer systems (18b) from the second retailer system, or as well as receiving identification information of one of the first retailer systems (18a) from the first retailer system, and means for storing and managing the order information, or both the order information and the customer information related to the identification

information of the second retailer system (18b) or the identification information of the first retailer system (18a) in the first database (12a)."

IV. The appellants' arguments can be summarized as follows:

The architecture of the claimed network order system according to claim 1 was non-standard and, besides basic functionalities to receive, store and transmit certain data entities, involved a second retailer system and a network server both adapted to authenticate a customer. Furthermore, the network server was also adapted to judge whether an authentication had already taken place by a second retailer system or not. The examining division was therefore wrong in arguing that a general purpose computer system could be considered to represent the closest prior art and the problem was simply to implement a pure business scheme. According to claim 1 several technical features which were non-notorious had not been considered when assessing inventive step (reference was made to case law, among others to T690/06). Despite having carried out a search for written prior art, none of those documents had been used by the examining division. The problem-solution-approach had not been properly applied because that would have required assessing the prior art on file.

The reasoning in the decision under appeal for not admitting the second auxiliary request filed on 20 October 2011 before the first instance was unfounded. Despite introducing further non-notorious technical features, the examining division refused to form an opinion on this as *prima facie* they were not considered to be inventive, without however having assessed the pertinent prior art on file, in particular

D1 and D2. Furthermore, there was no provision in the EPC requiring an auxiliary request to be converging. The lack of reasoning for the main request as well as for not admitting the second auxiliary request represented a substantial procedural violation justifying a reimbursement of the appeal fee.

- V. In a communication the Board informed the appellant that it intended to remit the case to the department of first instance for further examination on the basis of the main request.
- VI. With letter dated 5 December 2017 the appellant withdrew its auxiliary request for oral proceedings.

Reasons for the Decision

- 1. The decision under appeal
 - 1.1 The contested decision refusing the above mentioned application is based on a lack of inventive step attack in view of the common general knowledge of the skilled person and follows the so called COMVIK-approach according to decision T0641/00. Despite having carried out a search for pertinent written prior art, none of the pertinent documents was referred to in detail during the examination procedure. D1 and D2 were merely mentioned in a very general way as being illustrative evidence for the technical features of independent claim 1, a general purpose computer system (see point 2.4 of the decision). The technical teaching of the

written prior art was not assessed during the first instance proceedings.

- 1.2 The examining division essentially argued that the objective to manage customer and order information of both retailers and labs was merely a business related aim related to purely administrative aspects of print order processing. Claim 1 specified a network order system in which information concerning customers and orders was managed on a server. However, the decision to manage both lab and retailer information in one place did not imply any technical considerations. The application itself provided only a very general description of the implementation of the scheme for managing customer and order information, dealing only with pure business issues. The technical implementation of such a scheme for managing customer and order information on a general purpose computer system, which was considered as being an appropriate starting point for assessing inventive step, was a technical objective. However, it had to be deduced from the high abstract level of the description that the implementation itself was straightforward to the person skilled in the art using conventional programming skills, and that the applicant expected this. The business idea behind the scheme for managing customer and order information as above was not considered relevant to the point at issue. However, when a data processing expert, the person skilled in the art, was tasked with its implementation by providing all functions required, he would do so through use of standard programming techniques and would arrive at the subject matter of claim 1 without making an inventive step.

Main request

2. Interpretation of independent claim 1

The Board agrees with the appellant's argument that the subject-matter of claim 1 involves at least some technical features which are not regarded as notorious knowledge of the skilled person.

- 2.1 Apart from business related aspects of order processing the claimed subject-matter also involves aspects concerning authentication and identification of users at different entities of the claimed system. The Board considers the latter to contribute to the technical character of claim 1 so that they cannot be regarded as being part of the non-technical requirement merely to be implemented by the technical skilled person.

When referring to a general purpose computer system as closest prior art for assessing inventive step of claim 1, the examining division neither argued why it considered the claimed aspects concerning authentication and identification to be part of such a commonly known computer system, nor referred to other common general knowledge in this regard.

Instead it appears that the examining division considered those features to be part of the non-technical concept. The Board does not agree with this finding.

- 2.2 The Board considers at least the following features of claim 1 to be of a technical nature and therefore to contribute to the technical character of claim 1:

- a network server
- a communication network
- a first and a second database
- transmitting and receiving identification information
- means for performing an authentication process
- means for judging whether an entry channel has been authenticated by a particular computer in the system or not.

2.3 While the Board agrees with the decision that some of the technical features of claim 1 can be regarded as commonplace, the features related to authentication and identification information as well as what databases to use for what purpose go beyond what can be considered to be notorious knowledge.

2.3.1 In the contested decision it was argued that there were authentication methods which bear technical character, but the mere statement of "judging whether an order entry channel has been authenticated or not" amounted to a mere administrative decision since the examining division could not identify any technical interaction between technical means (see point 4.3 c).

That appears to be rather an objection for lack of clarity or missing essential features under Article 84 EPC regarding an interaction, than for lack of technical contribution. The Board does not agree that means for judging whether a communication channel has been authenticated or not are merely of an administrative nature, since this goes beyond the normal interactions between the components of the system and, hence, requires technical considerations.

2.3.2 The contested decision further argues that "[r]eceiving identification information" was no more technical than a simple greeting (see point 4.3 e). However, it has to be considered that transmission and reception of identification information happen between dedicated computer systems, here first and second retailer systems, in an automated way as a kind of protocol for establishing communication channels. Comparing this technical teaching to a "simple greeting" is an oversimplification without considering the technical context of the claim.

2.4 The appellant referred to decision T 690/06 in order to support its argumentation. The Board agrees with the reasoning in this decision that a general purpose networked computer system with a database is "notorious" in the sense of decision T 223/95 (not published in the OJ EPO) and thus did not require documentary evidence.

However, as described above (see points 2.3.1 and 2.3.2) the examining division interpreted technical features to be in the administrative, i.e. non-technical domain. The Board in contrast considers those features related to authentication and identification to be technical. In the Board's view this was an incorrect application of the COMVIK approach, which only permits "an aim to be achieved in a non-technical field" to appear in the formulation of the problem (T 641/00, supra, point 7). Transmitting and receiving identification information, performing an authentication process and judging whether an entry channel has been authenticated by a particular computer in the system are not aims in a non-technical field, but are technical features. Moreover, they can hardly be regarded as notorious, in particular since the term

"notorious" should be interpreted narrowly (see e.g. T 1242/04, point 8).

2.5 The Board does not rule out that, at the priority date of the application, it was common general knowledge to transmit and receive identification information, to perform an authentication process and to judge whether an entry channel has been authenticated by a particular computer in the system. But the Board is not convinced that the existence of this knowledge at the priority date cannot reasonably be disputed, and it was disputed by the appellant during the first instance proceedings as well as in the statement setting out the grounds of appeal. In such circumstances, the existence of common general knowledge needs to be proven by evidence. This means that consideration of the written prior art according to the Search Report is necessary.

2.6 Decision T 690/06 deals with the situation where no search has been carried out during the first instance proceedings. In the present case, the results of a search have been available, but were not assessed by the examining division. In the Board's view, however, the procedural situation is comparable. Present claim 1 cannot be definitively assessed with respect to novelty and inventive step without knowledge of the relevant documented prior art. The examining division did not assess the claimed subject-matter with regard to the pertinent written prior art, although this would have been necessary for the reasons set out above.

Remittal

3. According to Article 111(1) EPC the Board may exercise any power within the competence of the examining division (which was responsible for the decision under

appeal) or remit the case to that department for further prosecution. It is thus at the Board's discretion whether it examines and decides the case or whether it remits the case to the department of first instance. Since the written prior art has not been assessed during the first instance proceedings, a complete examination of novelty and inventive step has not taken place and the Board therefore considers that in the present case remittal is the more appropriate course of action.

4. Reimbursement of the appeal fee

4.1 An insufficiently reasoned decision has to be distinguished from a decision that has faulty or unpersuasive reasoning. The decision under appeal is not based on mere allegations, nor does it lack a clear comprehensive argumentation. The Board agrees with T 690/06 (see reasons, point 13) that notorious prior art, i.e. prior art which cannot reasonably be contested to have been generally known and which is cited without proof, is allowable by the jurisprudence. The COMVIK-approach may have been incorrectly applied, but this is a substantive issue, only involving judgement. Thus, the decision is reasoned in the sense of Rule 111(2) EPC.

4.2 Regarding the non-admission of the second auxiliary request filed on 20 October 2011 by the examining division for being late filed and not being converging, the Board also does not see a substantial procedural violation.

When exercising its discretion an examining division must consider all the relevant factors; in particular it must balance the applicant's interest in obtaining a

patent which is legally valid and the EPO's interest in bringing the examination procedure to an end (G 7/93, Reasons 2.5). The examining division exercised its discretion under Rule 137(3) EPC by using the following criteria: the timing of the request (one week before the oral proceedings), the divergence of the request and the prima facie unallowability of the request for lack of inventive step. The Board takes the view that in doing so, the examining division took all the factors into account that were relevant for the exercise of its discretion in the present case.

Contrary to the appellant's arguments, the Board takes the view that divergence of a request is a factor which may be taken into account in the exercise of discretion under Rule 137(3) EPC. Amendments which do not increasingly limit the subject-matter of the independent claims of a main request in the same direction of a single inventive idea may be contrary to the EPO's interest to bring the proceedings to a close (see e.g. T 1074/10, Reasons 3.3 and T 240/04).

The examining division considered that, by removing the features introduced with the first auxiliary request, the second auxiliary request diverged in a different direction. This was not accepted and the examining division, which also considered the timing of the request and prima facie allowability, exercised its discretion for the afore-mentioned reasoning according to the case law and gave reasons. It does not appear to the Board that when applying the criteria, the examining division exercised its discretion in an unreasonable way.

4.3 It follows that there is no basis for reimbursement of the appeal fee (Rule 103 EPC).

5. Since the case is remitted to the department of first instance on the basis of the main request, the auxiliary requests need not be considered.

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 on the basis of the main request for further examination with regard to the prior art mentioned in the European Search Report.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



T. Buschek

W. Chandler

Decision electronically authenticated