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**Datasheet for the decision
of 1 July 2013**

Case Number: T 0964/12 - 3.5.01

Application Number: 03708182.5

Publication Number: 1470511

IPC: G06F 17/60

Language of the proceedings: EN

Title of invention:
Supply chain fulfillment coordination

Applicant:
SAP AG

Opponent:
-

Headword:
Fulfillment coordination/SAP

Relevant legal provisions:
EPC Art. 52(2) and (3)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Technical character of invention (yes)"
"Additional search - necessary (yes)"

Decisions cited:
T 1242/04, T 1924/07, T 1411/08



Case Number: T 0964/12 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 1 July 2013

Appellant: SAP AG
(Applicant) Dietmar-Hopp-Allee 16
D-69190 Walldorf (DE)

Representative: Richardt Patentanwälte GbR
Wilhelmstraße 7
D-65185 Wiesbaden (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 28 November 2011
refusing European patent application
No. 03708182.5 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: S. Wibergh
Members: R. R. K. Zimmermann
P. Schmitz

Summary of Facts and Submissions

- I. Euro-PCT application number 03708182.5, published as international publication number WO 03/075195 A2, relates to a method and system to process and coordinate the fulfillment of an order placed with a company by a customer or any other entity outside or inside of the company.
- II. The European Patent Office as International Searching Authority issued a no-search declaration (declaration of non-establishment of an international search report under Article 17(2) (a) PCT) for the reason that the subject matter of the international application was related to schemes, rules or methods of doing business.
- III. The examining division raised various objections on the basis of the assertion that the claimed invention was non-technical in character. The applicant consistently disagreed, referring to technical features in the claims and technical advantages achieved by the invention. The applicant also substantiated why a prior art search had to be carried out on the basis of the claims.
- IV. In a decision posted on 28 November 2011, the examining division refused the application on the premise that nothing in claim 1 contributed to the technical character of the method claimed and thus the subject-matter of claim 1 was excluded from patentability under Article 52(2) and (3) EPC. This conclusion was drawn from a broad purposive interpretation of the terms of the claim. An auxiliary request limiting the subject matter of the claim to a computer-implemented method

was not admitted. The additional search requested by the applicant was declined as not necessary in view of the non-technical character of the invention.

V. The appellant (applicant) lodged an appeal against the refusal of the application on 7 December 2011, effected payment of the appeal fee on the same day, and filed the grounds of appeal by letter dated 23 March 2012 and received on 26 March 2012. An amended set of claims annexed to this letter was filed as new main request, claim 1 of the new main request reading as follows:

"1. A computer implemented data processing method of processing an order, the method comprising the steps of:

- providing a transport layer (503, 542) for transmitting a first message (515) from an order capturing application (505; 605) to an order fulfillment application (620; 625), wherein the transport layer is provided by an integration engine (503) and an integration directory (415; 542),
- capturing an order by means of the order capturing application (505; 605),
- generating the first message by the order capturing application (505; 605), the message body of the first message carrying an order document and an indication of a receiving organizational entity,
- transmitting the first message (515) from the order capturing application to the integration engine (503),
- determining by a logical routing framework (530) of the integration engine (503) the logical name of an order fulfillment coordination engine (603) from the

indication of the receiving organizational entity using a routing model directory (540) comprised in the central integration directory (415; 542),

- storing by the integration engine (503) the logical name in the header of the first message,
- converting by a mapping framework (545) of the integration engine (503) in the message body (525) the format of the order document to the format of the order fulfillment coordination engine (603) using a mapping directory (547) comprised in the central integration directory (415; 542),
- determining by a physical address resolution framework (559) of the integration engine (503) the physical address of the order fulfillment coordination engine (603) from the logical name stored in the header of the first message, wherein the determination of the physical address is performed using a service directory (548) comprised in the central integration directory (415; 542)
- storing by the integration engine (503) the physical address in the header (520) of the first message (515),
- sending the first message (515) from the integration engine (503) to the order fulfillment coordination engine (603) using the physical address,
- processing the order document by the order fulfillment coordination engine (603) to provide at least a second message, the second message carrying an order fulfillment document (615) and an indication of the order fulfillment application (620, 625), and
- transmitting the second message from the order fulfillment coordination engine to the order

fulfillment application (620; 625) by means of the transport layer."

- VI. The appellant requested as main request that the decision under appeal be set aside and a European patent be granted on the basis of the new claims filed by letter dated 23 March 2012 which was based on the auxiliary request before the examining division, as an auxiliary request that the case be remitted to the first instance "for an additional search removing the declaration under Rule 63 EPC", and as a further auxiliary request that oral proceedings be held in case the Board was of the opinion that none of the preceding requests could be granted.
- VII. In respect of the objection of non-technical character of the invention, the appellant cited as examples for means having technical character the features transport layer, message body and header, integration engine and fulfillment coordination engine, logical routing framework and physical address resolution framework and format conversion of the order document (cf claim 1 above). Since the claimed method was directed to a "computer-implemented data processing method" it was clear that these features were related to computer implementations and the technical field of software and computers. In their specific combination and complex interaction, the technical means so defined solved a technical problem in a technical manner; even if they were individually well known, their specific combination was certainly not obvious, much less notorious. It was not admissible for these reasons to refuse a prior art search and to issue instead a no-search declaration.

Reasons for the Decision

1. The admissible appeal is allowable on the basis of the auxiliary request.
2. The examining division refused the application because they considered the subject-matter of claims 1 and 7 to be excluded from patentability and that of claim 6 to lack novelty. The essential reasoning was for all claims that the invention comprised no, or merely notorious, technical features. The Board will therefore examine whether that reasoning was correct. This is also necessary in order to determine whether an additional search must be carried out since no search has as yet been performed.
3. The jurisprudence has laid out the following principles for determining when an additional search should be carried out. In decision T 1242/04 "Provision of product-specific data/MAN", OJ EPO 2007, 421 (see point 9 of the reasons) it is pointed out that the search is an essential element of the grant procedure, being designed to identify prior art relevant to the application. The intention is to make it possible to determine, on the basis of the documents mentioned in the search report, whether and to what extent the invention is patentable. Knowledge of the prior art forms the basis for examination of the application by the examining divisions. However, if no search report has been drawn up it is not necessary to carry out an additional search in the documented prior art where the objection is based on "notorious knowledge" (Cf T 1924/07 "FA Information/BRIDGESTONE CORP.", not published in OJ EPO, point 10 of the reasons). The term

"notorious" means prior art which is so well known that its existence at the date of priority cannot be reasonably disputed. It may also imply that technical detail is not significant (cf T 1411/08 "Pairing providers with consumers/IN-DEVELOPMENT", not published in OJ EPO, points 4.1 and 4.2 of the reasons).

4. In the present case the Board concurs with the appellant's view (cf point VII above) that the method and system claims define technical features and technical aspects which cannot be ignored in examining the patentability of the invention.

The skilled person would infer from the application that the claims are not solely related to a business method mixed with abstract ideas how to exchange messages between business people, somehow using purely non-technical computer programs and bypassing any technical means whatsoever, but that the claimed invention is a technical information system for processing data.

Such insights are easily inferred from the various references to computer systems in the introductory Summary (see the international publication, page 2 ff.) and the disclosed embodiments of the invention which are implemented using the integration platform Exchange Infrastructure of SAP that "provides an infrastructure that has a middleware which allows technical integration of SAP as well as non SAP systems by using open standards" (see e.g. figure 4 with page 15, line 13 ff. and figure 9 with page 26, line 26 ff.).

The (order) fulfillment coordination engine, an essential feature in the claims, "can be implemented with SAP's Exchange Infrastructure" (see page 26, line 26 ff.).

The exchange infrastructure includes an integration server 425 and an integration directory 415 (see page 27, line 5 ff.). At page 29, line 16 ff., the application indicates that "integration server 503 and integration directory 542 provide a transport layer for transmitting of message 515 from the sending application 505 to the receiving application 557" (underlining added). The integration server and the integration directory are implemented by the SAP Exchange Infrastructure as shown in figure 9. Hence, the integration server, the integration directory, and the transport layer are technical components of the computer system.

Also the features relating to routing messages through the transport layer, converting data formats and resolving addresses are technical, or at least have technical aspects related to computer-implemented processes.

5. The collection of these features cannot reasonably be said to fit the narrow definition of "notorious prior art". An additional search must therefore be carried out.
6. It also follows from the above analysis that the objections made in the decision under appeal against claims 1, 6 and 7 are not valid. The skilled person - a computer scientist - would not interpret the features

discussed above in a way that neither takes into consideration that the invention is computer-implemented, nor has support in the description.

7. The decision under appeal therefore has to be set aside. The appellant's main request for grant of a patent is refused since no search has been carried out, but its auxiliary request for remittal is granted. The examining division should perform the additional search on the basis of the claims filed with the statement setting out the grounds of appeal dated 23 March 2012, taking due regard to the description and drawings (cf Article 92 EPC).

8. There is consequently no need for the Board to hold the oral proceedings requested by the appellant on a further auxiliary basis.

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.

The Registrar:

The Chairman:

T. Buschek

S. Wibergh