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Datasheet for the decision
of 3 June 2022

Case Number:	T 0909/14 - 3.5.01
Application Number:	08836617.4
Publication Number:	2195777
IPC:	G06Q50/00
Language of the proceedings:	EN

Title of invention:
WEB SERVICE USER EXPERIENCE WITHOUT UPFRONT STORAGE EXPENSE

Applicant:
Microsoft Technology Licensing, LLC

Headword:
Web service without upfront storage/MICROSOFT

Relevant legal provisions:
EPC Art. 56

Keyword:
Inventive step - limiting functionality for new users and giving them fewer resources (no - not technical) - showing in a user interface features which can only be used after an upgrade (no - not technical)

Decisions cited:

G 0001/19, T 0641/00, T 1463/11, T 1635/09, T 1670/07

Case Number: **T 0909/14 - 3.5.01**

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 3 June 2022

Appellant:	Microsoft Technology Licensing, LLC
(Applicant)	One Microsoft Way
	Redmond, WA 98052-6399 (US)

Representative:	Grünecker Patent- und Rechtsanwälte
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| Decision under appeal: | **Decision of the Examining Division of the European Patent Office posted on 21 November 2013 refusing European patent application No. 08836617.4 pursuant to Article 97(2) EPC.** |

Composition of the Board:

Chairman	W. Chandler
Members:	W. Zubrzycki
	Y. Podbielski

Summary of Facts and Submissions

I.   This appeal is against the decision of the examining
        division to refuse European patent application No.
        08836617.4 for lack of inventive step (Article 56 EPC).

II.   The examining division found that the independent
        claims according to the main request and first and
        second auxiliary requests then on file lacked an
        inventive step over a notorious networked data
        processing system. The decision mentioned five patent
        documents as disclosing an example of such a system,
        including US2006/242581 (D5).

        The division argued, using the COMVIK approach, that
        the distinguishing features defined a non-technical
        administrative scheme, which would have been obvious to
        implement, once it had been given to the skilled person
        within the framework of the technical problem.

III.   In the statement setting out the grounds of appeal, the
        appellant requested that the decision be set aside and
        a patent be granted on the basis of the refused
        requests.

IV.   In a communication, the Board set out its preliminary
        opinion that the subject-matter of all requests lacked
        an inventive step over the disclosure of D5.

V.   In a reply dated 2 September 2020, the appellant
        refiled the second auxiliary request as a new main
        request and filed a new auxiliary request. It also
        submitted further arguments in favour of inventive
        step.

VI.   In the communication accompanying the summons to oral
       proceedings, the Board admitted the main request into
       the proceedings and informed the appellant that it
       intended to admit the auxiliary request. Furthermore,
       having analysed the appellant's arguments, the Board
       tended to consider that the main and auxiliary request
       lacked an inventive step over D5 (Article 56 EPC).

VII.   Oral proceedings took place as a videoconference on
       3 June 2022. The appellant's final requests were that
       the decision be set aside and a patent be granted on
       the basis of the main request or the auxiliary request,
       both filed with the reply dated 2 September 2020.

VIII. Claim 1 of the main request reads:
       *"A document sharing method of allocating resources for
       users of a service (102), the service providing an
       interface for a user having a first type of account on
       the service through which the user can perform first
       functions (506) related to documents associated with
       the user's own account and second functions (508)
       related to documents associated with accounts of other
       users, the first functions comprising creating at least
       one document by the user and the second functions
       comprising editing at least one document created and
       shared by another user wherein resulting edits are
       stored within the other user's account, the method
       comprising:*

       *communicating (202) an invitation from a user of the
       service to a prospective user to access the service;*

       *upon determining (204) that no account exists for the
       prospective user, automatically creating (208) an
       account of a second type for the prospective user based
       on information contained in the invitation, wherein the*

created account of the second type does not comprise resources on the server enabling the prospective user to create documents nor resources enabling the prospective user to perform the first functions, thereby reducing a cumulative amount of resources allocated to users of the service;

presenting (206) a prospective user interface (318) for the prospective user, the prospective user interface simulating (502) the user interface without enabling the prospective user to perform the first functions;

displaying (210), through the prospective user interface, documents managed by the user to enable the prospective user to access the documents;

offering (212), via the prospective user interface, to the prospective user an opportunity to utilize capabilities of the service comprising the first functions and the second functions; and

in response to the prospective user accepting the offer (214), creating (216) an account of the first type on the service for the prospective user, and presenting a modified user interface (308) for the prospective user, the modified user interface enabling the prospective user to perform the first functions and the second functions (220)."

IX.   Claim 1 of the auxiliary request replaces:

- The penultimate feature with the following one:
"in response to the prospective user attempting to perform a first function, displaying (212), through the prospective user interface, a clickable component (316, 408) enabling the prospective user to request becoming

a user having an account of the first type to utilize
capabilities of the service comprising the first
functions and the second functions"

- The wording "*accepting the offer*" in the last feature
with "*clicking the clickable component*"

X.   The appellant argued as follows:

The key-idea of discriminating between full users and
prospective users with fewer resources came from
technical considerations of saving server resources,
for example storage space for documents' metadata and
thus could not be ascribed to the business person. This
motivation was clearly stated in the application's
background section and should have been taken into
account in the assessment of inventive step. The
business requirement ended with how to save resources
without impairing usability.

Presenting a prospective user with a simulated
interface of a full user was technically motivated too.
It allowed a prospective user to see the full user's
interface from the beginning so that he did not need to
explore its functionality from scratch after becoming a
full user. This produced the technical effects of
increasing the service usability and reducing the time
the full user needed to explore the interface after the
upgrade and, hence, energy consumption.

Even if the creation of a group of prospective users
with less functionality were part of the business
scheme, it still would not have been obvious to reduce
resources given to these users. Rather, it would have
been obvious to give the same resources to all users,
but to disable some functionality for the prospective

users. It was also unobvious in view of the business
scheme to store edits to a shared document in
association with the sharer's account. The obvious
solution was rather to create a copy of this document
for each editing user.

Reasons for the Decision

1.   Admissibility under Article 13(1) RPBA

The Board admitted the main request and the auxiliary
request, filed on appeal, into the proceedings under
Article 13(1) RPBA 2020. The reasons are that the main
request corresponds to the refused second auxiliary
request and the auxiliary request is a bona fide
attempt to overcome the Board's new objections based on
D5.

2.   The invention

2.1   The invention concerns a web service enabling the
creation, storage and sharing of documents (see
published application page 1, lines 6 to 19). Such
services are known from the prior art.

The key idea is to allow new (prospective) users of the
service to access only part of the available
functionality in order to reduce resources consumed
(page 1, line 30 to page 2, line 13).

2.2   Claim 1 of the main request recites a method for
creating and upgrading user accounts. The service's
full users, having an account of the first type, may
create their own documents and edit documents shared by
others. By contrast, a prospective user, joining the
service in response to an invitation from an existing

user, gets an account of a second type not allowing him
to create his own documents, but only to edit shared
documents (page 12, lines 8 to 31).

The account of the second type is said to "not comprise
resources on the server enabling the prospective user
to create documents". The Board objected that the
application does not set out what actual resources are
saved on the server (page 6, lines 20 to 33). During
the oral proceedings, the appellant explained that the
saved resource was storage space for documents' names
and metadata within the full user account.

The service creates for the full user and the
prospective user different user interface websites, the
prospective user's website "simulating" the full user's
one. The appellant explained at the oral proceedings
that, looking at Figures 3A and 3B, an example of
simulating was displaying on the prospective user
website 310 a "My Documents" folder 312, even though,
unlike on the full user website 300, the folder was
empty because the prospective user was not allowed to
create documents (page 12, lines 26 to 31).

The prospective user can upgrade his status to the full
user by accepting an offer to do so presented on the
prospective user interface (page 5, lines 16 to 27).

2.3   Claim 1 of the first auxiliary request adds that in
        response to the prospective user attempting to create a
        document, a clickable component enabling the user to
        request the upgrade to the full user is displayed. For
        example looking at Figure 4B, the prospective user
        interface comprises a token "Add File" button 404,
        clicking upon which results in displaying a prompt and
        a further clickable button 408 enabling the user to

upgrade (page 13, lines 21 to 28).

3.   Main request, inventive step (Article 56 EPC)

3.1   The division started from a notorious data processing
        system comprising a plurality of networked computers.
        However, the Board prefers to start from D5 since it is
        concerned with a document sharing service, and hence
        closer to the claimed invention. In D5, all users have
        accounts of a first type.

        It was common ground that the subject-matter of claim 1
        differs from D5:

        A) In that the web service enables a user to edit
        documents shared by another user, wherein the resulting
        edits are stored within the other user's account (end
        of opening part of claim 1).
        B) By creating an account of second type for a
        prospective user, joining the service in response to an
        invitation from an existing user, wherein this account
        does not comprise resources on the server enabling the
        prospective user to create documents, thereby reducing
        a cumulative amount of resources allocated to users
        (first and second features of claim 1).
        C) By presenting a prospective user interface
        simulating the full user interface without enabling the
        prospective user to create his own documents (third
        feature).
        D) By offering to the prospective user an opportunity
        to upgrade his account via the prospective user
        interface (fifth feature).
        E) By creating for the prospective user the account of
        the first type and presenting to him the full user
        interface enabling the creation of documents in

response to him accepting the offer (sixth feature).

3.2   The main point of dispute in this appeal is whether
        discriminating between full users and prospective users
        with limited functionality is the *solution* to the
        technical problem of saving resources, as argued by the
        appellant (see section X, above), or a non-technical
        requirement that could be envisaged by the business
        person and thus part of the *problem* given to the
        skilled person under the COMVIK approach (see
        T 641/00 - *Two identities/COMVIK*) as argued by the
        division.

3.3   Decision T 1463/11 - *Universal merchant platform/
        CardinalCommerce*, further refining the COMVIK approach,
        set out that in the assessment of inventive step,
        circumstances under which inventions are developed in
        the real world have to be ignored to a certain extent.
        It introduced the concept of the notional business
        person who may formulate business requirements to be
        implemented but will not include in them any technical
        matter. The notional business person is a legal fiction
        representing a shorthand for a separation of business
        considerations from technical ones. Using this legal
        fiction is the price paid for an objective assessment;
        a real inventor does not hold such considerations
        separately from one another (see reasons 14 to 16).

3.4   Under the CardinalCommerce approach, the test used in
        deciding on technicality of a feature is whether the
        notional business person could have come up with it.
        This boils down to determining whether there would have
        been at least one way to devise it without technical
        considerations. If so, it does not have technical
        character and may form part of the requirement
        specification regardless of what alternative ways of

arriving at it were disclosed in the application or
were conceivable.

3.5   This result, although unfortunate for an applicant who
        did actually arrive at the feature via the technical
        path, is not unique to the business-related exclusion.

        As noted in G1/19 - *Pedestrian simulation* (see end of
        section 82), another example would be methods for
        treatment of the human body which have both patentable
        non-therapeutic and therapeutic uses falling within the
        exception to patentability under Article 53(c) EPC
        (see, for example, T 1635/09, OJ EPO 2011, 542,
        Reasons, points 3 and 5, where the claims could not be
        limited to a non-therapeutic method because the
        therapeutic elements and the non-therapeutic elements
        of the claimed use were inseparably associated with
        each other).

3.6   In the present case, the Board judges that providing
        limited functionality for some users, such as not
        enabling the creation of documents, is a business
        decision which need not be based on technical
        considerations. There are apparent business reasons for
        doing it, for example charging the full user a higher
        subscription fee than the prospective user.

        Furthermore, the Board judges that the notional
        business person knows that providing users with
        functionality utilises "resources" in general terms and
        limiting these resources might reduce costs.
        Accordingly, the notional business person seeking to
        reduce costs would have required that the prospective
        user not be given unnecessary resources. At this point
        nothing technical is going on yet.
        By contrast, the decision as to which computer

resources to save is a technical implementation issue
which is up to the skilled person. However, the only
implementation feature claimed is that the saved
resources are on the server. While the appellant argued
that the saved resource was storage space for document
metadata, this is neither claimed nor disclosed in the
application.

3.7   Concerning "simulating" the full user interface, the
       Board judges that including in the user interface a
       feature which is useless without an account upgrade,
       for example an empty document container, relates to the
       presentation of information and is not based on any
       technical considerations. The appellant's argument
       attempting to prove that this part of the solution
       derives technical character from effects produced when
       the user operates the upgraded user interface is not
       convincing. In addition to being speculative, it is a
       typical example of the "broken technical chain fallacy"
       in the sense of T 1670/07 - *Shopping with mobile
       device/NOKIA*, reason 11.

3.8   The Board judges that the notional business person
       would have tasked the skilled person with implementing
       a non-technical business scheme in the system of D5,
       wherein:
       - There are two user categories: full users and
       prospective users. Unlike the full user, the
       prospective user may not create documents and is not
       given resources required for doing it.
       - A new user, joining the service in response to an
       invitation from its existing user, becomes the
       prospective user. He can upgrade his status to the full
       user at a later point, if he accepts an offer to do so.
       - A visual container for documents created by a user is
       presented to the prospective users and the full users,

but the prospective users' container is empty.
- Both the full and the prospective users can modify a
document shared with them by another user such that the
sharing user sees the modifications made.

3.9   The Board judges that starting from the disclosure of
       D5 and seeking to implement the above scheme, the
       skilled person would have found the claimed
       implementation obvious.

       The following implementation features follow directly
       from the scheme:
       - Providing functionality for editing shared documents.
       - Automatically creating a prospective user interface,
       which does not enable the prospective user to create
       documents, but comprises an empty container for created
       documents.
       - Displaying in this interface, a prompt suggesting an
       account upgrade and triggering the upgrade in response
       to the user accepting the prompt, wherein the account
       upgrade entails creating the full user account and
       replacing the prospective user interface with the full
       user one.

       Furthermore, the Board judges that not allocating to
       the prospective user resources on the server, which are
       required for creating documents, would have been
       obvious.

3.10   Concerning the argument that the skilled person would
       have rather considered disabling functionality, the
       Board cannot see why allocating a resource, e.g. server
       memory, and disabling it is more obvious than not
       giving this resource in the first place.

3.11   Concerning the argument that the skilled person would
        have rather created a copy of the document for each
        user editing it, the business scheme requires that a
        document sharer see modifications made and the most
        obvious way of implementing this is to store the
        changes in association with his account.

3.12   Hence, claim 1 lacks an inventive step (Article 56
        EPC).

4.   Auxiliary request, inventive step (Article 56 EPC)

4.1   The Board judges that claim 1 of the auxiliary request
        adds nothing of inventive merit. Providing a token
        element for adding documents and displaying a clickable
        upgrade prompt when it is selected is an obvious
        implementation of the business requirement that an
        upgrade to the full user should be offered when the
        prospective user attempts to create a document.

4.2   Hence, claim 1 of the auxiliary request lacks an
        inventive step (Article 56 EPC).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

T. Buschek   W. Chandler

Decision electronically authenticated