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**Datasheet for the decision  
of 7 December 2021**

**Case Number:** T 1379/17 - 3.5.06

**Application Number:** 10741580.4

**Publication Number:** 2396747

**IPC:** G06K9/00

**Language of the proceedings:** EN

**Title of invention:**

SYSTEMS, METHODS, AND COMPUTER PROGRAM PRODUCTS FOR  
DETERMINING DOCUMENT VALIDITY

**Applicant:**

Kofax, Inc.

**Headword:**

Document validity/KOFAX

**Relevant legal provisions:**

EPC Art. 56, 84, 111(2), 123(2)

EPC R. 137(3), 103(1)(a)

RPBA 2020 Art. 11

**Keyword:**

Inventive step - main request and first auxiliary request (no)  
Amendments - second auxiliary request, added matter (no)  
Claims - second auxiliary request, clarity (yes)  
Remittal - admittance of third and fourth auxiliary request  
(not to be decided upon)  
Substantial procedural violation (no)  
Remittal to the department of first instance (yes)

**Decisions cited:**

G 0007/93, T 0190/99

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 1379/17 - 3.5.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.06**  
**of 7 December 2021**

**Appellant:** Kofax, Inc.  
(Applicant) 15211 Laguna Canyon Road  
Irvine, CA 92618 (US)

**Representative:** Dilg, Haeusler, Schindelmann  
Patentanwalts-gesellschaft mbH  
Leonrodstraße 58  
80636 München (DE)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 20 January 2017  
refusing European patent application No.  
10741580.4 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** M. Müller  
**Members:** T. Alecu  
K. Kerber-Zubrzycka

## **Summary of Facts and Submissions**

- I. The appeal is against the decision of the Examining Division to refuse the application.
- II. The Examining Division refused the main, first and second auxiliary request before it for lack of clarity and inventive step over the document

D1: US 2008/133388 A1,

and the second auxiliary request was further considered not to comply with Article 123(2)EPC. The third and fourth auxiliary requests were not admitted under Rule 137(3) EPC.

- III. With the grounds of appeal the appellant requested that the decision of the Examining Division be set aside and that a patent be granted on the basis of the main request, or of the first or second auxiliary request; further, that the third and fourth auxiliary requests, which were not admitted into the proceedings by the Examining Division, be admitted into the proceedings and that a patent be granted on the basis of one of those requests; yet further that the appeal fee be reimbursed, on the basis of an alleged substantial procedural violation, and that the case be remitted to the first instance for further prosecution. The requests were filed with the grounds of appeal and are the same as those underlying the decision, with a minor amendment "to correct the antecedent basis of the expression "predefined business rules" (statement of grounds 3.1). Oral proceedings were also requested.

- IV. In the communication accompanying a summons to oral proceedings, the Board informed the appellant of its provisional opinion that
- (a) the main and first auxiliary request were clear, but lacked inventive step;
  - (b) the second auxiliary request was clear and compliant with Article 123(2) EPC;
  - (c) it could not see any substantial procedural violation regarding the admittance of the fourth and fifth auxiliary requests;
  - (d) it intended to remit the case for further prosecution, to allow for a full examination on novelty and inventive step by the first instance, possibly on the basis of an additional search.
- V. With its letter of 4 November 2021 the appellant withdrew the request for oral proceedings conditional "*upon the Board's remittal of the application to the Examining Division for further consideration of the second auxiliary request, as proposed*". The appellant also requested "*the Board's consideration of the Appellant's ... arguments in support of entry of the third and fourth auxiliary requests, and an order instructing same to accompany the remittal and re-examination of second auxiliary request claims*". The oral proceedings were then cancelled.
- VI. Claim 1 of the main request defines (underlined the minor amendment mentioned above):
- A method, comprising:*  
*extracting an identifier from an electronic first document;*  
*identifying a complementary document associated with the first document using the identifier;*

*normalizing data from the first document using the textual information from the complementary document and predefined business rules, wherein normalizing data comprises converting unit differences between the first document and the complementary document;*  
*determining a validity of the first document by considering:*

*textual information from the first document;*

*textual information from the complementary document; and*

*the predefined business rules; and*

*outputting an indication of the determined validity of the first document.*

VII. Claim 1 of the first auxiliary request defines (emphasis by the Board):

*A method, comprising:*

*extracting an identifier from an electronic first document;*

*identifying a complementary document associated with the first document using the identifier;*

*normalizing data from the first document using the textual information from the complementary document and predefined business rules, wherein normalizing data comprises converting grams to kilograms, ounces to grams, or dollars to euro;*

*determining a validity of the first document by considering:*

*textual information from the first document;*

*textual information from the complementary document; and*

*the predefined business rules; and*

*outputting an indication of the determined validity of the first document.*

VIII. Claim 1 of the second auxiliary request defines (emphasis by the Board):

*A method, comprising:*

*extracting an identifier from an electronic first document;*

*identifying a complementary document associated with the first document using the identifier;*

*normalizing data from the first document using the textual information from the complementary document and predefined business rules, wherein normalizing data comprises converting grams to kilograms, ounces to grams, or dollars to euro;*

*generating a list of hypotheses mapping the first document to the complementary document using:*

*textual information from the first document;*

*textual information from the complementary document; and*

*the predefined business rules; and*

*wherein generating the list of hypotheses comprises determining an overall cost of validating the first document according to each of the hypotheses;*

*determining a validity of the first document based on the hypotheses, wherein determining the validity of the first document comprises determining from among the hypotheses a hypothesis associated with a lowest cost;*

*and*

*outputting an indication of the determined validity.*

IX. The formulation of the third and fourth auxiliary request is of no relevance for this decision.

## **Reasons for the Decision**

### *The application*

1. The application relates to a method of verifying the validity of business documents, e.g. invoices. The document to be verified is compared with a complementary document, such as an order (summary of the invention; further page 7). In order to do so, the text is extracted from the document (by OCR), the data is normalized by e.g. converting units of measure, and data fields are associated with each other and with those of the complementary document (see e.g. figure 2 and its description starting on page 17; see also figures 1 and 3). The association process relies on evaluating, by field-wise summation, the cost for each matching hypothesis (or score) and choosing the hypothesis with the minimum cost (see pages 23 to 29). Predefined business rules dictate whether the document is to be considered valid or not. The normalization and the association process also rely on predefined business rules (see page 8, lines 13 to 27).

### *Main request*

#### *Article 84 EPC (points 14.1.1 to 14.1.4 of the decision)*

2. The Examining Division objected to the expression *normalizing data from the first document using the textual information from the complementary document and predefined business rules, wherein normalizing data comprises converting unit differences between the first document and the complementary document.*  
It was considered that the expression "converting unit differences" was not clear because it could be read as converting differences of one unit (i.e., "1") and not



necessarily as converting units of measure (point 14.1.1 of the reasons of the decision), and that it was not clear what normalizing data meant in general (point 14.1.2). Furthermore, the conversion of units of measure did not fall within the scope of "business rules".

3. The appellant submits (partly by reference to the letter of 8 December 2016, see pages 6 to 8 therein) that the claims should be read so as to arrive at a technically sensible claim interpretation (T 190/99, catchword); in so doing, the skilled person would find the cited phrase to be clear, understand that the conversion of units referred to converting units of measure and realise that this was an example of data normalization, which was a term clear to the skilled person.
4. The Board agrees with the appellant. The claim needs to be construed in the context of the application and should be construed in a reasonable manner. In the Board's judgment, the way in which the Examining Division interpreted "unit differences", although semantically justifiable, was unreasonable in the application context. There would be no reason to convert differences of one unit into something else, and the application itself only specifically discloses converting *units* of measure. This also means that the corresponding objection of added matter (Article 123(2) EPC, point 14.1.1 in the decision) is not valid.
5. Regarding data normalization, the Board agrees with the appellant that this term is clear to the skilled person. It also notes that in D1 the term "normalization" is used in the same way as in the application (see therein, page 5, lines 14 to 25; page

7, last paragraph; and cf. D1, paragraph 36: "The step of transforming the incoming structured and/or unstructured invoice data into a common format is sometimes referred to as a "'normalization' step"), also.

6. Furthermore, the conversion of units may not constitute a business rule per se, but the claims do not say that it does. They say that the normalization processes uses business rules, and that it comprises unit conversion. In other words, which data is converted may be determined by business rules, e.g. by determining which is the price field on the basis of business rules for data field arrangement, which is then converted according to (non-business) conversion rules (see description page 8, lines 20 to 27).
7. The objection in point 14.1.3 (use of the definite article in "the business rules" without an antecedent in the claims) was rendered moot by amendment. Related to that, in 14.1.4, the Examining Division found a lack of support because it was claimed that the same predefined business rules were used twice, for normalisation and for validation, but that "using the conversion" of units such as "US dollars to euro twice [lead] to faulty results". The Board does not follow this objection, because it is based on the incorrect assumption just addressed that the conversion would constitute a business rule. Furthermore, the claim language does not imply that the exact same business rules are used for conversion and for validation, or in the exact same way, but only that some business rules are used in both steps.

*Inventive step*

8. The Examining Division (point 14.2 of the decision) also rejected the main request for a lack on inventive step over document D1. This document teaches methods of verifying invoices by checking them against e.g. history data (purchase orders, paragraph 57) or by checking for potential duplicates (paragraph 48). In this process inter alia price and quantity variations are determined (paragraphs 2, 75), and data is normalized before validation (paragraph 36).
9. The appellant submits that the entire feature of data normalization is novel over D1 (statement of grounds page 6), whereas the Examining Division came to the conclusion that only the unit conversion sub-feature is novel (point 14.2.1). The Board agrees with the appellant: although data normalization per se is disclosed in D1, there is no explicit indication in D1 that information from a complementary document is used for that normalization, the normalization may be done into a predefined common format.
10. However, the Board considers that the normalization feature, even when taken in its entirety, is obvious in view of D1, because, if the invoice differs from the purchase order in the used data format (date or currency), the straightforward option is to convert one document into the format of the other for comparison. In doing so, textual information from the other document must be used to determine the necessary units of measure.
11. The Board further agrees with the argument of the Examining Division in point 14.2.2 of the decision that the claimed matter is the result of mere automation.

The appellant's argument seems to be that the features of conversion and normalisation possess technical character and provide the "technical effect of permitting accelerated correlation of documents having differences in the units expressed therein". This may be correct, but it does not change the fact that these operations would be implemented as the automated - and hence accelerated - version of the manual operations.

12. Thus claim 1 of this request lacks an inventive step over D1, Article 56 EPC.

*First auxiliary request*

13. All of the conclusions above hold for this request as well, which only further defines *converting grams to kilograms, ounces to grams, or dollars to euro*. The added clarity objection (point 15.2 in the decision) is a rewording of the objections in 14.1 and fails for the same reasons. However, claim 1 of this request lacks an inventive step for the same reasons as for the main request.

*Second auxiliary request*

*Article 123(2) EPC*

14. The Examining Division objected that the original application did not disclose the combination of a conversion step with cost hypothesis generation. The Board disagrees, because the normalization step is understood by the skilled person as a prerequisite to the validation (see page 5, lines 14 to 25; page 7, last paragraph). Thus a combination of this step with

subsequent processes for validation is directly and unambiguously derivable for the skilled person.

*Clarity*

15. For the same reasons as discussed above with reference to the main request, the Board also disagrees with the Examining Division that the claim of this request lacks clarity or support.
16. The Examining Division further held that the claims lacked clarity (point 16.3 in the decision) in that the expression *overall cost* would be read as referring to price, as opposed to matching costs for field association. Given the context (hypothesis generation and determining the hypothesis associated with a lowest cost), the Board does not find this interpretation to be reasonable either, and concludes that the objection is unjustified.

*Inventive step*

17. The Examining Division stated (point 16.2) that the objections as to a lack of inventive step for the main request, as raised in point 14.2.2, applied to this request "mutatis mutandis" as well. This assertion is rather superficial. For instance, the Examining Division did not express clearly whether they considered the newly claimed generation of hypotheses and the selection of the hypothesis associated with a lowest cost to correspond to a normal manual business procedure as referred to in point 14.2.2, or to which one.
- 17.1 The Board considers likely that the Examining Division did not specifically address this feature because it lacked clarity (point 16.3 of the decision) and thus could not be considered for an inventive step analysis

(see the decision at point 14.2.1 by analogy), or in view of the above-mentioned clarity and added-matter objections (points 16.1 and 16.2 in the decision referring back to 14.1.3 and 14.1.4).

- 17.2 As explained above, the Board disagrees with the Examining Division on the clarity and added-matter objections. As a consequence, inventive step of the hypothesis generation process will now have to be considered in full.
- 17.3 The Board also notes that the claimed hypothesis generation and selection cannot be considered to constitute mere business method steps which could, for that reason alone, be found not to contribute to inventive step.
- 17.4 D1 does not disclose the pertinent features. At the same time, the Board is not prepared to assess inventive step of these features without reference to a piece of prior art.
- 17.5 The Board however has doubts that the feature in question was covered by the search, because it had been introduced from the description only during the examination phase. This means that the Board, were it to keep the case under Article 11 RPBA2020, might base its inventive step assessment on an incomplete search. The Board also notes that, although the current claim wording is non-specific, the description contains a substantial amount of corresponding subject matter that may need to be taken into account for the search to be complete.
- 17.6 The Board sees therefore a need for the Examining Division to reassess its reasoning and on that basis to decide whether, and to what extent, an additional search is necessary to cover the subject matter defined in this request. These are special reasons justifying remittal under Article 11 RPBA 2020.

*Third and fourth auxiliary requests*

*Substantial procedural violation*

18. The appellant claims (last paragraph in section 6 and 7 of the grounds of appeal respectively) that its "right to be fully heard as to the patentability of these claims was infringed", on the basis that these requests were not admitted under Rule 137(3) EPC. According to the appellant, based upon the balancing of factors pertinent to the exercise of discretion, the Examining Division has erroneously denied "entry" of these requests (section 6 and 7 of the statement of grounds).
19. Even if this were true, it would only constitute an error of judgment rather than a procedural error, so that it cannot establish a violation of the appellant's right to be heard. Notably, the appellant does not contest that the admittance of these requests was discussed during the oral proceedings (see points 17 and 18 of the corresponding minutes). Accordingly, also the reimbursement of the appeal fee under Rule 103(1) (a) EPC is impossible.

*Admittance*

20. The appellant requests that the Board order "entry" of the third and fourth auxiliary requests by the Examining Division, because the Examining Division had provided inadequate reasons for not admitting those requests. In particular it had wrongly assessed the convergence criterion by not taking into account that their subject matter had been examined earlier.

21. However, in view of the foregoing it is clear that the question of whether the third and fourth auxiliary requests should have been admitted by the Examining Division or are to be admitted now, by the Board or the Examining Division, does not arise at this point. On further prosecution, the Examining Division will be bound by the ratio decidendi of this decision, Article 111(2) EPC. This means that, initially, the second auxiliary request will be before the Examination Division. No further instructions by the Board regarding the further prosecution are called for.
  
22. Whether any further request is to be admitted will have to be decided by the Examining Division when - and only when - examination has come to a negative conclusion on all higher-ranking requests. More specifically, if and when the appellant were to submit again what are now the third and fourth auxiliary requests, the Examining Division will have to exercise its discretion whether to give its consent under Rule 137(3)EPC, considering the circumstances of the case at that moment of time (in this regard, see, in particular, G7/93, point 2.5 of the reasons).



**Order**

**For these reasons it is decided that:**

The case is remitted for further prosecution.

The Registrar:

The Chairman:



L. Stridde

Martin Müller

Decision electronically authenticated