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**Datasheet for the decision
of 27 June 2023**

Case Number: T 0935/20 - 3.5.01

Application Number: 11730793.4

Publication Number: 2583221

IPC: G06Q10/00

Language of the proceedings: EN

Title of invention:
CHEMICAL ADDITIVE INGREDIENT PALETTE

Applicants:
S.C. Johnson & Son, Inc.
Vedula, Usha

Headword:
Chemical ingredient palette/SC JOHNSON

Relevant legal provisions:

EPC Art. 56
EPC R. 103(1)(a)
RPBA Art. 11

Keyword:

Substantial procedural violation - (decision based on a wrong set of claims - no)

Reimbursement of appeal fee - (no)

Inventive step - providing information about the chemical components of products without disclosing which component is in which product (no - not technical)

Decisions cited:

T 1976/18, T 0641/00



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Case Number: T 0935/20 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 27 June 2023

Appellant: S.C. Johnson & Son, Inc.
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Appellant: Vedula, Usha
(Applicant 2) 5541 Whirlaway Lane
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Representative: Murgitroyd & Company
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 16 January 2020
refusing European patent application No.
11730793.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman M. Höhn
Members: I. Kürten
D. Rogers

Summary of Facts and Submissions

- I. The appeal concerns the decision of the examining division to refuse the European patent application No. 11730793.4 on the grounds that the main and first auxiliary requests then on file lacked an inventive step (Article 56 EPC) over a general-purpose networked computing system.

- II. In the statement setting out the grounds of appeal, the appellants requested that the decision under appeal be set aside and that a patent be granted on the basis of the main or first auxiliary request filed with the grounds. Apart from minor amendments made to claim 7 of the first auxiliary request, these requests corresponded to the refused requests. The appellants also requested reimbursement of the appeal fee on the grounds that the examining division's decision was based on a wrong set of claims, which they considered a substantial procedural violation. Oral proceedings were requested on an auxiliary basis.

- III. In a communication pursuant to Rule 100(2) EPC, the Board set out its preliminary view that, although the examining division appeared to have made an error in their decision, the Board did not consider this error to be a substantial procedural deficiency justifying the refund of the appeal fee. Furthermore, Rule 103(1) (a) EPC required an allowable appeal for a refund to be ordered, and the Board did not consider this requirement to be met since claim 7 of the main and first auxiliary request appeared to lack an inventive step.

- IV. In a reply, the appellants further explained why they considered that the examining division had committed a substantial procedural violation and submitted further arguments in support of inventive step. The request for oral proceedings was maintained.
- V. The Board arranged for oral proceedings. In the communication accompanying the summons, the Board elaborated on the reasons why the main and first auxiliary requests lacked an inventive step, why the Board did not consider that the examining division had committed a substantial procedural violation, and why the request for reimbursing the appeal fee could not be granted.
- VI. In a reply, the appellants filed a second auxiliary request and provided supporting inventive step arguments.
- VII. At the oral proceedings, held by videoconference on 27 June 2023, the appellants confirmed the main, first and second auxiliary requests submitted in writing, as well as the request for reimbursement of the appeal fee. They also requested that the case be remitted back to the examining division for further prosecution.
- VIII. Claim 7 of the main request reads:

An automated computer system storing and updating a written or electronic list of pre-approved chemicals, the system comprising:

(a) a first computer database listing at least ten selected products marketed by a company;

(b) a second computer database listing chemical components of at least ten different multi-component materials used in one or more of those products; and

(c) a third computer database listing chemicals present in the selected products, by product, except that multi-component materials present in at least some of the products are identified in the third database without disclosing at least some of their chemical components in the third database;

(d) wherein the second and third databases are publically accessible by telecommunication so that someone accessing these databases can review the chemical content of a product, except that chemical contents of a multi-component material in that product will be identified by being present in the second database, without the second or third database disclosing which of the components in the second database are in which third database multi-component material or in which third database product.

IX. Claim 7 of the first auxiliary request adds at the end of claim 7 of the main request:

wherein if a new multi-component material is proposed for inclusion in the system, the system is configured to compare the chemical components thereof with the chemical components in the second database, and if all are already in the second database then the system is configured to add a product comprising the new multi-component material only to the first and third databases, and

wherein if a new product having the multi-component material is proposed for inclusion in the system, the

system is configured to compare the chemical components of its multi- component material to the second database, and if all those components are already in the second database then the system is configured to add the new product only to the first and third databases.

X. Claim 7 of the second auxiliary request adds in feature (b) of claim 7 of the first auxiliary request that the chemical components in the second computer database are listed "*by Chemical Abstracts Service registry numbers, CASRN*".

XI. The appellants' arguments can be summarised as follows:

The examining division based their decision on a wrong set of claims, as they failed to acknowledge that the claimed databases were *computer* databases. Hence, the applicants had no valid decision on their main request. Deciding on a wrong set of claims was a substantial procedural violation that warranted a remittal and reimbursement of the appeal fee.

The system defined in claim 7 of the main and first auxiliary requests allowed customers to determine the presence of an allergen in a product. It also enabled the easy and cost effective addition of new products to the system. These effects were technical and achieved by the three computer databases, their content, and their interactions. Therefore, these features were technical and had to be taken into account in the assessment of inventive step. Such databases were not obvious when starting from a general-purpose computing system.

The CAS numbers in the second auxiliary request uniquely identified the stored chemical compounds. These numbers enabled the reliable comparison of compounds and prevented the redundant storage of compounds, resulting in reduced memory consumption.

Reasons for the Decision

1. The invention

- 1.1 The invention deals with the problem of disclosing the chemical composition of products, such as household products, without violating confidentiality agreements protecting the composition of proprietary materials (e.g. fragrances) used in these products (paragraph [0003] of the published application).
- 1.2 The claimed solution involves three computer databases (claim 7, [0022]). The first database stores a list of products marketed by a company (feature (a)). The second database stores a list of chemical components present in proprietary materials, such as fragrances ("multi-component materials"), used in these products (feature (b)). The third database stores the chemical composition of each of the products in the first database, except for the proprietary materials, which are only identified (feature (c)).
- 1.3 The second and third databases are publically accessible. Hence, a customer can view the chemical make-up of a product, except for the chemicals of the proprietary materials used in that product.

Confidentiality agreements are not breached because the second database only stores a list of chemicals without specifying which chemicals are in which materials. However, the customer can still obtain some information from the second database, such as which chemicals are not in the product (feature (d), [0023],[0032]).

2. *Substantial procedural violation*

2.1 The appellants argued that the examining division had based their decision on a wrong set of claims, which amounted to a substantial procedural violation. This was evident from the fact that claim 7 analysed in the decision referred to a first, second, and third database, whereas claim 7 in the applicants' main request specified that these were *computer* databases (e.g. pages 4 and 5 of the decision). According to the appellants, a computer database was inherently technical. The examining division's statement that the databases were non-technical indicated that they did not consider the applicants' request. This was a procedural error. The error was also substantial since if the division had examined the correct set of claims, the appellants would not have had to appeal.

The appellants argued that the present case was similar to T 1976/18 (*Substantial procedural violation/NATERA*), where the examining division based their decision on a request that had been superseded by another request. The Board in that case found that the examining division had committed a substantial procedural violation, remitted the case and ordered the appeal fee to be reimbursed in full.

2.2 The Board disagrees with the appellants that the examining division based their decision on a wrong set

of claims. The applicants' main request before the examining division, which was filed on 6 November 2019, is explicitly stated under point 9 of the summary of facts and submissions as the basis for the decision to refuse. The claims annexed to the decision also bear the correct date and comprise the limitation to *computer* databases. Furthermore, the minutes of the first instance oral proceedings confirm that during the oral proceedings the examining division acknowledged the request filed on 6 November 2019 and gave their opinion on the amendment related to *computer* databases (page 1 of the annex to the minutes, lines 9 to 15). These facts indicate that the examining division indeed based their decision on the correct set of claims.

- 2.3 Amended claim 7 of the appellants' main request differs from the previous version of this claim in that it limits the three databases to *computer* databases. It appears that when preparing the written reasons for the refusal, the examining division copied part of their earlier arguments from the annex to the summons to oral proceedings, which pertained to the previous version of claim 7, without adapting that part to reflect the amendments made (pages 4 and 5 of the decision). This appears to be the reason why this part of the decision does not mention the limitation to *computer* databases.

Hence, it appears that the examining division indeed made an error in this part of the decision. The Board would classify this as a drafting error.

- 2.4 However, it is evident from other parts of the decision that the examining division did consider the limitation to *computer* databases. For instance, in the paragraph bridging pages 5 and 6, the division stated that the use of a database in a networked computer system was

notoriously known and "[e]ven if considered to be technical [a database] its use would not require any inventive activity". On page 14 of the decision, the examining division further elaborated that:

"... Computer implemented databases are notoriously known ... They [the three databases in claim 7] are merely used as data collections (see T154/04). Their content is non-technical as it is merely an administrative choice what database shall contain which data. This organisation of data or modelling is non-technical as the same content could be organised in a non-technical, non-computerised database... The computerised databases are not at all adapted to solve the technical problem ... claimed by the applicant ..." [emphasis added by the Board]

The Board understands from this passage that the examining division considered the three databases, to the extent they were defined by the content of the information stored in them, as non-technical and that using *computer* databases for storing such information was notorious. As a result, the Board concludes that the division took into account all limitations of the applicants' main request before reaching their decision, and that the drafting error they made did not have any impact on the outcome of the examination proceedings.

- 2.5 The Board is of the opinion that T 1976/18 (*supra*) is not relevant to the present case. In T 1976/18, the examining division was uncertain whether a newly submitted set of claims replaced the previous main request or whether it constituted an auxiliary request. Consequently, the division decided on both requests,

which was explicitly stated in the decision. The deciding Board considered that there was clear evidence indicating that the latest claims replaced the previous main request. Deciding on a request that had not been approved by the applicants was deemed to violate the principle of party disposition (*ne ultra petita*) and to constitute a substantial procedural violation.

In contrast to this case, the decision to refuse underlying the present appeal provides sufficient evidence that the examining division considered and decided upon the correct request.

- 2.6 In view of the above, the Board judges that the examining division did not commit a substantial procedural violation.

3. *Requests for remittal and reimbursement of the appeal fee*

- 3.1 In view of the Board's conclusion that the decision to refuse the application was based on the correct set of claims and that there was no substantial procedural violation, the Board sees no reason for remitting the case to the examining division (Article 11 RPBA).

- 3.2 Furthermore, the appellants' request for reimbursement of the appeal fee cannot be granted, as reimbursement is contingent upon the presence of a substantial procedural violation (Rule 103(1)(a) EPC).

4. *Main request - inventive step*

- 4.1 The examining division started their inventive step assessment from a general-purpose networked computing system. They held that claim 7 did not involve an

inventive step because it defined an obvious implementation of a non-technical administrative scheme on such a system.

4.2 The Board agrees with this assessment. In particular, the Board finds that claim 7 comprises the following non-technical features:

(a) a first data collection listing at least ten selected products marketed by a company;

(b) a second data collection listing chemical components of at least ten different multi-component materials used in one or more of those products; and

(c) a third data collection listing chemicals present in the selected products, by product, except that multi-component materials present in at least some of the products are identified in the third data collection without disclosing at least some of their chemical components in the third data collection;

(d) wherein the second and third data collections are publically accessible so that someone accessing these data collections can review the chemical content of a product, except that chemical contents of a multi-component material in that product will be identified by being present in the second data collection, without the second or third data collections disclosing which of the components in the second data collection are in which multi-component material or in which product in the third data collection.

4.3 The three data collections are merely catalogues with product information. They are designed to balance two conflicting non-technical requirements. On the one

hand, there is a business need to inform customers about the chemical composition of the company's products. On the other hand, there is a legal obligation to protect the content of proprietary materials, such as fragrances included in the products, which are covered by confidentiality agreements. The task of creating product catalogues satisfying these requirements falls under the competence of marketing and/or legal experts. It does not require technical knowledge or skills.

- 4.4 Requirements that can be formulated by a non-technical person are part of the non-technical framework and can be given to the technically skilled person (a computer specialist) for implementation (T 0641/00 - *Two identities/COMVIK*). Therefore, the technical problem solved can be defined as how to implement features (a) to (d) on a general-purpose networked computer system.
- 4.5 The claimed solution involves storing the data collections in three computer databases and accessing these databases "by telecommunication". This is a straightforward automation of the non-technical features, which would be obvious to the skilled person.
- 4.6 The appellants argued that the three computer databases, their content and their interactions allowed customers to determine if a product, and in particular a fragrance in the product, contained an allergen. This effect was inherently technical. It was achieved by checking the content of the second computer database, which comprised the chemical components of all fragrances of all marketed products. Moreover, since the second database comprised the chemical components of at least ten fragrances and did not specify which fragrance contained which chemical components, the

compositions of fragrances could not be inferred. In this way, confidentiality agreements were not violated.

- 4.7 The Board is not convinced that the effect identified by the appellants is technical. While customers may find information about the presence or absence of a specific allergen in a product useful and this information may influence their purchasing decisions, these are cognitive effects rather than technical ones.

The Board is also not convinced that the effect identified by the appellants is achieved. The second database comprises the chemical components of all fragrances, without specifying which components belong to which fragrance. This means that if a particular allergen is listed in the second database, a customer can only infer that this allergen is present in at least one of the company's marketed products. The customer would not be able to determine if the allergen is contained in a product they are interested in.

- 4.8 In view of the above, the Board judges that claim 7 of the main request does not involve an inventive step (Article 56 EPC).

5. *First auxiliary request - inventive step*

- 5.1 The additional features in claim 7 specify how a new product comprising a new proprietary material is added to the system. In particular, the system compares the chemical composition of the new material to the chemicals in the second database. If all components are already present in the second database, the system adds the new product only to the first and third databases.

- 5.2 The appellants argued that this avoided the repetitive inclusion of chemical components in the second database, which made the addition of new products "technically easy" and "cost effective".
- 5.3 The Board, however, considers that maintaining a single copy of each chemical component present in a set of proprietary materials is a further non-technical requirement that pertains to the cognitive content of the stored information. Claim 7 provides a straightforward implementation of this requirement. Any efficiency, if indeed achieved, is a direct consequence of the straightforward technical implementation of this requirement.
- 5.4 Accordingly, claim 7 of the first auxiliary request does not involve an inventive step (Article 56 EPC).
6. *Second auxiliary request - inventive step*
- 6.1 Claim 7 of this request further specifies that the chemical components in the second database are listed by their Chemical Abstracts Service registry numbers (CASRN).
- 6.2 The appellants argued that using CAS numbers prevented redundant database entries for the same compound under different names, thereby reducing storage space consumption. Furthermore, the CAS numbers ensured reliable comparisons of the chemical components.
- 6.3 The Board, however, considers that storing CAS registry numbers is another non-technical requirement related to the cognitive content of the stored information. These numbers are merely stored in the database without being used. Even if the claim incorporated the uses suggested

by the appellants, it would still not involve an inventive step because using unique identifiers, such as CAS numbers, is an obvious way to ensure the integrity and consistency of stored data.

6.4 Accordingly, claim 7 of the second auxiliary request does not involve an inventive step (Article 56 EPC).

7. Since none of the appellants' requests is allowable, the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



T. Buschek

M. Höhn

Decision electronically authenticated