BESCHWERDEKAMMERN   BOARDS OF APPEAL OF   CHAMBRES DE RECOURS
DES EUROPÄISCHEN   THE EUROPEAN PATENT   DE L'OFFICE EUROPEEN
PATENTAMTS   OFFICE   DES BREVETS

Datasheet for the decision
of 10 October 2007

Case Number: T 0845/05 - 3.5.01

Application Number: 99650055.9

Publication Number: 1049039

IPC: G06F 17/60

Language of the proceedings: EN

Title of invention:
Application apparatus and method

Applicant:
Minerva Holdings NV

Opponent:
-

Headword:
Application apparatus/MINERVA

Relevant legal provisions:
EPC Art. 56

Keyword:
"Inventive step - treatment of non-technical features"
"Mere wish to automate a manual procedure - obvious"

Decisions cited:
-

Catchword:
Cf. point 1.6 to 1.8 of the Reasons

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Beschwerdekammern   Boards of Appeal   Chambres de recours

Case Number: T 0845/05 **-** 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 10 October 2007

Appellant: Minerva Holdings NV
                                   Parnassustoren
                                   Locatellikade 1
                                   NL-1076 AZ Amsterdam   (NL)

Representative: Fleuchaus, Michael A.
                                   Fleuchaus & Gallo
                                   Melchiorstrasse 42
                                   D-81479 München   (DE)

Decision under appeal: **Decision of the Examining Division of the**
                                   European Patent Office posted 7 February 2005
                                   refusing European application No. 99650055.9
                                   pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. Steinbrener
Members: S. Wibergh
                   A. Pignatelli

Summary of Facts and Submissions

I.   This appeal is against the decision of the examining
        division to refuse European patent application
        No. 99650055.9.

II.   The following document will be referred to in the
        present decision:

        D1: US-A-5 765 144.

III.   The examining division held that the invention
        according to the main and auxiliary requests before it
        did not involve an inventive step.

IV.   In the statement of grounds of appeal the appellants
        requested that the decision be set aside and a patent
        be granted based on claims according to one of the main
        request and two auxiliary requests filed together with
        the grounds.

V.   In reply to a communication from the Board, the
        appellants submitted a new main request by letter dated
        10 September 2007.

VI.   Oral proceedings were held on 10 October 2007. In the
        course of the proceedings the appellants filed claims
        according to three new auxiliary requests.

VII.   Claim 1 of the appellants' main request, filed with
        letter dated 10 September 2007, reads:

"An apparatus for receiving and assessing an
application made by an applicant, said apparatus
including:
computing means (23) configured or programmed to
present a plurality of application forms (8) to said
applicant (5), to receive said forms once completed
from said applicant (5) and to assess said application;
input means (3,4) for said applicant (5) to complete
and return said forms (8) to said computing means (23);
and
communication means for communicating or sending said
assessment of said application to said applicant (5);
wherein said computing means (23) is configured or
programmed to construct second and subsequent forms of
said plurality of forms (8) progressively on the basis
of information provided by said applicant (5) by means
of said input means (3,4) in one or more of said
completed and received forms, to assess said
application, and to communicate said assessment by
means of said communication means."

Claim 22 is directed to a corresponding "computer-
implemented method for receiving and assessing an
application", claims 30 and 31 to computer program
products and claim 32 to a computer readable medium.

VIII.   Claim 1 of auxiliary request 1 differs from the main
request by the addition that the forms are constructed
progressively on the basis of "an analysis performed by
said computing means of" information provided by the
applicant.

Auxiliary request 2 is limited to the claims of the
main request directed to the apparatus.

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Auxiliary request 3 is limited to the claims of
auxiliary request 1 directed to the apparatus.

IX.   The appellants requested that the decision under appeal
        be set aside and that a patent be granted on the basis
        of claims 1 to 32 of the main request submitted with
        letter of 10 September 2007 or on the basis of claims 1
        to 32 of auxiliary request 1 or of claims 1 to 21 of
        auxiliary request 2 or of claims 1 to 21 of auxiliary
        request 3, all auxiliary requests as submitted during
        the oral proceedings before the Board.

X.   At the end of the oral proceedings the Board announced
        its decision.

Reasons for the Decision

Main request

1.   Inventive step

1.1   In the patent application, an existing practice for
        applying for finance, eg a mortgage, is described
        (paragraph [0002]). This practice "requires an
        applicant to contact a recipient in the form of, for
        example, a lender, often in person or by telephone, and
        complete - orally or in writing - a loan application
        for subsequent consideration by the lender".

1.2   The examining division held that the subject-matter of
        claim 1 was a straight-forward computer implementation
        of such a practice, noting that a lender (bank

administrator) would only ask pertinent questions
(decision, point 4.4). The Board understands this to
mean that if a bank administrator is for example
informed that an applicant for a mortgage has no
dependents, he would not ask for their age. In the same
way a computer performing the task should ideally be
programmed to suppress irrelevant questions. The
examining division pointed out that this could easily
be achieved by the use of nested "if then else"
statements (decision, point 4.2).

1.3   The appellants have argued that although lenders may
collect information orally, they also have to fill in a
form summarizing the answers. This was a pre-printed
form which could not be altered. Computer
implementations of the application process were known,
for example from D1, but also then predetermined forms
were provided and filled in by the applicant on the
screen. The invention improved on this technique by
configuring the computer to analyze the answers given
to the questions displayed and modify subsequent parts
of the forms as needed. In the words of claim 1, the
forms were *progressively constructed*.

1.4   In spite of the appellants' counter-arguments, the
Board finds the reasoning in the decision under appeal
convincing. The mere wish to automate a manually
performed administrative procedure, such as an
application for finance, must be regarded as obvious,
and clearly a computer would be used for this purpose.
The natural starting point for a programmer - who is
the technically skilled person in this case - is to
develop a system which as far as possible mimics the
behaviour of the bank administrator. Since the bank

administrator is capable of analyzing answers and react
to them, an ideal computer system should be programmed
to react to answers in a similar way, in particular by
avoiding displaying questions which in the light of
previous answers have become irrelevant. Thus the
screen contents should be adapted to the needs of
individual applicants or, in the words of claim 1, be
constructed "progressively on the basis of information
provided by said applicant". Only if the skilled person
could not readily see a way of making the computer
analyze answers as desired might a claimed automation
implementation in this respect be non-obvious. But in
the present case there can have been no such
difficulties since the application contains no
programmation details.

1.5   The appellants have argued that even if the manual
procedure could be automated, the computer in any
obvious implementation would not be arranged to
construct forms progressively. It would rather present
predefined forms in the same way as a bank
administrator uses pre-printed paper forms. It was
instructive to contrast the invention with a printing
press, the invention being capable of constructing
forms progressively but the printing press being
limited to creating inalterable forms. Furthermore, in
D1 the forms, and thus the questions put to an
applicant, were predetermined and the answers were
recorded without being analyzed. Thus also D1 did not
disclose progressive form construction.

1.6   The Board, however, cannot accept these arguments. The
skilled person in the year of priority - 1999 - was
certainly aware that a computer is a more versatile

apparatus than a printing press. It is not limited to displaying and outputting predetermined forms even if it may be so used, and in D1 arguably is. Automating a manually performed procedure means aiming at making a computer behave like a human being, not like a printing press. The bank administrator must use pre-printed forms even if they contain superfluous information simply because he has nothing else. The computer does not use pre-printed forms and therefore would not create identical forms in a situation where such forms might be awkward. Whether they are awkward or not is mainly a non-technical question since it will depend on the contents of the forms. For example, if situations may occur where a large number of the prepared questions become irrelevant, then it would be preferable to adapt the forms as they are created. If few or no questions are ever irrelevant there is little need to adapt. This is an issue to be decided by bank managers, not programmers.

1.7   It may further be noted that a claimed solution to a technical problem does not necessarily involve an inventive step merely because less sophisticated solutions exist (or even have been patented). The D1 system may result in unnecessarily long forms but will instead have the advantage of being relatively simple. There is no indication in D1 that systems more closely simulating the way a human being acts would be undesirable, and even less that a technical prejudice against such systems existed.

1.8   Finally, the appellants have argued that the present invention required technical considerations, that its steps are designed in such a way as to be particularly

suitable for implementation on a computing system, and that it could not conceivably be implemented other than on a computing system (letter dated 10 September 2007, p.5). The Board agrees that constructing forms progressively and automatically would probably not be possible without a computer. But this is not a decisive point since there was no realistic alternative to using a computer for the automation. The important question is rather whether the progressive construction of forms involved an inventive use of a computer, and this question the Board has already answered in the negative.

1.9   Thus, the subject-matter of claim 1 does not involve an inventive step (Article 56 EPC).

Auxiliary request 1

2.   According to auxiliary request 1 the forms are constructed progressively on the basis of *an analysis performed by said computing means of* information provided by the applicant. This addition emphasizes the fact that the computer not merely records answers but reacts to them in order to construct the forms. However, since this aspect of the invention has already been considered in connection with the main request, the auxiliary request contains no further restrictions of claim 1 and must be refused for the same reasons.

Auxiliary request 2 and 3

3.   Claim 1 of auxiliary requests 2 and 3 are identical with claim 1 of the main request and auxiliary request 1, respectively. These requests are therefore also refused.

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Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

T. Buschek S. Steinbrener