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**Datasheet for the decision  
of 24 April 2007**

**Case Number:** T 0690/06 - 3.5.01

**Application Number:** 02767678.2

**Publication Number:** 1449133

**IPC:** G06F 17/60

**Language of the proceedings:** EN

**Title of invention:**

Financial records maintenance system

**Applicant:**

Aukol Limited

**Opponent:**

-

**Headword:**

Financial records/AUKOL

**Relevant legal provisions:**

EPC R. 45, 67, 68(2)

PCT Art. 17(2)(a)

**Keyword:**

"Declaration pursuant to Article 17(2)(a) PCT"

"Additional search"

"Substantial procedural violation (no)"

"Remittal (yes)"

**Decisions cited:**

T 0766/91, T 0223/95, T 0438/97, T 0641/00, T 1242/04

**Catchword:**

As long as no search has been performed an examining division should normally not refuse an application for lack of inventive step if the invention as claimed contains at least one technical feature which is not notorious (point 8 of the reasons).



Case Number: T 0690/06 - 3.5.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.01  
of 24 April 2007

**Appellant:** Aukol Limited  
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**Representative:** Kenrick, Mark Lloyd  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 23 December 2005  
refusing European application No. 02767678.2  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** S. Steinbrener  
**Members:** S. Wibergh  
P. Schmitz

## Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division to refuse European patent application No. 02767678.2.
- II. According to the decision appealed, the subject-matter of claims 1 to 9 (in the version of 8 July 2005) did not involve an inventive step having regard to common general knowledge. A search had neither been performed in the International phase nor in the European phase of the procedure.
- III. Claim 1 reads:

"A computer system for monitoring financial records for a plurality of users (5) and for giving a plurality of mutually independent financial service providers (6) selective access to the financial records, the system comprising a database (2) partitioned into areas each of which is allocated to a respective user (5), a processor for writing data to and reading data from the database (2), computer network connections (4) coupling the processor to each user (5) and each financial service provider (6), a user access control system which is arranged to give a user access via the processor only to the respective data storage area such that each user (5) can only update and read financial data stored in the respective data storage area, and a financial service provider access control system which is arranged to give a financial service provider (6) at least read access via the processor to a data storage area only if that financial service provider (6) is

authorised by the user (5) to which that data storage area has been allocated."

Independent claim 9 is directed to a corresponding "method for maintaining financial records".

- IV. The appellants request that:
- the decision be set aside,
  - the case be remitted to the examining division for a search for prior art to be carried out,
  - the appeal fee be reimbursed.

Unless the case is remitted the appellants further request that oral proceedings before the Board be held and that certain questions on the no-search issue be referred to the Enlarged Board of Appeal.

- V. The appellants' arguments can be summarized as follows:

During the International phase the EPO acting as International Searching Authority (ISA) declined to carry out a search, citing Rule 39.1 and Article 17(2)(a)(i),(ii) PCT in support of its position. The ISA indicated that it was declining to search the claims on the basis that they related to a presentation of information. That was not a sufficient reason, given that the invention did not relate to a **mere** presentation of information as stated in Rule 39.1(v) PCT. If the application had been filed directly as a European patent application instead of as a PCT application the appellants would have had a legitimate expectation that the EPO would carry out a search, because it would be inappropriate to decline to search under Rule 45 EPC given that a search would always be

meaningful if novelty and inventive step were to be considered. Therefore, in the interest of obtaining uniformity of procedure between directly filed European applications and Euro-PCT applications, an additional search should have been carried out in accordance with the "Guidelines for Examination in the European Patent Office" C-VI, 8.5.

In order to consider inventive step the closest prior art must be identified. The closest prior art could only be properly identified by the EPO carrying out a search to locate relevant prior art. Without such a search the closest prior art could not be identified, and the problem and solution approach could therefore not be correctly applied. In the present case, no search had been carried out, but the examining division had nevertheless considered inventive step. This was wrong. The assessment of inventive step was based on what "appeared" to be the closest prior art (cf the decision under appeal, p.4 par.3). What was said to appear to be the closest prior art was a vaguely described networked computer system, the details of which were not evidenced.

The conduct of the examining division in refusing the application on the basis of inventive step without carrying out a search was wrong on two counts: it was wrong to make unsubstantiated allegations of prior art without providing documentary evidence of the same to the appellants, and it was wrong to assess inventive step without concrete knowledge of what actually was the prior art.

Considering the first error, it was clear that where prior art was contended to exist, the person making such a contention must prove its existence. The appellants had been provided with no evidence that prior art as described by the examining division existed. The application had therefore been refused on the basis of an inventive step assessment based upon a mere contention. The examining division went further and contended that the described prior art was part of the common general knowledge and did not require written evidence. This was wrong. As made clear in decision T 766/91 (not published in OJ EPO), common general knowledge was represented by basic handbooks and textbooks. Thus, to successfully make out that the alleged prior art was in fact common general knowledge the examining division would have needed to provide evidence in the form of such handbooks or textbooks. It was clear that where an assertion that something was part of the common general knowledge was challenged, the person making the assertion must provide proof that the alleged subject-matter indeed did form part of the common general knowledge, cf T 438/97 (not published in OJ EPO).

The approach applied by the examining division caused further problems. Specifically, what exactly did the alleged prior art disclose? If this was not known definitively, as was the case here, application of the problem and solution approach became impossible. Indeed, it was fundamental to the operation of the EPO that a party be provided with an opportunity to comment on prior art which was alleged to be relevant to a patent application. Such an opportunity afforded an applicant the opportunity to read the prior art and consider its

disclosure before assessing the relevance of the disclosure to the application. Where an application was processed without a search being carried out and unsubstantiated allegations of prior art were made, this was of course impossible. Thus, the approach to inventive step employed by the examining division was fundamentally flawed. Inventive step could not be assessed without a clear understanding of the closest prior art. This required that a search was carried out.

In so far as the appellants were able to understand the examining division's unsubstantiated allegations, the prior art simply comprised a database which was assessable from a general purpose networked computer system. The detailed implementation of such a system was not known, given that no evidence had been provided. Starting from the alleged prior art, the technical problem which the invention was directed to solve was how to provide improved access control for the database. Controlling user access to a database was necessarily a technical problem. The invention provided a computer system in which controlled access to a database was provided to two distinct groups of users, viz financial service providers and users. The nature of the controlled access provided was based upon a relationship between the two distinct groups of users. The user access control system and the financial service provider access control system required by the claim were both technical features and both lay firmly in the technical field of database access control. Accordingly it was clear that these features provided a technical solution.

Reimbursement of the appeal fee was equitable given that the application was refused under Article 56 EPC without a search having been carried out, which constituted a substantial procedural violation. Even if the examining division believed that the technical features were notoriously well known they failed to include such reasoning in the decision under appeal, which represented a further substantial procedural violation.

### **Reasons for the Decision**

1. The decision under appeal, according to which the subject-matter of claim 1 and 9 (in the version of 8 July 2005) did not involve an inventive step, was taken without a search having been performed. In the grounds of appeal the appellants argue that it is improper to examine and decide a case under Article 56 EPC without a search having been carried out.
  
2. In decision T 1242/04 - *Bereitstellung produktspezifischer Daten/MAN* (to be published in the OJ EPO) it is held that only when a search is not at all possible can it be denied under Rule 45 EPC. Whether or not the search division believes that the result of a search will be of use for the substantive examination is irrelevant (point 8.3). If nevertheless the situation occurs that no search has been performed although it could (and should) have been, an examining division is not obliged to perform an additional search for purely formal reasons if it considers a refusal of the application to be justified on the basis of prior art which is either so well known that it clearly does



not require written proof or accepted by the applicant as known (point 9.2). In all other cases an additional search should be performed.

3. The invention according to claim 1 is a computer system for monitoring financial records. It comprises in particular:
  - a database partitioned into areas each of which is allocated to a respective user,
  - a processor for writing data to and reading data from the database,
  - computer network connections coupling the processor to each user and each financial service provider,
  - a user access control system which is arranged to give a user access via the processor only to the respective data storage area such that each user can only update and read financial data stored in the respective data storage area,
  - a financial service provider access control system which is arranged to give a financial service provider at least read access via the processor to a data storage area.
  
4. The EPO acting as ISA notified the appellants according to Article 17(2)(a) PCT that no international search report would be established. Without having performed an additional search the examining division decided that the invention did not involve an inventive step. Intending to apply the "Comvik approach" (cf T 641/00 - Two identities/COMVIK, OJ EPO 2003,352), the examining division included the partitioned database and the selective access to storage areas in a business method "implemented in a general purpose computer system" (cf the decision, paragraph bridging p.3 and 4). The

closest prior art, consisting of a general purpose networked computer system with a database (p.4, par.3), was regarded as so well known as not requiring proof. The technical problem was "how to automate the business method described in the claim" (p.4, par.7). It was solved by "conventional programming techniques" (p.5, top).

5. The appellants have in particular argued that it was wrong by the examining division to make allegations of prior art without documentary evidence. It was also wrong to assess inventive step without concrete knowledge of what actually was the prior art.
  
6. As to the first argument it should be noted that "a general purpose networked computer system with a database" was the only art which the examining division explicitly assumed to be known. The Board agrees that such a system is indeed "notorious" in the sense of decision T 223/95 (not published in the OJ EPO) and thus did not require documentary evidence.
  
7. As to the second argument the Board first observes that the examining division included technical features - a database, a processor, network connections and access via the processor to storage areas - in the business method. In the Board's view this was an incorrect application of the Comvik approach, which only permits "an aim to be achieved in a non-technical field" to appear in the formulation of the problem (T 641/00, *supra*, point 7). To partition a database connected to a processor and design control systems providing read/write access via the processor are not aims in a non-technical field but very much technical features.

They can hardly be regarded as notorious (nor did the examining division allege they were). Therefore, in the absence of documents proving the contrary they must be assumed to be new as such. Since the decision under appeal does not cover these aspects of the invention, it must be set aside.

8. Regarding the procedure before the examining division the Board is of the opinion that the examining division should have performed an additional search since the database partitioning and access control features are neither non-technical nor notorious. Following the principles set out in decision T 1242/04, point 8 (*supra*), the Board considers that as long as no search has been performed an examining division should normally not refuse an application for lack of inventive step if the invention as claimed contains at least one technical feature which is not notorious. The term "notorious" should be interpreted narrowly.
9. The same considerations apply to method claim 9.
10. The Board concludes that the decision under appeal should be set aside and the case be remitted to the examining division for an additional search to be carried out and continuation of the proceedings.

*Reimbursement of the appeal fee*

11. The appellants request that the appeal fee be reimbursed by reason of a substantial procedural violation (cf Rule 67 EPC). In their opinion the examining division committed a first substantial procedural violation by refusing the application for

lack of inventive step when no search for prior art had been carried out and a second by not including reasoning in the decision under appeal why the technical features of claim 1 were held to be notorious.

12. As to the appellants' first argument, the Board found in decision T 1242/04 that it is not always necessary for the examining division to carry out an additional search if such search is not expedient under the prevailing circumstances. It must therefore be assumed that the examining division has an, albeit limited, discretion in this respect. In the present case, the examining division did not consider an additional search expedient in view of their (incorrect) inclusion of technical features in the business method which as such did not require a search. However, whether or not such inclusion is justified is a matter of judgment on a substantive issue rather than a question of non-observance of procedural rules. Although this kind of incorrect judgment will normally also have procedural consequences, these consequences are not reducible to a procedural violation, ie an incorrect conduct of the procedure.

13. As to the second argument, in the Board's view an insufficiently reasoned decision has to be distinguished from a decision that has faulty or not persuasive reasoning. In the present case, the Board cannot agree with the appellants that the decision is insufficiently reasoned. It is neither based on mere allegations, nor does it lack a clear comprehensive argumentation. Notorious prior art (ie prior art which cannot reasonably be contested to have been generally known) is cited without proof, but, as already noted,

this is allowed by the jurisprudence. Furthermore, the COMVIK approach may have been incorrectly applied but this is a substantial issue, again only involving judgment. Thus, the decision is reasoned in the sense of Rule 68(2) EPC.

14. It follows that there is no basis for reimbursement of the appeal fee (Rule 67 EPC).
  
15. Since the case is remitted to the department of first instance as requested by the appellants, their auxiliary requests need not be considered.

**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 the first instance for further prosecution, including an additional search.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

T. Buschek

S. Steinbrener