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**Datasheet for the decision
of 6 June 2011**

Case Number: T 1411/08 - 3.5.01

Application Number: 00963625.9

Publication Number: 1218839

IPC: G06F17/60

Language of the proceedings: EN

Title of invention:

SYSTEM AND METHOD FOR PAIRING PROVIDERS WITH CONSUMERS OF
ONLINE GOODS AND SERVICES

Applicant:

In-Development, LLC

Headword:

Pairing providers with consumers/In-Development

Relevant legal provisions:

EPC 1973 Art. 56

EPC R. 103(1) (a)

Keyword:

"Substantial procedural violation (yes)"

"Unsearched subject matter - examination proceedings"

Decisions cited:

T 1242/04, T 1515/07

Catchword:

"Notorious" knowledge, for which no search need be performed before an objection of lack of inventive step is raised, is understood, firstly, as being so well known that its existence at the date of priority cannot be reasonably disputed; and, secondly, as relating to generic features, that is, to features which are defined in such a way that technical details are not significant (Reasons 4.1, 4.2 and 7.3).



Case Number: T1411/08 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 6 June 2011

Appellant: In-Development, LLC
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Representative: Peterreins, Frank
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted 8 February 2008
refusing European patent application
No. 00963625.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: S. Wibergh
Members: P. Scriven
P. Schmitz

Summary of Facts and Submissions

- I. The appeal is against the Examining Division's decision to refuse European patent application 00963625.9.
- II. The application was originally filed as international application PCT/US00/25664, claiming a priority of 24 September 1999. The EPO acted as International Searching Authority (ISA).
- III. In its capacity as ISA, the EPO requested, informally, clarification of the subject matter which should form the object of its search. The applicant responded with further explanation of the invention. The EPO nevertheless found that no search was to be performed, because the claims related, essentially, to a method of doing business, and issued a corresponding declaration, under Article 17(2)(a) PCT, on 20 September 2001.
- IV. The USPTO established an International Preliminary Examination Report (IPER) on 24 September 2001, and a correction to it on 29 January 2002. The corrected IPER cited document D1 (US-A 5764906).
- V. The Examining Division sent a communication under Article 96(2) EPC 1973 on 10 September 2004. In it, they set out their view that there was a lack of inventive step in view of D1. The applicant responded by filing amendments and arguments.
- VI. The Examining Division then sent a summons to attend oral proceedings, which were scheduled for 4 December 2007. In the accompanying communication, a lack of inventive step was again substantiated by reference to D1. However, it was also argued that the subject matter

of claim 1 would have been obvious to the skilled person, even without knowledge of D1.

- VII. With the letter of 29 October 2007, the applicant filed amended claims and submitted further arguments.
- VIII. A telephone conversation took place on 16 November 2007, between the entrusted examiner and the representative. The minutes show that inventive step was discussed from the point of view of a skilled person confronted with a business problem.
- IX. A second telephone conversation took place on 22 November 2007. The minutes show that the question of inventive step was further discussed, from the point of view of a skilled person implementing a business method in a computer system.
- X. The Examining Division held oral proceedings as scheduled. The minutes, at point 7, show that the applicant had not previously understood that D1 was no longer the basis for the Examining Division's objection as to lack of inventive step, and that the subsequent discussion of inventive step did not make reference to D1 or to any other document.
- XI. During the oral proceedings, the applicant filed an amended set of claims as part of its sole request. Claim 1 according to this request read as follows.

A method comprising:

maintaining a database (106) of personal information relating to a consumer (102), the database (106) being a component of a system;

receiving a request initiated by a consumer (102) and transmitted over a global communication network to

the system, wherein the system is associated with a plurality of domain names, wherein the request includes one of the plurality of domain names, and wherein each of the domain names includes a common domain name element, and an identification of a subject of the request without specifying a specific provider thereof;

identifying at least one provider (104a, 104b, 104c) of goods and/or services related to the subject matter of the request in response to the received request, based upon the received request and the personal information relating to the consumer (102) in the database (106);

forwarding information regarding the or each identified provider from the system to the consumer (102), wherein the consumer (102) is subsequently capable of choosing a provider from the or each identified provider (104a, 104b, 104c) to communicate therewith;

facilitating completion of a transaction between the consumer (102) and a provider selected from the or each identified provider; and

updating the personal information based on the completed transaction, wherein the updated personal information is accessible by the system (150) for use in connection with a subsequent request initiated by the consumer (102).

Claim 21 was directed to the corresponding system.

- XII. At the end of the oral proceedings, the Examining Division refused the application on the ground that the subject matters of claims 1 and 21 lacked inventive step.

XIII. The applicant filed an appeal against this decision. With the statement setting out the grounds of appeal, the appellant requested that the appealed decision be set aside and that the case be remitted to the Examining Division with the order to grant a patent on the basis of a new main request; alternatively, that the case be remitted to the Examining Division with the order to grant a patent on the basis of new first to fourth auxiliary requests. The appellant also requested oral proceedings, if the Board did not consider that the claims of the main request comply with the requirements of the EPC.

XIV. In the statement setting out the grounds of appeal, the appellant referred to three pieces of prior art, D1 to D3. Of these, D2 and D3 were fictitious and were said to represent prior art to which the Examining Division had referred. D3 was said to represent *alleged prior art*, concerning *websites capable of storing information about a user's behaviour*, for which there is *no evidence on file as to the actual availability to the public* before the priority date. Arguments were given in favour of novelty over each of D1 to D3, and in favour of inventive step from the starting point of D1.

Reasons for the Decision

1. The Examining Division refused the application due to a lack of inventive step. No document was cited as evidence, but the decision identifies differences over the prior art in the following way (Reasons point II 1., at page 5, from line 2):

In comparison with a normal http request-response sequence, the examining division identified three differences:

1) When parsing a URL, it is usually the part that follows the actual resource which is parsed (a query, the content of a form), in this case it is the domain name that is parsed.

2) A central database containing information about the consumer.

3) The update of the information about the consumer based upon the transaction.

2. The decision then goes on to discuss these three differences. 1) is said to result from a technically straightforward implementation of a business idea. Of 2), it is said to be well known that websites store information about the user's behaviour, and to do this using a central database is just one of two well-known alternatives, each with well-known advantages and disadvantages. The other alternative is to store the information in a cookie. 3) is, again, seen as a technically straightforward implementation of a business idea.
3. The Examining Division's argument, then, relies on an understanding of the prior art. For the argument to work, it must be the case that the claimed invention actually does differ in the three points identified, and it must also be the case that there were websites which tracked the behaviour of users.
4. In general, when a Search Division has found that no search is to be performed, it is not always necessary

for the Examining Division to carry out an "additional search" before raising an inventive step objection. T 1242/04 "Provision of product-specific data/MAN", OJ EPO 2007, 421 explains it this way, at point 9.2: *According to the established case law of the boards of appeal it is possible to raise an objection of lack of inventive step without documented prior art ... That should be allowable where the objection is based on "notorious knowledge" or indisputably forms part of the common general knowledge. Such cases, however, are exceptional, and a search is otherwise essential.*

- 4.1 Under the term "notorious", the present Board understands, firstly, prior art which is so *well known* that its existence at the date of priority cannot be reasonably disputed. This is to be distinguished from the skilled person's common general knowledge, which is something that generally can be reasonably questioned.

- 4.2 Further to that, the present Board understands "notorious" as implying that technical detail is not significant. The examination of a combination of features in relation to inventive step normally involves questions such as what advantages and disadvantages the combination is said to have, and in what technical areas it is used. This is the sort of information a search should uncover. On the other hand, a claim may be so drafted that such questions do not arise. It is prior art reflecting such *generic* features that the Board understands as "notorious". Thus a "computer for sending a message" is notorious, whereas a "32-bit computer for sending a message" would not be, when, for example, questions of advantages and disadvantages of 32-bit computers arise.

5. In the present case, the Examining Division has not identified the prior art as "notorious" or an indisputable part of the skilled person's common general knowledge. In the Board's understanding of those terms, neither the normal http request-response sequence, nor the websites which store information about the user's behaviour falls within their meaning. The issue of what constituted the normal http request-response sequence at the priority date is certainly open to question, and it is certainly something towards which a search can be directed. The same goes for websites storing information on user behaviour.
6. The Board, therefore, concludes that in the present case, the Examining Division could and should have ensured that a search was performed before refusing the application for lack of inventive step.
7. The Board considers that the failure to carry out an "additional search" constitutes a substantial procedural violation and that the reimbursement of the appeal fee must be ordered. The reasons are as follows.
 - 7.1 The consequence of the lack of search is that the decision is founded on prior art which cannot reasonably be assessed. It may be true that the invention defined in claim 1 differs from the normal http request-response sequence precisely as the Examining Division states, but neither the appellant nor the Board can see whether that is the case. Nor can the appellant or the Board assess whether or not there were websites which stored information on user behaviour before the priority date. The appellant cannot prove that there were not, other than by providing all the previously published technical literature and saying that it cannot be found there.

Such an assessment of the literature is what the search is supposed to provide.

7.2 In T 1515/07, "Cost estimate/SAP", not published in the OJ, the Board found that *the examining division must be held to have committed a substantial procedural violation in the sense of Rule 103(1)(a) EPC* because it did not perform an additional search that was *manifestly necessary*.

7.3 In the present case, the additional search was manifestly necessary since, as set out above, the invention claimed contained technical features which cannot be regarded as notorious. The Board, therefore, finds that a substantial procedural violation was committed.

8. Since the Board allows the appeal and does not take a position as to whether the claims comply with the requirements of the EPC, it is not necessary to appoint oral proceedings.

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 first instance for further prosecution, which should include an additional search.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

T. Buschek

S. Wibergh