

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of 14 December 2011**

Case Number: T 0698/11 - 3.5.01

Application Number: 05815787.6

Publication Number: 1969538

IPC: G06Q 10/00

Language of the proceedings: EN

Title of invention:
Packaging Specification

Applicant:
SAP AG

Opponent:
-

Headword:
Packaging specification/SAP

Relevant legal provisions:
EPC R. 103(1)(a)
PCT Art. 17(2)(a)

Keyword:
"Notorious feature - no"
"Remittal for a search into the prior art - yes"
"Procedural violation - no (error of judgement)"

Decisions cited:
T 0641/00, T 1242/04, T 1287/04, T 0690/06

Catchword:
-



Case Number: T 0698/11 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 14 December 2011

Appellant: SAP AG
(Applicant) Dietmar-Hopp-Allee 16
69190 Walldorf (DE)

Representative: Schneider, Günther Martin
Bettinger Schneider Schramm
Patent- und Rechtsanwälte
Postfach 86 02 67
81629 München (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 13 October 2010
refusing European application No. 05815787.6
pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: S. Wibergh
Members: K. Bumés
P. Schmitz

Summary of facts and submissions

- I. The appeal is against the decision of the examining division to refuse European patent application No. 05815787.6, entitled "Packaging Specification", for lack of inventive step.
- II. According to the examining division, the claimed interface aimed to implement a business scheme and amounted to no more than a notorious general purpose networked computer system linked to a generic packaging machine as a commonplace peripheral thereof. The description did not mention any technical detail but dealt with a scheme for doing business. Therefore, no prior art search had been carried out at any stage of the application:
- (a) In the international phase of the application, the EPO in its capacity as International Searching Authority declared, according to Article 17(2)(a) PCT, that no international search report would be established since a meaningful search was not possible because all (original) claims were directed to schemes, rules and methods for doing business, Rule 39.1(iii) PCT. If the application was to proceed into the regional phase before the EPO, a search might be carried out during examination before the EPO, should the problems which led to the declaration under Article 17(2) PCT be overcome.
- (b) During the examination under Article 94 EPC, the examining division considered it appropriate to proceed with the examination of the application

without the introduction of any specific prior art citation. The examining division was of the opinion that it was not necessary to prove with a document that networked computers were well-known in the art at the priority date of the application. According to decision T 1242/04-*Provision of product specific data/MAN* (OJ EPO 2007, 421, point 9.2), the closest prior art might be notorious knowledge (decision under appeal, point 3.3).

According to point 3.2 of the decision under appeal, the closest prior art was considered to be a general-purpose networked computer in which the packaging machine was considered to be a commonplace peripheral.

III. The appellant requests that the decision under appeal be set aside and a patent be granted on the basis of the claim set ("Main Request") filed with the statement setting out the grounds of appeal (received 23 February 2011), the claims corresponding to those underlying the decision under appeal.

Oral proceedings are requested in the event that the Board is unable to grant the aforementioned request on the basis of the written submissions.

Further, a reimbursement of the appeal fee is requested pursuant to Rule 103(1)(a) EPC.

IV. Claim 1 according to the main request reads:

"1. An interface between a packaging machine and a data storage which stores a plurality of packaging specifications, for selecting at least one packaging

specification out of the plurality of packaging specifications, the interface comprising a plurality of input parameters and at least one output parameter, wherein each input parameter receives a search key from the packaging machine, and the interface triggers the selection of at least one packaging specification according to the received search key, the output parameter provides the at least one selected packaging specification, and the packaging specification provides a plurality of packaging instructions, whereby the packaging machine uses the packaging specification for packing products according to the packaging instructions of the packaging specification."

V. According to the appellant, the invention as claimed solves a technical problem, the means proposed for solving the problem have technical character, and the claimed solution involves an inventive step. The invention belongs to a technical field as it relates to controlling packaging machines/processes within a supply chain. A technical problem solved by the invention may be identified as providing a means and a method for controlling a packaging machine such as to optimise transportation and/or storage space requirements. A more ambitious problem may be formulated once relevant state of the art has been identified. In any event, the problem cannot be simply reduced to an issue of how to implement a business scheme.

VI. The appellant asserts a substantial procedural violation in that neither the search division nor the examining division performed a search into the state of the art although the claimed subject-matter has

technical character and the claimed solution cannot be considered as notorious. Thus, the examination procedure contravened decisions T 1242/04, T 1287/04, T 690/06 or T 1515/07 which state as a general rule 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.

Reasons for the decision

1. *The refused application*

1.1 The application, filed as international application PCT/EP2005/056492, was published as

A2: WO-A2-2007/065472

and relates to systems and methods for controlling packaging systems. In the context of supply chain management, the systems and methods serve to manage packaging processes within e-business systems (A2, page 1).

In its most general aspect (original claim 1), the application provides an interface between a packaging system and a database storing packaging specifications, for selecting at least one packaging specification according to a search key (see also A2, page 2, paragraph 1). According to the description, the interface may be accessible by a plurality of different packaging systems for selecting the required packaging specifications (A2, page 2, paragraph 3). The search

key may depend on the field of business of the packaging system (A2, page 3, paragraph 1).

- 1.2 "The advantage of the packaging specification is that it can be integrated in a plurality of logistic processes. The product flow from a supplier to a warehouse or from a warehouse to a customer can be optimized, such that less shipping costs occur or a better availability of products can be ensured. As the packaging specification can be replicated in several data storages, e.g. with several supply chain management systems, further applications or packaging systems might use the packaging specification in the future. By using business keys for identifying packaging specifications, the amount of packaging specifications can be kept as small a possible and at the same time, the business keys allows [sic] full flexibility" (A2, page 5, paragraph 3).

2. *Additional search*

- 2.1 The application was refused for lack of inventive step without a search having been performed. As set out in decision T 1242/04, an examining division may 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 indisputable common general knowledge. Such cases, however are exceptional, and a search is otherwise essential.
- 2.2 The Board concurs with the examining division in considering a networked general-purpose computer as part of notorious knowledge. However, the Board judges that the examining division overstretched the concept

of a notorious networked general-purpose computer by alleging that a packaging machine constituted a commonplace peripheral of such a computer so that the notoriety of the computer system propagated to the packaging machine. Even though the application refers to packaging machines only in a generic way, the Board does not regard packaging machines as notorious components. A packaging machine is a technical device which is not a usual computer peripheral, such as a printer, keyboard, data storage, display, I/O modem or the like.

- 2.3 An examining division should not normally refuse an application for lack of inventive step if the invention as claimed contains at least one technical feature which is not notorious (T 690/06-*Financial records/AUKOL*). Therefore, it would have been necessary for the examining division in this case to carry out a search into the documented prior art pertaining to packaging machines controlled by (networked) computers, and to take the result of that search into account during the examination of the application.

3. *Request for reimbursement of the appeal fee*

According to Rule 103(1)(a) EPC, the appeal fee shall be reimbursed where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

Thus, the appeal fee can only be reimbursed if a procedural violation has occurred. An error of judgement on substantive issues by the examining

division does not constitute a procedural violation (T 690/06, point 12).

- 3.1 In the present case, the examining division's reasoning that a generic packaging machine might be considered as a notorious peripheral of a networked general-purpose computer constitutes an error of judgement on a substantive issue rather than an incorrect conduct of the procedure.

Therefore, the examining division's decision not to carry out a search into the prior art of the present application is not considered as a *procedural* violation.

- 3.2 Furthermore, and in contradistinction to case T 1287/04-*Internetbasierte Datenbank/TRANSACTION & MANAGEMENT* (see points 4.4 and 4.5 of the reasons), the reasoning in the refused decision is sufficient, i.e. existent in a form that can be examined by the Board and the appellant. Although *prima facie* containing no non-technical feature, claim 1 read in the light of the description, i.e. in the light of the objectives and advantages emphasised by the applicant itself (see e.g. point 1.2 *supra*), can be seen to relate to an interface embedded in a commercial context. Therefore, again it was a matter of judgement for the examining division whether or not to base their reasoning on the case law developed for assessing mixtures of technical and non-technical features, e.g. T 641/00-*Two identities/COMVIK* (OJ EPO 2003, 352), as it is reflected in the Guidelines for Examination.

3.3 In conclusion, the Board does not identify a substantial procedural violation and, thus, cannot order a reimbursement of the appeal fee.

4. *Request for oral proceedings*

Since the Board sets the decision under appeal aside 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, with the order to carry out a search into the prior art.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

T. Buschek

S. Wibergh