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**Datasheet for the decision
of 8 December 2015**

Case Number: T 2428/11 - 3.5.01

Application Number: 06250962.5

Publication Number: 1770625

IPC: G06Q10/00

Language of the proceedings: EN

Title of invention:

Communicating with business customers

Applicant:

One Smart Star Limited

Headword:

Communications nickname/ONE SMART STAR LTD.

Relevant legal provisions:

EPC 1973 Art. 56

Keyword:

Inventive step - mixture of technical and non-technical
features - (no)
Inventive step - administrative scheme

Decisions cited:

T 0641/00

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2428/11 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 8 December 2015

Appellant: One Smart Star Limited
(Applicant) Drake Chambers
Tortola (VG)

Representative: Körfer, Thomas
Mitscherlich PartmbB
Patent- und Rechtsanwälte
Sonnenstrasse 33
80331 München (DE)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 30 June 2011 refusing European patent application No. 06250962.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman W. Chandler
Members: P. Scriven
P. Schmitz

Summary of Facts and Submissions

- I. This is an appeal against the decision of the Examining Division to refuse European patent application 06250962.5.
- II. The Examining Division considered, *inter alia*, that the subject matter of claim 1 according to the main request was not an invention in the sense of Article 52(1) EPC. In particular, the Division did not consider the features "unit", "database" and "updater" in claim 1 as implying any technical means.
- III. In the statement setting out the grounds of appeal, dated 10 November 2011, the appellant requested that the decision to refuse the application be set aside and that a patent be granted on the basis of a main request, or, alternatively, on the basis of an auxiliary request, both filed with this statement. The main request was based on the refused auxiliary request, with some amendments. The auxiliary request was the same as the refused main request. The appellant also filed an auxiliary request for oral proceedings.
- IV. In a communication accompanying a summons to oral proceedings, the Board set out its preliminary observations, *inter alia* agreeing with the Examining Division (that claim 1 according to the main and auxiliary request did not define technical subject-matter which could be considered as an invention within the meaning of Article 52(1) EPC) and expressing doubts as to novelty and inventive step (Articles 54 and 56 EPC).

- V. In response to the Board's communication, the appellant filed, with letter dated 6 November 2015, new main and first to third auxiliary requests. The claims according to the third auxiliary request were the same as those according to the previous main request.
- VI. Oral proceedings before the Board took place on 8 December 2015. The appellant's final requests were that the appealed decision be set aside and that a patent be granted on the basis of the main request, or one of first to third auxiliary requests, all filed with letter dated 6 November 2015.
- VII. Claim 1 of the main request reads:

"A communication system comprising:

a compact contact details coordination unit, CCDCU, (40) to coordinate contact details between communication service providers (42a, 42b, 42c, 42d) and a business, the CCDCU (40) comprising:

a communications nickname database (46) associating each of a multiplicity of businesses with its communications nickname (60);

a determining unit to coordinate with physical, analog and digital communication service providers (42a, 42b, 42c, 42d) to determine if a unique communications nickname (60) is available for a business, wherein one of said communication service providers (42a, 42b, 42c, 42d) is a physical post office mail provider (42a) and wherein an available said unique communications nickname (60) is recorded in said communications nickname database (46); and

an updater to update said router databases (52a, 52b, 52c, 52d) of said communications providers (42a, 42b, 42c, 42d) when said unique communications database (40) is changed, thereby enabling each of said communications providers (42a, 42b, 42d, 42d) to independently route by means of an associated router (54a, 54b, 54c, 54d) incoming communications from a costumer [sic] of said business to said business that are addressed in accordance with said unique communications nickname (60)."

VIII. Claim 1 according to the first auxiliary request differs from the main request,

in that the first feature reads (emphasis added):

*"a compact contact details coordination unit, CCDCU, (40) to coordinate **compact** contact details between communication service providers (42a, 42b, 42c, 42d) and a business, **wherein the compact contact details comprise fewer communication access numbers (34) than full-length contact details (12),"***

and by the addition of the following feature at the end:

"wherein each said router database (52a, 52b, 52c, 52d) comprises an address database for its associated said communications provider (42a, 42b, 42c, 42d) associating at least some of said multiplicity of businesses with their addresses as issued by said communications provider (42a, 42b, 42c, 42d)".

IX. The second auxiliary request differs from the first auxiliary request in that the following definition of the *"determining unit"* is added to claim 1:

" , wherein said determining unit comprises:

a selector to select a temporary communications nickname;

a confirmer to confirm with each said communications provider (42a, 42b, 42c, 42d) that said temporary communications nickname is not being used by any other business; and

a mapper to map, if the output of said confirmer is true, said communications nickname (60) between said business and the communication access numbers assigned to said business by said communications providers (42a, 42b, 42c, 42d) "

X. Claim 1 of the third auxiliary request reads:

"A compact contact details coordination unit (40) comprising:

a communications nickname database (46) associating each of a multiplicity of businesses with its communications nickname (60);

a determining unit to determine if a unique communications nickname (60) is available for a business for a plurality of communications providers (42a, 42b, 42c, 42d), wherein an available said unique communications nickname (60) is recorded in said communications nickname database (46); and

an updater to update said router databases (52a, 52b, 52c, 52d) of said communications providers (42a, 42b, 42c, 42d) when said unique communications database (40) is changed, thereby enabling each of said communications provider [sic] (42a, 42b, 42c, 42d) to

independently route by means of an associated router (54a, 54b, 54c, 54d) incoming communications from a costumer [sic] of said business to said business that are addressed in accordance with said unique communications nickname (60)."

XI. The appellant's arguments can be summarized as follows:

Claim 1 was directed to a communications system, which was inherently technical. The term "database" in claim 1 referred to an organised collection of data accessed through a database management system. Thus, it could not reasonably be interpreted as something existing in a person's mind.

The invention aligned the different communication "topologies" of the communication service providers into one system, by using a common nickname for all. This was a solution to a technical problem.

The use of a common nickname for a plurality of communication service providers reduced the amount of data to be transmitted. Since one and the same nickname was used for all the service providers, only one transmission, at one time, was required to update the router databases. Furthermore, having a short (or compact) nickname saved storage space and transmission bandwidth.

The problem-solution approach required that the closest prior art be selected. This should be one piece of prior art, and not a combination of known concepts, such as a post office and a telephone system. Furthermore, documentary evidence was required to prove that something was, indeed, prior art. It was not

sufficient to rely on the description of the background art in the application, because this could be internal prior art which was not available to the public at the priority date.

Even starting from a system comprising postal services, telephony, and Internet, the skilled person would not have thought of using a common nickname for all services, because the systems were set up very differently. Each system had its own form of addressing, and that would tend to point the skilled person away from the invention rather than towards it. Therefore, some further hint would be needed, and no document provided one. Thus, the use of nicknames would not have been obvious.

Reasons for the Decision

1. *The invention*
 - 1.1 The invention concerns the use of a single "nickname" for contacting a business via one of a plurality of communication means. As shown in Figure 2 (compared to Figure 1), the nickname "*2879" replaces the postal address, telephone number, fax number, mobile telephone number, and website address, of "Busy Business, Inc."
 - 1.2 The communication service providers (Figure 3; 42a... 42d) maintain databases (52a...52d) for routing communications for the nickname to the correct destination. For example, the post office (42a) forwards mail addressed to "*2879" to "Glass Building, Suite 100" etc., and the telephone service provider

(42b) routes calls made to "*2879" to the number "(222) 555-2222".

1.3 The communication system according to the invention comprises a coordination unit (CCDCU 40), which coordinates the nicknames between the communication service providers. The CCDCU has a database (46) for storing the nicknames, a "determining unit" and an "updater". When a new nickname is set up (published application, paragraph [0035]), the determining unit checks the database to determine whether the nickname is available (i.e. that it has not been assigned to some other business). If the nickname is free, it is recorded in the nickname database, and the updater updates the router databases of the communication service providers.

2. *Article 52(2) EPC*

2.1 The Board remains doubtful as to the technicality of the claimed subject matter (all requests). However, even considering the various components of the system (the "compact contact details coordination unit", the "communications nickname database", etc.) as technical, the Board finds that none of them, whether individually or in combination, makes a non-obvious technical contribution over the prior art. The reasons are set out below. Given this finding, it is unnecessary to go further into the question of whether any of the requests defines eligible subject matter for a European patent.

3. *Main request, inventive step*

3.1 Claim 1 of the main request is directed to a communications system comprising a compact coordination unit (CCDCU) having a communications nickname database, a determining unit, and an updater.

It is common ground that the "determining" and "updat[ing]" in claim 1 refer to the process of setting up a new nickname as described in paragraph [0035]. The actual use of the nickname for communicating with a business is not covered by the claim.

3.2 The Board takes, as the starting point for assessing inventive step, the situation described in paragraphs [0004] and [0005] of the published application, and illustrated by the business card in Figure 1. A business (Busy Business, Inc.) has different contact details for different means of communication (post office mail, (mobile) telephone, Internet). The Board does not accept that this could have been "internal" prior art, known only to the appellant. Postal and telephone services, and their respective addressing/ numbering systems, were well known at the priority date (28 September 2005). Indeed, the Board's view is that this was so well known that even without the statement, in paragraph [0004], that the *"typical contemporary business has kept pace with the technological advances in the field of communications which have increased and diversified the methods by which customers and businesses communicate"*, there could be no reasonable dispute on this point.

3.3 Claim 1 refers to *"physical, analog and digital communication service providers"*.

The Board has some doubts as to whether there is a clear distinction between these different types of communication service (for example, both analog and digital communications involve physical means), and whether there is sufficient basis in the application as filed for this generalised language. Those doubts notwithstanding, the Board interprets claim 1 as covering the examples related to post office mail, telephone, and Internet services, set out in paragraph [0034] of the published application. This feature, therefore, is part of the starting point set out above.

- 3.4 All of the communication services indicated on the business card involve the use of routers for routing incoming communications to their destinations. In the case of post office mail, the function of the "router" is to map the address ("Glass Building, Suite 100 ...") to a particular location and to a route from, say, a sorting office to that location. In a simple case, this could just be the postman who delivers the letter. In a telephone system, the router maps a sequence of numbers to a path through the telephone network. Thus, the routers (54a, 54b, 54c and 54d) in claim 1 belong to the prior art.
- 3.5 The Board considers that the communication system, as defined in claim 1 of the main request, differs from the prior art by having a common nickname for a plurality of communication service providers, as coordinated by the coordination unit.
- 3.6 As set out in decision T 641/00 "Two identities/COMVIK" (OJ EPO 2003, 352), it is only technical features, i.e. those which contribute to the solution of a technical problem by providing a technical effect, that can support the presence of an inventive step.

Non-technical features, i.e. those which do not make a technical contribution, may legitimately appear in the formulation of the objective technical problem.

3.7 The appellant argued that the invention solved the technical problem of aligning the "topologies" of different service providers into one system.

In the Board's view, the provision of a single nickname is no different from the business card of Figure 1. There, a customer can use a single name "Busy Business, Inc.", and find "routing" information in the form of a postal address, a telephone number and so on. It is generally required that a name should be unique, i.e. that it should not be possible to confuse Busy Business Inc. with some other business.

What the invention contributes is, rather, a shift in responsibility for this. Rather than the customer looking up the mapping from name to route, that is left to the service provider. The customer, then, can simply inform the post office that her letter should go to "Busy Business, Inc." and leave the post office with the task of looking up where that is. Or she may call the operator and ask to be connected to "Busy Business" and leave it to the telephone company to find the right connection. The Board sees no technical considerations in that.

Claim 1 specifies that the service providers maintain routing databases. While the Board is not persuaded by the appellant's argument that such a database must be inherently technical (see points 2.1 and 3.4, above), it is satisfied that a computerised database would be an obvious technical implementation. Whether the database is technical or not, however, it cannot be

other than obvious to keep it up to date.

Thus, the Board sees an inventive step neither in the use of a single nickname, nor in the use and updating of routing databases.

3.8 The appellant also argued that the invention provided the following technical effects:

- a common nickname saved transmission bandwidth, because all the router databases were updated at one time;

- a compact nickname saved storage space and bandwidth;

3.9 The Board is not persuaded that the invention provides either of these effects, even assuming the databases and the means of communication are technical.

The use of nicknames seems to require additional transmission and storage, which would not be necessary without them. The mappings between nicknames and, say, telephone numbers or the corresponding connections need to be transmitted and stored in addition to whatever routing information is already there; and update messages have to be sent to all the communication service providers. Furthermore, the amount of data to be transmitted does not depend on whether the updating of router databases 52a and 52b take place simultaneously or not. Indeed, the application does not enter into any details of the amount of data transmitted or the timings of transmissions.

The appellant's argument regarding the compactness of the nicknames applies when the system is used for

communication: a customer need only remember, and need only transmit, a relatively short code (e.g. "*2879") rather than a long postal address or telephone number. Claim 1 is not concerned with the use of the system for actual communication, but only with the setting up of the system (see point 3.1, above), but the Board acknowledges that setting up a system so that it can later be used more efficiently might well involve a technical effect and support an inventive step. However, in the present case, there is no specification of how addresses or nicknames are encoded for storage or transmission. There is nothing to imply that a nickname requires less data than, say, a telephone number.

3.10 In conclusion, the Board considers that the subject-matter of claim 1 according to the main request does not involve an inventive step (Article 56 EPC).

4. *First auxiliary request*

4.1 Claim 1 of the first auxiliary request specifies that the contact details be "compact" and that they *"comprise fewer communication access numbers than full-length contact details"*.

4.2 As mentioned in point 3.9, above, there is no basis in the application for the compactness of the nickname implying any technical effect, such as a reduction in data size. The Board understands "compact contact details" as meaning that a single nickname replaces a plurality of contact details (see paragraph [0030]). This is already implied in claim 1 of the main request. Therefore, claim 1 of this request is not allowable,

for the same reasons as provided with regard to the main request.

5. *Second auxiliary request*

5.1 Claim 1 according to the second auxiliary request specifies, in more detail, how a new nickname is set up (see paragraphs [0018] and [0035] of the published application). First, a temporary nickname is selected. Second, it is confirmed with the communications providers that the nickname is not being used by another business. Third, the mappings between the nickname and the access numbers are established.

5.2 The Board considers these features to be part of an administrative scheme of setting up the nickname. It does not imply any technical means, or technical effect. Thus, they do not contribute to inventive step.

6. *Third auxiliary request*

6.1 Claim 1 according to the third auxiliary request is broader than claim 1 of the main request. Consequently, the third auxiliary request cannot be allowable for the same reasons.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



T. Buschek

W. Chandler

Decision electronically authenticated