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**Datasheet for the decision
of 14 March 2019**

Case Number: T 1503/12 - 3.5.01

Application Number: 05725845.1

Publication Number: 1745365

IPC: G06Q30/00

Language of the proceedings: EN

Title of invention:

METHODS AND APPARATUS FOR GIFTING OVER A DATA NETWORK

Applicant:

Qualcomm Incorporated

Headword:

Compatible content gifts/QUALCOMM

Relevant legal provisions:

EPC Art. 56

Keyword:

Inventive step - providing a compatible content gift (no -
usability of gifts not technical, obvious implementation)

Decisions cited:

T 1006/09, T 0641/00, T 1463/11



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Case Number: T 1503/12 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 14 March 2019

Appellant: Qualcomm Incorporated
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 17 January 2012
refusing European patent application No.
05725845.1 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman W. Chandler
Members: A. Wahrenberg
P. Schmitz

Summary of Facts and Submissions

I. This is an appeal against the examining division's decision to refuse the European patent application No. 05725845.1 (published as WO2005/109182 A2) for lack of inventive step (Article 56 EPC).

II. The following documents were mentioned in the examination proceedings:

D1: WO 01/29794 A
D2: WO 02/48839 A
D3: US 5426594 A
D4: WO 02/03630 A
D5: US 7092702 B

D1, D2, and D4 were cited in the supplementary European search report; D3 was cited in the international search report, and D5 was cited by the examining division.

III. In the decision under appeal, the examining division found that the subject-matter of claim 1 of the main and first auxiliary requests did not involve an inventive step over D1, and that the subject-matter of claim 26 of the second auxiliary request provided an obvious implementation of a business scheme on a notorious data processing system. Documents D4 and D5 were briefly mentioned in connection with the second auxiliary request. In a section of the decision headed "Obiter dictum", the examining division stated that the reasons for rejecting the second auxiliary request were applicable also to the main and first auxiliary requests.

- IV. In the statement setting out the grounds of appeal, the appellant requested that the decision of the examining division be set aside and that a patent be granted on the basis of the main request, or the first, or second, auxiliary request, filed therewith.
- V. The Board set out its provisional view in the communication accompanying the summons to oral proceedings. The Board was of the opinion that the claimed invention achieved the non-technical aim of better gift giving, and that the technical implementation would have been obvious in view of the prior art system mentioned in the introductory part of the description.
- VI. In a reply dated 6 February 2019, the appellant filed amended main and first and second auxiliary requests.
- VII. During oral proceedings before the Board on 14 March 2019, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request or one of the first and second auxiliary requests, filed by letter of 6 February 2019.
- VIII. Claim 1 of the main request reads:

A method in a first terminal (102) of providing a content gift to a second terminal (110), both terminals selectively communicating with a gift server (108) in a data network (104), the method comprising the steps of:

transmitting (502) a catalog request by the first terminal to the gift server to obtain a catalog that identifies content files compatible with the hardware and software configuration of the second terminal, the catalog request including a terminal identifier of the

second terminal used by the server to compile a list of compatible content files by searching a server database for configuration information and compatible content files;

receiving (504) the catalog of compatible content files at the first terminal;

incorporating, in a gift request, one or more identifiers that identify selected content gifts from the catalog of compatible content files by the first terminal; and

transmitting (508) the gift request by the first terminal to the gift server requesting that the one or more selected content gifts be provided to the second terminal.

- IX. The first auxiliary request adds to the main request the following feature at the end of claim 1:

updating the database in the gift server to show that the second terminal has already been provided with the selected content gift by the server.

- X. The second auxiliary request adds to the first auxiliary request the following text at the end of claim 1:

wherein the gift server communicates with the second terminal to determine whether the second terminal owns the selected content gift and does not provide the selected content gift if already owned by the second terminal; and

receiving (322) a notification message at the first terminal that the selected content gift was not delivered to the second terminal because the content is already owned by the second terminal.

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

There was a divergence in how computer-implemented inventions were examined at the EPO. If the application happened to be classified as a business method, the EPO would use the Comvik approach and dismiss features of the invention as non-technical. If, on the other hand, the application was classified in the field of telecommunications, it would be assessed using the "normal" problem-solution approach, and, irrespective of the underlying aim, features relating to data transmission would be treated as a technical telecommunications protocol.

Applicants wanted consistency and certainty, especially in the field of computer-implemented inventions, which had become increasingly important. The correct approach, in all fields, was the problem-solution approach.

The invention was not about gift giving. It concerned the transmission of an electronic file over a network. The file was meant to be opened and executed by the second terminal. The claims defined a specific communications protocol between the first terminal, the gift server, and the second terminal.

The disclosure in paragraphs [0006] and [0007] of the published application was not an admission that something was prior art. It merely presented a problem identified by the inventors.

The prior art documents cited in the search reports and during examination were all directed to electronic cards. The disclosed systems were closed, proprietary systems, in which it was simply assumed that the

content (the card) would be compatible with the receiving terminal.

None of the cited documents disclosed a catalogue that identified content files compatible with the hardware and software configurations of the second terminal. Consequently, the prior art did not show the features of transmitting a catalogue request and receiving a catalogue of compatible content files in claim 1.

Formulating a problem relating to the compatibility of content files with a terminal's hardware and software configuration required technical considerations. A business person would not have considered such technical compatibility issues.

In decision T 1006/09, the compatibility of software versions in an instant messaging system was considered to be a technical issue. Thus, by the same logic, the compatibility of content files with the receiving terminal's software and hardware configurations was technical.

The claimed invention had a number of technical effects. Since it ensured, before delivery, that the content file was technically compatible with the receiving terminal, malfunction, or even damage to the receiving terminal caused by incompatible content files, could be avoided. Furthermore, the invention prevented the waste of bandwidth and memory resources that would have resulted from sending or storing unusable or duplicate content.

Reasons for the Decision

1. *Background*

1.1 The invention generally concerns "content gifts", for example program files or multimedia files, that are provided over a data network.

1.2 The invention allows the user of a first terminal to give a content gift to the user of a second terminal via a gift server. The user of the first terminal selects the content gift from a catalogue comprising a list of content that is compatible with the hardware and software configuration of the second terminal. This ensures that the content gift will operate properly on the second terminal.

In one example, the user of the first terminal visits a Web page hosted on the gift server to view the catalogue and select the content gift.

2. *Main request, claim 1*

Claim 1 of the main request is directed to a method in the first terminal. It comprises the steps of:

transmitting a "catalog request" to the gift server to obtain the catalogue, the "catalog request" including a terminal identifier of the second terminal used by the server to compile a list of compatible content files by searching a server database for configuration information and compatible content files;

receiving the catalogue;

incorporating, in a gift request, one or more identifiers that identify selected content gifts from the catalogue; and

transmitting the gift request to the gift server requesting that the one or more selected content gifts be provided to the second terminal.

3. *EPO's approach to mixed-type inventions*

- 3.1 The invention in claim 1 of the main request consists of a mixture of technical and non-technical features. Gift giving is inherently non-technical, but providing an electronic "content gift" over a network involves technical matter.
- 3.2 The established approach for dealing with mixed inventions at the EPO is the "Comvik approach" (after decision T 641/00 - *Two identities/COMVIK*, OJ EPO 2003, 352); see the Case Law of the Boards of Appeal, 8th edition 2016, section I.D.9.1.3 b), and the Guidelines for Examination, G-VII, 5.4.
- 3.3 The Board would like to emphasise that the Comvik approach does, in no way, stand in contradiction to the problem-solution approach. Comvik is rather a special application of the problem-solution approach to inventions that contain a mix of technical and non-technical features (see T 641/00, reasons 5 and 6).
- 3.4 The problem-solution approach includes the step of defining the objective technical problem solved by the invention. The main point in *Comvik* is that non-technical features that do not contribute to the solution of a technical problem by providing a technical effect have no significance in the assessment

of inventive step. Therefore, it is legitimate to include those features in the formulation of the objective technical problem, for example as a set of requirements to be met.

- 3.5 The appellant had the impression that there was a divergence in how different EPO departments dealt with computer-implemented inventions. The Board does not quite agree. If there is a divergence at all (and the Board is not convinced that there is), it is in how the line is drawn between what is technical and what is not technical. That is an assessment that each division or Board has to make by applying the law to the facts of the particular case. It is an exercise that requires careful consideration of all the features of the invention. Features that *prima facie* seem non-technical may interact with the technical features of the invention to produce a technical effect. Conversely, features that may, at first glance, appear technical, for example because they exist in the context of a technical system, do not necessarily produce a technical effect in that system.

- 3.6 Decision T 1463/11 (*Universal merchant platform/ CardinalCommerce*) introduced the notional business person as a tool for distinguishing between technical and non-technical features. Requirements that can be formulated by the business person are non-technical, and simply given to the technically skilled person. Those requirements cannot specify any technical means, however notorious or trivial, or arise after consideration of technical aspects. The choice of technical means is part of the technical solution, which has to be evaluated for obviousness.

The approach used in *CardinalCommerce* balances the

requirement that non-technical features do not contribute to inventive step, and also that the technical contribution of the invention is not overlooked.

4. *Main request, inventive step*

4.1 The Board considers that the "related art" described in paragraphs [0002] to [0007] of the published application is an appropriate starting point for assessing the inventive step of the subject-matter of claim 1 of the main request. The related art is a system that allows the user of a first terminal to give a content gift to the user of a second terminal via a gift server.

4.2 Thus, the Board considers that the following features of claim 1 are known:

A method in a first terminal of providing a content gift to a second terminal, both terminals selectively communicating with a gift server in a data network, the method comprising the steps of:

transmitting by the first terminal to the gift server a terminal identifier of the second terminal;

incorporating, in a gift request, one or more identifiers that identify selected content gifts by the first terminal; and

transmitting the gift request by the first terminal to the gift server requesting that the one or more selected content gifts be provided to the second terminal.

- 4.3 The appellant contested that the application described such system as being prior art. The Board, however, finds the appellant's contention unpersuasive.

Paragraph [0007] of the published application refers to "current systems" for providing content gifts, and the invention is set out against that background. The Board has no doubt that a system allowing the user of a first terminal to give a content gift to the user of a second terminal, via a server and a network, was known at the priority date. Indeed, during the oral proceedings, the appellant conceded that D1 to D4 all disclosed such a system.

- 4.4 The invention as defined in claim 1 differs from the known content gift system by the catalogue that identifies content files compatible with the hardware and software configuration of the second terminal. The first terminal obtains the catalogue by transmitting a request to the gift server that compiles a list of compatible content files by searching a server database for configuration information and compatible content files.

- 4.5 The appellant argued that by ensuring, before delivery, that the content file was compatible with the second terminal, the invention avoided malfunctions of the second terminal. Another technical effect of the invention was savings in bandwidth and storage. Furthermore, the issue of compatibility involved technical considerations of the hardware and software configuration of the second terminal.

- 4.6 The Board does not consider the effect of avoiding malfunctions to be credible. The effect of the invention is rather that the gift is usable to the

receiver. In the Board's view, the usability of gifts is a non-technical problem. The business person could formulate a requirement such as "allow only gifts that the customer can use", for example as a reaction to complaints from customers that had received gifts that they could not use. A customer with an Xbox console might have received an Ybox game, and wanted to exchange it for a usable Xbox game. At this level, there is nothing technical going on.

- 4.7 Any effect on bandwidth or storage would be based on the assumption that unusable gifts waste resources. However, that applies for any kind of gift. For example, a grandmother who buys the wrong present for her grandson's birthday may have to go back to the shop. If she does not do so, the unwanted present may end up occupying space in the cellar. Thus, the Board is of the view that these types of savings are inherent effects of providing usable gifts.
- 4.8 Therefore, the Board considers that the problem solved by the invention is implementing the business requirement "allow only gifts that the customer can use".
- 4.9 The Board judges that, given this task, the skilled person would translate the usability requirement into the technical requirement of checking which content files are compatible with the hardware and software configuration of the receiving terminal. This requires storing and comparing the relevant information. A list of compatible content needs to be provided to the user of the first terminal, who selects the gift. The skilled person would consider implementing all this on a website hosted on the gift server. The first terminal

would, then, send a request to the web server, which responds with the requested data.

4.10 In conclusion, the Board judges that the skilled person would have arrived at the invention in claim 1 of the main request without an inventive step (Article 56 EPC).

5. *First auxiliary request*

5.1 The first auxiliary request adds to the main request the feature "updating the database in the gift server to show that the second terminal has already been provided with the selected content gift by the server" in claim 1.

5.2 The appellant argued that this feature avoided duplicate gifts, which saved bandwidth and other resources.

5.3 The Board notes that the information about already-given gifts is not used in claim 1. Therefore, it does not have any effect, at all, apart from being stored.

However, even assuming that it is used to generate the catalogue the next time the user of the first terminal wants to give a content gift to the user of the second terminal, the Board considers that avoiding duplicate gifts is a non-technical problem, for the same reasons that avoiding unusable gifts is a non-technical problem. Given the instructions from the business person to keep track of purchases to avoid duplicate gifts, the skilled person would update the database with the necessary information.

5.4 For these reasons, the Board finds that the first auxiliary request does not involve an inventive step (Article 56 EPC).

6. *Second auxiliary request*

6.1 Claim 1 of the second auxiliary request specifies that the gift server communicates with the second terminal to determine whether the second terminal has the selected content gift. If the second terminal already has the selected content gift, the server does not provide it. If the gift fails in this way, the first terminal receives a notification message that the content gift was not delivered.

6.2 For the same reasons as given in respect of the main request and the first auxiliary request, the Board considers that the invention in claim 1 of the second auxiliary request addresses the problem of providing a suitable gift. The Board takes the view that the step of asking the user of the second terminal whether he or she already has the proposed gift is a non-technical requirement. So is the step of notifying the user of the first terminal. The Board also finds that the implementation of those steps on the prior art system would have been a matter of routine design.

6.3 For these reasons, the Board judges that the subject-matter of claim 1 of the second auxiliary request lacks an inventive step (Article 56 EPC).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



T. Buschek

W. Chandler

Decision electronically authenticated