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**Datasheet for the decision
of 25 October 2019**

Case Number: T 2272/13 - 3.5.01

Application Number: 12157737.3

Publication Number: 2511863

IPC: G06Q10/00

Language of the proceedings: EN

Title of invention:

Portable device inventory tracking

Applicant:

SAP SE

Headword:

Portable device inventory tracking/SAP SE

Relevant legal provisions:

EPC Art. 56, 111(1)

EPC R. 63

Keyword:

Inventive step - mixture of technical and non-technical features - technical features not properly assessed (yes)
Appeal decision - remittal to the department of first instance (yes)

Decisions cited:

T 1351/04, T 1242/04, T 0690/06, T 1411/08, T 0270/05,
T 0578/06



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Case Number: T 2272/13 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 25 October 2019

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

Representative: Richardt Patentanwälte PartG mbB
Wilhelmstraße 7
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 25 June 2013
refusing European patent application No.
12157737.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman W. Chandler
Members: N. Glaser
C. Schmidt

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division to refuse the application No. 12157737.3 on the ground that the subject-matter was not inventive (Article 56 EPC) over an automation of an abstract scheme of tracking the proximity of things which can be within a short range of a central authority on a *set of generic devices communicating over a WLAN network*. The division considered these features as belonging to the common general knowledge which were so well known that no document needed to be cited.
- II. In the statement setting out the grounds of appeal the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the refused main request filed with the letter dated 30 January 2013, or an auxiliary request filed with the statement setting out the grounds of appeal.
- III. On an auxiliary basis the appellant requested to remit the case to the first instance for further examination. Oral proceedings were requested as a further auxiliary request.
- IV. The Board arranged for proceedings to be held. In a communication accompanying the summons to oral proceedings, the Board set out its preliminary view that it was not convinced that the existence of the technical features could not be reasonably disputed and needed to be proven by evidence. In particular, the Board considered that it was appropriate to remit the case to the first instance for performing a search and for further examination on the merits of novelty and inventive step. The Board informed the appellant that

such a decision could be issued in writing if the request for oral proceedings was withdrawn.

V. In letter dated 12 July 2019 the appellant withdrew his request for oral proceedings.

VI. The Board cancelled the oral proceedings.

VII. Claims 1 and 11 of the main request read as follows:

1. A computer-implemented method for enabling a user of a mother device (102) to track one or more satellite devices (104) that are in a short range communication with the mother device (102), wherein respective identity information is assigned to the one or more satellite devices (104), wherein the mother device (102) and the one or more satellite devices (104) are portable devices, wherein the short range communication comprises a Wireless Local Area Network communication, the method comprising at the mother device:

- storing the identity information on the mother device (102), thereby registering the one or more satellite devices (104);

- sending a reachability request (210) to each of the registered one or more satellite devices (104) by using the short range communication; wherein sending the reachability request (210) is performed according to at least one rule configured on the mother device (102), wherein the at least one rule comprises sending the reachability request in predefine time intervals; and

- alerting the user if at least one satellite device (104) of the one or more satellite devices (104) does not respond to the reachability request (210).

11. A portable device (102) for enabling a user to track one or more satellite devices (104) that are in

near field communication with the portable device (102), wherein respective identity information are assigned to the one or more satellite devices (104), wherein the short range communication comprises a Wireless Local Area Network communication, the portable device comprising :

- a storing unit for storing the identity information on the portable device (102), thereby registering the one or more satellite devices (104);*
- a sending unit for sending a reachability request (210) to each of the registered one or more satellite devices (104); wherein sending the reachability request (210) is performed according to at least one rule configured on the mother device (102), wherein the at least one rule comprises sending the reachability request in predefine time intervals; and*
- an alerting unit for alerting the user if at least one satellite device (104) of the one or more satellite devices (104) does not respond to the reachability request (210).*

VIII. Claim 1 of the auxiliary request is based on claim 1 of the main request with the following amendments:

- replacement of the feature "to track one or more" in lines 2 and 3 of claim 1 with the feature "to track data stored on one or more";*
- deletion of the last two clauses of the sending feature;*
- addition at the end of the claim of "transmitting the data from reachable satellite devices of the one or more satellite devices to the mother device".*

Corresponding amendments were made to claim 11.

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

Claim 1 of the main request had to be regarded as a whole and the effect of the features had to be assessed in the context of the invention of portable device inventory tracking. The features in combination solved the objective technical problem of how to efficiently detect the loss of one or more devices belonging to a user.

In particular, the feature "identity information" had technical character, because this information was used as a tool by the mother device to search and find satellite devices, which was in agreement with decision T 1351/04, in which the Board held that an index file containing information to be used for searching a file was a technical means.

Furthermore, the feature of sending a reachability request from the mother device to satellite devices and the feature of transmitting data from a satellite device back to the mother device by using short range communication WLAN was technical, because it described an interaction between two devices.

Finally, when a networked computing system of satellite devices was taken as closest prior art, claim 1 was novel and inventive, because the usage of WLAN for tracking or detecting devices was not part of common general knowledge. It was not known to register satellite devices with specific identity and then to track them using reachability requests during predefined time periods.

Claim 1 of the auxiliary request solved the objective technical problem of how to access data stored in one

or more satellite devices. This problem was solved by a mother devices which alerted a user of a mother device either when a satellite device was not reachable or transmitted data from the satellite device to the mother device.

Reasons for the Decision

1. Background of the invention
 - 1.1 The invention concerns portable inventory tracking which addresses the problem of tracking personal belongings, so that if they are lost they can be found again. In addition to tracking personal belongings, one may wish to track data stored on a portable device (see page 2, first paragraph of the originally filed application).
 - 1.2 Claim 1 is for a computer-implemented method that enables a user of a portable mother device, e.g. a mobile phone, to track one or more portable satellite devices, e.g. a wallet or a backpack, that are in a short range communication, e.g. via Wireless Local Area Network (WLAN) communication, with the mother device (see page 4, lines 10 to 25).
 - 1.3 Each satellite device is registered with its identity information, e.g. its serial number, on the mother device which sends at predefined time intervals a reachability request to the registered satellite devices and informs the user if a satellite device does not respond (see page 13, lines 10 to 24 and page 14, last paragraph).

2. Article 56 EPC

2.1 The Board does not agree with the examining division that the features "storing", "sending" and "alerting" of claim 1 are *per se* non-technical prescriptions of an inventory scheme. These features have within the context of claim 1 clearly technical character.

2.2 The examining division identified the non-technical process, see decision paragraph 12.1, to be a "generic method of tracking the proximity of things which can be within a short range of a central authority, in a manner similar to a parent's surveillance of his offspring or of a person's tracking of his belongings".

However, this analogy fails even on a business level. A parent obviously knows the identity of his or her children and would not require them to register with him or her. The same would apply for his or her belongings.

2.3 Neither the Board nor the appellant disputed that it is common general knowledge that portable devices can be connected by short range WLAN communication. It may further be assumed that it is common general knowledge that each of the devices is identified within the wireless network, usually based on a device's unique MAC address and on an IP address attributed by the DHCP host of the wireless network.

But, in the Board's view, the use of WLAN communication *for regular tracking of portable devices* goes a technical step further and cannot, without further justification, be considered "notorious" or irrefutable

in the prior art of data communication, as no such prior art was cited in the decision under appeal.

- 2.4 The appealed decision, paragraph 12.3, points out that the specification of WLAN communication in claim 1 does not solve a particular technical problem, because various protocols *"are contemplated throughout the application are presented as being freely interchangeable"* and concludes that the feature cannot contribute to inventive step.
- 2.5 The Board notes that the application indeed lists various options, including RFID, infrared, WLAN, Bluetooth and others, for example, on page 3, lines 27 to 30, for realising a "short range communication" between the mother device and satellite devices. However, in the Board's view it cannot be simply concluded that this feature would not contribute to inventive step simply by stating so without any reasoning why this would be the case.
- 2.6 Moreover, the Board does not rule out that, at the priority date of the application, it was common general knowledge to track satellite devices by reachability requests, sent to them from a mother device which is connected to the satellite devices via a WLAN. Since it was disputed by the appellant during the first instance proceedings as well as in the statement setting out the grounds of appeal, the existence of relevant common general knowledge needs to be proven by evidence.
- 2.7 In T 270/05, reasons point 6, the present Board in a different composition formulated the following legal principle: If claimed subject-matter goes beyond what is "notorious", or essentially irrefutable, in the prior art, an (additional) search should be performed

(cf. T 690/06, points 2 and 8) to establish the relevant prior art by which to judge the inventive step. This is based on the generally accepted principle in proceedings before the European Patent Office that whoever raises an objection has the burden of proof for it, see, for example, T 578/06, point 21.

2.8 According to Rule 63(1) EPC 2000 the applicant has to be invited to file a statement indicating the subject-matter to be searched if the European Patent Office considers that the application fails to comply with the Convention to such an extent that it is impossible to carry out a meaningful search. Since, in the present case, such an invitation was not sent, the search examiner apparently considered it to be possible to carry out a "meaningful search" regarding the state of the art. The prior art was then rather seen to be so "notorious", see declaration in the search report, that no documentary evidence was found to be needed. The question then arises if the examining division should have provided written evidence when the "notoriety" of the prior art was challenged by the appellant.

2.9 However, since the Board takes the view that the subject-matter of claim 1 of the main request is clearly and inherently technical, the statement given in the European Search Report that the *"claimed subject-matter, with due regard to the description and drawings, relates to the automation of processes comprised in the list of subject-matter and activities excluded from patentability under Article 52(2) and (3) EPC"*, appears not to be justified.

2.10 While it is legitimate to refuse an application for lack of inventive step where the objection is based on knowledge that was "notorious" or indisputably formed

part of the common general knowledge (see T 1242/04, reasons 9.2), in circumstances, such as in the present case, if the notoriety of the prior art was disputed, the existence of such notorious or common general knowledge needs to be proven by evidence.

- 2.11 In this context the Board wishes to stress that the term "notorious" has to be interpreted narrowly (see: T 690/06 and T 1411/08) and requires that the technical feature in question should be "so well known that its existence at the date of priority cannot be reasonably disputed" and that the "technical detail is not significant".
- 2.12 In the present case, the Board judges that the usage of short range communication WLAN for tracking devices in regular time intervals does not form part of the common general knowledge. Therefore claim 1 of the main request and of the auxiliary request cannot be said to lack inventive step (Article 56 EPC) on this basis.
3. Thus, in reaction to the appellant's request that the decision of the examining division "*not to perform a search*", the examining division should have performed one in response. Refuting this request with a simple statement that "the notoriety of such prior art cannot reasonably be contested" without providing any reasons, appears to be not in compliance with Rule 111(2) EPC, which requires that a decision has to be substantiated.
4. According to Article 111(1) EPC the Board may exercise any power within the competence of the examining division or remit the case to that department for further prosecution. It is thus at the Board's discretion whether it examines and decides the case or

whether it remits the case to the department of first instance.

5. Since the written prior art has not been assessed during the first instance proceedings and the purpose of appeal proceedings is to review the decision, in the Board's view it is appropriate to remit the case to the first instance for performing a search and for further examination on the merits of novelty and inventive step, as requested by the appellant on an auxiliary basis.

Order

For these reasons it is decided that:

1. The decision is set aside.
2. The case is remitted for further prosecution, in particular to perform a search of all technical features of claim 1, and to examine it on the merits of novelty and inventive step.

The Registrar:

The Chairman:



T. Buschek

W. Chandler

Decision electronically authenticated