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File Number: T 167/92 - 3.5.1

Application No.: 86 110 055.0

Publication No.: 0 216 063

Title of invention: Document composition from parts inventory

Classification: G06F 15/20

D E C I S I O N
of 23 October 1992

Applicant: International Business Machines Corporation

Headword:

EPC Article 52(2), (3)

Keyword: "Exclusions from patentability (yes) - no technical contribution to the art" -
"Text processing" -
"Presentations of information"



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Boards of Appeal

Chambres de recours

Case Number : T 167/92 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 23 October 1992

Appellant : International Business Machines
Corporation
Old Orchard Road
Armonk, N.Y. 10504 (US)

Representative : Bonneau, Gérard
Compagnie IBM France
Département de Propriété Intellectuelle
F - 06610 La Gaude (FR)

Decision under appeal : Decision of the Examining Division of the
European Patent Office dated 6 August 1991
refusing European patent application
No. 86 110 055.0 pursuant to Article 97(1) EPC.

Composition of the Board :

Chairman : P.K.J. van den Berg
Members : W.B. Oettinger
F. Benussi

Summary of Facts and Submissions

- I. The appeal contests the decision dated 6 August 1991 of the Examining Division to refuse the European patent application No. 86 110 055.0 which had been filed on 22 July 1986 (publication No. 0 216 063).

The reason given for the refusal was that the subject-matter of Claim 1 (last) filed on 15 January 1991 is in accordance with Article 52(2) not regarded as an invention within the meaning of Article 52(1) EPC.

That claim reads as follows:

"A process for creating a document made up of a plurality of predefined parts, in a processing system comprising at least an operator display and operator input means, said process including the step of:

allowing the operator to define at least one file by its content and a corresponding identifier, for the filling of each of said predefined parts,

and being characterized in that it comprises the steps of:

displaying an inventory screen of said identifiers of the operator defined files for all of said predefined parts,

receiving operator input for designating one of said defined files by its corresponding identifier, for the filling of each of said predefined parts, and

assembling said document from said designated files."

More particularly, according to the decision under appeal, the claimed subject-matter would be implemented as a mixture of old hardware, old software and new software not providing a technical effect. Having regard to prior art document

D1: EP-A-0 075 732,

the only contribution to the art would be a matter of presentation of information and programming; i.e. it would lie in a field excluded from patentability. It might well be that the claimed solution (to a known problem) is more efficient and safe than the prior art process from the human operator's point of view, but not from a technical point of view. No contribution in a field not excluded from patentability under Article 52(2) could therefore be identified; i.e. the application relates to non-patentable subject-matter as such, cf. Article 52(3) EPC.

Referring to a previous communication, the Examining Division drew a similar conclusion for the dependent claims. In respect of Claims 2 and 3 and 5 to 7 it considered that the characterising features were non-technical for reasons analogous to the ones raised against Claim 1; the characteristic features of Claim 4 were said to be known from D1.

II. The appeal was lodged, and the respective fee paid, on 24 September 1991 with a request that the decision be reversed.

On 16 December 1991, the Appellant filed a Statement of Grounds.

III. In those Grounds, the Appellant submitted that the claimed process eliminated wasteful encumbering of the computer

memory and the need for the "resolve supervisor" in D1, resulting in a faster and cheaper creation of a standard letter and thus bearing a technical contribution to the art.

- IV. In accordance with a further request for oral proceedings, the Appellant was on 8 July 1992 summoned to 23 October 1992.

On 21 October 1992, the Appellant informed the Board by telefax that he would not be able to attend the oral proceedings due to heavy workload. He requested that, instead, the proceedings be continued on the basis of the grounds of appeal. Should the Board require Claim 1 to be amended for emphasising technical contribution over prior art, such amendments would certainly be accepted by the Appellant.

In the oral proceedings of 23 October 1992, in which the Appellant was not represented, the Board considered that under Article 113(1) EPC there was no sufficient reason for continuing the proceedings under Rule 71(2) by a communication, because no amendment rendering Claim 1 allowable was envisageable. Rather, the appeal was regarded as ripe for a decision. The Board decided accordingly and dismissed the appeal.

Reasons for the Decision

1. The appeal (cf. paragraph II) is admissible.
2. Amendments

The Examining Division considered Claim 1 to be based on the original Claim 2, and the dependent claims to be based on the original Claims 4, 6 to 8 and 10 to 12.

The Board agrees with this view. No objection arises therefore under Article 123(2) EPC against the amendments made to the application.

3. Claim 1: Exclusions from patentability (Article 52(2) and (3) EPC)

The present application was refused by the Examining Division on the grounds that the claimed subject-matter was excluded from patentability in accordance with Article 52(2) EPC. The issue to be resolved by the Board is therefore whether this finding was correct, i.e. whether the process according to Claim 1 is or is not to be considered as an invention within the meaning of Article 52(1) EPC.

3.1 The process specified in Claim 1 involves hardware - a processing system comprising a display and input means - as well as software.

When a claim contains a mixture of features excluded from patentability under Article 52(2), considered in conjunction with 52(3), EPC and features not excluded, the jurisprudence of the Board is that an invention within the meaning of Article 52(1) EPC should involve some contribution to the art in a field not excluded from patentability (see e.g. T 38/86, OJ 1989, 384, headnote II). Features which fall under Article 52(2) can only contribute to an invention within the meaning of Article 52(1) if they have an impact on non-excluded subject-matter. They should in other words contribute to a technical effect or to the solution of a technical problem.

3.2 The process according to Claim 1 enables a user to create a document, such as a letter, by selecting from a screen suitable text parts symbolised by codes referred to as "identifiers". The text parts have been previously defined by the user and stored as data files.

In order to decide whether a contribution to prior art lies or does not lie in a field excluded by Article 52(2) EPC, it must first be determined what this contribution is. The Examining Division chose to regard the document creation process described in D1 as the closest prior art. This known process consists in selecting and merging two documents, the "shell document" and the "fill-in document". The shell document contains variables where items from the fill-in document should be inserted. The user selects which documents he wants to merge by inputting their names. The final document may for example be a letter.

The Examining Division concluded that, having regard to this prior art, not only the features contained in the first part of Claim 1 were known in combination, but also two of the characterising features. These features were the reception of an operator input for designating one of the defined files for each document part and the assembling of a document from the designated files. The Board agrees that these steps form part of the known method (cf. for example the abstract of D1).

3.3 Thus the only feature in Claim 1 which is not disclosed in D1 is the displaying of an inventory screen showing the identifiers of the operator-defined files for all predefined parts.

The Board takes the view, as did the Examining Division, that this feature is a presentation of information as

such. It is not apparent that it has any technical effects; on the contrary, the display is provided for the sole purpose of conveying information to the operator. If, as a consequence of the content of this information, the operator is led to input a selected identifier, this act does not constitute a technical effect since it involves the judgment of the operator to handle the displayed information according to his intentions.

- 3.4 In the Grounds of appeal, the Appellant by means of practical examples for the claimed method and for the method known from D1 illustrated their differences and submitted that technical contributions to the art described in D1 should be seen in the saving of memory space - since, for example, there is no need to store a separate shell document for every standard letter - and in the elimination of the "resolve supervisor" resulting in a faster and cheaper process (cf. point III above).

The Board notes that neither of these arguments is based on the present wording of Claim 1. If, in accordance with the above interpretation of the claim, the "plurality of predefined parts" consists of only two sets of data files, corresponding to the known shell document and fill-in document in D1, no memory space is saved. As to the "resolve supervisor" described in D1, this unit is, according to the Grounds of appeal, "able to distinguish in the 'shell document' between effective text and 'control codes' referring to sections to be embedded from the 'fill-in document'". In the present Claim 1 the final method step is "assembling said document from said designated files"; this wording seems not to exclude the use of a "resolve supervisor".

- 3.5 Thus the subject-matter of Claim 1 is excluded from patentability under Article 52(2)(d) EPC.

4. The Appellant's further request

The Appellant has requested that the Board indicate any amendment to Claim 1 that might overcome the objections raised.

It goes without saying that a Board of Appeal has no obligation to suggest amendments to application documents or to examine claims which do not form part of a request. In the present case, however, considering that a straightforward comparison of the features of Claim 1 with those of D1 appears only possible for the special case that the claimed "predefined parts" are two in number, it might be justified to consider the principal aspects of the subject-matter of Claim 1 to determine whether the objection under 52(2) EPC is fundamental or if it could easily be overcome by a suitable amendment to the claim.

4.1 To make the argumentation more general the starting point will no longer be the particular method described in D1; instead, the prior art is taken to be the - clearly conventional - hardware configuration specified in Claim 1 comprising a processor, a display, and operator input means.

Involving this hardware, the claimed method essentially comprises the steps of

- displaying the identifiers of files corresponding to predefined text parts,
- receiving operator input for designating one identifier for each part,
- assembling a document from said files.

- 4.2 The overall purpose of the method is the creation of a text document, such as a letter. No contribution in a field not excluded by Article 52(2) EPC can be seen in the process of creating a text, which is of a non-technical nature; see for example Decision T 186/86 dated 5 December 1989 (not published in the OJ), reason 3.

The displaying of identifiers is only technical as far as the display equipment is concerned; however, since such equipment is conventional no technical contribution is implied by this step either.

Similarly, there is no technical contribution in the step of receiving operator input using conventional input means.

The assembling of a document from the designated files presupposes that it is possible to concatenate data files. The application is silent on the exact nature of the assembling. It must therefore be assumed that known means are used for this step, so that no contribution to prior art, whether technical or non-technical, is implied by it.

- 4.3 The arguments furnished by the Appellant to demonstrate a technical contribution to the art described in D1 (cf. points III and 3.4 above) will now be considered for the more general interpretation of Claim 1.

- 4.3.1 It appears that the amount of memory space saved by not having to store one shell document for each standard letter is basically a measure of the achieved reduction of redundancy. It is no doubt true that sometimes reduced redundancy implies a technical effect; an example might be the elimination of the need for retransmitting data in a communication channel by enhancing the signal-to-noise

ratio. However, in cases like the present one where stored data has been compressed in such a way that the information content, while no longer being identical with the information content of the data stored according to prior art for the practical purposes of a user, it may be that the reduction of redundancy has been achieved at some disadvantage to the user. Then technicality is not necessarily given. An obvious example would be the use of abbreviations in a text where an operator must restore the original information content by a mental act, using his own knowledge and judgment.

In the present case the claimed method may avoid the need for storing a multiplicity of shell documents, but in return the operator must go through the process of defining each corresponding document from the set of predefined files. The fact that the information stored is not the same as according to prior art must thus be compensated by the operator.

The Board is therefore not able to accept that the reduction of memory space is a sufficient indication of technicality.

4.3.2 Nor is the fact that the present method does not involve a "resolve supervisor", resulting in a faster and cheaper process, a sufficient indication. Firstly, there is nothing inherently technical about the qualities "fast" and "cheap". Secondly, features which the claimed process does not involve - be they technical or not - are obviously of no importance for the present issue. Instead the features in Claim 1 replacing the prior art features must be considered, as was done in paragraph 4.2 above.

4.4 It is also not apparent that the dependent claims would contain unconventional subject-matter not excluded by Article 52(2) EPC.

Claim 2 specifies that files which have been designated are identified on the screen by visually perceptible means. This is a mere presentation of information.

Claims 3 and 4 specify that the created document is displayed and/or printed. Since the technical means for performing these steps are conventional, no contribution to prior art is implied.

Claims 5 to 7 specify that one of the document parts is the current date, which is derived from a system clock and may be set by the operator. The Board has no doubt that it is already known to generate the current date from an internal clock, so that the possibly technical aspects of these features must be regarded as conventional. The displaying of the current date as one of the document parts is no more than a presentation of information.

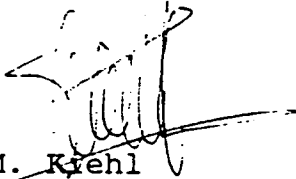
4.5 It follows that the Board can see no way of amending Claim 1 to overcome the objection under Article 52(2), taking account of Article 52(3), EPC.

Order


For these reasons, it is decided that:

- The appeal is dismissed.

The Registrar:


M. Kiehl

The Chairman:


P.K.J. van den Berg

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