Datasheet for the decision
of 10 October 2007

Case Number: T 0845/05 - 3.5.01
Application Number: 99650055.9
Publication Number: 1049039
IPC: G06F 17/60
Language of the proceedings: EN
Title of invention:
Application apparatus and method
Applicant:
Minerva Holdings NV
Opponent:
-
Headword:
Application apparatus/MINERVA
Relevant legal provisions:
EPC Art. 56
Keyword:
"Inventive step - treatment of non-technical features"
"Mere wish to automate a manual procedure - obvious"
Decisions cited:
-
Catchword:
Cf. point 1.6 to 1.8 of the Reasons
Case Number: T 0845/05 - 3.5.01

DECISION
of the Technical Board of Appeal 3.5.01
of 10 October 2007

Appellant: Minerva Holdings NV
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Decision under appeal: Decision of the Examining Division of the European Patent Office posted 7 February 2005 refusing European application No. 99650055.9 pursuant to Article 97(1) EPC.

Composition of the Board:
Chairman: S. Steinbrener
Members: S. Wibergh
A. Pignatelli
Summary of Facts and Submissions

I. This appeal is against the decision of the examining division to refuse European patent application No. 99650055.9.

II. The following document will be referred to in the present decision:


III. The examining division held that the invention according to the main and auxiliary requests before it did not involve an inventive step.

IV. In the statement of grounds of appeal the appellants requested that the decision be set aside and a patent be granted based on claims according to one of the main request and two auxiliary requests filed together with the grounds.

V. In reply to a communication from the Board, the appellants submitted a new main request by letter dated 10 September 2007.

VI. Oral proceedings were held on 10 October 2007. In the course of the proceedings the appellants filed claims according to three new auxiliary requests.

VII. Claim 1 of the appellants' main request, filed with letter dated 10 September 2007, reads:
"An apparatus for receiving and assessing an application made by an applicant, said apparatus including:

computing means (23) configured or programmed to present a plurality of application forms (8) to said applicant (5), to receive said forms once completed from said applicant (5) and to assess said application; input means (3,4) for said applicant (5) to complete and return said forms (8) to said computing means (23); and

communication means for communicating or sending said assessment of said application to said applicant (5); wherein said computing means (23) is configured or programmed to construct second and subsequent forms of said plurality of forms (8) progressively on the basis of information provided by said applicant (5) by means of said input means (3,4) in one or more of said completed and received forms, to assess said application, and to communicate said assessment by means of said communication means."

Claim 22 is directed to a corresponding "computer-implemented method for receiving and assessing an application", claims 30 and 31 to computer program products and claim 32 to a computer readable medium.

VIII. Claim 1 of auxiliary request 1 differs from the main request by the addition that the forms are constructed progressively on the basis of "an analysis performed by said computing means of" information provided by the applicant.

Auxiliary request 2 is limited to the claims of the main request directed to the apparatus.
Auxiliary request 3 is limited to the claims of auxiliary request 1 directed to the apparatus.

IX. The appellants requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 32 of the main request submitted with letter of 10 September 2007 or on the basis of claims 1 to 32 of auxiliary request 1 or of claims 1 to 21 of auxiliary request 2 or of claims 1 to 21 of auxiliary request 3, all auxiliary requests as submitted during the oral proceedings before the Board.

X. At the end of the oral proceedings the Board announced its decision.

**Reasons for the Decision**

*Main request*

1. **Inventive step**

1.1 In the patent application, an existing practice for applying for finance, eg a mortgage, is described (paragraph [0002]). This practice "requires an applicant to contact a recipient in the form of, for example, a lender, often in person or by telephone, and complete - orally or in writing - a loan application for subsequent consideration by the lender".

1.2 The examining division held that the subject-matter of claim 1 was a straight-forward computer implementation of such a practice, noting that a lender (bank
administrator) would only ask pertinent questions (decision, point 4.4). The Board understands this to mean that if a bank administrator is for example informed that an applicant for a mortgage has no dependents, he would not ask for their age. In the same way a computer performing the task should ideally be programmed to suppress irrelevant questions. The examining division pointed out that this could easily be achieved by the use of nested "if then else" statements (decision, point 4.2).

1.3 The appellants have argued that although lenders may collect information orally, they also have to fill in a form summarizing the answers. This was a pre-printed form which could not be altered. Computer implementations of the application process were known, for example from D1, but also then predetermined forms were provided and filled in by the applicant on the screen. The invention improved on this technique by configuring the computer to analyze the answers given to the questions displayed and modify subsequent parts of the forms as needed. In the words of claim 1, the forms were progressively constructed.

1.4 In spite of the appellants' counter-arguments, the Board finds the reasoning in the decision under appeal convincing. The mere wish to automate a manually performed administrative procedure, such as an application for finance, must be regarded as obvious, and clearly a computer would be used for this purpose. The natural starting point for a programmer - who is the technically skilled person in this case - is to develop a system which as far as possible mimics the behaviour of the bank administrator. Since the bank
administrator is capable of analyzing answers and react to them, an ideal computer system should be programmed to react to answers in a similar way, in particular by avoiding displaying questions which in the light of previous answers have become irrelevant. Thus the screen contents should be adapted to the needs of individual applicants or, in the words of claim 1, be constructed "progressively on the basis of information provided by said applicant". Only if the skilled person could not readily see a way of making the computer analyze answers as desired might a claimed automation implementation in this respect be non-obvious. But in the present case there can have been no such difficulties since the application contains no programmation details.

1.5 The appellants have argued that even if the manual procedure could be automated, the computer in any obvious implementation would not be arranged to construct forms progressively. It would rather present predefined forms in the same way as a bank administrator uses pre-printed paper forms. It was instructive to contrast the invention with a printing press, the invention being capable of constructing forms progressively but the printing press being limited to creating inalterable forms. Furthermore, in D1 the forms, and thus the questions put to an applicant, were predetermined and the answers were recorded without being analyzed. Thus also D1 did not disclose progressive form construction.

1.6 The Board, however, cannot accept these arguments. The skilled person in the year of priority - 1999 - was certainly aware that a computer is a more versatile
apparatus than a printing press. It is not limited to displaying and outputting predetermined forms even if it may be so used, and in D1 arguably is. Automating a manually performed procedure means aiming at making a computer behave like a human being, not like a printing press. The bank administrator must use pre-printed forms even if they contain superfluous information simply because he has nothing else. The computer does not use pre-printed forms and therefore would not create identical forms in a situation where such forms might be awkward. Whether they are awkward or not is mainly a non-technical question since it will depend on the contents of the forms. For example, if situations may occur where a large number of the prepared questions become irrelevant, then it would be preferable to adapt the forms as they are created. If few or no questions are ever irrelevant there is little need to adapt. This is an issue to be decided by bank managers, not programmers.

1.7 It may further be noted that a claimed solution to a technical problem does not necessarily involve an inventive step merely because less sophisticated solutions exist (or even have been patented). The D1 system may result in unnecessarily long forms but will instead have the advantage of being relatively simple. There is no indication in D1 that systems more closely simulating the way a human being acts would be undesirable, and even less that a technical prejudice against such systems existed.

1.8 Finally, the appellants have argued that the present invention required technical considerations, that its steps are designed in such a way as to be particularly
suitable for implementation on a computing system, and that it could not conceivably be implemented other than on a computing system (letter dated 10 September 2007, p.5). The Board agrees that constructing forms progressively and automatically would probably not be possible without a computer. But this is not a decisive point since there was no realistic alternative to using a computer for the automation. The important question is rather whether the progressive construction of forms involved an inventive use of a computer, and this question the Board has already answered in the negative.

1.9 Thus, the subject-matter of claim 1 does not involve an inventive step (Article 56 EPC).

Auxiliary request 1

2. According to auxiliary request 1 the forms are constructed progressively on the basis of an analysis performed by said computing means of information provided by the applicant. This addition emphasizes the fact that the computer not merely records answers but reacts to them in order to construct the forms. However, since this aspect of the invention has already been considered in connection with the main request, the auxiliary request contains no further restrictions of claim 1 and must be refused for the same reasons.

Auxiliary request 2 and 3

3. Claim 1 of auxiliary requests 2 and 3 are identical with claim 1 of the main request and auxiliary request 1, respectively. These requests are therefore also refused.
Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

T. Buschek  S. Steinbrener