

Shopping for a technical effect (T 1670/07)

We report on a recent Technical Board of Appeal decision at the EPO which gives us a glimpse at how arguments often used when attempting to establish an inventive step may be perceived by the Boards.

During the recent appeal against an Examining Division's decision to refuse a European patent application, the Technical Board of Appeal has clarified its position on some of the arguments often presented by applicants attempting to show that claimed inventions are technical. The Board's decision has provided some useful insight into the utility of such arguments in the form of three so-called fallacies, and also into the circumstances in which they may be deemed to be persuasive.

This decision suggests that when arguing in favour of inventive step and, more particularly, that claimed features are technical, one needs to establish a real technical effect of any novel features without relying on their interaction with other technical features, or user reaction, and one should not rely upon non-technical shortcomings of the prior art.

In the following we summarise the appealed decision of the Examining Division, the Board's decision in brief, and each of the three fallacies formulated by the Board in response to the lines of arguments presented by the patentee.

The appealed decision of the Examining Division

The appealed decision of the Examining Division results from an application concerned with generating an itinerary for shopping from a number of high street vendors. The application was refused during examination due to lack of an inventive step. The claimed invention was

defined by the Board as being essentially that a shopper enters two or more desired goods/services into their mobile device before going shopping and the device displays a shopping itinerary showing an order (i.e. sequence) in which the shopper can visit a group of vendors to obtain the desired goods/services. The itinerary is a function of a user profile, e.g. requiring shortest distance between vendors or goods at the cheapest purchase price.

The Examining Division had decided that obtaining goods from a plurality of vendors is not technical and therefore did not contribute to an inventive step. Regarding the feature of providing an itinerary, the Examining Division suggested that the problem to be solved may be how to provide a technical means to optimise an itinerary. The inclusion of the feature of the itinerary in the problem suggests that the Examining Division considered it to be non-technical too. The fact that the itinerary is a function of a profile of the user was considered by the Examining Division to be obvious.

The Board's decision in brief

The Board agreed with the Examining Division that the claimed subject-matter was distinguished from the prior art in that the user can obtain goods from a number of vendors at a shopping location, and in that the user is provided with an itinerary with the choice of an order to visit identified vendors, where the itinerary is a function of a profile of the user.

The Board went further than the Examining Division to say that all of the identified novel features are non-technical. In upholding the decision of the Examining Division, the Board helpfully set out its views on various lines of argument that it has observed in cases coming before it. These lines of argument are summarised as:

1. the technical leakage fallacy,
2. the broken technical chain fallacy, and
3. the non-technical prejudice fallacy.

The technical leakage fallacy

The appellant argued that the feature of the selection of a group of vendors at a shopping location contributes to the technical character of the claimed invention in that it involves a non-technical feature that interacts with a technical means. In response, the Board put forward the first of its three fallacies: the [technical leakage fallacy](#).

The technical leakage fallacy is described by the Board as the assertion that the mere interaction with an established technical feature should result in the non-technical feature itself becoming technical. This is to say that the technical nature of the implementation of the invention, e.g. a server, should somehow leak back to the non-technical features of the invention. In the present case, the argument involved the information of a group of vendors interacting with technical elements in the form

of a server to produce a technical effect in the selection of vendors and transmission of the selection. Needless to say, the Board did not find this type of argument convincing.

The broken technical chain fallacy

The appellant further argued that the difference of identifying a group of vendors rather than a single vendor as in the prior art implies a problem of logistics. In the Board's view, producing an itinerary is not technical as it involves only standard human behavioural concepts like going to the bank and then to a supermarket. The appellant replied that the physical act of going to the locations conferred technical character to those thoughts. The Board applied its second of three fallacies here: the [broken technical chain fallacy](#).

The broken technical chain fallacy refers to the commonly used argument that a technical effect might exist in the user's reaction to information that is generated by a technical feature of the claim. According to the Board, this argument is often made in view of a previous decision of the Technical Boards of Appeal that involves user interfaces and the existence of a technical effect in a user's reaction to information presented in the interface. This previous decision concluded that a chain of effects from providing information to its use in a technical process is broken by the intervention of the user. Thus, any possible technical effect that is arguably brought about by the action of a user cannot be used to establish an overall technical effect, since any possible technical effect is dependent on a user's reaction. The Board pointed out that a technical effect might arise from the provision of data about a technical process, regardless of the presence of a user or its subsequent use, or from the provision of data that is applied directly in a technical process. However, neither of these was found to be present in the application in question.

The appellant also attempted to draw similarities between its invention and an apparatus set out in a previously appealed case that provided an optical display for providing a current and ideal gear to be selected based on conditions of a gear box. The Board was not swayed in its view, stating that in the present case there is no comparable technical system, since shopping is non-technical, and that the displayed information is not representative of the status of the technical parts of the claimed invention (i.e. the server and the mobile device), rather the displayed information is non-technical information that the technical parts process.

In attempting to persuade the Board that the claimed invention involves an inventive step, the appellant formulated a problem to be solved by the claimed invention as the provision of a technique which has greater flexibility and can provide results tailored to a user's preferences. The Board's view was that this problem is not technical and is too general because it does not take into account the non-technical aspects of the claimed invention. The Board stated that the problem is far more specific and should be how to modify the prior art to implement non-technical aspects of planning a shopping trip that includes orders from different vendors. According to the Board's formulation of the problem, it was considered obvious by the Board to modify the prior art.

The non-technical prejudice fallacy

The appellant reasserted that the system described in the prior art only provides a single facility, which is in contrast to the claimed invention that provides a group of vendors and navigation information on how to get to the group of vendors. According to the appellant, the prior art system would return a single vendor for all the desired items, but a single vendor may not be capable of supplying all the desired items,

or the vendor may be located a long way away from the user. Finally, the Board referred to the third of its fallacies: the [non-technical prejudice fallacy](#).

The non-technical prejudice fallacy, put simply, results from attempting to use non-technical aspects of an invention as a motivation not to modify the prior art. In such scenarios, the Board noted that it is not whether the skilled person would consider adding these, non-technical, tasks to the prior art but how the skilled person would. Since these could be added by standard hardware, there is no technical reason why the skilled person cannot modify the hardware to perform non-technical tasks.

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