

GRÜNECKER KINKELDEY STOCKMAIR & SCHWANHÄUSSER

ANWALTSSOZIELTÄT

EPO - Munich
34

25. Aug. 2004

GKS & S MAXIMILIANSTRASSE 58 D-80538 MÜNCHEN GERMANY

EUROPEAN PATENT OFFICE

ERHARDTSTR. 27
80298 MUENCHEN

RECHTSANWÄLTE
LAWYERS

MÜNCHEN
DR. HELMUT EICHMANN
GERHARD BARTH
DR. ULRICH BLUMENRÖDER, LL.M.
CHRISTA NIKLAS-FALTER
DR. MAXIMILIAN KINKELDEY, LL.M.
DR. KARSTEN BRANDT
ANJA FRANKE, LL.M.
UTE STEPHANI
DR. BERND ALLEKÖTTE, LL.M.
DR. ELVIRA PFRANG, LL.M.
KARIN LOCHNER
BABETT ERTLE
CHRISTINE NEUHIERL
SABINE PRÜCKNER

PATENTANWÄLTE
EUROPEAN PATENT ATTORNEYS

MÜNCHEN
DR. HERMANN KINKELDEY
PETER H. JAKOB
WOLFHARD MEISTER
HANS HILGERS
DR. HENNING MEYER-PLATH
ANNELIE EHNOLD
THOMAS SCHUSTER
DR. KLARA GOLDBACH
MARTIN AUFENANGER
GOTTFRIED KLITZSCH
DR. HEIKE VOGELSANG-WENKE
REINHARD KNAUER
DIETMAR KUHLE
DR. FRANZ-JOSEF ZIMMER
BETTINA K. REICHEL
DR. ANTON K. PFAU
DR. UDO WEIGELT
RAINER BERTRAM
JENS KOCH, M.S. (J of PA) M.S.
BERND ROTHAEHEL
DR. DANIELA KINKELDEY
THOMAS W. LAUBENTHAL
DR. ANDREAS KAYSER
DR. JENS HAMMER
DR. THOMAS EICKELKAMP
JOCHEN KILCHERT
DR. THOMAS FRIEDE
DR. ANJA DIETEL

PATENTANWÄLTE
EUROPEAN PATENT ATTORNEYS

BERLIN
PROF. DR. MANFRED BÖNING
DR. PATRICK ERK, M.S. (MIT)
KÖLN
DR. MARTIN DROPMANN
CHEMNITZ
MANFRED SCHNEIDER

OF COUNSEL
PATENTANWÄLTE

AUGUST GRÜNECKER
DR. GUNTER BEZOLD

DR. WILFRIED STOCKMAIR
(-1996)

IHR ZEICHEN / YOUR REF.

UNSER ZEICHEN / OUR REF.

DATUM / DATE

EP15813 I RKjok

24 August 2004

European Patent No. 0 927 945

Application No. 99 105 948.6

Proprietor: AMAZON.COM, INC.

Opponents: (1) GESELLSCHAFT FÜR INFORMATIK E.V.

(2) FLEUROP-INTERFLORA EUROPEAN BUSINESS COMPAY AG

(3) FÖRDERVEREIN FÜR EINE FREIE INFORMATIONALE
INFRASTRUKTUR E.V.

**WRITTEN STATEMENT IN RESPONSE TO THE OPPOSITIONS FILED BY
GESELLSCHAFT FÜR INFORMATIK E.V. (Opponent 1), FLEUROP-INTERFLORA
EUROPEAN BUSINESS COMPAY AG (Opponent 2), and FÖRDERVEREIN FÜR EINE
FREIE INFORMATIONALE INFRASTRUKTUR E.V. (Opponent 3)**

I. Requests

1. It is requested to reject the oppositions as filed by Opponent 1, Opponent 2 and Opponent 3.
2. Auxiliary, oral proceedings are requested.

GRÜNECKER KINKELDEY
STOCKMAIR & SCHWANHÄUSSER
MAXIMILIANSTR. 58
D-80538 MÜNCHEN
GERMANY

TEL. +49 89 21 23 50
FAX +49 89 22 02 87
FAX +49 89 21 86 92 93
<http://www.grunecker.de>
e-mail: info@grunecker.de

DEUTSCHE BANK MÜNCHEN
No. 17 51734
BLZ 700 700 10
SWIFT: DEUT DE MM

II. Admissibility

Opposition 3 is signed by Mr. Koglin. Mr. Koglin is obviously not on the list of European representatives and for that reason, he may not act on behalf of an opponent in front of the European Patent Office. Therefore, opposition 3 signed by him cannot be regarded as an opposition in the name of FÖRDERVEREIN FÜR EINE FREIE INFORMATIONALE INFRASTRUKTUR E.V. For this reason, opposition 3 should be deemed inadmissible.

Opposition 3 is substantially a copy of opposition 2. For this reason, we will refer only to oppositions 1 and 2 in the following. In as far as opposition 3 is deemed admissible, any comments made in regard to opposition 2 should be considered to apply vis-à-vis to opposition 3.

III. European Patent No. 0927045 Validly Claims the Priorities of Earlier Years Applications US 928951 and US 46503

The subject matter claimed in claims 1 to 15 is disclosed in US 46503 and therefore the time rank of the claimed subject matter is March 23, 1998. Column 12, line 17 to column 17, line 17 and FIGs 10 to 18 of the present patent are identically disclosed in priority document US 46503 (merely the reference numerals differ being a consequence of additional FIGs 1 to 9 stemming from priority document US 928951).

For this reason, cited referenced US 5737729 (D2) having a publication date of April 7, 1998 is not prior art in the sense of Article 54 EPC.

Opponent 2 has not specifically stated any particular features that in his opinion are not sufficiently disclosed in the prior art document. In as far as Opponent 2 wishes to argue that alleged violations of Article 123(2) EPC lead to the additional consequence that the priority cannot be validly claimed, we refer to the following comments under IV, wherein it is explained in detail why the claimed subject matter is in agreement with Article 123(2) EPC.

IV. Article 123(2) EPC

A violation of Article 123(2) EPC was alleged only by Opponent 2, and not by Opponent 1.

In order to simplify the further discussion, we refer in the following to the feature analysis as set forth by Opponent 2 under items 1, 2.1 and 2.2, respectively.

The claim wording of claims 1 and 7 as granted is clear and accurately defines what the skilled person derives as the essential teaching in regard to gift delivery from the originally filed application.

It is established practice that an applicant is not bound by the wording of originally filed claims. If that would be the case, most divisional applications claiming subject matter that was not claimed by the parent application would not be possible. What is important is if the finally claimed teaching is sufficiently supported by the originally filed disclosure.

In particular, Opponent 2 considers the fact that features M1-.3 and M1-.4 of claim 1 as filed for the divisional application are not included in granted claim 1 to be in violation of Article 123(2) EPC. These two features both relate to an embodiment described in the originally filed application according to which it is assumed that the information on the recipient is not sufficient to allow a delivery, and in this regard it is suggested to obtain the necessary information from other sources. This aspect is literally mentioned in column 13, line 30 of the patent as an additional embodiment (see also column 14, line 36-39). Since this is an additional embodiment, it is clear to the skilled person that the solutions described before this additional embodiment have to be understood as not necessarily requiring to obtain additional information from additional sources.

Moreover, the fact that FIG. 10 of the patent shows steps M1-.3 and M1-.4 only as optional steps, which may never be taken, it is evident that the skilled person derived from the originally filed disclosure that these steps are optional and are in no way necessary or essential.

The same comments apply to features M7-.3b and M7-.3c addressed by Opponent 2.

Furthermore, Opponent 2 is of the opinion that there is no basis in the originally filed application for features M1.1, M1.5a and M1.5b. With respect to feature M1.1, it is clear to the skilled person from the overall language of claim 1 that the gift does not, in fact, physically come from the gift giver. If that would be the case, there would be no need for the method according to claim 1.

The wording of claim 1 is to be understood by the skilled person in the sense that the gift giver donates a gift to the recipient and that the delivery of the gift is made in accordance with the claimed method.

In accordance with feature M1.5a, it is referred to column 12, lines 50 to 52, wherein it is mentioned that "an attempt via electronic mail is made to initially contact the recipient and gather sufficient delivery information".

Details for the delivery information are disclosed, for example in column 17, lines 22 to 40, suggesting as delivery information the postal address. Thus, feature M1.5a is sufficiently disclosed.

The same comments apply to feature M7.5a.

Feature M1.5b provides the teaching that the physical delivery of the gift can take place only if the gift delivery computer system has obtained the necessary, i.e. complete, delivery information. From the overall disclosure in FIGs 10 to 18 and the related description, it is clear that it is the gift delivery computer system that initiates the delivery after the necessary information has been obtained, and since the gift delivery computer system is an electronic system, this initiating is made electronically. Thus, feature M1.5b is sufficiently disclosed.

The same comments apply to feature M7.5b.

With respect to feature M7.1, we would like to note that original claims 47 and 48 filed with the parent application already were directed to a computer-readable medium claim.

V. Article 100 (b) EPC

Opponent 1 seems to raise on page 14 the grounds for opposition in accordance with Article 100(b) EPC. This ground is not indicated in the summary of the request, as provided on page 1 of Opponent 1's letter dated August 27, 2003. In as far as the ground in accordance with Article 100(b) EPC is considered to be raised by Opponent 1, we would like to note that this ground most apparently cannot be considered to have any merit, as the subject matter of claims 1 to 15 is undoubtedly disclosed in a manner that is sufficiently clear and complete to be carried out by a skilled person.

VI. Article 52(2)(c) EPC

The present invention is related to a **technical field** and **solves a technical problem by technical features**. The solution is based on **technical considerations** and provides various **"further technical effects"**.

The present invention solves the object to simplify the donation of a gift, in particular a gift purchased via the Internet (e-commerce) by a gift giver to a recipient.

The present invention achieves this by the steps of:

- *receiving (1401, 1404) from the gift giver an indication that the gift is to be delivered to the recipient and an electronic mail address of the recipient; and*
- *sending (1409) to a gift delivery computer system an indication of the gift and the received electronic mail address,*
wherein the gift delivery computer system coordinates delivery of the gift by:
 - *sending (1501b) an electronic mail message addressed to the electronic mail address of the recipient, the electronic mail address requesting that the recipient provide delivery information including a postal address for the gift; and*
 - *upon receiving the delivery information, electronically initiating (1701-1708) delivery of the gift in accordance with the received delivery information.*

The following “further technical effects” /advantages are achieved by the present invention:

- By the present invention, the gift giver or donator is relieved from the burden to know or to search for the exact postal address of the intended recipient at the time he/she initiates the donation. Rather, he/she can complete the transaction without this information. The cumbersome task to find out the exact postal address is taken over by an electronic system.

In particular, the gift giver does not have to worry about postal addresses having formats that differ for each country and which are sometimes, for an inexperienced sender, quite confusing if they are different from postal addresses the gift giver is accustomed to from his/her own country. Instead, the gift giver needs simply to know an e-mail address that enables contact with the intended recipient. E-mail addresses have a unified format around the world, meaning that there is no structural difference either in format or in language between an e-mail address, for example, of France and China.

- In accordance with the present invention, the gift giver has, in particular, no need to worry about postal address changes of people he/she wishes to donate gifts since e-mail addresses are not linked to a physical address of a person, but rather to the person themselves. This means, in accordance with the present invention, the gift giver is relieved from the cumbersome task to steadily update postal address databases for possible recipients.
- Moreover, in accordance with the principles of the present invention, it is no longer necessary to transmit sensitive postal address information over the Internet each time a donation is made. Rather, in accordance with the present invention, physical address information for a possible recipient is not sent by third parties over the Internet and the recipients themselves may decide on the manner and the encryption status by which their physical address information is transmitted to the server.
- Moreover, in accordance with the principles of the present invention, a person can receive gifts without having to disclose their postal address to the gift giver. For example, if another person met via an Internet chat, sometimes it is not desirable to provide a home address to that yet relatively unknown person. If that person wants

to send a gift, then the invention can be used for sending a gift without disclosing the home address that person – only the delivery computer needs to know the home address.

- In accordance with the present invention, the physical addresses finally used for the mailing of the gift are more accurate, as these postal addresses have been obtained from the recipients themselves at the time of mailing. This avoids the mailing of a gift on the basis of an old, non-updated, postal address with the consequence that the gift is returned to the sender as non-deliverable. Thus, the present invention avoids problems with the delivery of gifts and in particular will lead to less errors in regard to the delivery of gifts. Moreover, the danger that the donator initially provides an incorrect postal address is significantly reduced, as the donator needs merely to state a short e-mail address having a unified worldwide format. This means, the chances that the gift giver provides wrong information is reduced to a minimum, in contrast to traditional methods and systems where the gift giver has to state a complete postal address leaving many possibilities for spelling errors, in particular, if the language in the country of the recipient is different from that of the country of the gift giver.

The more error-free delivery of gifts reduces mailing costs, which otherwise have to be absorbed by the customer or the provider/operator.

- Furthermore, the software for inputting a gift order is simplified since it does not need to check the validity of postal addresses, which is a much more complex process (especially if international recipients are finally to be addressed) than checking the validity of an e-mail address.
- In accordance with the principles of the present invention, the intended recipient is automatically pre-informed about the delivery of a gift and thus can make necessary arrangements at the appropriate time to safely receive the gift (column 15, lines 39 to 41). For example, the recipient may make sure that at the time of delivery someone is present at the postal address to accept delivery from the mailing service thereby avoiding the gift being returned to the sender. Moreover, the recipient may undertake other arrangements for a perfect delivery in terms of space, temperature, etc.

- Moreover, in accordance with the principles of the present invention, the intended recipient identified by e-mail may himself decide to which physical address the gift should be delivered; for example, his home, his office, a vacation hotel, etc. This means, the gift can be delivered to the currently most appropriate address which cannot be known by the donator.
- The inventive solution is based on a technical structure that was not known prior to the present invention. The present invention suggests for the first time to automate the mailing and delivery of a physical gift in such a manner that the gift giver does not need to state a physical address of the intended recipient. Rather, in accordance with the present invention, the gift giver has merely to state a virtual address, namely an e-mail address, and by virtue of the present invention, it is possible to automatically link this virtual address to the most appropriate current physical address of the intended recipient without the need of any further input from the gift giver. The present invention is in the field of automated mailing services. The manner of how the system achieves retrieval of the most updated address information and thereby relieves the user of the burden of searching and updating such address information on his own, may be compared to a handshake between sender and receiver in the area of telecommunications. When a call between a sender and a receiver is established in the area of telecommunications, certain parameter data is initially exchanged in order to enable an error-free and successful communication. The inventive solution, although very different from the solutions in the area of telecommunication, is nevertheless comparable. The sender, namely the server, contacts the receiver, i.e. recipient, in order to gain appropriate information to secure a successful transmission. In this manner, a very flexible communication is achieved, as the finally necessary data is obtained most accurately from the recipient (receiver) himself based on his needs. The user of the system, here the gift giver, does not need to worry about those details and experiences the entire procedure in a very comfortable way.

The various "further technical effects" deriving from the present invention have been outlined hereinabove.

In as far as the Opponents argue that the claimed subject matter would lack technical character, this finding is based on the wrong interpretation of the present invention and/or of the relevant case law of the Board of Appeal.

In as far as Opponent 2 is of the opinion that Decision T 931/95 would support his argument concerning the alleged lack of technical character, an obvious misinterpretation of this Decision has been made. In T 931/95 it was found that, *"Methods only involving economic concepts and practices of doing business are not inventions within the meaning of Article 52(1) EPC". "A feature of a method which concerns the use of technical means for a purely non-technical purpose and/or for processing purely non-technical information does not necessarily confirm a technical character to such a method"*.

There is a fundamental difference between the subject matter of the present patent and the subject matter to which Decision T 931/95 is related. Claim 1 of application number 88 302 239 addressed by Decision T 0931/95 reads as follows:

"A method of controlling a pension benefits program by administering at least one subscriber employer account on behalf of each subscriber employer's enrolled employees each of whom is to receive periodic benefits payments, said method comprising:

providing to a data processing means information from each said subscriber employer defining the number, earnings and ages of all enrolled employees of the said subscriber employer;

determining the average age of all enrolled employees by average age computing means;

determining the periodic costs of life insurance of all enrolled employees of said subscriber employer by life insurance cost computing means; and

estimating all administrative, legal, trustee, and government premium yearly expenses for said subscriber employer by administrative cost computing means;

the method producing, in use, information defining each subscriber employer's periodic monetary contribution to a master trust, the face amount of a life insurance policy on each enrolled employee's life to be purchased from a life insurer and assigned to the master trust and to be maintained in full force and effect until the death of the said employee, and periodic

benefits to be received by each enrolled employee upon death, disability or retirement.”

The Board of Appeal found that this claim 1, apart from various computing means mentioned in the claim, is directed to a “method for controlling a pension benefits program by administering at least one subscriber employer account”. All the features of the claim are steps of processing and producing information having purely administrative, actuarial and/or financial character. Processing and producing such information are typical steps of business and economic methods. For that reason, the invention claimed in application number 88 302 239 would not go beyond a method of doing business as such and was therefore excluded from patentability.

The subject matter of the present patent is very different from the subject matter of the above-quoted claim 1 for application number 88 302 239.

Claim 1 of the present patent does not merely define a method for doing business that is carried out on a computer. Rather, all steps mentioned in claim 1 are technical in nature and involve an interaction between technical means. Claim 1 is directed to an electronically automated mailing system leading to the advantages and further technical effects listed hereinabove. In the end, the subject matter of claim 1 leads to an automated sending of a physical gift, and the retrieval of the necessary information to successfully mail the gift are automated by electronic means.

With respect to claim 7 of the present patent, it should be noted that even Decision T 931/95 comes to the conclusion that *“an apparatus constituting a physical entity or concrete product suitable for performing or supporting economic activity is an invention within the meaning of Article 52(1) EPC”*.

VII. Article 56 EPC

In order to simplify the following discussion, the documents filed by Opponent 1 and Opponent 2 are numbered in the following order:

D1: (Opponent 1) The Bell System Technical Journal, “Language Development Tools”, 1978, Vol. 57, No. 6, Part 2

D2: (Opponent 2) US 5,737,729A (published on April 7, 1998 and thus later than the priority dates of the present patent)

D3: (Opponent 2) Patent Abstracts of Japan, 04-153795

D4: (Opponent 2) US 5,555,496A

D5: (Opponent 2) Alleged print-out from www.fleurop.com, allegedly from 1995.

D6: (Opponent 2) Correspondence dated March/April 1996 between Fleurop-Interflora Netherlands and Fleurop-Interflora Switzerland.

Document **D4** relates to a system for selecting, ordering and sending social expression cards from a card distribution center using a personal computer (abstract). In accordance with D4, a user is provided on his personal computer with the window shown in FIG. 4 comprising envelope images 365 to 405, each associated with an icon, such as a birthday cake 420, a Christmas tree 430, etc. in order to indicate the respective occasion. The image of the envelope conveys information regarding the urgency of the occasion. For example, an envelope related to an occasion that will not occur for a relatively long period of time, the image of the envelope appears as a faint outline of an envelope as shown by envelope image 384. If the occasion will occur fairly soon, the image appears partially gray as shown by envelope image 365. If the occasion will occur very soon and requires immediate attention, the image appears as normal envelope as shown by envelope images 370, 375, etc. (column 7, lines 14 to 40).

Once the user has selected an envelope, the system switches to the card event dialog box 515 shown in FIG. 5. By means of recipient screen 525, the user may enter recipient data directly or by means of an address book 645 (column 8, lines 6 to 14).

In response to clicking the address book box, an address book view screen 710 as shown in FIG. 6a appears. Address book view 720 allows the user to enter recipient information, such as name 725, address 730, relationship to the user 735 and card type preference 740 (column 9, lines 41 to 49). Once the appropriate card selection has been made and the appropriate address information has been entered, the user hits the order button, for example FIG. 4, 480, leading to the display of FIG. 10. This display informs the user on the costs of the order and triggers the user to input a payment selection. Once all the

necessary data has been entered, the user confirms the completeness of the order by clicking the send button 1095 (column 11, lines 47 to 65).

The confirmed order is transmitted from the user's location to the card distribution center 40 of FIG. 11. The transmission of the order may be made by written mail 50, telephone order 55, facsimile order 60, on-line service order 1200 or direct dial-up 1205. Once the card distribution center 40 receives the order 30, it retrieves the selected cards from a stock of inventory cards 1220. The personalized message or signature is then primed on the card by laser primer 1225 or other suitable printer. Alternatively, the laser printer 1225 may print the graphical card design on blank paper stock. In this way, the distribution center 40 need not stock each of the various cards, but rather can print each card from blank card stock on a high quality color printer. The cards 120 are then shipped to the recipients or to the customer via the user's carrier of choice at the appropriate time (column 12, line 56 to column 13, line 3).

In accordance with an alternate embodiment, the user may print cards without the use of card distribution center 40. In this situation, the user enters all necessary information into the personal computer 4 and directly prints the card on an attached printer 1230 (column 13, lines 4 to 8).

All embodiments discussed in document D4 have in common that the sender has to enter and send to the distribution center, or his own printer, the complete postal address of the recipient. Moreover, the final card is printed and is then delivered by mail service. In as far as the embodiment according to which a card is printed on the user's own laser printer 1230, document D4 suggests merely a method of how to generate a card with all necessary information, which is then printed on the laser printer 1230.

In as far as card distribution center 40 of FIG. 11 is involved, the suggested method can be summarized as a method to generate a personalized card which is finally printed at the card distribution center by laser printer 1225. Additionally, the card distribution center 40 relieves the user of the burden of putting the physical card into a mailbox or to submit the card in any other way to the mailing service.

Document **D2** was published on April 7, 1998 and thus later than the relevant priority date of September 12, 1997. Thus, D2 is not prior art in the sense of Article 54 EPC. However, for the sake of completeness, we herewith provide a summary of the content of this document.

Document D2 is related to an unattended interactive kiosk displaying an array of postcards which a consumer may select and personalize with a message. The selected postcard is printed and postage is applied to the card. The finally created card is sent by a mailing service) (column 1, lines 6 to 12 and FIG. 5). FIG. 1 shows a representation of the interactive kiosk, wherein reference 12 indicates the housing of the kiosk, reference 14 indicates the display for displaying postcards 16, and a money acceptor 26 is used for payment. Monitor 18 has touch screen capabilities for allowing selections by the user (column 3, line 43 to column 4, line 6). In accordance with FIG. 2, the printing of the card is not done inside the interactive kiosk, but inside a central processing location 38 linked to the interactive kiosk by means of a modem connection. FIG. 3 provides details about how the user can make a selection at the interactive kiosk. Blocks 62, 64, 66, 68, 72 and 76 refer to the entering of recipient address data. FIG. 3 in connection with FIG. 4 foresees searches in address data bases in case the customer is not able to enter the address directly (column 5, lines 16 to 39). In accordance with FIG. 5, alternative to printing the postcard, the user may use an e-mail address and the postcard may be created as a graphics file. The graphics file is then sent by microprocessor 40 inside central processing location 38 via the Internet to the e-mail address (column 7, lines 6 to 10).

In summary, D2 suggests an interactive kiosk that allows a user to create a personalized postcard. This postcard is either set as a physical postcard via a mailing service to the intended recipient or in the form of an e-mail via the Internet to the intended recipient. In both cases, the mailing is processed and organized by a central processing unit 38. In the case of a physical card, the user enters the postal address of the intended recipient or searches for the complete address in an address database. The finally completed address is printed on the card. In the case of an electronic message being sent rather than a physical postcard, the user merely enters the e-mail address of the recipient.

From the above summary, it is apparent that document D2 does not suggest the sending of an electronic message to an intended recipient on the basis of an e-mail address entered by the user in order to inquire from the intended recipient his postal address. D2 does not suggest to use such a mechanism for the sending of a physical postcard to a physical address. In as far as document D2 is related to the sending of electronic messages, such sending is nothing more than the sending of an ordinary e-mail including a graphics file as an attachment.

Document **D3** is an English abstract of a Japanese patent application published on May 27, 1992. D3 is therefore prior art in the sense of Article 54(2) EPC.

Document D3 relates to an apparatus for sending a gift to an intended recipient. The apparatus comprises a money reception/payment part 16 by means of which the user is able to make a payment for the purchased gift. The user obviously can enter data for selecting a particular gift and data related to the recipient's address. If the payment is sufficient, the apparatus transmits the data to a department where the gift is actually stocked. From there, the purchase gift is mailed to the intended recipient on the basis of the received address data.

In accordance with D3, the user has to enter the complete postal address of the recipient since D3 does not foresee any data base searches for addresses.

Document **D1** relates to language development tools and in particular relates to a generator of parses called "Yacc" and the generator of regular expression recognizers called "Lex". Opponent 1 has compared the disclosure of D1 merely with claim 2, but not with independent claims 1 and 7. Thus, Opponent 1 has not provided any hint as to why he considers document D1 to be relevant for the subject matter of claims 1 and 7.

The relevance of document D1 for independent claims 1 and 7 cannot be seen by the Proprietor, either. For this reason, a detailed analysis of the content of D1 is not made at the present time. Should the Opposition Division consider this document to be of any relevance, we reserve the right to provide our detailed comments concerning D1 at a later time.

Document **D5** allegedly constitutes a print-out from the Internet, which allegedly was printed in 1995. Opponent 2 has not provided any evidence that the content of D5 was actually publicly available on the Internet in the year 1995. As long as no evidence supporting Opponent 2's allegations is provided, document D5 cannot be regarded as prior art in the sense of Article 54(2) EPC. However, an initial study of this document reveals that it appears to have no relevance to the present invention in the sense of acquiring a postal address from the intended recipient for the physical delivery of a gift by means of an electronic message.

Document **D6** comprises two letters allegedly written in March/April 1996. Opponent 2 has not provided any evidence that these letters are actually from 1996 and also has not

provided any evidence that these letters became available to the public at that time. Consequently, D6 cannot be considered as prior art in the sense of Article 54(2) EPC.

In as far as Opponent 2 attempts to argue that certain features of claim 1/claim 7 are not to be regarded for the assessment of inventive step, such a finding is based on an incorrect understanding of Decision T 0641/00. In this Decision, it was found that for the assessment of invention step only those features of a claim are taken into account which contribute to the technical character, whereas features making no such contribution cannot support the presence of inventive step.

This Decision has no relevance for the present patent since all features mentioned in claims 1 and 7 have technical character and thus must be regarded for the assessment of inventive step. Decision T 0641/00 was related to a totally different subject matter. The improvement of the invention in EP 0 579 655, which is addressed by Decision T 0641/00, resided in the idea to store two different subscriber identities IMSI on the same subscriber identity module and allowing the user to selectively activate each of these two different identities.

The subject matter differed from the closest prior art by the following features:

- (i) the subscriber identity module is allocated to at least two identities,
- (ii) said at least two identities being selectively useable, and
- (iii) the selective activation being used for distributing the costs for service and private calls or among different users.

On the basis of this situation, the Board of Appeal found that distributing costs according features (ii) and (iii) were not disclosed as a technical function of the system and that it was therefore left to the user to decide and to select the desired identity and to the network operator to use the additional identity data in one or the other way. Thus, the Board concluded that, *"The inconveniences to be eliminated are actually not located in any technical aspects of the network system; distributing costs according to the claimed kind of cost attributing scheme is rather a financial and administrative concept which as such does not require the exercise of any technical skills and competence and does not, on the administrative level, involve any solution to a technical problem. Technical aspects first come into play with the implementation of such a scheme on the GMS system..."*.

The subject matter of the present patent differs fundamentally from the subject matter discussed in Decision T 0641/00. All features mentioned in claims 1 and 7 have technical character. The claimed subject matter provides a complete, new automated interaction between a gift giver, a (mailing) server and an intended recipient. The manner of how the postal address is automatically requested by the server is not known from any prior art reference and involves an exchange of data between different physical entities and the processing of such information is done in a manner that allows finally the delivery of a physical gift to an appropriate recipient.


Since all technical features of claim 1, as well as claim 7, are of technical nature, Decision T 0641/00 cannot be considered relevant for the present proceedings.

It has been shown hereinabove that neither document D3 nor D4 provide any hint or somehow can render obvious the fundamental principle of the present invention, namely to provide a solution on how a gift giver is relieved from the burden of knowing or searching for the exact postal address of an intended recipient at the time he/she initiates the donation of the gift. None of the documents provide any hint of how the cumbersome task of determining the exact postal address is taken over by an electronic system leading to the various advantages that have been explained in detail hereinabove under item VI.

The same is true for document D2, which however does not qualify as prior art in the sense of Article 54 EPC.

Thus, the subject matter of claims 1 and 7 is inventive over the prior art.

The above provided arguments justify a rejection of oppositions 1, 2 and 3.


(Krauer)