

Amazon One-Click Patent still lingering in Europe after 15 years EPO recognizes patentability and novelty, FFII expects another appeal

Hartmut PILCH

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1 Still opposing the Amazon One-Click Patent today after 15 years

This morning, before pleading at the hearing, I wrote:

Today the FFII is opposing what remains of Amazon's one-click gift ordering patent at the European Patent Office. Actually all of it remains, just in different, extremely verbose and redundant claim wording, most of which describes prior art just for the sake of sounding "technical". The main claim and its subclaims in a variety of auxiliary requests teaches a way of using standard data processing equipment, i.e. a "program for computers" unpatentable according to Art 52 EPC, to operate an equally unpatentable method of doing business. The claimed invention purports to solve a problem of how to avoid a resubmission of user information that is already there, given the prior art of using cookies that the claim itself refers to. Thus this claimed invention solves a problem which, based on its own claim wording, is already solved to begin with. In other words, the patent itself says that it is not novel and in fact does not propose any problem solution that could be checked for novelty. Yet the Technical Board of Appeal of the EPO remitted it to the Opposition Division because it still saw it as potentially novel. Thus, an extremely hazardous patent, which even according to the EPO's extremely generous patentability and inventivity standards should have been easy to reject, has been kept in life for 15 years. The other opponents have lost interest. Thus

the FFII team consisting of Georg Jakob, Stephan Uhlmann and myself is the only opponent in today's proceedings.

2 Revocation on Shaky Grounds

Meanwhile, the patent has been revoked. The Opposition Division revoked it for the second time. In 2007 it had already revoked this patent, which had been granted in 2003 and filed in 1998. However the Technical Board of Appeal (TBA) revived the patent and remitted it to the Opposition Division, alleging that the Opposition Division had failed to prove that the feature of simplification to a "single action" (one click) was not novel. In today's hearing, the Opposition Division considered this feature novel. Moreover it also considered novel the process of ordering a gift for a friend without fully disclosing his address. However the Opposition Division doubted, whether the combination of these two features could be considered an "inventive step".

According to EPO caselaw, when two features from different claimsets (in this case coming from two divisional patent applications that both were derived from the original Amazon One Click Patent) are combined into one new claimset, the new combination must, in order to fulfil the requirement of "inventive step", achieve a further effect (interaction, synergy) that goes beyond the mere addition (aggregation) of the effects that the two features achieve alone. There must be a synergy or a surprising technical effect. Since this was the question that the EPO asked, we argued that the claim presented by Amazon did present an integrated process in which two features performed their functions for a common purpose, but that the common purpose contained no further technical effect beyond the mere addition of the known effects. The chief examiner endorsed our reasoning.

The patentee then drafted another claimset which concretised the known steps of building a session with cookies and storing user data in a persistent manner. The Opposition Division argued that this claimset, while using more verbose wordings to suggest an "interaction", failed to provide any additional technical features and was therefore unable to address the objections raised against the old claimset.

We argued that the claimset did in fact provide additional concretising features, but that these features were irrelevant, because they only concretised the same known means and effects that the old claimset already covered. The reason why the Opposition Division saw no additional features here was that it understood the implicit aim of the old wording, which consisted in monopolizing the well known web technique of using cookies for user management. Therefore, rather than rely on shaky concepts such as "interaction" or "surprising effect", the EPO should revise its decision to consider the claims to be novel. These claims are about as novel as a claim to cutting bread with a known knife or a claim to flipping your fingers to signal to your bartender that you, today as always, want the usual glass of beer, or, in the case of gift ordering, "additionally pointing a finger to your friend to signal that he should have a beer as well".

The Opposition Division did not follow our suggestion but confined itself to the precarious "interaction for further technical effect" reasoning cited from EPO caselaw.

On this basis, it revoked the patent as lacking inventive step.

We consider this reasoning fairly plausible but by no means cogent. It is not uncommon for the EPO in similar cases to consider the effect of a combination of features as "more than the sum of the parts" and therefore sufficiently inventive. The patentee plausibly argued that a "surprising technical effect" exists only in applied natural science, especially chemistry. He also correctly pointed out that the aggregated features do not really come from two different claimsets but from one single mother application, the Amazon One Click patent. Just as happened after the first rejection, the patentee could once more suspect that the Opposition Division may be applying a double standard in order to get rid of a politically inconvenient patent. We therefore would by no means be surprised if Amazon decided to appeal once more.

3 EPO reasoning may reflect deficient governance

It is typical for the EPO to interpret the law in a way that maximizes its discretion. The EPO seems to shy away from any simple and straightforward interpretation of its statutory law that could systematically limit patentability and thereby cut off the EPO, which has to finance large pension funds, from important sources of revenue. Thus EPO caselaw has evolved in directions where patents are preferably rejected on formalistic or idiosyncratic grounds. The advantage for the EPO is that it can thereby flexibly encourage or discourage patenting so as to match its own examining capacities. This results in the world's lowest inventivity hurdles and a low degree of legal security and efficiency, as witnessed by the prolonged life of Amazon's One Click Gift Ordering Patent.