



Clarification of the Concept of the “Notional Business Person”

The *Comvik* approach to examination of inventive step of mixed inventions, which is now standard practice in the EPO, requires that the inventing process is considered to have two phases: first non-technical requirements are formulated and secondly those requirements are implemented using technical means. An inventive step is only recognised if it occurs in the implementation phase. The *CardinalCommerce* decisions addressed the first phase, holding that the non-technical requirements are formulated by a notional business person, who is considered to have no technical knowledge. Therefore, technical features, even notorious features such as general purpose computers, cannot be included in the non-technical requirements.

The *CardinalCommerce* decisions can be helpful where an examiner has used technical language in formulating the non-technical requirements, as sometimes happens.

However, in *Waterleaf* the applicant sought to push this argument further and suggested that the non-technical requirements should not be formulated in such a way as to have “technical implications”. The invention at issue concerned on-line gaming and proposed that, to reduce waiting times for gamblers seeking to join a game, waiting gamblers from several on-line casinos should be pooled to provide the minimum number necessary to make up a new game. To implement this idea, the invention provided an additional “gaming server” which operated the game amongst the pooled gamblers and distributed wins and losses to the gamblers’ accounts at their home casinos.

The applicant argued that the non-technical requirements should be formulated as “to find more gamblers to reduce waiting times” and not “to pool gamblers between casinos” because the latter would have technical implications because it would require modifications to the servers and networks implementing the on-line games.

For more information, please contact:

John Leeming – jleeming@jakemp.com

This argument was rejected by the Board, which held that it went too far in restricting the capabilities of the notional business person. The Board explained that there is a distinction between requiring technical means and requiring something that has technical implications; using the example that the simple desire to have a copy of a particular book has technical implications because to fulfil that desire someone has to make a physical copy of the book.

According to the Board, the notional business person’s requirements are only technical if they go so far as to specify technical features in a way that “pre-empts” technical decisions by the person skilled in the technical art. In the example, the simple requirement to have a copy of a book leaves all the decisions as to how that is to be achieved to the person implementing that requirement. Thus, non-technical requirements (which do not contribute to inventive step) can be formulated in such a way as to require technical implementation as long as they do not constrain how that technical implementation is achieved, as might be done, for example, if specific technical features are required.

We have recently reported on [changes to the EPO’s Guidelines](#) for Examination relating to user interfaces, in particular graphical user interfaces, which took effect from 1 November 2017. These changes do not take account of either the *CardinalCommerce* or the *Waterleaf* decisions; the EPO usually waits to see if the Boards of Appeal take a consistent approach before amending the Guidelines.

Footnotes

1. [T 1463/11](#) (Universal merchant platform/*CardinalCommerce*) and [T 1658/15](#) (Universal merchant platform II/*CardinalCommerce*).