

Commissioner's Decision #1451

Décision du commissaire #1451

TOPICS: O00 Obviousness

SUJETS: O00 Évidence

Application No: 2,415,071

Demande no: 2 415 071

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,415,071, having been rejected under subsection 30(3) of the *Patent Rules* (SOR/96-423), has consequently been reviewed in accordance with paragraph 30(6)(c) of the *Patent Rules*. The recommendation of the Board and the decision of the Commissioner are to refuse the application.

Agent for the Applicant

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INTRODUCTION

- [1] This recommendation concerns the review of rejected Canadian patent application number 2,415,071 (“the instant application”), which is entitled “ELECTRONIC BILL PRESENTMENT AND PAYMENT SYSTEM AND METHOD” and is owned by JPMORGAN CHASE BANK, NA (“the Applicant”). A review of the rejected application has been conducted by the Patent Appeal Board (“the Board”) pursuant to paragraph 30(6)(c) of the *Patent Rules*. As explained in more detail below, our recommendation is that the Commissioner of Patents refuse the application.
- [2] This recommendation and Commissioner’s Decision are being released concurrently with the recommendation and Commissioner’s Decision for Canadian patent application no. 2,819,055, which was filed as a divisional application of the instant application.

BACKGROUND

The Application

- [3] The instant application, based on a previously filed Patent Cooperation Treaty application, is considered to have been filed in Canada on June 27, 2001 and was laid open to the public on January 10, 2002.
- [4] The instant application relates to an electronic bill presentment and payment (“EBPP”) system wherein a registered user of the billing system is notified, for example via email, of an upcoming bill payment due. The notification includes summary information that is formatted in a manner equivalent to a traditional remittance slip used to accompany payment of a bill in a traditional paper-based payment method. The notification provides the user with the option of printing the summary information formatted as a remittance slip and remitting this portion with payment via regular mail or of activating an embedded hyperlink that enables the user to access full billing information and effect electronic payment of the bill.

Prosecution History

- [5] On March 13, 2015, a Final Action (“FA”) was written pursuant to subsection 30(4) of the *Patent Rules*. The FA stated that the instant application is defective on the grounds that claims 1-30 on file at the time of the FA (“claims on file”) would have been obvious and therefore non-compliant with section 28.3 of the *Patent Act*.
- [6] In a September 11, 2015 response to the FA (“R-FA”), the Applicant proposed grammatical amendments to the claims on file and submitted arguments in favor of the non-obviousness of the claims.
- [7] As the Examiner considered the application not to comply with the *Patent Act* and *Patent Rules*, pursuant to paragraph 30(6)(c) of the *Patent Rules*, the application was forwarded to the Board for review on January 22, 2016 along with an explanation outlined in a Summary of Reasons (“SOR”). The SOR set out the position that the claims on file were still considered to be defective due to obviousness and that the amendments proposed in the R-FA did not overcome this defect.
- [8] In a letter dated February 2, 2016, the Board forwarded to the Applicant a copy of the SOR and offered the Applicant the opportunity to make further submissions and/or attend an oral hearing.
- [9] In a written communication dated April 27, 2016, the Applicant requested that an oral hearing be scheduled and indicated that written submissions would be provided. The Applicant also indicated that it would be expedient to hold the hearing for the instant application and the divisional application no. 2,819,055 at the same time.
- [10] The present panel (“the Panel”) was formed to review the instant application as well as the related divisional application no. 2,819,055 under paragraph 30(6)(c) of the *Patent Rules*.

[11] In a preliminary review letter (“PR letter”) dated October 19, 2017, the Panel set out its preliminary analysis of the obviousness issue with respect to the claims on file as well as the proposed claims submitted with the R-FA. In light of the Applicant’s suggestion of one hearing to address both the instant application and the divisional application no. 2,819,055, the Panel also proposed a single oral hearing date that would address both reviews.

[12] Written submissions in response to the PR letter (“R-PR”) were provided on November 15, 2017 by the Applicant in advance of the oral hearing. The submissions included proposed claims 1-29 (“proposed claims”) as well as arguments in favor of the non-obviousness of the claims on file as well as the proposed claims.

[13] An oral hearing was held via teleconference on November 29, 2017.

ISSUES

[14] The issue to be addressed by the present review is whether:

- claims 1-30 on file would have been obvious.

[15] If the claims on file are considered defective, we may turn to the proposed claims 1-29 and consider whether they constitute amendments necessary for compliance with the Act and Rules.

LEGAL PRINCIPLES AND OFFICE PRACTICE

Claim Construction

[16] In accordance with *Free World Trust v Électro Santé Inc.*, 2000 SCC 66, essential elements are identified through a purposive construction of the claims done by considering the whole of the disclosure, including the specification and drawings (see also *Whirlpool Corp v Camco Inc.*, 2000 SCC 67 at paragraphs 49(f) and (g) and 52). In accordance with the

Manual of Patent Office Practice, §13.05 (revised June 2015), the first step of purposive claim construction is to identify the person skilled in the art and their relevant common general knowledge (“CGK”). The next step is to identify the problem addressed by the inventors and the solution put forth in the application. Essential elements can then be identified as those required to achieve the disclosed solution as claimed.

Obviousness

[17] The *Patent Act* requires that the subject matter of a claim not be obvious to a person skilled in the art. Section 28.3 of the *Patent Act* provides:

28.3 The subject matter defined by a claim in an application for a patent in Canada must be subject matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to

- (a) information disclosed more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant in such a manner that the information became available to the public in Canada or elsewhere; and
- (b) information disclosed before the claim date by a person not mentioned in paragraph (a) in such a manner that the information became available to the public in Canada or elsewhere.

[18] In *Apotex Inc v Sanofi-Synthelabo Canada Inc*, 2008 SCC 61 at paragraph 67 [*Sanofi*], the Supreme Court of Canada stated that it is useful in an obviousness inquiry to use the following four-step approach:

- (1) (a) Identify the notional “person skilled in the art”;
- (b) Identify the relevant common general knowledge of that person;
- (2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;

- (3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;
- (4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

ANALYSIS

Claim Construction

The person skilled in the art

[19] In the PR letter, the person skilled in the art was characterized as being:

a team collectively skilled in the art of electronic bill presentment and payment (“EBPP”) and familiar with generally related financial transactions and IT system infrastructure.

The relevant common general knowledge

[20] In the PR letter, the relevant CGK was set out as including:

- Knowledge of traditional bill payment process and systems that include:
 - The provision of a summary bill often printed on a detachable remittance stub that is intended to be returned with a cheque, with the bill containing summary information comprising:
 - The amount due
 - The due date for payment
 - A customer account number
 - A statement issuer (e.g., biller) name and address
 - The provision of a pre-addressed return envelope
 - A detailed invoice of charges
 - Marketing materials
 - Payments typically made by writing a cheque, placing the cheque and the remittance stub in the pre-addressed envelope, sealing the envelope, applying a postage stamp and sending the payment to the biller

- Knowledge of EBPP systems that allow a biller to present a customer with an electronic version of a bill, whether it is a scan of a paper version or a specifically formatted electronic version
- Knowledge of the provision of bills in electronic form to a computer or other display device via email or via access to a website requiring customer authentication, which authentication may be in the form of a user id and password
- Knowledge of the reception and processing of bill payments whether in traditional paper or electronic form and the associated infrastructure
- Knowledge of the use of electronic bill payment service bureaus that allow customers to pay bills via a home computer or telephone. Such bureaus receive payment from customers and forward these payments to a biller either individually or collectively
- Knowledge of the use of Automated Clearing Houses (“ACHs”) that are authorized by customers to deduct amounts from a customer’s bank account that are due to a biller
- Knowledge of the use of a centralized payment network where participating customers can pay bills to participating billers by transmitting a pay order to their bank. The bank then submits a pay message to a payment network and the customer’s account is debited while the biller’s bank account is credited
- Knowledge of the use of public and secret key encryption in electronic transactions over networks
- Knowledge of the use of centralized EBPP systems that act as intermediaries between billers and customers. The systems can collect bills on behalf of a customer and communicate them to the customer for payment
- Knowledge of the scepticism of some customers with the use of EBPP systems due to a perceived lack of control over payment processes
- Knowledge of the diversity of customer IT systems, which can create issues for both billers and customers in payment presentation and payment
- Knowledge of the lack of flexibility to make a payment in the traditional paper-based manner when billing is provided by EBPP systems.

Clarification

[21] In the R-PR, the Applicant appeared to disagree with the level of CGK attributed to the skilled person by the Panel, but did not provide any details as to the points that were in dispute. At the hearing, it was clarified by the Applicant that the dispute was not with the content of the CGK set out by the Panel, but instead with how this CGK was combined with the prior art to arrive at the conclusion that the claims on file would have been obvious. That issue will be dealt with later in this recommendation as part of step 4 of the *Sanofi* four-step approach. In light of this clarification, the person skilled in the art and the relevant CGK as set out above are adopted.

Essential Elements

[22] With respect to the determination of essential/non-essential elements and the meaning of terms in the claims, as we stated in the PR letter:

In the present case, there are no issues on the record of any debate as to the meaning of any terms in the claims, nor does the Panel see any issues in that regard. The Panel has not undertaken a detailed construction of the individual claims since as shown below under obviousness, even considering all the features of the claims on file, the Panel's preliminary view is that all of claims 1-30 on file would have been obvious. The outcome in this case would therefore not be affected by the omission of any non-essential elements.

Obviousness

(1)(a) Identify the notional "person skilled in the art"

[23] The person skilled in the art has been set out above under Claim Construction at paragraph [19].

(1)(b) Identify the relevant common general knowledge of that person

[24] The relevant CGK has also been identified above under Claim Construction at paragraph [20].

(2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it

[25] In the PR letter, the Panel stated with respect to the inventive concepts of the claims on file that in the present case we have taken into account all the features of the claims in the assessment of obviousness:

For the purpose of the assessment under obviousness in the present case we have taken into account all the features of the claims on file. As noted above in relation to Claim Construction, even starting from this point, our preliminary view is that the claims on file would have been obvious. Therefore, the result of the assessment would not be affected by the

identification of an inventive concept that may be something less than all the claimed features. We note that at step 3 of the *Sanofi* assessment in the FA of the instant application as well as that of the divisional, all features of the claims were considered in assessing the differences between them and the state of the art.

[26] This view was not disputed by the Applicant and we therefore apply it in our analysis.

[27] Claim 1 on file was taken by the Panel to be representative of the claims on file and is reproduced below for ease of reference:

1. An electronic bill presentment and payment system providing a billing service to payers having user devices for paying at least one biller, the system comprising:
 - at least one computer memory storing instructions and data; and
 - at least one computer processor accessing the memory and executing the instructions to perform steps including:
 - hosting a website for establishment and administration of user billing information;
 - sending data to the user devices including mobile devices accessing an internet web browser, the data including an email with an embedded URL for the hosted website, the email notifying the user device of an option for the payers to register for the billing service and become registered users;
 - formatting at least one portion of a billing summary in the form of a remittance slip, wherein the step of formatting further makes the remittance slip printable for use in a traditional paper-based payment method;
 - sending billing notifications to registered users, the billing notifications including an email having (a) the billing summary enabling the registered a user to pay the bill either electronically or with the remittance slip and (b) an embedded URL enabling the registered user to access to full billing information;
 - when the registered user selects the URL, authenticating the user and presenting a full billing statement for electronic payment; and
 - processing the payment as requested by the registered user.

(3) Identify what if any differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed

[28] In the PR letter, with respect to the state of the art, we stated that:

[i]n the FA two pieces of prior art were applied, of which only the following document is applied in our obviousness analysis:

D1: CA 2,275,211 Power June 18, 1998

In the FA, the differences between the state of the art and the claims were assessed in view of prior art document D1. We agree that D1 best represents the state of the art and use it in our assessment below.

D1 discloses an EBPP system, in particular a secure interactive electronic statement delivery system suitable for use on open networks such as the internet. Although D1 is primarily focussed on the security of communications in relation to bill presentment and payment, D1 also discloses an overall bill presentment and payment process and system.

D1 discloses a process by which a customer may register with a biller to receive electronic bills (figure 7A and page 14, line 28 to page 16, line 25 of D1). Figure 8 of D1 illustrates a process by which a biller may send a bill or other account statement to a customer. When a billing date occurs, summary and detailed billing data are generated and sent to customers by email (page 16, line 26 to page 17, line 6 of D1). The email includes summary bill data as well as optionally activated links for accessing detailed billing data, for accessing advertising materials and for initiating electronic payment of the bill (page 17, lines 7-9 of D1).

As disclosed at page 18, lines 11-13:

[i]f a customer does not activate any of the options, bill delivery is completed at block 808. The customer may print out the bill, or leave it stored on the computer. The customer may pay the bill by mail or by electronic means.

Like the summary bill data, the detailed bill data may contain links to advertising materials and/or to an electronic bill payment process or system (page 19, lines 10-11 of D1).

Activation of advertising links brings the customer to an advertiser’s webpage. Activation of electronic payment links initiates an electronic payment process that may or may not be provided by the customer’s certified bank.

Figure 10 of D1 illustrates an example of a summary bill that includes information such as biller name, customer account number, customer name and address, listing of charges, explanation of charges, return address for biller and customer service information. Customer service information includes the

biller's customer service telephone number, email address and a URL that can be used to contact the biller. As disclosed at page 23, lines 14-16 of D1:

[t]he summary information, contained in the summary bill information area 1010 corresponds generally to the information that would be [20] contained on the remittance stub of a mailed, paper bill.

A "Print" button is disclosed in Figure 10 as part of the summary bill, which when activated, causes a hard copy of the summary bill to be produced (page 23, lines 29-30 of D1).

[29] After considering the FA and the Applicant's submissions in the R-FA, we were of the preliminary view that the differences between independent claims 1 and 16 on file and the state of the art represented by D1 were:

1. The user devices include mobile devices accessing an internet browser;
2. The email notifies the user device of an option for the payers to register for the billing service and become registered users; and
3. The summary information produced by the EBPP system is specifically formatted in the form of a remittance slip.

[30] In the R-PR, although the submissions focused mainly on the proposed claims, the Applicant contended that prior art document D1 teaches away from any kind of traditional paper-based payment system in which a remittance slip is used, and instead focuses on a purely electronic EBPP system. At the hearing, the Applicant contended that D1 is strictly related to such an EBPP system. In particular, in the R-PR, the Applicant asserted that, with respect to the subject-matter of claims 1 and 16 on file (and the proposed claims, which are discussed later):

- D1 does not suggest use of a remittance slip because D1 is directed to an EBPP system;
- D1 does not show a summarized bill in the form of a remittance slip; and
- D1 does not teach or suggest sending billing notifications including a billing summary that provide the option of either electronic bill payment or paper-based bill payment.

- [31] While we agree that the focus of prior art document D1 is on providing an EBPP system, in our view, as set out in the PR letter and restated above, D1 does disclose the use of a summarized bill that is provided to a customer, a summarized bill that is generally in the form of a remittance slip used in a traditional paper-based payment method.
- [32] With respect to the first two bulleted points above, in the PR letter, we pointed to the relevant passages in D1 that characterize the information provided in the summarized bill as that which “corresponds generally to the information that would be 20 [*sic*] contained on the remittance stub of a mailed, paper bill” (page 23, lines 14-16 of D1). We acknowledged that, as shown by the differences between independent claims 1 and 16 on file and D1 as set out above from the PR letter, D1 does not explicitly disclose that the summarized bill is formatted as a traditional remittance slip.
- [33] Further, with respect to the last bulleted point, in the PR letter, we pointed to the passages in D1 that indicate that a customer is presented with a bill notification email providing links for accessing detailed billing data, for obtaining advertising materials and for initiating electronic payment of the bill (page 17, lines 7-9 of D1). An option of printing the summarized bill provided in the email and then forwarding payment in the traditional paper-based manner is particularly discussed at page 18, lines 11-13 of D1 where it is stated that:
- [i]f a customer does not activate any of the [electronic link] options, bill delivery is completed at block 808. The customer may print out the bill, or leave it stored on the computer. The customer may pay the bill by mail or by electronic means. (emphasis added)
- [34] In our view, the explicit disclosure of payment by mail indicates that the printed summarized bill is used to implement the traditional paper-based payment method, which is also discussed in the “Background Art” section of D1, taken to have been part of the CGK.
- [35] At the hearing, the Applicant’s attention was drawn to Figure 10 of D1 which, as set out in the PR letter, illustrates an example of the summarized bill provided by the system of D1.

The summarized bill includes a “PRINT” button to print the summary for paper-based payment. Also included is “Send Payment to:” information containing the mailing address to which payment may be sent, information which would not be necessary if the D1 system was strictly related to the provision of an EBPP system.

[36] In light of the above, it is our view that the differences between the subject-matter of independent claims 1 and 16 on file and that of the state of the art are the differences 1-3 set out above from the PR letter.

[37] With respect to the dependent claims, as noted in the PR letter, the Panel identified only two additional differences between them and the prior art, which was not disputed by the Applicant in the R-PR. We will consider them below at step 4.

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

[38] In the PR letter, we set out our preliminary view that claims 1 and 16 on file would have been obvious:

With respect to the first difference identified above, that of the user device used in the EBPP system including mobile devices, in our preliminary view, the use of mobile devices within an EBPP system as one example of an electronic device would have been an obvious variation to one of skill in the art. As shown by the CGK listed above, the skilled person was well aware that customer interaction with an EBPP system occurred by means of a home computer or other display device and that customers could effect payment by means of computers or telephones. With a mobile device simply being an example of a computer, the use of such devices would have been evident to the person skilled in the art.

In respect of the second difference, prior art document D1 discloses a system whereby customers may register with a biller to receive electronic bills (for example, figure 7A of D1). Implicit in such a process is that the customer became aware of such a possibility, whether through information distributed generally or targeted to a specific group. In our view, the person skilled in the art would have considered communicating such information by email obvious, email being one of several well-

known manners of providing such information to a potential user of an EBPP system.

With respect to the third difference, in our preliminary view, formatting the summary bill information as a remittance slip would also have been obvious to the person skilled in the art within the context of an EBPP system. Prior art document D1, which relates to an EBPP system, discloses in its discussion of the background art traditional paper-based bill payment methods where a detachable remittance stub containing summary information is attached to a bill for the purpose of remitting payment to a biller, the payment being traditional by cheque.

Further, as noted above in step 3 in discussing the EBPP system proposed, D1 discloses the presentation of summary bill information that “corresponds generally to the information that would be contained on the remittance stub of a mailed, paper bill” (page 23, lines 14-16 of D1) and that may be printed. D1 also discloses that in response to reception of the bill in electronic form, “[t]he customer may print out the bill, or leave it stored on the computer. The customer may pay the bill by mail or by electronic means” (page 18, lines 12-13 of D1). In our view, these passages clearly suggest to the skilled person that D1 contemplates the option of traditional paper-based payment of a bill and if this route is chosen, the summary information provided to the customer in electronic form, when printed, may act as a traditional paper-based remittance slip. We also note that the summary information provided by the system of D1 and illustrated by Figure 10 is consistent with the information provided by a traditional remittance slip as set out above as part of the relevant CGK.

In light of the above it is our preliminary view that independent claims 1 and 16 on file would have been obvious in view of prior art document D1 and the relevant CGK.

[39] The Applicant did not specifically respond to the reasons above in the R-PR or at the hearing, other than as part of the position that certain features of the claims were not disclosed by prior art document D1, which has already been dealt with under step 3.

[40] The Applicant did contend in the R-PR that the Panel did not properly apply the judicial test for obviousness, stating that in assessing obviousness, both the conception and implementation of an invention must be considered in accordance with the principles presented in *Diversified Products Corp v Tye-Sil Corp* (1991), 35 CPR (3d) 350 (FCA). However, the Applicant did not elaborate on exactly how the Panel’s assessment was inconsistent with these principles.

- [41] The Applicant clarified at the hearing that in its view, a central feature of the invention was in providing the option of paying by electronic means or by a traditional paper-based method in an EBPP system and that while they did not dispute the content of the CGK allocated to the person skilled in the art, they do dispute the combination of the CGK with prior art document D1 in order to arrive at a conclusion that such an invention would have been obvious.
- [42] With respect to the option of paying by electronic means or by the traditional paper-based method, as discussed at step 3, it is our view that this option was disclosed by D1, which is an EBPP system as well.
- [43] With respect to the Panel's combination of the CGK with D1 to arrive at the invention, the Applicant did not provide any specific reasons as to why the manner in which the Panel combined the relevant CGK with D1 was improper. Reference is made at page 4 of the R-PR to the Panel having "incorrectly extended the CGK to render claim 1 as obvious", but in our view this simply restates the Applicant's broad objection in different terms.
- [44] *Sanofi* at step 4 poses the question as to whether the differences identified at step 3 constitute steps that would have been obvious to the person skilled in the art, who possesses the relevant CGK. In our view, the slight differences between claims 1 and 16 on file and D1, discussed above, would have been self-evident to the person skilled in the art in light of the CGK. For example, the specific formatting of the summarized bill as a traditional remittance slip, while not explicitly set out in D1, nonetheless, in our view, would have been obvious, since even in a traditional paper-based system, the exact formatting would vary from biller to biller. Further, even in the instant application, the Applicant has not provided an example of what is considered a traditional remittance slip format that might be used to compare with the prior art.
- [45] In light of the above, we conclude that claims 1 and 16 on file would have been obvious and therefore non-compliant with section 28.3 of the *Patent Act*.

[46] With respect to the dependent claims, in the PR letter we set out our preliminary view that these claims would have been obvious as well, stating:

In respect of the dependent claims, the FA only identified two additional differences between them and the state of the art as represented by D1, as noted above. The FA considered such differences to have been obvious and there was no submission in the R-FA in response to that position.

In our preliminary view, such differences would have been obvious to the person skilled in the art in view of D1 and the relevant CGK. With respect to user authentication, D1 discloses an EBPP system that allows a customer to retrieve detailed billing information upon receiving summary bill information electronically. Detailed billing data may only be accessed after the customer's identification is authenticated, in the case of D1 by means of digital signatures and session keys (for example, page 18, line 24 to page 19, line 9 of D1). However, as noted above as part of the relevant CGK, the use of user ids and passwords was a well-known method of authenticating customers in such transactions. In our view, the person skilled in the art would have viewed the use of such a method as an obvious alternative.

Likewise, the use of ACHs that are authorized by customers to deduct amounts from a customer's bank account that are due to a biller was part of the relevant CGK. It would have been obvious to the person skilled in the art to use such a system in a case where a customer was not a customer of the bank operating the EBPP system, since otherwise there would be no reason for using such an intermediary for the payment transaction.

[47] While the Applicant did not directly respond to the Panel's views on the obviousness of the dependent claims on file, the Applicant did, as part of the proposed claims, incorporate the features of dependent claims 9 and 15 on file in proposed independent claims 1 and 16. We will therefore address the features of claims 9 and 15 on file.

[48] Claim 9 on file specifies that a third-party Billing Service Provider (BSP) provides the billing services for a biller, rather than the biller providing bills directly to a customer. In our view, the use of such services in combination with an EBPP system such as that of D1 would have been obvious since this option and its effects were well-known to the person skilled in the art as part of the CGK, set out above under Claim Construction.

[49] Claim 15 on file sets out minimum information that is to be included as part of the summary information provided with electronic bill notification. Such information has been identified as part of the relevant CGK of the skilled person for a traditional paper-based payment system. While the variation of setting out a “minimum amount due” was not listed in the PR letter as part of the CGK, as noted by the Panel at the hearing and acknowledged by the Applicant, the instant application at page 7, line 26 to page 8, line 2 describes the “traditional” information included on a remittance slip, which includes a minimum amount due.

[50] In light of the above, we conclude that the dependent claims on file would also have been obvious and therefore non-compliant with section 28.3 of the *Patent Act*.

Conclusions on Obviousness of Claims on File

[51] Having considered the record before us including the Applicant’s submissions in the R-PR and at the hearing, we conclude that claims 1-30 on file would have been obvious and therefore non-compliant with section 28.3 of the *Patent Act*.

Proposed Claims

[52] In the R-PR, the Applicant submitted proposed claims 1-29. As noted above, proposed independent claims 1 and 16 incorporated the features of claims 9 and 15 on file. We have discussed above why in our view these features individually would not render the claims non-obvious as they were well-known options in an EBPP system. We are also of the view that both in combination as part of proposed claims 1 and 16 would not render such claims non-obvious as they do not lead to any unexpected result.

[53] The Applicant also submitted a new proposed dependent claim 15 that focuses on the provision of the electronic summary bills by Billing Service Providers for each of a plurality of customer accounts from bulk billing data on a periodic basis. In our view, such features simply result from the necessity to provide separate periodic bills to customers

once it is known to provide such summary bills as part of a EBPP system, as is the case in prior art document D1.

[54] Other minor changes in the claim language were proposed as well that would not affect our conclusions.

[55] In light of the above, we conclude that proposed claims 1-29 do not overcome the obviousness defect and therefore the introduction of these claims does not constitute a specific amendment that is “necessary” pursuant to subsection 30(6.3) of the *Patent Rules*.

CONCLUSIONS

[56] We have determined that claims 1-30 on file would have been obvious and therefore non-compliant with section 28.3 of the *Patent Act*. We have further determined that proposed claims 1-29 do not overcome the obviousness defect and therefore the introduction of these claims does not constitute a specific amendment that is “necessary” pursuant to subsection 30(6.3) of the *Patent Rules*.

RECOMMENDATION OF THE BOARD

[57] In view of the above, the Panel recommends that the application be refused on the basis that the claims on file, namely claims 1-30, would have been obvious and therefore non-compliant with section 28.3 of the *Patent Act*.

[58] Further, proposed claims 1-29 do not overcome the obviousness defect and therefore the introduction of these claims does not constitute a specific amendment that is “necessary” pursuant to subsection 30(6.3) of the *Patent Rules*.

Stephen MacNeil
Member

Leigh Matheson
Member

Lewis Robart
Member

DECISION

[59] I concur with the conclusions and recommendation of the Patent Appeal Board that the application be refused on the ground that claims 1-30 on file would have been obvious and therefore non-compliant with section 28.3 of the *Patent Act*.

[60] Therefore, in accordance with section 40 of the *Patent Act*, I refuse to grant a patent on this application. Under section 41 of the *Patent Act*, the Applicant has six months within which to appeal my decision to the Federal Court of Canada.

Johanne Bélisle
Commissioner of Patents

Dated at Gatineau, Quebec,
this 10th day of May, 2018