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Datasheet for the decision
of 29 January 2010

Case Number: T 1402/06 - 3.5.05

Application Number: 00309874.6

Publication Number: 1102152

IPC: G06F 1/00

Language of the proceedings: EN

Title of invention:
Mechanism for dynamically constructing customized
implementations to enforce restrictions

Applicant:
SUN MICROSYSTEMS, INC.

Headword:
Constructing customized implementations/SUN MICROSYSTEMS

Relevant legal provisions:
EPC Art. 52(1)(2)(3), 111(1), 113(1)
RPBA Art. 11(3), 14(6), 15(3)

Relevant legal provisions (EPC 1973):
EPC Art. 56, 106, 107, 108
EPC R. 67

Keyword:
"Oral proceedings held in absence of appellant"
"Inventive step - main request and first auxiliary request (no)"
"Support by the description - second auxiliary request (no)"
"Remittal (no)"
"Deferral of substantive decision (no)"
"Reimbursement of appeal fee (no)"

Decisions cited:
J 0010/07, T 0204/93, G 03/08

Catchword:
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EPA Form 3030 06.03

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Case Number: T 1402/06 **-** 3.5.05

D E C I S I O N
of the Technical Board of Appeal 3.5.05
of 29 January 2010

Appellant: SUN MICROSYSTEMS, INC.
                                   4150 Network Circle
                                   Santa Clara, California 95054   (US)

Representative: Harris, Ian Richard
                                   D Young & Co LLP
                                   120 Holborn
                                   London EC1N 2DY   (GB)

Decision under appeal: **Decision of the Examining Division of the**
                               European Patent Office posted 19 April 2006
                               refusing European application No. 00309874.6
                               pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: D. H. Rees
Members: P. Corcoran
                   G. Weiss

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Summary of Facts and Submissions

I.   This is an appeal against the decision of the examining
        division to refuse the European patent application
        No. 00 309 874.6 published as No. 1 102 152. The
        decision was announced in oral proceedings held on
        16 March 2006 and written reasons were dispatched on
        19 April 2006.

II.   The decision under appeal was based on a set of claims
        1-65 filed with the letter dated 16 February 2006.

        Claim 1 of said set of claims read as follows:

            "A method of operating a framework (102) to
            provide cryptographic services to at least one
            computer program application (104), said method
            comprising:

                receiving (202) a request from the computer
            program application for a customized
            implementation of a cryptographic service;

                determining (204) a set of zero or more
            restrictions to be imposed upon said customized
            implementation;

                dynamically constructing (206) said
            customized implementation, said customized
            implementation incorporating said restrictions,
            and comprising enforcement logic for enforcing
            said restrictions; and

> providing (208) said customized
> implementation to the computer program
> application, whereby said computer program
> application can thereafter directly invoke said
> customized implementation to perform said
> cryptographic service."

The examining division found that claim 1 did not fulfil the inventive step requirements of Article 56 EPC 1973.

In the reasons for the decision, the examining division essentially argued to the effect that no technical subject-matter beyond the provision of cryptographic services was identifiable in the claim 1 and that the provision of cryptographic services was well known from the prior art. The remaining features of the claim were considered to relate to subject-matter excluded from patentability under Article 52(2) and (3) EPC and could not contribute to inventive step.

In an *obiter dictum* to the decision the following was stated: *"Even if the way the method is implemented in software would be considered as a technical feature and therefore used for the assessment of inventive step it is noted that any implementation using a programming language like Java, which defines objects and supports run-time creation of objects through so-called "constructors", would fall within the terms of the claim. Those features following directly from the choice to implement the task in an object oriented programming language would then still not render claim 1 inventive."*

III.   Notice of appeal was filed with a letter dated 19 June
        2006 which was received at the EPO by telefax on the
        same date. A statement setting out the grounds of
        appeal was filed with a letter dated 17 August 2006
        which was received at the EPO by telefax on the same
        date. Both the notice of appeal and the statement of
        grounds contained precautionary requests for oral
        proceedings. The appeal fee was paid on 19 June 2006.

IV.   In the statement setting out the grounds the appellant
        argued that the claimed invention was clearly
        distinguished from the subject-matter of D1
        (EP 0 828 208) a document which had been cited in the
        first official communication dated 7 June 2004 in
        support of a novelty objection which was not
        subsequently pursued by the examining division (cf.
        statement of grounds: items 4. - 6.).

        The appellant further disputed the inventive step
        objection which formed the basis of the impugned
        decision (cf. statement of grounds: item 8.). The
        appellant alleged that the discussion of inventive step
        during oral proceedings had been very confused,
        essentially due to the examining division attempting to
        discuss the matter without reference to any prior art
        documents whereas the representative tried to anchor
        the discussion to the document D1 (cf. statement of
        grounds: items 7.6 and 13.12).

        The appellant additionally requested reimbursement of
        the appeal fee under Rule 67 EPC 1973 alleging that
        various actions of the examining division constituted
        substantial procedural violations, in particular:

(i) The refusal to even consider or discuss, without a bona fide reason, the established case law (*viz.* decision T 0204/84) cited by the representative which was of direct relevance to the primary ground of rejection of the decision (cf. statement of grounds: item 11.).

(ii) Basing the summons to oral proceedings exclusively on a new ground of rejection that should have been previously raised in a communication in accordance with Rule 51(3) and Article 96(2) EPC 1973 (cf. statement of grounds: item 13.1-13.10).

(iii) Raising in oral proceedings a completely new ground of rejection (obviousness) which had not been mentioned in either the first communication or the summons (cf. statement of grounds: item 13.11-13.13).

V. In a communication accompanying a summons to oral proceedings to be held on 29 January 2010 the board gave its preliminary opinion that none of the applicant's requests were allowable.

The communication made reference to the following additional prior art documents introduced by the board of its own motion pursuant to Article 114(1) EPC 1973:

D5: M. E. Fayad et al., "Building Application Frameworks", Chapter 2, pp.29-54, Wiley Computer Publishing, September 1999, ISBN 0-471-24875-4;

D6: J. Knudsen, "Java Cryptography", Chapters 3 and 7, Appendix C, Appendix E (in part), pp.28-37,

120-162, 263-267, 279-281, 308-309, O'Reilly &
Associates, Inc., May 1998, ISBN 1-56592-402-9;

D7:   S. Oaks, "Java Security", Chapter 5, pp.90-123,
O'Reilly & Associates, Inc., May 1998, ISBN 1-
56592-403-7.

With respect to the appellant's main request, the board
noted that it had reservations concerning compliance
with the requirements of Article 84 EPC 1973. The board
also considered the issue of exclusion from
patentability under the terms of Articles 52(2) and (3)
EPC to be of potential relevance with respect to the
subject-matter of the independent claims.

The board was further of the preliminary opinion that
even if the appellant were to succeed in establishing
that the exclusion from patentability was not
applicable, an objection due to a lack of inventive
step would still apply. For the purpose of assessing
inventive step, the board was of the opinion that it
would be appropriate to take as the closest prior art
the Java Cryptography Extension to the Java Platform
acknowledged in [0003] of the published application. In
this regard reference was made to D6, a textbook
extract relating to version 1.2 of the Java
Cryptography Extension.

With respect to the appellant's request for a
reimbursement of the appeal fee, the board noted that
it was not inclined to follow the appellant's
submissions to the effect that the proceedings before
the department of first instance had involved one or
more substantial procedural violations. Moreover, it
was noted that an essential precondition for the

reimbursement of the appeal fee would be that the appeal be deemed allowable. Therefore, further consideration would be given to the request for the reimbursement of the appeal fee only in the case that the board found the appeal to be allowable.

VI.   With a letter of reply dated 29 December 2009 and received at the EPO by telefax on the same date, the appellant filed new requests as detailed in item VII. below and also filed an amended version of page 5 of the description. In a further submission dated 27 January 2010 and received at the EPO by telefax on the same date, the appellant's representative informed the board that he would not be attending the oral proceedings.

VII.   The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of a main request comprising claims 1 to 64 as filed with the letter dated 29 December 2009 or, alternatively, on the basis of a first auxiliary request comprising claims 1 to 42 likewise filed with the letter dated 29 December 2009 or on the basis of a second auxiliary request comprising claims 1 to 65 as filed with the letter dated 16 February 2006 with claim 1 thereof being amended in accordance with the first auxiliary request set forth in the statement of grounds dated 17 August 2006 (cf. letter of 29 December 2009: item 1 c), p.1; statement of grounds: item 14., p.10).

The qualifying provision relating to the amendment of claim 1 (*viz.* "with claim 1 thereof being amended in accordance with the first auxiliary request set forth

in the statement of grounds dated 17 August 2006") was
inadvertently omitted from the specification of the
second auxiliary request in the minutes of the oral
proceedings which should be corrected by including the
aforementioned provision.

As a third auxiliary request, the appellant requested
that the case be remitted to the department of first
instance for further prosecution on the basis of claims
1 to 64 of the main request.

A further conditional request was made to defer making
a substantive decision in the present case until the
outcome of G 03/08 be known.

Finally, the reimbursement of the appeal fee was also
requested due to alleged procedural violations on the
part of the department of first instance.

VIII. The further documents on which the appeal is based, i.e.
the text of the description and the drawings, are as
follows:

Description, pages:
1, 3, 4, 6-41 as originally filed;
2 as filed with the letter of 29 September 2004;
2a as filed with the letter of 16 February 2006;
5 as filed with the letter of 29 December 2009.

Drawings, sheets:
1/14-14/14 as originally filed.

IX. Claim 1 of the main request reads as follows:

"A computer-implemented method of operating a framework (102) to provide cryptographic services to at least one computer program application (104), said method comprising:

receiving (202) a request from the application for an implementation of a cryptographic service;

determining (204) a set of zero or more restrictions to be imposed upon a customized implementation to be provided to the computer program application in response to said request;

dynamically constructing (206) said customized implementation, said customized implementation incorporating said restrictions, and comprising enforcement logic for enforcing said restrictions; and

providing (208) said customized implementation to the application, whereby said computer program application can thereafter directly invoke said customized implementation to perform said cryptographic service."

Claim 22 of the request reads as follows:

"A computer system including a framework (102) for providing a cryptographic service to at least one computer program application (104), the framework comprising:

a mechanism for receiving a request from the
computer program application for an implementation of
a service;

a mechanism for determining a set of zero or more
restrictions to be imposed upon a customized
implementation to be provided to the computer program
application in response to said request;

a mechanism for dynamically constructing said
customized implementation, said customized
implementation incorporating said restrictions, and
comprising enforcement logic for enforcing said
restrictions; and

a mechanism for providing said customized
implementation to the computer program application,
whereby said computer program application can
thereafter directly invoke said customized
implementation to perform said cryptographic
service."

Claim 43 of the request is directed towards "a computer
program for a system comprising at least one
application (104), the computer program being operable,
when executed by one or more processors, to cause the
one or more processors to implement a framework (102)
which dynamically constructs a customized
implementation of a cryptographic service for said at
least one application program". The claim further
specifies that the computer program comprises
instructions for causing one or more processors to
perform a series of actions which essentially

correspond to the steps of the method defined in
claim 1.

X.   Oral proceedings were held as scheduled on 29 January
        2010. The appellant was not represented. After
        deliberation by the board, the chairman announced the
        decision.

Reasons for the Decision

1.   *Admissibility*

1.1   The appeal complies with the provisions of Articles 106
        to 108 EPC 1973 which are applicable according to
        J 0010/07, point 1 (cf. Facts and Submissions, item III.
        above). Therefore it is admissible.

2.   *Non-attendance at oral proceedings*

2.1   According to Article 116(1) EPC 1973, oral proceedings
        shall take place either at the instance of the European
        Patent Office if it considers this to be expedient or
        at the request of any party to the proceedings. Oral
        proceedings provide an appellant with the opportunity
        to present its concluding comments on the outstanding
        issues (Article 113(1) EPC 1973) with the aim of
        ensuring that the case is ready for a decision at the
        end of the oral proceedings (Rule 111(1) EPC; see also
        Article 14(6) RPBA).

2.2   The need for procedural economy requires the board to
        reach its decision as quickly as possible while giving
        the appellant a fair chance to argue its case. In the

present case the holding of oral proceedings was
considered by the board to meet both these requirements.
The appellant had also made a conditional request for
oral proceedings. A summons was therefore issued.

2.3   In accordance with Article 15(3) RPBA the board shall
        not be obliged to delay any step in the proceedings,
        including its decision, by reason only of the absence
        at the oral proceedings of any party duly summoned who
        may then be treated as relying on its written case. The
        board considered that, despite the notification from
        the appellant's representative announcing his intention
        not to attend, the twin requirements of fairness and
        procedural economy were still best served by holding
        the oral proceedings as scheduled.

2.4   The appellant could reasonably have expected that
        during the oral proceedings the board would consider
        the objections and issues raised in the communication
        annexed to the summons to oral proceedings (cf. point V.
        above). In deciding not to attend the oral proceedings,
        the appellant chose not to avail itself of the
        opportunity to present its observations and counter-
        arguments orally but instead to rely on its written
        case.

2.5   The board considers that the reasons on which its
        decision are based do not constitute a departure from
        grounds or evidence previously put forward which would
        require that the appellant be given a further
        opportunity to comment.

2.6   In view of the foregoing, the board concludes that the
        appellant had an opportunity to present comments on the

grounds and evidence on which the board's decision,
arrived at during oral proceedings, is based. The right
to be heard under Article 113(1) EPC 1973 has thus been
satisfied despite the appellant's non-attendance at the
oral proceedings.

Main Request

3.   *Claim 22*

3.1   Claim 22 of the main request is directed towards a
        computer system including a framework for providing a
        cryptographic service to at least one computer program
        application. According to the disclosure, the Java
        Cryptography Extension to the Java Platform is an
        example of such a framework for providing a
        cryptographic service to at least one computer program
        application (cf. [0003]). In the board's judgement,
        said Java Cryptography Extension represents the closest
        prior art to the subject-matter of claim 22. In view of
        the fact that the application does not cite any
        documents relating to this prior art, the board
        considered it appropriate to make reference to a
        textbook extract, i.e. D6, in order to clarify what was
        generally known to the skilled person in this respect
        at the priority date of the application. D6 is a
        textbook extract relating to version 1.2 of the Java
        Cryptography Extension, hereinafter referred to as the
        JCE 1.2.

3.2   The "Cipher object class" referred to in [0016] of the
        present application is a known programming construct of
        the JCE 1.2 where it is used in a manner substantially
        identical to that disclosed in the present application

to dynamically construct implementations (i.e.
"instances") of requested cryptographic services via
the associated GetInstance() method (see, for example,
D6: sections entitled "Factory Methods" and "The
Provider Architecture", p.31-37; section entitled
"Getting a Cipher", p.129-130; section entitled "Class
javax.crypto.Cipher", p.308-309).

The requesting application then proceeds to interact
directly with the obtained Cipher instance which it
initialises by invoking its Init() method (see, for
example, D6: the section entitled "Initializing a
Cipher", p.131-132).

The JCE 1.2 also supports the passing of initialisation
parameters via the Init() method as referred to in
[0028] of the application (see, for example, D6: the
section entitled "Initializing a Cipher", p.131-132;
the section entitled "Class javax.crypto.Cipher",
p.308-309).

3.3   Computer systems including the JCE 1.2 were clearly
        known at the priority date of the present application
        as evidenced by D6. In the wording of claim 22, such a
        computer system is a computer system including a
        framework for providing cryptographic services to at
        least one computer program application wherein the
        framework comprises:
           a mechanism for receiving a request from the computer
          program application for an implementation of a
          cryptographic service;
           a mechanism for dynamically constructing said
          implementation; and

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a mechanism for providing said implementation to the
computer program application whereby said computer
program application can thereafter directly invoke said
implementation to perform said cryptographic service.

3.4   The "framework" of claim 22 differs from the JCE 1.2 in
        that it additionally determines a set of restrictions
        to be imposed upon the implementation and provides a
        "customized implementation" which incorporates these
        restrictions along with enforcement logic for their
        enforcement as recited in claim 22.

        In the JCE 1.2, the cryptographic service
        implementation returned to the requesting application
        executes without any inherent restriction. For this
        reason, legal restrictions were imposed on the
        distribution of the JCE 1.2 (cf. D6: p.29, item "JCE").

3.5   The effect of the differences noted in 3.4 above is to
        provide the requesting applications with customised
        cryptographic service implementations that are
        compliant with the prescribed legal regulations
        governing the use of cryptography.

3.6   The objective technical problem may thus be formulated
        as how to modify the JCE 1.2 to ensure that it provides
        the requesting application with cryptographic service
        implementations which are compliant with the prescribed
        legal regulations governing the use of cryptography.

3.7   In the board's judgement, the specification of
        regulations governing the use of cryptography is an
        inherently non-technical activity. Once such
        regulations have been specified, the technical task

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facing the skilled person in the present case reduces
to modifying the framework so that the supplied
implementations only provide the requested
cryptographic services in accordance with the
applicable regulations.

3.8   Given that, in principle, cryptographic services can be
        classified into two basic categories, i.e. restricted
        and non-restricted services, the solution of providing
        a basic set of non-restricted services as a built-in
        module and an additional set of restricted services as
        an extension module (or "framework") is reasonable and
        such an approach is used in the case of the Java
        Cryptography Extension referred to in [0003] of the
        application (cf. D6: p.29, item "JCE").

        The present application is, however, concerned with a
        more complex legal situation, where the regulations
        governing the use of cryptographic services may vary
        from country to country and from one type of
        application to another. To supply a different extension
        for each country would clearly be very inconvenient and,
        moreover, would not solve the problem of different
        categories of application being subject to different
        legal restrictions. In the light of these
        considerations, the board judges that it would be
        obvious to the skilled person to supply a single
        extension which could respond to the varying
        circumstances.

3.9   The disclosed solution is based on modifying the
        functionality of existing JCE 1.2 programming
        constructs using conventional object-oriented
        programming techniques which, in the board's judgement,

lie within the routine competence of the skilled person. In this regard, it is further noted that the description states in respect of the "limitations" associated with the cryptographic service implementations that "any desired form may be used" (cf. col.11 l.38-44). This is understood as an indication that the implementational details of the "limitations" in technical terms, as distinct from the cognitive information content thereof, are not of any particular significance for the purposes of putting the claimed invention into practice.

3.10   In the communication accompanying the summons to oral proceedings the board gave its preliminary opinion that the prior art referred to in 3.1 above, *viz.* the Java Cryptography Extension to the Java Platform acknowledged in [0003] of the application and as reflected by the textbook extract D6, was prejudicial to the inventive step of the claimed invention for reasons substantially the same as those set forth above (cf. communication: item 6.). The appellant did not submit any rebuttal in response to the board's preliminary opinion in this regard but merely requested remittal of the case to the department of the first instance for further consideration.

3.11   In view of the foregoing, the board sees no reason to deviate from the aforementioned preliminary opinion and concludes that a computer system including a framework as defined in claim 22 does not involve an inventive step over the prior art referred to in 3.1 above. Observations relating to the applicant's request for a remittal are given under 15. below.

4.   *Claims 1 and 43*

4.1   The above finding in respect of claim 22 of the main
         request applies, *mutatis mutandis*, to claim 1 of the
         request. It also applies, in principle, to claim 43 of
         the request which is directed towards "a computer
         program for a system comprising at least one
         application".

4.2   Under the given circumstances, the board judges that
         with respect to claim 43 it is not necessary to give
         further consideration to the issue of exclusion under
         the provisions of Article 52(2) and (3) EPC, i.e.
         whether or not claim 43 relates to a computer program
         as such.

5.   In view of the foregoing, the board concludes that the
         main request is not allowable.

First auxiliary request

6.   The first auxiliary request comprises a set of claims
         1-42 which are identical to claims 1-42 of the main
         request.

7.   The above finding in respect of claims 22 of the main
         request (cf. point 3.11 above) thus applies to claim 22
         of the first auxiliary request and likewise to claim 1
         thereof (cf. point 4.1 above).

8.   In view of the foregoing, the board concludes that the
         first auxiliary request is not allowable.

Second auxiliary request

9.   The claims of the second auxiliary request correspond
        to the claims of the first auxiliary request filed with
        the letter dated 17 August 2009, i.e. the statement of
        the grounds of appeal (cf. statement of grounds:
        item 14.).

10.   Claim 1 of the second auxiliary request differs from
        claim 1 of the main request in that it specifies
        receiving a request for a <u>customized</u> implementation of
        a cryptographic service whereas claim 1 of the main
        request specifies that the request is for an
        implementation of a cryptographic service.

11.   Claim 22 of the second auxiliary request differs from
        claim 22 of the main request in that it is directed
        towards a framework for providing a cryptographic
        service to at least one computer program application
        rather than towards a computer system including such a
        framework and in that it specifies receiving a request
        for a <u>customized</u> implementation of a cryptographic
        service as opposed to receiving a request for an
        implementation of a cryptographic service.

12.   *Article 84 EPC 1973*

12.1   Claims 1, 22 and 43 of the present request specify that
        the computer program application requests a "customized
        implementation" of a cryptographic service. However,
        according to the description, the computer program
        application merely requests <u>an</u> implementation of a
        particular cryptographic service. The framework
        responds to this request by supplying a <u>customized</u>

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implementation of the cryptographic service to the application (cf. application: [0010], [0016],[0020]).

12.2   It is noted in this regard that the aforementioned inconsistency between the claims and the description was brought to the appellant's attention in the communication accompanying the summons to oral proceedings and that the appellant amended the wording of claims 1, 22 and 43 of the main request in response thereto.

12.3   The board finds that the specification in claims 1, 22 and 43 to the effect that the computer program application requests a customized implementation of a cryptographic service is not supported by the description contrary to the requirements of Article 84 EPC. In view of this deficiency, the second auxiliary request is not allowable.

13.   The board further notes that even if the deficiency noted under 12.3 above were to be remedied by appropriate amendment to the wording of claims 1, 22 and 43 of the present request, said claims would still recite substantially the same subject-matter as the corresponding claims of the main request and, thus, the objections detailed under 3. and 4. above in respect of the main request would also apply *mutatis mutandis* in the case of the present request.

14.   Under the given circumstances, the board judges that it is not necessary to give further consideration to the issues raised in its communication relating to the question of exclusion under the provisions of Article 52(2) and (3) EPC, in particular in relation to

claim 22 directed towards a framework and claim 43 directed towards a computer program.

15.   *Request for remittal*

15.1   The appellant made an auxiliary request for the board to remit the application in the form of the main request to the department of the first instance for further consideration (cf. letter dated 29 December 2009: item 5.4). According to the appellant, the inventive step objection raised by the board was so significantly different from that given in the decision under appeal, that a remittal of the case was appropriate in order to safeguard the appellant's rights to have two levels of review.

15.2   More specifically, the appellant submitted that the decision under appeal argued that all the claim features (apart from cryptographic services *per se*) did not make a technical contribution and hence were to be disregarded for the purposes of considering inventive step whereas the objection raised by the board was based on a newly cited document, *viz.* D6, and suggested that all the claim features were known or obvious from the prior art.

15.3   The board does not concur with the appellant's submissions to the effect that the differences between the inventive step objection which the board has raised and that set forth in the decision under appeal are sufficiently significant to justify a remittal of the case to the department of first instance.

15.4   The objection raised by the examining division starts
        from the premise that cryptographic services are known
        per se. This effectively implies an underlying
        assumption that cryptographic services represent a
        technical aspect of the claimed invention but one which
        is a matter of general knowledge. It is implicit in the
        examining division's argumentation that this
        undocumented general knowledge constitutes the closest
        prior art to the subject-matter of claim 1. On this
        basis, the examining division proceeded to argue that
        none of the other claim features made a technical
        contribution to the claimed subject-matter and hence
        were to be disregarded for the purposes of considering
        inventive step.

        However, the board notes that in an *obiter dictum* to
        its decision the examining division further indicated
        that it was of the opinion that even if features which
        it had discounted as not making a technical
        contribution were to be considered as technical
        features this still would not lead it to acknowledge an
        inventive step in respect of the subject-matter of
        claim 1 (cf. item II of the Facts and Submissions of
        the present decision).

15.5   The inventive step objection raised by the board is
        based on the premise that the prior art referred to in
        3.1 above, *viz.* the Java Cryptography Extension to the
        Java Platform acknowledged in [0003] of the description
        and reflected in the disclosure of D6, represents the
        closest prior art to the subject-matter of the
        independent claims.

15.6   The prior art referred to in 3.1 above is not at
        variance with the undocumented prior art underlying the
        examining division's objection inasmuch as it relates
        to a framework for providing cryptographic services and
        thereby confirms the examining division's assertion
        that cryptographic services were generally known *per se*.

        In addition, as may be inferred from 3.3 above, the
        textbook extract D6 provides evidence that further
        features of the claimed invention were known from this
        prior art at the relevant priority date. These further
        features are features which the examining division had
        discounted as not making a technical contribution.
        However, irrespective of whether these further features
        are treated as making a technical contribution or not,
        they are clearly known from the prior art referred to
        in 3.1 above and this has not been disputed by the
        appellant.
        The issue which the examining division would have to
        decide upon in the case of a remittal effectively
        reduces to the question as to whether the
        distinguishing features of the claimed invention as
        identified in 3.4 above involve an inventive step.

15.7   The board notes that the appellant has not submitted
        any argumentation as to why the aforementioned
        distinguishing features should be considered to involve
        an inventive step. In the absence of any relevant
        submissions in this respect there are no identifiable
        grounds for supposing that the examining division would
        be inclined to deviate from its original finding of a
        lack of inventive step merely due to taking the
        aforementioned prior art as the starting point for its

assessment, in particular, when due account is taken of the *obiter dictum* referred to in 15.4 above.

15.8   In view of the foregoing, the board judges that the arguments advanced by the appellant in support of its request for remittal are not compelling and that, under the given circumstances, a remittal would not be justified. This request is therefore rejected.

16.   *Request to defer making a substantive decision*

16.1   The appellant also made a conditional request for the board to defer making a substantive decision until the outcome of the referral G 03/08 to the Enlarged Board of Appeal be known in the case that the board intended to place any reliance upon the decision T 0204/93 (cf. letter dated 29 December 2009: item 4.5).

16.2   The decision T 0204/93 was referred to in the board's communication in the context of observations relating to the question of exclusion under Article 52(2) and (3) EPC (cf. communication: item 5.4). The appellant submitted that G 03/08 placed the validity of this decision into doubt and could lead to it being overruled.

16.3   The board notes that in its communication it referred to decision T 0204/93 solely in the context of its observations relating to the question of exclusion under Article 52(2) and (3) EPC. Neither in said communication nor in the present decision has decision T 0204/93 been relied on or invoked in relation to the issue of inventive step. Thus the conditions under

which the board would be required to consider this
request do not apply.

17.   *Conclusion*

17.1   Referring in particular to points 5., 8. and 12.3 above,
       the board judges that in the absence of an allowable
       request, the appeal is to be dismissed.

18.   *Request for reimbursement of appeal fee*

18.1   An essential precondition for the reimbursement of the
       appeal fee under Rule 67 EPC 1973 is that the appeal be
       deemed allowable. Given that the board does not deem
       the present appeal to be allowable, the request for the
       reimbursement of the appeal fee cannot be granted.

18.2   In view of the foregoing, it is not necessary for the
       board to give further consideration to the allegations
       of substantial procedural violations raised by the
       appellant in relation to the proceedings before the
       department of first instance.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

K. Götz   D. H. Rees

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