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Datasheet for the decision of 20 December 2011

Case Number: T 0272/08 - 3.5.05

Application Number: 99966120.0

Publication Number: 1149335

IPC: G06F 3/14

Language of the proceedings: EN

Title of invention:
Authoring e-mail with modular components

Patentee:
Intellinet, Inc.

Headword:
Authoring e-mail with modular components/INTELLINET

Relevant legal provisions:
EPC Art. 52(1)
RPBA Art. 15(3)(6)

Relevant legal provisions (EPC 1973):
EPC Art. 54(1)(2)

Keyword:
"Non-attendance at oral proceedings"
"Novelty - no"

Decisions cited:
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Catchword:
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Case Number: T 0272/08 - 3.5.05

D E C I S I O N
of the Technical Board of Appeal 3.5.05
of 20 December 2011

Appellant: Intellinet, Inc.
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 18 October 2007 refusing European patent application No. 99966120.0 pursuant to Article 97(1) EPC 1973.**

Composition of the Board:

Chair: A. Ritzka
Members: P. Corcoran
F. Blumer

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division to refuse the European patent application no. 99 966 120.0, publication no. EP 1 149 335, originally published as international application no. WO 00/034852. The decision was dispatched on 18 October 2007.

II. The decision under appeal was based on a request comprising a set of claims 1 to 10 filed with the letter dated 26 January 2006. Claim 1 of said request reads as follows:

"An electronic mail client comprising a plurality of integrated authoring and reading components, a first of said plurality of authoring components for creating a representation of a document including an other-than-text portion and for creating said other-than-text portion of the document, encoding means for automatically encoding said representation into an internet-compatible email message, and decoding means for automatically decoding said representation encoded by said encoding means,
characterised in that said encoding means and said decoding means communicate bi-directionally with said authoring components."

III. The decision under appeal was issued following a consultation by telephone which took place between the examiner entrusted with the substantive examination of the case and the applicant's representative on 9 October 2007, in the course of which the representative announced that he would not attend the oral proceedings scheduled for 10 October 2007 and requested a decision according to the state of the file.

IV. The grounds for the decision read as follows:

"In the communication(s) dated 04.10.2007, 19.12.2006 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 09.10.2007

The application must therefore be refused."

V. The communication dated 19 December 2006 referred to in the decision under appeal was a communication annexed to a summons to oral proceedings before the examining division. In said communication, the examining division raised objections, *inter alia*, under Articles 84, 54 and 56 EPC 1973 and made reference, *inter alia*, to the following documents:

D2: Ming Ouhyoung, et al., "The MOS Multimedia E-Mail System", Proceedings of IEEE International Conference on Multimedia Computing and Systems, 15-19 May 1994, Boston, US, Los Alamitos, US, pp.315-324, IEEE Computer Society Press, ISBN: 0-8186-5530-5;

D4: EP 0 566 482 A.

The examining division expressed the opinion that the subject-matter of claim 1 of the request on file lacked novelty over D2, or at least an inventive step over a combination of D2 and D4.

VI. The communication dated 4 October 2007 referred to in the decision under appeal was a communication transmitted to the applicant by telefax in which the examining division stated *inter alia* that, in its opinion, all objections concerning Articles 84, 54 and 56 EPC 1973 which had been communicated with the summons to oral proceedings were still valid.

VII. Notice of appeal was received at the EPO on 18 December 2007 with the appropriate fee being paid on the same date. A written statement setting out the grounds of appeal was received at the EPO on 29 January 2008. With the written statement the appellant did not make any amendments to the claims on file but merely made submissions to the effect that the invention as defined by claim 1 was novel and involved an inventive step with respect to the prior art.

VIII. In particular, the appellant made submissions concerning alleged differences over the document D2 which may be summarised as follows:

(i) According to the appellant, the present invention eliminated the concept of attachments, the term "attachment" denoting a file attached to an email which required another program external to the e-mail client to view. In the case of the present invention, other-than-text content was incorporated into the body of the email message by the authoring component which communicated bi-directionally with the main email component comprising the encoding and decoding means. When the recipient received the message, the main e-

mail component communicated bi-directionally with the reading component to display the email message with the other-than-text content incorporated therein. On this basis, it was submitted that the claimed invention avoided attachments by avoiding the need for any other program to read or create documents containing portions other than text.

(ii) The appellant submitted that D2 was still bound to the concept of an attachment which might or might not be viewed by the recipient and referred to p.316 of said document, in particular the description of "Receiving site". In contrast, the claimed invention enabled the entire e-mail message to be automatically decoded and displayed without the recipient needing to find a program or execute a media player to view the entire message.

(iii) The appellant referred in particular to the discussion of the "decompose module" on p.320 of D2 and submitted that the media portions of email created by the compose module were not automatically decoded by the decompose module whereas the decoding means of the claimed invention automatically decoded what was encoded by the encoding means. On this basis it was argued that D2 allegedly addressed part of the problem with email attachments (difficulty finding the attached file and difficulty finding the program needed to read the attached file) but it still separated the attached files from the email message, and this taught the skilled person away from arriving at the claimed invention. The attachments of D2 were still attachments which had

to be viewed separately from the email message itself whereas in the case of the present invention it was submitted that "there are no attachments".

IX. In a communication accompanying a summons to oral proceedings to be held on 20 December 2011, the board gave its preliminary opinion that the appellant's request was not allowable.

X. The observations set forth in said communication which are of most immediate relevance for the present decision may be summarised as follows:

(i) Reservations were expressed concerning the clarity of certain wording used in claim 1 of the request.

In particular, the board was of the opinion that in the given context, the technical limitation implied by the terms "encoding" and "decoding" was unclear. Whereas the term "encoding" implied some kind of transformation of data from an initial non-encoded format to a second encoded format and the term "decoding" implied an inverse transformation, the precise nature of the transformation which the term was intended to cover in the given context was not evident.

The technical limitation implied by the wording used in the characterising part of claim 1 relating to bi-directional communication was likewise said to be unclear because the wording of the claim failed to specify particular details of the communication, i.e. the technical means

deployed to effect the communication were not specified and there was no specification of what was communicated between the communicating entities.

(ii) Notwithstanding its reservations concerning the clarity of the claim wording, the board was of the opinion that claim 1 could be interpreted as seeking protection for a program (i.e. "an electronic mail client") for authoring and transmitting multimedia electronic mail messages, i.e. electronic mail messages which include content other than unstructured text, and likewise for receiving and rendering such messages.

(iii) Based on the aforementioned interpretation of claim 1, the board was of the preliminary opinion that D2 was prejudicial to the novelty of said claim. In this regard it was noted that insofar as the term "automatically decoding" could be understood, D2 appeared to disclose the automatic decoding of received message content. The fact that certain embodiments of D2 envisaged user intervention to select particular elements of the content prior to their decoding did not, in the board's opinion, alter the fact that the decoding took place in a substantially automatic manner.

The board further noted that, in its opinion, the disclosure of D2 implied bi-directional communication substantially as specified in the characterising part of claim 1. The aforementioned bi-directional communication would appear to represent an inherent requirement of any software

system comprising a plurality of modules. If the modules of such a system were not configured to communicate bi-directionally then they would be incapable of exchanging the control signals and data needed to support their interoperability and the components of the system could not interact to enable the system as a whole to perform the tasks for which it was designed.

(iv) The board additionally made observations in response to the appellant's submissions, in particular those concerning the alleged differences over D2 (cf. item VIII. above), and indicated that it was not inclined to concur with the arguments advanced by the appellant in this regard.

(v) The board further noted that insofar as the aforementioned submissions of the appellant might be found to have merit, such differences as arguably existed over D2 did not appear to involve the exercise of inventive skill. Hence, even if the appellant were to succeed in establishing the novelty of the claimed invention over D2, a rejection of the request due to a lack of inventive step was to be expected.

XI. With a letter of reply dated 13 December 2011 from the appellant's representative, the board was notified that the representative had been instructed not to attend the scheduled oral proceedings. No substantive response was made to the objections raised in the board's communication. Neither were any amendments made to the appellant's request.

XII. The appellant has requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 10 as filed with the letter dated 26 January 2006 (cf. item II. above).

XIII. Oral proceedings were held on 20 December 2011. Nobody attended on behalf of the appellant. The board decided to hold the oral proceedings in the absence of the appellant. The chairperson summarised the relevant facts as appearing from the file. After the board had deliberated on the basis of the appellant's request and written submissions, the chairperson proceeded to announce the decision.

Reasons for the Decision

1. *Admissibility*

The appeal is admissible (cf. Facts and Submissions, item VII. above).

2. *Non-attendance at oral proceedings*

2.1 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.

2.2 In the present case the board decided that, despite the notification to the effect that the appellant's representative had been instructed not to attend, the

requirement of procedural economy was best served by holding the oral proceedings as scheduled.

2.3 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. Facts and Submissions, item X. above) which form the basis for the present decision.

2.4 In deciding not to attend the proceedings, the appellant effectively chose not to avail of the opportunity to present its observations and counter-arguments orally but instead to rely on its written case (cf. Article 15(3) RPBA). In view of the fact that no substantive response was submitted in reply to the board's communication, the appellant's written case corresponds to that presented in the written statement setting out the grounds of appeal.

2.5 The board was in a position to announce a decision at the conclusion of the oral proceedings as foreseen by Article 15(6) RPBA. The reasons on which this decision was 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.

3. *Interpretation of claim 1*

3.1 In the board's judgement, claim 1 is to be interpreted as seeking protection for a program (i.e. "an electronic mail client") for authoring and transmitting multimedia electronic mail messages, i.e. electronic mail messages

which include content other than unstructured text, and likewise for receiving and rendering such messages.

3.2 The claimed "electronic mail client" comprises a plurality of modules ("components") for generating different types of multimedia content ("authoring components") and for formatting the message for transmission ("encoding means"). It further comprises means for extracting the content of received messages ("decoding means") and rendering said content to the recipient.

3.3 In the absence of any more precise definition of what is intended by the characterising part of claim 1, the board judges that this claim feature is to be understood as merely denoting that the specified modules of the system communicate with each other in a conventional manner to exchange control signals and data as required such that the encoding means can encode data generated by the appropriate authoring components for transmission and that when the data thus encoded is received the decoding means at the receiving site can decode this data for presentation via the appropriate reading components.

The board notes in this regard that, in its judgement, the term "authoring components" as used in the characterising part of claim 1 is to be interpreted in the light of the description as being intended to denote "authoring/reading components" (cf. published application: p.4 l.1 - p.5 l.4).

4. *Observations re D2*

4.1 D2 which discloses a multimedia electronic mail system is found to represent the closest prior art to the claimed invention. The multimedia electronic mail system of D2 is provided with means for composing and sending multimedia electronic mail messages and with corresponding means for receiving and displaying such messages (cf. D2: 2. System Overview). In particular, the system of D2 permits the user to generate different types of multimedia content using a plurality of "authoring components" (or "media editor modules" in the terminology of D2, cf. D2: in particular 3.2 Document authoring and 4.2 Media editor modules).

On this basis, D2 is found to disclose "[a]n electronic mail client comprising a plurality of integrated authoring and reading components, a first of said plurality of authoring components for creating a representation of a document including an other-than-text portion and for creating said other-than-text portion of the document" as recited in claim 1.

4.2 The system of D2 further comprises means for formatting the message for transmission (cf. D2: 2. System Overview, in particular "Sending site"; 3.3 Format specification; 4.1 Compose/decompose module, in particular "Compose module") which are judged by the board to be substantially identical to "encoding means for automatically encoding said representation into an internet-compatible email message" as recited in claim 1.

4.3 The system of D2 likewise comprises means for retrieving incoming e-mails and decoding and displaying the content thereof (cf. D2: 2. System Overview, in particular "Receiving site"; 4.1 Compose/decompose module, in particular "Decompose module").

D2 discloses an embodiment which includes "decoding on demand" (cf. D2: 4.1 Compose/decompose module, in particular "Decompose module" on p.320). According to this embodiment, the decompose module first of all extracts all text and records all media data associated with the message and only decodes the media data when a user selects the medium he wants to access. The aim of this implementation is to avoid unnecessary decoding operations which are often time consuming especially in the case of high volume media such as video. Thus, according to this embodiment a user can survey the text of the message and selectively view individual media elements which he wishes to have rendered.

4.4 In the board's judgement, the aforementioned "decoding on demand" implies the automatic decoding of a received message. The message is subject to an initial decoding step in which text is extracted and all media data associated with the message are recorded. A further decoding step takes place in response to a user selection of a particular medium. In both steps the decoding is substantially "automatic" insofar the user is not required to directly manipulate the message content or elements thereof or to provide or locate a program for decoding the message content. Once the initial decoding step has been performed on the received message and the user is informed as to which message content elements are available, he or she merely has to select the content

elements whose decoding is desired and the further decoding operation then proceeds in an automatic manner.

On this basis, the board finds that the term "automatically decoding" as used in claim 1 does not exclude an arrangement such as the "decoding on demand" embodiment of D2 according to which the full decoding of particular message content elements is deferred until such time as the user indicates that the decoding should be performed.

4.5 In view of the foregoing, D2 is found to disclose "decoding means for automatically decoding said representation encoded by said encoding means" as recited in claim 1.

4.6 D2 discloses that a user uses a corresponding authoring component ("media editor") to prepare data which, when the preparation is finished is inserted into the document automatically (cf. D2: 3.2 Document authoring, in particular the first paragraph of the section). Likewise, D2 discloses the extraction of content from a received message using a decompose module and its subsequent rendering using an appropriate reading component or "player" (cf. D2: p.320, section entitled "Decompose module").

It is additionally noted in this regard that the disclosure relating to the compose/decompose module of D2 (cf. D2: p.319, Section 4.1) explicitly states that this module "controls the data flow pipeline from authoring document to internal representation, then to mailing message, and vice versa" (emphasis added). In the board's

judgement the use of the expression "vice versa" in the given context provides a clear and unambiguous indication to the effect that the communication which takes place between the system modules is bi-directional in nature.

4.7 In view of the foregoing, the board judges that it is implicit in the aforementioned disclosure of D2 that the encoding means and decoding means communicate in a bi-directional manner with "authoring components" [recte: "authoring/reading components", cf. item 3.3 above] substantially as recited in the characterising part of claim 1. Otherwise, it would not be possible to carry out the required data exchange between the respective modules of the system of D2 in order to perform the disclosed composition and decomposition operations on the multimedia e-mails.

5. *Observations re appellant's submissions*

5.1 Concerning the appellant's submission to the effect that the present invention eliminates the concept of attachments (cf. Facts and Submissions, item VIII(i) above), the board notes that the present application explicitly envisages the use of MIME format attachments (cf. published application: p.14 l.18-25) and further states in a number of passages that the main e-mail component of the invention performs saving, encoding and attaching without any of this being exposed to the user (cf. for example, published application: p.14, second paragraph ; p.15, second paragraph; p.16, penultimate paragraph; p.17, second paragraph; p.18, second paragraph).

In view of the foregoing, the board finds that the teaching of the application in this respect is not that "attachments" are eliminated but that the use of "attachments" is not exposed to the user of the system. In the board's judgement, a more accurate characterisation of the invention would be to say that it aims to eliminate the requirement for the user to understand the concept of attachments and how to manipulate them because there is no need for the user of to understand or to interact directly with attachments when composing or reading e-mail messages.

5.2 Concerning the appellant's submissions to the effect that D2 is still bound to the concept of an attachment and that, in contrast to the claimed invention, D2 does not enable the entire e-mail message to be automatically decoded and displayed without the recipient needing to find a program or execute a media player to view the entire message (cf. Facts and Submissions, item VIII(ii) and VIII(iii) above), the board notes that it does not concur with the appellant's submissions in this regard for the reasons which follow.

5.3 In the board's judgement, the passages of D2 referred to by the appellant in this regard (cf. D3: p.316, section entitled "Receiving site"; p.320, section entitled "Decompose module") provide a disclosure to the effect that multimedia mails are retrieved, decoded and displayed by the system at the receiving site and that decoding is preferably performed as "decoding on demand", in particular in cases where the decoding operation is time-consuming as in the case of video.

5.4 Concerning the question as to whether D2 discloses "automatically decoding" the content of a received message as recited in claim 1, the board first of all notes that, in the given context the precise scope of the generic term "decoding" as used in the claim is somewhat unclear and, in the given context, said term must be interpreted broadly.

Referring to the observations under 4.3 and 4.4 above, the board judges that merely because the disclosure of D2 pertaining to "decoding on demand" envisages user intervention to select elements of the content to be decoded this does not alter the fact that the decoding takes place in a substantially automatic manner without any apparent need for the user to find and execute an external program to view the received content.

6. *Novelty*

6.1 Referring to the preceding observations, in particular those under item 4. above, the board finds that D2 discloses at least implicitly all of the features of claim 1 and, hence, the subject-matter of said claim lacks novelty over the disclosure of said document.

6.2 Referring to the observations under item 5. above, it is noted that the appellant's written submissions did not convince the board that there was any effective difference in technical terms between the subject-matter of claim 1 and the disclosure of D2.

6.3 Having regard to the above finding, it is not necessary to give further consideration to the additional matters

raised by the board in its communication, in particular the question of inventive step (cf. Facts and Submissions, X(v) item above).

7. *Concluding remarks*

7.1 In view of the foregoing, the appellant's request is not allowable. In the absence of an allowable request the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chair:

K. Götz A. Ritzka