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**Datasheet for the decision
of 26 March 2010**

Case Number: T 1165/08 - 3.5.01

Application Number: 00975364.1

Publication Number: 1234252

IPC: G06F 17/30

Language of the proceedings: EN

Title of invention:

Search system having user-interface for searching online information

Applicant:

Cochran, Nancy P.

Opponent:

-

Headword:

Search system / COCHRAN

Relevant legal provisions:

EPC Art. 108
EPC R. 99(1)(a),(2), 101(1),(2)
RPBA Art. 12(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Admissibility of appeal - sufficient grounds (no)"

Decisions cited:

-

Catchword:

-



Case Number: T 1165/08 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 26 March 2010

Appellant: Cochran, Nancy P.
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Representative: P&TS
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 28 January 2008
refusing European patent application
No. 00975364.1 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: S. Wibergh
Members: R. R. K. Zimmermann
P. Schmitz

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division to refuse European patent application No. 00975364.1.
- II. The refusal, dated 28 January 2008, was on the file as it stood. It referred to the examining division's communication dated 9 January 2008, in which it had been concluded that claim 1 of all requests - main request and four auxiliary requests - did not involve an inventive step with respect to document D1 (US-A-5 768 581).
- III. Claim 1 of the main request before the examining division reads (cf the appellant's letter dated 12 December 2007):

"1. A method for searching an electronic information source using a display device and a pointing device displayed on the display device, the method comprising: displaying search category names on the display device; characterised in that enabling [*sic*] the user to display a list of search terms associated with a category name by passing the pointing device over any of the displayed category names; and enabling [*sic*] the user to select one of the displayed search terms by selecting the search terms with the pointing device in order to display the results of the search".

IV. The notice of appeal was filed on 19 March 2008. The fee for the appeal was paid on the same day. On 28 May 2008 a statement of grounds was filed. It read as follows:

Grounds for appeal

All arguments for the patentability have been given in the letters dated from October 12, 2006 and the letter dated from December, 12, 2007.

The examination division has never taken into account these arguments. Especially there has been never any rejection or argumentation against the claimed feature of

- enabling the user to display a list of search terms associated with a category name by passing the pointing device over any of the displayed category names; and*
- enabling the user to select one of the displayed search terms by selecting the search terms with the pointing device in order to display the results of the search[.]*

As this is the relevant question of the decision of the examination, the appellant requests from the board of appeal to check the arguments of the examination division expressed in the written decision in view of all arguments given in the written procedure (especially both letters dated from October 12, 2006 and December, 12, 2007). The main request and the auxiliary request are maintained.

The appellant is happy to answer any question and to give any additional argument, if required, once a written judgment of the board of appeal is available.

V. By letter dated 29 May 2008 the appellant requested oral proceedings as an auxiliary request.

VI. In a communication under Rule 100(2) EPC dated 15 July 2009 the Board expressed doubts as to the admissibility of the appeal. The appellant replied by letter dated 18 November 2009. On 16 December 2009 the Board invited the appellant to oral proceedings.

VII. By letter dated 16 March 2010 the appellant withdrew her request for oral proceedings and requested that a decision be issued directly. The Board then cancelled the oral proceedings.

Reasons for the Decision

1. *Admissibility of the appeal*

1.1 Article 108 EPC states that within four months of notification of the decision a statement setting out the grounds of appeal shall be filed. According to Rule 99(2) EPC this statement shall indicate the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based. Article 12(2) RPBA states that the grounds of appeal shall contain a party's complete case, set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, and specify expressly all the facts, arguments and evidence relied on. The Boards of Appeal have constantly ruled that in order for an appeal to be admissible the arguments in the statement setting out the grounds of appeal should enable a board to understand immediately why the decision is alleged to be incorrect and on what facts the appellant bases his

arguments, without first having to make investigations of its own. A statement of grounds of appeal which merely refers generally to previous submissions is normally not considered sufficient (cf "Case Law of the Boards of Appeal of the European Patent Office", 5th edition, 2006, VII.D.7.5.1 and 7.5.4).

1.2 The appellant submits that the examination division had "never taken into account" the appellant's arguments and that there had never been "any rejection or argumentation against" two explicitly cited features in claim 1. However, this submission is not at all substantiated. The examining division did in fact examine the two features in question in the communication dated 9 January 2008 to which the decision under appeal refers. It is stated in this communication (see the paragraph bridging p. 1 and 2) that the first half of the first feature and the entire second feature are disclosed in expressly indicated passages of D1. The second half of the first feature is discussed on p. 2 to 6 of the communication. The arguments put forward in the appellant's submissions dated 12 October 2006 and 12 December 2007 are repeatedly referred to. Only after having performed this thorough analysis does the examining division conclude that the invention does not involve an inventive step.

1.3 For the statement setting out the grounds of appeal to have been sufficiently reasoned it would have been necessary for the appellant to explain why the detailed reasons given by the examining division were found unconvincing. Since this has not been done the Board is not in a position to understand why the appellant

challenges the decision under appeal. As explained above, the purpose of a statement setting out the grounds of appeal is exactly to avoid this kind of situation. The object of appeal proceedings is not a re-examination of the application where the Board itself would have to find relevant facts and arguments, but an examination whether or not the decision under appeal was correct based on the facts and arguments presented by the appellant.

- 1.4 It follows that the statement setting out the grounds of appeal does not contain the reasons for setting aside the decision under appeal, as required by Rule 99(2) EPC. Thus, the appeal must be rejected as inadmissible under Rule 101(1) EPC.
- 1.5 The appellant has argued (cf the letter dated 18 November 2009, page 1) that a communication under Rule 101(2) EPC should have been sent inviting him to remedy the deficiencies noted within a period to be specified. Only if after having received such a communication and only if such deficiencies were not remedied in due time should a Board of Appeal reject an appeal. Since such a communication had never been communicated to the appellant there seemed to be no legal basis for rejecting the appeal as inadmissible.
- 1.6 The Board notes however that Rule 101(2) EPC refers to Rule 99(1)(a) EPC, which paragraph only concerns an appellant's name and address. The relevant Rule in the present case is instead Rule 101(1) EPC, which refers (in particular) to Rule 99(2) EPC dealing with the contents of the statement of grounds. According to Rule 101(1) EPC, an appeal is rejected as inadmissible

unless any deficiency has been remedied before the relevant period under Article 108 EPC has expired (here: four months). After expiry of this period a communication by the Board serving to point out such deficiencies is not foreseen.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:

T. Buschek

S. Wibergh