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Datasheet for the decision of 9 September 2016

Case Number: T 0719/09 - 3.5.05

Application Number: 02727013.1

Publication Number: 1374028

IPC: G06F3/06

Language of the proceedings: EN

Title of invention:
CONTENT-BASED STORAGE MANAGEMENT

Patent Proprietor:
Nice Systems Limited

Opponent:
Graf Software GmbH

Headword:
CONTENT-BASED STORAGE MANAGEMENT/GRAF

Relevant legal provisions:
EPC Art. 108
EPC R. 99(1)(a), 101(2)

Keyword:
Admissibility of opposition - (yes)
Admissibility of appeal - (no)

Decisions cited:
G 0001/12, T 0001/97, T 0097/98, T 0774/05, T 1486/10, T 0034/90, T 0229/90, T 0810/93, T 0501/92, T 1251/07

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

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Case Number: T 0719/09 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 9 September 2016

Appellant: (Opponent)	Graf Software GmbH Mainzer Strasse 36 55411 Bingen am Rhein (DE)
Representative:	2K Patentanwälte Blasberg Kewitz & Reichel Partnerschaft mbB Schumannstrasse 27 60325 Frankfurt am Main (DE)
Respondent: (Patent Proprietor)	Nice Systems Limited 8 Hapnina Street, P.O. Box 690 43107 Ra'anana (IL)
Representative:	Fenlon, Christine Lesley Haseltine Lake LLP Lincoln House, 5th Floor 300 High Holborn London WC1V 7JH (GB)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 10 February 2009 concerning maintenance of the European Patent No. 1374028 in amended form.**

Composition of the Board:

Chair	A. Ritzka
Members:	M. Höhn
	G. Weiss

Summary of Facts and Submissions

I. This appeal is against the interlocutory decision of the Opposition Division of the European Patent Office posted on 10 February 2009 maintaining European patent No. 1374028 in amended form.

II. Claim 1 as maintained reads:

"1. A method for managing data storage according to content of video or audio data obtained from one or more input source, comprising
- rendering the video or audio data into a common format and subsequently automatically analyzing the data in said common format in order to automatically determine at least one characteristic of the data according to the content, and according to said at least one characteristic
EITHER
selecting one of a plurality of storage media, storage device, storage system or a combination thereof and placing the video or audio data into or removing the video or audio data from said selected storage media, storage device, storage system or combination thereof;
OR
selecting not to store the video or audio data."

III. The opponent (appellant) filed an appeal against this decision. The notice of appeal was received on 27 March 2009. The appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 8 June 2009. The appellant requested that the appealed decision be set aside and that the patent be revoked in its entirety. Oral proceedings were requested as an auxiliary measure.

IV. The patent proprietor (respondent) did not appeal the decision and, hence, is a party as of right. The respondent requested that the opposition and the appeal both be rejected as inadmissible, and that the appeal be dismissed. Oral proceedings were requested as an auxiliary measure. In addition, the respondent requested that documents E101 to E127, submitted with the statement setting out the grounds of appeal, not be admitted because they had been filed late.

V. With a communication dated 9 June 2016 the board summoned the parties to oral proceedings on 9 September 2016. In an annex to the summons the board expressed its preliminary opinion.

According to this preliminary opinion, the opposition appeared to be admissible for the reasons given in the decision T 1486/10 (see reasons, points 1.5 to 1.9) of board 3.5.03, in which the underlying facts were comparable to those in the present case.

As to the admissibility of the appeal which was challenged by the respondent for not providing the name and the address of the appellant, the board stated that the notice of appeal dated 27 March 2009 had been filed by the professional representative appointed in the proceedings before the first instance. From the letter heading it was clear that the letter concerned the opposition against the patent "EP 1374028" giving the title of the patent, the name of the patentee and the reference to the number of the "Zusammenschluss" "EPA 194". Furthermore, the first paragraph referred to the decision under appeal "... *Beschluss ... vom 10.2.2009 eingegangen 13.02.2009 wird Beschwerde eingelegt...."*

In the board's view, from all these elements of information it was possible to deduce with a sufficient degree of probability by whom the appeal should be considered to have been filed. The Board considered that in line with the established case law (see inter alia T 1/97 of 30 March 1999, Reasons No. 1.1 and T 97/98, Reasons No. 1.3 (OJ EPO 2002, 183)) and endorsed by the Enlarged Board of Appeal in G 1/12 (OJ EPO 2014, A114), the appellant had been sufficiently identifiable within the period for filing an appeal and thus, that the appeal appeared to be admissible.

In the line with the G 1/12 conclusions and for the proper administration of the case the board invited the appellant to remedy the deficiency of the omission of the name of the appellant in the notice of appeal by confirming in writing the name and the address of the appellant before the scheduled oral proceedings.

As to the admissibility of documents submitted with the statement setting out the grounds of appeal, in the board's preliminary opinion it appeared that at least publications E101, E105 and E123 had been sufficiently substantiated (see pages 12 to 14 of the grounds of appeal).

E101 (WO 94/27404) appeared to be the most pertinent prior art on file with regard to amended claim 1 as maintained. The board tended to concur with the appellant's argumentation that this publication at least rendered the subject-matter of claim 1 obvious (Article 56 EPC 1973).

VI. By letter dated 3 August 2016 the appellant indicated that it agreed with the board's preliminary view as to patentability. If the patentee submitted amended claims

which were not based on dependent claims, such amendments should not be admitted into the proceedings or a new date for oral proceedings should be arranged such that the opponent would be provided with time for search regarding such features.

VII. By letter dated 9 August 2016 the respondent submitted two sets of claims according to auxiliary requests 1 and 2, supported by arguments in favour of inventive step.

VIII. By letter dated 25 August 2016 the appellant observed that the respondent's amended requests submitted with letter of 9 August 2016 included features which were not based on dependent claims and which had been taken from the description. The appellant requested that these requests not be admitted into the proceedings. On a subsidiary basis to this the appellant requested that the board provide a search regarding these features or that an extension of period be granted such that the opponent would be provided with more time for search.
The request reads in its original German wording:
"a) Es wird beantragt, die Anträge zurückzuweisen, hilfsweise
b) amtsseitig im Rahmen des Amtsermittlungsgrund zu recherchieren oder
c) eine Fristverlängerung zu gewähren, so dass die Einsprechende mehr Zeit für eine Recherche hat."
Further, document E150 (US 5859662) was submitted.

IX. By letter dated 1 September 2016, the appellant responded by putting forward further arguments with regard to novelty and inventive step of the auxiliary requests based on prior art publications E150 (US 5859662), E151 (WO 98/10358 A1), E152 (US 5012522) and

E153 (US 5635981), submitted with letters of 25 August 2016 and/or 1 September 2016.

X. Oral proceedings were held on 9 September 2016, during the course of which the appellant (opponent) requested that the following question be referred to the Enlarged Board of Appeal:

"Muß die Adresse des Beschwerdeführers, wenn der Name bei einem Online-Filing im Beschwerdeverfahren genannt wurde, erneut angegeben werden, wenn die Adresse bereits im Einspruchsverfahren angegeben wurde."

XI. The appellant requested that the decision under appeal be set aside and that the patent be revoked. Concerning the admissibility of the appeal, the appellant requested that the question filed during the oral proceedings be referred to the Enlarged Board of Appeal.

XII. The respondent requested
- that the opposition be rejected as inadmissible,
- that the appeal be rejected as inadmissible,
- that the appeal be dismissed (main request) or that the decision be set aside and the patent be maintained in amended form on the basis of auxiliary request 1 or 2 filed with letter dated 9 August 2016.

XIII. After due consideration of the parties' arguments the chair announced the decision.

Reasons for the Decision

1. Admissibility of the opposition

The respondent's arguments in this respect may be summarised as follows:

1.1 The opposition was filed with the following wording: "Hiermit wird namens und im Auftrag der Harry Graf Software GmbH, Mainzer Strasse 36, 55411 Bingen am Rhein, Einspruch gegen ... eingelegt". The designation of the opponent thus corresponds neither to the natural person Harry Graf nor to the legal person Graf Software GmbH, both mentioned in the telephone directory at the address indicated in the notice of opposition. As a result, the opponent cannot be clearly and unmistakably identified, since the opponent could be the natural person "Harry Graf", the legal person "Graf Software GmbH", or the natural and legal persons jointly ("Harry Graf und Graf Software GmbH").

1.2 The respondent (patent proprietor) argued that the opposition should therefore be rejected as inadmissible pursuant to Article 99(1) and Rules 55 and 56(1) EPC 1973, because the opponent could not be correctly identified.

1.3 It is not in dispute that the designation "Harry Graf Software GmbH" is incorrect, because no company of that name existed at the address provided in the notice of opposition.

1.4 The board, however, concurs with the reasons given in the decision T 1486/10 of 20 March 2014 (see reasons,

points 1.5 to 1.7) taken by board 3.5.03 of which the underlying facts are considered to be comparable to the present case.

1.5 In particular, the board agrees that the indication of the opponent as given in the notice of opposition does not fairly allow room for speculation as to the identity of the opponent. The erroneous name "Harry Graf Software GmbH" would not plausibly lead to the opponent's designation being construed as either the natural person "Harry Graf" or as joint opponents "Harry Graf und der Graf Software GmbH" instead of the corrected version "Graf Software GmbH". The board agrees with the appellant that it is not plausible that the term "Software" is part of a natural person's name.

1.6 The board further agrees with the appellant that the wording used in the notice of opposition "Hiermit wird namens und im Auftrag der Harry Graf Software GmbH, Mainzer Strasse 36, 55411 Bingen am Rhein, Einspruch gegen ... eingelegt" would lead the reader to conclude that the opponent is a company (GmbH). This is corroborated by the presence of the word "der" (= the) which is grammatically associated with the feminine noun "GmbH" as the genitive case of the definite article. In the board's judgement, it is implausible that the opponent is not a company, since then both the beginning and the end of the opponent's designation would have been erroneous. In this respect, filing an opposition in the name of a natural person according to the rules of German grammar would have resulted in one of the following wordings which would not include the word "der": "im Auftrag von Harry Graf", or less likely "des Harry Graf".

1.7 Hence, it would be concluded that the opponent was actually "Graf Software GmbH", which in the above-cited German sentence would read "... der Graf Software GmbH" following the words "im Auftrag" (i.e. in the name of) and that the discrepancy (i.e. the presence of the additional word "Harry") was the result of an error, which is all the more plausible considering that document A2 cited in the opposition procedure indicates Harry Graf as being the founder of the Graf Software GmbH.

1.8 Since the other requirements concerning admissibility of the opposition are met, the opposition is admissible.

2. Admissibility of the appeal

2.1 The respondent argued in writing that the notice of appeal dated 27 March 2009 did not identify the appellant. Contrary to the requirements of Article 108 EPC and Rule 99(1)(a) EPC, neither the name nor the address of the appellant were provided.

2.2 At the oral proceedings the respondent argued that the appellant had not reacted to the invitation "to remedy to the deficiency of the omission of the name of the appellant in the notice of appeal by confirming in writing the name and the address of the appellant before the scheduled oral proceedings". The board would therefore now be obliged to reject the appeal as inadmissible in accordance with Rule 101(2) EPC, second sentence. The respondent made reference to decision T 774/05 which concerned a similar case and where a lack of reaction to the board's invitation resulted in the appeal being held inadmissible (see reasons, point 4.2). The respondent further referred to the annex to

the summons in case T 774/05 and pointed out that almost the same wording had been used therein to invite the appellant to remedy the deficiency (see communication dated 2 July 2007, point 5.4).

2.3 The appellant argued that, in contrast to case T 774/05, in the present case according to the wording used in the annex to the summons ("For the proper administration of the case the appellant is invited to remedy to the deficiency of the omission of the name of the appellant in the notice of appeal by confirming in writing the name and the address of the appellant before the scheduled oral proceedings."), no reference had been made to Rule 101(2) EPC, but it was intended merely "For proper administration of the case...". No legal consequences were indicated, hence a notification under Rule 101(2) EPC of a loss of rights was missing. By not referring to Rule 101(2) EPC, no time limit resulting in the legal consequences according to Rule 101(2) second sentence EPC would have been triggered.

2.4 The name of the appellant had been submitted, in the appellant's view, before the scheduled oral proceedings on the form for online filing for submitting the appellant's letter dated 1 September 2016 (available via online file inspection). That form indicated "- als Vertreter des/der Einsprechenden: GRAF Software GmbH". This form was regularly used in appeal proceedings and it was not possible to edit the term "Einsprechenden". So merely the address could be missing.

2.5 Furthermore, according to the appellant, the present case was not comparable to T 774/05, where several opponents existed and it was therefore not clear which party would be appellant. In the present case, however, there was only a single opponent in the proceedings.

There could not be any doubt during the appeal proceedings about which would be the appealing opponent of which the name and the address were already known from the first instance proceedings. Thus, the purpose of Rule 101(2) EPC did not fit the present case and, consequently, that was why the board had not referred to this Rule and had instead issued its request to the appellant merely for proper administration of the case.

3. The board cannot follow the appellant's line of argument.

3.1 The notice of appeal dated 27 March 2009 was filed by the professional representative appointed in the proceedings before the first instance. From the letter heading it appears that the letter concerns the opposition against the patent "EP 1374028" with the indications of the title of the patent, the name of the patentee and the reference to the number of the "Zusammenschluss" "EPA 194". Furthermore, the first paragraph refers to the decision under appeal "... *Beschluss ... vom 10.2.2009 eingegangen 13.02.2009 wird Beschwerde eingelegt....".* From all these elements of information it was possible to derive with a sufficient degree of probability by whom the appeal should be considered to have been filed. The Board considers that, in line with the established case law (see inter alia T 97/98, Reasons No. 1.3 (OJ EPO 2002, 183) and T 1/97 of 30 March 1999, Reasons No. 1.1, endorsed by the Enlarged Board of Appeal in G 1/12, Reasons No. 21 (OJ EPO 2014, A114), the appellant was sufficiently identifiable within the period for filing an appeal. This corresponds to what the board clearly and unmistakably indicated in the annex to the summons to the oral proceedings.

3.2 The respondent was correct in stating in its reply to the grounds of appeal that contrary to the requirements of Article 108 EPC and Rule 99(1)(a) EPC neither the name nor the address of the appellant had been provided. The respondent further argued that according to Rule 101(2) EPC the board had to invite the appellant to remedy the deficiencies noted within a period to be specified. If the deficiencies were not remedied in due time the board should reject the appeal as inadmissible. In fact, the board had invited the appellant to rectify the deficiency of the omission of the name of the appellant in the notice of appeal by confirming in writing the name and the address of the appellant before the scheduled oral proceedings. The appellant did not react to this invitation. As a consequence the board had to reject the appeal as inadmissible. This applied independently of whether or not explicit reference to Rule 101(2) EPC was made. The board agrees with the respondent's argument which reflects the reasoning in Reasons No. 22 of G 1/12, according to which, once the appellant’s identity has been established, the deficiency noted has to be remedied and, if it is not remedied in due time, the legal consequence is rejection of the appeal as inadmissible.

In contrast to the appellant's point of view, the passage in the annex to the summons to oral proceedings about rectifying the omission of the name and address (see point 5.2 second paragraph) is a notification according to Rule 101(2) EPC, especially since the wording of the invitation is almost identical to the wording of Rule 101(2) EPC and specifies a time limit (i.e. before the scheduled oral proceedings).

This passage refers specifically to the reasons for decisions T 1/97 and T 97/98 taken by the technical boards of appeal (the latter published in OJ EPO) which analyse in detail the provisions concerning the admissibility of the appeal if the name and address are missing (Rule 65(1) and (2) EPC 1973; Rule 101(1) and (2) EPC); decision G 1/12 is also specifically mentioned which endorsed this case law and likewise analysed the connection between the various provisions in question (Rule 101(1) and (2) EPC). By referring to these decisions, the board thus stated unambiguously the provisions applicable in this case, together with the legal consequence if the noted deficiencies were not remedied in due time.

Furthermore, the formal requirements were also met. The invitation to remedy the deficiencies was notified with the annex to the summons to oral proceedings, i.e. by registered letter with advice of delivery, which was demonstrably received on 10 June 2016, i.e. well over two months prior to the date of the oral proceedings scheduled for 9 September 2016. The invitation mentioned a time limit as provided for in Rule 101(2) EPC, which moreover was longer in this case than the two months usually set for remedying such deficiencies.

3.3 As to the argument that the present case was not comparable to T 774/05, where more than one opponent existed, the board agrees with the respondent's argument that each appeal has to be admissible separately and that T 774/05 is indeed comparable to the present case. In both cases the invitation to remedy the deficiency was issued in the summons to oral proceedings. Rule 101(2) EPC does not specify at which point in time after noting the deficiency the invitation has to be issued. Therefore, it is

irrelevant that the invitation was sent with the summons and not immediately at the time when the appeal was filed.

Rule 101(2) EPC does not depend on how many opponents might have appealed the decision of the first instance, in particular, Rule 101 EPC also applies to *ex parte* proceedings where there is only one possible party which could be appealing a decision adversely affecting it. The appellant's argument to the contrary therefore does not convince.

As to the appellant's argument that the name of the appellant was indicated on the form for online filing (see point 2.3 above), the board notes that this indication does not present a reaction to the invitation to confirm in writing the name and address of the appellant as the field indicates "Vertreter des Einsprechenden" (representative of the opponent) and the address is not confirmed. Even if this field can not be edited, the appellant had many options to communicate the required confirmation, e.g. by adding a comment on the form in the comment field or by including it in the letter which was submitted with this form by electronic filing.

The board is not convinced that providing the name of the appellant on the form for online filing is a proper submission. The address was clearly not provided in the appeal proceedings before the scheduled oral proceedings. The board agrees with the respondent that the address cannot be inferred, nor can the appellant refer to the respondent having used the proper address of the appellant in its submissions, in order to fulfil the requirements of Rule 99(1)(a) EPC or in order to remedy a deficiency under Rule 101(2) EPC.

3.4 The respondent had referred to the correct address in its submissions (see respondent's letter dated 2 October 2009, page 2, first paragraph referring to the appellant's address "Mainzer Strasse 36, 55411 Bingen"). However, this reference was made in the context of the admissibility of the opposition and of the question whether it was possible to identify the opponent on the basis of its address (see point 2 of letter of 2 October 2009). Under point 3 "Admissibility of the notice of appeal" the respondent explicitly stated that neither the name nor the address of the appellant were provided (see page 4 of letter of 2 October 2009). Thus, it cannot be concluded from the fact that the address of the opponent was mentioned in the respondent's letter that the appellant had implicitly agreed with this address.

3.5 Since the appellant did not remedy the deficiencies within the set time limit, the legal consequences are clearly specified in Rule 101(2) EPC, second sentence. The board has no discretion and can therefore only conclude that the appeal be rejected as inadmissible.

4. Referral of a question to the Enlarged Board of Appeal

4.1 The appellant argued that this case had been under way for more than seven years before oral proceedings were held, without the board ever saying anything about the name and address of the appellant being missing. Even the respondent had referred to the correct address in his submissions (see respondent's letter dated 2 October 2009, page 2, first paragraph referring to the appellant's address "Mainzer Strasse 36, 55411 Bingen"). It was therefore clear that the appellant had implicitly agreed to this address being used throughout

the appeal proceedings, even by the respondent. The address had therefore at least been tacitly accepted by both parties.

4.2 Asking for information which was already known to the board and to the other parties was contrary to procedural economy and was not done for legal reasons, but merely for proper administration, and therefore did not give rise to any legal consequences. The appellant therefore requested that the following question be referred to the Enlarged Board of Appeal:

"Muß die Adresse des Beschwerdeführers, wenn der Name bei einem Online-Filing im Beschwerdeverfahren genannt wurde, erneut angegeben werden, wenn die Adresse bereits im Einspruchsverfahren angegeben wurde."

In the translation of the board:
"If the appellant's name is indicated in an online submission in appeal proceedings, does its address have to be provided again even if it was already given in opposition proceedings?"

4.3 The board takes this question raised by the appellant as a fundamental criticism of the relevant provisions of the EPC. However, the legal framework for the case in point is clearly specified in the EPC.

4.4 An appeal only comes into existence if a party files a notice of appeal and pays the appeal fee, both within two months of the date of notification of the written decision in question (Article 108 EPC, first and second sentences). The notice has to indicate the name and the address of the appellant (Rule 99(1)(a) EPC). The appeal procedure established by the EPC constitutes, contrary to the appellant’s view, a procedure which

takes place after the administrative examination and opposition procedures and, as such, is completely separate from them. The board wishes to reiterate the well-established principle consistently laid down in the case law of the boards of appeal, that appeal proceedings are definitely not and were never intended to be the mere continuation of first-instance proceedings (see T 34/90, OJ EPO 1992, 454, Reasons No. 2; T 229/90 of 28 October 1992, Reasons No 2; T 810/93 of 15 March 1995, Reasons No. 2.2, T 501/92, OJ EPO 1996, 261, Reasons No 1.1 and T 1251/07 of 21 September 2010, Reasons No. 5). Rather, their function is to give a judicial decision upon the correctness of a separate earlier decision given by the first-instance department. It follows that, as intended by the legislator, for the purpose of the admissibility of the appeal, as well as for other procedural purposes, appeal proceedings are wholly separate and independent from first-instance proceedings. The evaluation of the admissibility of the appeal can therefore only be based on information provided by the appellant within the appeal proceedings and in principle at their outset.

4.5 In view of the fact that the legal framework for such a situation is already clearly defined in the EPC, and case law exists for similar circumstances (see reference to T 774/05) which the board is following in the present case, the board does not need to answer the question raised by the appellant for deciding the issue. In view of applying constant case law, a referral to the Enlarged Board of Appeal on this point is not necessary in order to ensure uniform application of the law (Article 112(1) EPC), nor does the board regard this question as raising an important point of law.

Order

For these reasons it is decided that:

1. The request for a referral to the Enlarged Board of Appeal is refused.
2. The appeal is rejected as inadmissible.

The Registrar: The Chair:

K. Götz-Wein A. Ritzka

Decision electronically authenticated