Internal distribution code:

(A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

Datasheet for the decision of 7 May 2015

Case Number: T 1076/09 - 3.5.07

Application Number: 98909722.5

Publication Number: 0976053

IPC: G06F17/30

Language of the proceedings: EN

Title of invention:
Automatic conversion system

Applicant:
Google Inc.

Headword:
Multi-lingual communication/GOOGLE

Relevant legal provisions:
EPC Art. 94(3), 113(1), 123(2), 56
RPBA Art. 11

Keyword:
Substantial procedural violation - (no)
Remittal to the department of first instance - fundamental deficiency in first instance proceedings (no)
Right to be heard - opportunity to comment (yes)
Amendments - added subject-matter (main request - yes)
Inventive step (all requests - no)

Decisions cited:

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1076/09 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 7 May 2015

Appellant: (Applicant)	Google Inc. 1600 Amphitheatre Parkway Mountain View, CA 94043 (US)
Representative:	Nederlandsch Octrooibureau P.O. Box 29720 2502 LS The Hague (NL)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 16 October 2008 refusing European patent application No. 98909722.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	R. Moufang
Members:	M. Rognoni
	P. San-Bento Furtado

Summary of Facts and Submissions

I. After having changed its name into Netmask (El-Mar) Internet Technologies Ltd., the original applicant transferred the European patent application No. 98909722.5 to Google Inc. The registration of the transfer took effect on 10 October 2011.

In the following no distinction is made between the current applicant/appellant and its predecessor.

II. The applicant (appellant) appealed against the decision of the Examining Division to refuse European patent application no. 98909722.5.

III. In the contested decision, the Examining Division came, *inter alia*, to the conclusion that the subject-matter of claim 1 according to the main request filed on the day of the oral proceedings, namely on 17 September 2008, did not involve an inventive step having regard to the following document:

D1: SAKAGUCHI, Tetsuo, et al., "A Browsing Tool for Multi-lingual Documents for Users without Multi-lingual Fonts", *Proceedings of the first ACM international conference on Digital libraries*. ACM, 1996, pages 63-71.

Furthermore, the Examining Division considered that the subject-matter of claims 1 and 17 according to the auxiliary requests 1 to 4, all filed by letter dated 15 August 2008, violated Article 123(2) EPC.

IV. With the statement of grounds of appeal, the appellant filed a new main request and two auxiliary requests, and requested refund of the appeal fee on the ground of

a substantial procedural violation and remittal to the Examining Division for continuation of the procedure.

Additionally, the appellant implicitly requested that the decision under appeal be set aside and a patent be granted on the basis of the main request or, if that was not possible, on the basis of the first or the second auxiliary request.

V. With letter dated 17 December 2014, the appellant was summoned to oral proceedings before the Board to be held on 7 May 2015.

VI. In a communication pursuant to Article 15(1) RPBA dated 2 March 2015, the Board introduced the following prior art into the appeal proceedings:

D6: Kan, Wing-Kay, et al., "On-demand Multi-lingual Font Service on Heterogeneous Computer Platforms", *WebNet 96*, San Francisco, CA, October 15-19, 1996, pages 1/7 to 7/7;

D7: Constantine, Larry L. "Essential modeling: use cases for user interfaces", *interactions*, Vol. 2, Issue 2, April 1995, pages 34 to 46.

In the same communication, the Board expressed the following preliminary opinions:

- it appeared that no serious procedural violation had occurred in the examination proceedings;

- claim 1 according to the main request appeared to contain subject-matter extending beyond the content of the application as filed;

- in the light of the teaching of document D1 and of document D6 (or D7), it would appear to be obvious to arrive at a system as recited in claim 1 of the main request;

- the subject-matter of claim 1 according to the first and second auxiliary requests appeared to lack an inventive step within the meaning of Article 56 EPC;

- in summary, none of the appellant's requests appeared to provide a basis for granting a patent.

VII. In reply to the Board's observations, the representative of the appellant informed the Board, with letter dated 30 April 2015, that the appellant did not intend to attend the oral proceedings.

VIII. On 7 Mai 2015 oral proceedings were held as scheduled in the absence of the appellant. At the end of the proceedings, the Chairman pronounced the Board's decision.

IX. Claim 1 according to the main request reads as follows:

"A method for transferring data between a server (24) and a client (8) in a multi-lingual situation in which said data is in accordance with a first language or standard and said client is set up in accordance with another language or standard, comprising:
integrating into a relationship between said server and said client a converter;
receiving said data, said data being in the form of an Internet hypertext document, said data being received by said converter (22) from said server (24);

replacing an object of the hypertext document suitable for said first data language or standard by the converter (22) with a replacement object suitable for said second language or standard; and
transferring the Internet hypertext document with the replacement object to the client (28),
wherein the method is characterized in that:
said converter is an applet providing emulation of an input object,
said object suitable for said first language or standard comprises said input object, said input object being for obtaining input from a user, said replacement object comprising a call to a program, said replacing thereby enabling said client to provide input to said Internet hypertext document using said second language or standard."

Claim 1 according to the first auxiliary request differs from claim 1 of the main request in that its characterising part reads as follows:

"wherein the method is characterized in that:
said converter is located in association with said client; and
said object suitable for said first language or standard comprises an input object for obtaining input from a user, said replacement object comprising a call to a program, said replacing thereby enabling said client to provide input to said Internet hypertext document using said second language or standard."

Claim 1 according to the second auxiliary request differs from claim 1 of the main request in that its characterising part reads as follows:

"wherein the method is characterized in that:
said converter is run on a same computer as said client; and
said object suitable for said first language or standard comprises an input object for obtaining input from a user, said replacement object comprising a call to a program, said replacing thereby enabling said client to provide input to said Internet hypertext document using said second language or standard."

All requests further comprise an independent claim directed to an apparatus for transferring of data between a server using a first language or standard and a client using a second language or standard. As the apparatus claims are not relevant to the present decision, there is no need to specify their wording.

X. In the statement of grounds of appeal the appellant essentially argued that a substantial procedural violation had occurred and the rights of the applicant had been violated so that the case should be sent back to the Examining Division for continuation of the procedure.

Furthermore the appellant contested the objections raised by the Examining Division under Article 56 EPC and submitted arguments in support of the inventive step of all requests starting from document D1.

Reasons for the Decision

1. The appeal is admissible.

Alleged substantial procedural violation

2. The appellant has alleged that a substantial procedural violation occurred during the examination proceedings, since the application was refused after only one communication followed by the summons to oral proceedings. This was not in compliance with Article 94(3) EPC which prescribed that the Examining Division should invite the applicant, as often as necessary, to file observations and to amend the application.

2.1 In particular, the appellant has argued that the issue of added subject-matter under Article 123(2) EPC, raised in the summons to oral proceedings, resulted from amendments made after the first communication with a view to providing a patent of broadly similar scope in different countries of the world. As such, the applicant's reply to the first communication was a *bona fide* response trying to overcome the initial objections of the Examining Division. Such a *bona fide* response did not necessitate the severe sanction of refusal of the application.

2.2 Essentially, the appellant considered that the first instance proceedings had not provided sufficient opportunity for filing observations and amending the application in order to overcome the Examining Division's objections.

In fact, after filing a main request and three auxiliary requests in response to the summons to oral proceedings, the applicant telephoned the examiner and

was informed that the requests were not acceptable. The applicant then tried to file further requests in order to overcome the issues which had come up during the consultation with the examiner.

The further requests were filed as soon as possible after the telephone conversation, but were not admitted into the proceedings. The minutes gave the impression that filing of these further requests was attempted during the oral proceedings, but in fact they had been supplied in advance.

2.3 According to the appellant's account, the Examiner gave no reasons during the telephone consultation, except in the most general terms, as to why the requests were considered not to render the application allowable. The applicant therefore had to prepare new requests without knowing the actual opinion of the Examining Division. Actually, the applicant was first informed about the Examining Division's views, as per sections 6 and 7 of the reasons for the decision, at the oral proceedings themselves. No such arguments had been presented in the written procedure and the applicant was genuinely surprised.

2.4 The appellant did not contest that the oral proceedings provided an opportunity to comment. However, in the appellant's view there was effectively no possibility to answer the arguments by amending the claims since no requests filed within the month preceding the oral proceedings had been found admissible.

3. As it appears from the examination file, the Examining Division objected in its first communication, dated 29 June 2006, that the application did not meet the requirements of Article 84 EPC because claims 1, 5 to

7, 11 and 18 were not clear. Furthermore, the subject-matter of claims 1 and 2 was found not to be new (Article 54 EPC), whereas claims 3, 4 and 6 to 21 did not involve an inventive step (Article 56 EPC).

With a letter dated 9 January 2007, the applicant submitted a new set of claims.

With letter dated 22 April 2008, the applicant was summoned to oral proceedings to be held on 17 September 2008. In the communication accompanying the summons, the following new document was cited as D2 (in the following it will be identified as D2' to distinguish it from another document also identified as D2 in the contested decision):

D2' JACOBS, Stephan, et al.,"Filling HTML forms simultaneously: CoWeb — architecture and functionality", *Computer Networks and ISDN Systems*, 1996, Vol. 28, Issue 7 - 11, pages 1385 to 1395.

The Examining Division expressed the opinion that several claims, inter alia independent claims 1 and 17, violated Article 123(2) EPC. Further objections under Articles 84 and 56 EPC were also raised.

3.1 On 15 August 2008 the applicant filed a main request and first to third auxiliary requests with some general observations.

3.2 On 8 September 2008 there was a telephone consultation between the applicant and the first examiner (see communication dated 11 September 2008). The results of the consultation, which reflected the non-binding

opinion of the Examining Division, were essentially as follows:

- The main and the three auxiliary requests did not comply with Article 123(2) EPC. The amendments concerned were specified.

- Even if the claims were to be amended so as to overcome the Article 123(2) EPC objections, the Examining Division considered that the main request, the first and the third auxiliary requests were not new over D2' (Article 54 EPC) and not inventive over D1 (Article 56 EPC). The second auxiliary request did not appear to be inventive over D1 in combination with D2' (Article 56 EPC).

3.3 On 17 September 2008 at 7:37 the applicant sent a fax with a fourth auxiliary request and some comments, a fifth auxiliary request and some comments, and a sixth auxiliary request and some comments. These requests were thus submitted on the day of the oral proceedings.

3.4 From the minutes of the oral proceedings it can be seen that the Examining Division considered the fourth to sixth auxiliary requests. The fourth auxiliary request, which according to the Examining Division complied with Article 123(2) EPC, was admitted into the proceedings and thereafter, following a corresponding statement by the applicant, became the main request. The former main request and first to third auxiliary requests were respectively renumbered as first to fourth auxiliary requests.

3.5 According to the minutes (see paragraph bridging pages 3 and 4), the fifth auxiliary request was also

discussed in detail and found not to comply with Article 123(2) EPC. Considering that this request also did not satisfy the requirements of Article 56 EPC, the Examining Division decided not to admit it into the proceedings. As the same applied to the sixth auxiliary request, it was also not admitted into the proceedings.

3.6 According to the minutes, a seventh auxiliary request was filed by the applicant at the oral proceedings. Finding that this request would not overcome the Article 123(2) EPC objection and would also not comply with Article 56 EPC in view of D1, the Examining Division decided not to admit it into the proceedings.

3.7 The Board considers that the applicant was given sufficient opportunity to present its case before the Examining Division and that all its requests were duly considered. In particular, the Board notes that with the main request, filed as fourth auxiliary request by fax on the day of the oral proceedings, the applicant had overcome the Examining Division's objections under Article 123(2) EPC, and that this request only failed because of lack of inventive step over D1.

3.8 In summary, the Board is of the opinion that no fundamental deficiencies are apparent in the examination proceedings which would justify the remission of the case to the department of first instance for further prosecution pursuant to Article 11 RPBA, or the reimbursement of the appeal fee.

Main request

4. Claim 1 of the main request relates to a *"method for transferring data between a server (24) and a client (8) in a multi-lingual situation in which said data is*

in accordance with a first language or standard and said client is set up in accordance with another language or standard".

The claimed method comprises the following features:

(a) integrating into a relationship between said server and said client a converter,
(b) receiving said data,
    (i) said data being in the form of an Internet hypertext document,
    (ii) said data being received by said converter from said server,
(c) replacing an object of the hypertext document suitable for said first data language or standard by the converter with a replacement object suitable for said second language or standard,
(d) transferring the Internet hypertext document with the replacement object to the client,
(e) said converter is an applet providing emulation of an input object,
(f) said object suitable for said first language or standard comprises said input object,
(g) said input object being for obtaining input from a user,
(h) said replacement object comprising a call to a program,
(i) said replacing thereby enabling said client to provide input to said Internet hypertext document using said second language or standard.

The above claim differs from claim 1 of the main request considered in the contested decision essentially in that it further comprises features (e) and (h).

5. According to the Examining Division, document D1, which constituted the closest prior art, related to a method for transferring data between a server and a client in a multilingual situation and disclosed features (a) to (d) of claim 1.

5.1 Starting from D1, the Examining Division considered that the problem solved by the method of claim 1 of the main request then on file was to allow a client to input characters/strings in an alphabet supported by the server.

5.2 According to the Examining Division, document D1 (page 65, left-hand column, first full paragraph) addressed the problem of keyboard input, *i.e.* the input/upload of a search string, from a client terminal to a server. Document D1 disclosed the functionality of an input mechanism allowing a client terminal with no support of the server's alphabet to provide input in a different alphabet. Even if D1 failed to provide any implementation details of this functionality, it was known to a skilled person that any HTML element, such as a text, an image or an input box, could be replaced with other elements or even with a call to a program (Java applet) when achieving the programmatic functionality of a web page, as exemplified in document D2'. Thus, the skilled person would consider replacing the input object with another element which would allow the client to provide input in the server's language or "standard".

6. The appellant has pointed out that according to the feature introduced into the independent claims (feature (e)) the converter was an applet which provided input emulation and thus allowed input objects to be recognized. The use of emulation allowed the user to

view at the client the input data in the server's language and for the converter to be placed anywhere in the system.

6.1 While document D1 indeed allowed a user in a first language to enter data to a server that operated according to a second language, this entry of data had to be done blindly. In other words, in the appellant's opinion, document D1 did not teach that the user could see what was being done.

6.2 Thus, according to the appellant, the inventive step consisted in providing input emulation alongside the converter so that the user could view the input information and see how it might work in a browser environment. The claimed solution had furthermore an unexpected effect, namely that the input emulation did not require the actual presence of the server. Hence, the input emulator-converter of the present invention could be located at the server, or at a proxy or at the client itself.

Article 123(2) EPC

7. The wording of feature (e)("*said converter is an applet providing emulation of an input object*") is not directly disclosed in the application as originally filed. Hence, a question to be considered is whether feature (e) can be directly and unambiguously derived from the original application documents and thus complies with Article 123(2) EPC.

7.1 As illustrated in Figures 1A to 1C and explained in the published application (page 12, lines 18 to 25), "*incompatible portions of the HTML file are automatically converted by converter 22 such that*

client 28 is capable of displaying the information in text object 10 and/or performing input request 12. Preferably, this process is substantially invisible to client 28 and server 24. When client 28 requests a file from server 24, server 24 supplies the file to converter 22. Converter 22 modifies the file, on the fly, so that displaying the information in the file will be within the capabilities of client 28 and sends the modified file to client 28. If input is entered at client 28, which input is not compatible with server 24, converter 22 converts the input to a form usable by server 24"(underlining added).

In particular (*ibid.* page 12, lines 26 to 32), "*converter 22 replaces input objects with Java applets, for example, an applet 16. These Java applets enable a user at client 28 to enter data in a manner which is more comfortable for him and which manner is not otherwise supported by client 28. Preferably, the applet supports keyboard mapping, character combining and/or different types of display of RTL languages. JavaScript, BasicScript and ActiveX may be used instead of Java, however, they are less preferred due to their technical limitations and because they are not as widely used as Java*" (underlining added).

7.2 In other words, according to the above passages of the description, the converter may replace input objects with Java applets which can provide input emulation. However, the converter is not defined as an applet.

7.3 According to the appellant feature (e) corresponded to "*the material described on page 18 line 29 and the following page or so in the description of Fig. 7*" (see statement of grounds of appeal, page 3/6, last paragraph).

In fact, the way an applet operates in the context of the present invention is shown in Figure 7 and explained on page 18, line 30 to page 19, line 3 of the description as follows:

"*The applet preferably deals with incoming keystrokes on an individual basis. The handling of the keystrokes is dependent on the keyboard mapping supplied by the Java applet. If a keystroke is mapped to a control, the control is executed. Examples of controls include,* inter alia, *"backspace", "delete character", "change language and/or writing direction", "insert file", "help" (which displays a help for using the Java applet, and in particular, the keyboard mapping), "connect letters" and "compose letter". In some cases, a control may display a keyboard mapping (for output only) or a matrix of characters, which can be directly selected using a mouse*" (underlining added).

Furthermore (*ibid.* page 19, lines 18 to 25), "[o]*ne way of sending the data to converter 38 is to replace the submit button, of which each form contains at least one, with a second Java applet which queries the other Java applets in the form before uploading the form contents. The standard submit button only queries input objects, not Java applets. In accordance with an alternative embodiment of the invention, the Java applet sends its contents to converter 38 when the data is entered thereto. When the submit button is pressed at client 28, converter 38 adds the input data it received from the Java applet to what the submit button sends*".

7.4 In summary, the present application and, in particular, the passage cited by the appellant in support of

feature (e) present the converter and the applet as separate entities. Furthermore, the Board has not found any suggestion in the application as filed that the converter might be implemented as an applet.

Consequently, feature (e), which identifies the converter with an applet providing emulation of an input object, extends the subject-matter of claim 1 beyond the content of the application as originally filed (Article 123(2) EPC).

Article 56 EPC

8. Apart from the objection of added subject-matter, the Board agrees with the appellant that claim 1 of the main request relates to the embodiment of the invention shown in Figure 7. Its gist consists essentially in using an applet to emulate at the client the input of characters which the client does not support.

8.1 In the light of the arguments submitted in support of inventive step (see points 6. to 6.2 above), the appellant does not appear to contest that the method of the invention differs from the prior art document D1 essentially in that the replacement object is an applet providing emulation of an input object. This seems also to be confirmed by the two-part form of claim 1, whereby the characterising features (e) to (i) can be interpreted as relating to the input emulation provided by the applet.

8.2 Document D6 is concerned with the problem of displaying multi-lingual documents. Under the heading "Multi-lingual Document Syntax", document D6 explains how a Java applet is used to display, at a client, language

characters sent from a server and not supported by the client.

In the second paragraph of the section titled "Future Developments", document D6 points out that "[i]*nput method support is an important part in a truly multi-lingual environment. ... From time to time, users may want to type feedbacks to the WWW server, or to search for a particular word in the retrieved document".*

8.3 Hence, document D6 teaches using a Java applet to allow the display of an output object of a hypertext document having unsupported characters or fonts, and furthermore hints at the importance of providing also input of unsupported characters.

8.4 In the Board's opinion, a skilled reader of document D6 would realise that the teaching of document D6 relating to the display of unsupported objects of a hypertext on a client by means of applets could also be advantageously used to solve the problem of input support in a multi-language environment.
This is corroborated by the fact that it is generally known to use an applet as "keyboard extender" to simplify the insertion of special characters into a software application (cf. D7, Figure 1: "Example of a commercial keyboard extender applet", and page 40 "The keyboard extender problem").

8.5 In the light of the teaching of document D6, the Board considers that it would have been obvious to a person skilled in art, starting from document D1 and wishing to implement the multi-lingual input function hinted at in this document (see D1, page 65, left-hand column, first full paragraph: "Retrieving documents, however, requires the input function"), to arrive at a method

relying on an applet as input emulator, as shown in the present application (Article 56 EPC).

First auxiliary request

9. Claim 1 according to the first auxiliary request differs from claim 1 of the main request in that feature (e) of the former has been modified as follows:

(e') said converter is located in association with said client.

Furthermore, feature (f) and (g) have been amended as follows:

(f') said object suitable for said first language or standard comprises an input object

(g') for obtaining input from a user.

10. The appellant has essentially argued that document D1 hinted at the possibility of data being input at a keyboard of a computer set up in one language and then being sent to a server where the data was converted for the language system available at the server.

By contrast, the present invention allowed for the data to be transformed at the client side which enabled the client to take in data from the server and read it, even though the server operated in a different language.

10.1 In the appellant's view D1 did not disclose any implementation of the language converter. Thus, the skilled person would have to rely on other documents or on common general knowledge to find possible

implementations. Furthermore, the skilled person would have to independently realise that the direct solution still did "not allow a user client to read material on the server". All the skilled person could do was to upload the data to the server. This would discourage the skilled person from investigating further, since there was no point in uploading data if the result of this could not be seen (cf. statement of grounds of appeal, page 5/6, first full paragraph).

10.2 According to the appellant, the skilled person would arrive at the conclusion that locating the converter at the server was not suitable because the server would not know what the language at the client was and it was not practicable to have universal alphabet converters at the server. On the other hand, the skilled person would also reject the option of placing the converter at the local computer, since the client did not know the language of the server.

10.3 In summary, in the appellant's opinion, the invention lay in the realisation that it was advantageous to choose the local option because the problem was smaller at the client, since an individual user was likely to concentrate on only a limited number of foreign language web servers.

11. As to feature (e'), the Board notes that it relates to one of the three possible configurations described in the application (see application as published, page 13, last three paragraphs). According to the description, neither the configuration of Figure 1A nor the configuration of Figure 1C appears to present particular advantages or disadvantages over the other configurations. However, the configuration of Figure 1B, which shows the separation of the converter from

the server and the client, is said to be desirable if the converter acts as a server or translation-service provider which is not associated with any particular client or server (*ibid.* page 13, lines 22 and 23).

11.1 The appellant's arguments in favour of inventive step rest essentially on the allegedly non-obvious realisation that the implementation of the "local option" (cf. Figure 1C) would present fewer problems, as the converter required by the client to communicate in a server's language could be selected merely on the basis of the user's interests, whereas a converter located at the server would have to deal with a potentially large number of users with different languages.

11.2 Apart from the fact that the appellant's arguments find no support in the application, they do not appear to relate to the actual subject-matter of the claim or to apply to a real world implementation of the claimed invention.

11.3 Claim 1 relates to a method for transferring data between a server and a client in a multilingual situation in which said data (received from or sent to the server) is in a first language and the client is set up in accordance with a second language. Thus, the problem addressed in claim 1 relates to the conversion of data from one language into another language, and not from one language into a plurality of languages. In a two-language situation it seems plausible to assume that the skilled person would know in advance which languages were involved.

11.4 Furthermore, the appellant's arguments fail to take into account that some languages are much more

widespread than others. If it is assumed, for the sake of example, that the client's language is English and that the server's language is Hebrew, it will make more sense to locate the converter at the server in order to make the server's data accessible to the English speaking world, than to provide all possible English clients with an appropriate converter from English into Hebrew. On the other hand, it would be straightforward to locate a language converter at a Greek client to enable communication with an English server.

11.5 In summary, the Board considers that the skilled person wishing to implement the teaching of document D1 would be able to evaluate where it was appropriate to locate the converter and, according to circumstances, arrive at the method according to claim 1 without involving any inventive skills (Article 56 EPC).

Second auxiliary request

12. Claim 1 according to the second auxiliary request differs from claim 1 of the first auxiliary request in that feature (e') has been replaced with:

(e'') said converter is run on a same computer as said client.

12.1 As pointed out above, the Board considers that it would be obvious to a person skilled in the art to decide, according to circumstances, to locate the language converter at the client. Once the skilled person has made this choice, it would be an obvious implementation to run the client and the converter on the same computer (Article 56 EPC).

13. In summary, the Board arrives at the conclusion that none of the appellant's requests provides a basis for granting a patent. Hence, the appeal has to be dismissed.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for reimbursement of the appeal fee is refused.

The Registrar: The Chairman:

I. Aperribay R. Moufang

Decision electronically authenticated