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**Datasheet for the decision
of 7 September 2017**

Case Number: T 1408/09 - 3.5.01

Application Number: 04009036.7

Publication Number: 1469409

IPC: G06F17/60

Language of the proceedings: EN

Title of invention:

System for exchanging mail among members belonging to group

Applicant:

Kabushiki Kaisha Square Enix
(also trading as Square Enix Co., Ltd.)

Headword:

Group identifier / SQUARE ENIX

Relevant legal provisions:

EPC Art. 56

Keyword:

Inventive step - uniquely identifying a group with a uid and time (no - obvious from UUID) - need for pointer to problem in closest prior art (no)

Decisions cited:

Catchword:

According to the problem solution approach, the objective technical problem is formulated based on the technical effect of the difference between the claimed subject-matter and the starting point in the prior art. It is not a requirement for obviousness that the starting point address this problem. If it does, that could make the solution all the more obvious. If, on the other hand, there is a pointer away from the invention, that might be an indication *in favour of* inventive step.



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Case Number: T 1408/09 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 7 September 2017

Appellant: Kabushiki Kaisha Square Enix
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 18 December
2008 refusing European patent application No.
04009036.7 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman W. Chandler
Members: A. Wahrenberg
I. Beckedorf

Summary of Facts and Submissions

- I. The appeal is against the Examining Division's decision to refuse the European application No. 04009036.7 for lack of inventive step (Article 56 EPC).
- II. The Examining Division considered that the subject-matter of claim 1 according to the sole requests would have been obvious over D1 (EP 1 257 144 A2), in view of the skilled person's general knowledge.
- III. The applicant (appellant) appealed and requested that the decision to refuse the application be set aside and that a patent be granted on the basis of a set of claims filed with the statement setting out the grounds of appeal dated 23 April 2009, of which claim 1 reads:

"A mail exchange system comprising:

a plurality of terminal devices (1-1, 1-2, 1-n) connected to one another via a communications network (2), each terminal device (1-1, 1-2, 1-n) having a member information storage (12, 13) for storing member information (31, 32, 3n) of members who belong to a group that exchanges mail via said communications network (2), wherein group information (GID) indicating the group exchanging the mail is added to the mail (41, 42, 43, 51) to be exchanged among said terminal devices (1-1, 1-2, 1-n) of the members, who belong to the group, the plurality of the terminal devices (1-1, 1-2, 1-n) comprising a specific member terminal, an existing member terminal, and a newly joining member terminal;

said specific member terminal including:

a participation mail receiver (16) for receiving a participation mail (42), including member information of a member who newly joins the group, from said newly joining member terminal via said communications network (2);

a first member information adder (11) for extracting the member information included in the participation mail (42) received by said participation mail receiver (16) and storing the extracted member information in the member information storage (12, 13); and

a new member information mail transmitter (16) for transmitting a new member mail (42), including the member information of the newly joining member, to said existing member terminal according to information stored in said member information storage (12, 13) via said communications network (2),

said existing member terminal including:

a new member information mail receiver (16) for receiving the new member mail (42);

a second member information adder (11) for extracting the member information included in the received new member mail (42) and storing the extracted member information in a member list (3) in the member information storage (12, 13); and

a self-information mail transmitter (16) for transmitting an existing member mail (42), including self-member information, to said newly joining member terminal via said communications network (2), and

said newly joining member terminal including:

a new participation mail transmitter (16) for transmitting the new member mail (42), including self-member information of the newly joining member, to said specific member terminal via said communications network (2);

an existing member information mail receiver (16) for receiving the existing member mail (42); and

a member information generator (11) for generating a member list (3) stored in the member information storage (12, 13) based on the received existing member mail (42),

wherein user information (UID) that uniquely specifies each user is allocated to each of said terminal devices (1-1, 1-2, 1-n);

characterized in that

each of said terminal devices (1-1; 1-2; 1-n) comprises a group information generator (11) including an internal timer for generating said group information (GID),

wherein the group information generator (11) of the terminal device (1-1, 1-2, 1-n) of a member forming the group generates said group information (GID) by combining the user information (UID) of the terminal device (1-1, 1-2, 1-n) of the member forming the group and the time of forming the group, measured by the internal timer, such that the group information (GID) uniquely specifies the group and is generated without

involving a server apparatus and without making an inquiry to another apparatus."

- IV. In a communication pursuant to Rule 100(2) EPC, the Board observed that the subject-matter of claim 1 appeared to lack an inventive step over D1. The Board cited the following, Internet document:

D7: DCE 1.1: Remote Procedure Call, Universal Unique Identifier, The Open Group, 1997, available at <http://pubs.opengroup.org/onlinepubs/9629399/apdxa.htm>.

- V. In a letter of reply, the appellant questioned the date when D7 had been made available on the Internet, and submitted further arguments in support of inventive step.

- VI. In a communication pursuant to Article 15(1) RPBA accompanying a summons to oral proceedings, the Board referred to an archived version of D7 (D7') from 30 January 2000, provided by "web.archive.org" (Internet Archive/WayBackMachine).

- VII. The appellant's arguments in favour of inventive step are summarized in the reasons for the decision.

Reasons for the Decision

1. *The invention*

The invention concerns group e-mail. The groups are managed by the members' terminals, without involving a server.

To this end, the terminals use a group identifier for identifying the groups. The group identifier is generated by combining user information of the terminal of the member forming the group and the time of forming the group. Since the same user cannot create more than one group at exactly the same time, the group identifier is unique throughout the system.

2. *Inventive step*

2.1 D1 discloses a method of establishing communication groups in a serverless system. It is common ground that the subject-matter of claim 1 differs from D1 by the features in the characterising portion, namely the group identifier ("group information") generated by combining user information of the user generating the group and the time of forming the group. The question is whether this would have been obvious to the skilled person.

2.2 It is also common ground that the group identifier solves the problem of providing a unique identifier for identifying the groups, without using a server. The appellant argued that, since D1 did not address the problem of uniqueness of identifiers, the skilled

person would not have been motivated to search for how to generate one. There was no pointer in D1 which would have prompted the skilled person in this direction.

2.3 The Board does not find the appellant's arguments convincing. According to the problem solution approach, the objective technical problem is formulated based on the technical effect of the difference between the claimed subject-matter and the starting point in the prior art. It is not a requirement for obviousness that the starting point address this problem. If it does, that could make the solution all the more obvious. If, on the other hand, there is a pointer away from the invention, that might be an indication *in favour of* inventive step.

2.4 The Board does not see any teaching away from the use of unique identifiers in D1. On the contrary, there must be a way to identify the communication groups. That the identification should be unique is self-evident; there would not be much point otherwise. Therefore, the skilled person implementing the communication system in D1 would have had to choose an appropriate group identifier.

2.5 The Examining Division considered this choice to be an obvious one. Since the user was already uniquely identified in the system of D1, and since it was impossible for a single user to create more than one group at exactly the same time, the combination of a user ID and the time of forming the group would have been an obvious alternative. Another possibility would have been to combine the user ID with a sequence number.

- 2.6 In the Board's view, this reasoning involves a degree of hindsight. Just because a solution can be justified by some circumstances, it does not necessarily mean that those circumstances would have led the skilled person to that solution. Furthermore, the existence of an alternative solution does not render the particular claimed solution obvious. Therefore, the Board is of the opinion that some evidence is required to show that the skilled person would have considered a group identifier that is based on a combination of user information and the time of forming the group.
- 2.7 Document D7, cited by the Board, describes a unique identifier called "universal unique identifier" (UUID), which is generated without involving a server. The UUID is based on user information (a node ID, or a POSIX user ID) and a timestamp. At the oral proceedings, the appellant no longer disputed that D7 was prior art, and the Board is satisfied that D7 was available on the Internet well before the priority date.
- 2.8 The appellant argued that, since the UUID in D7 was disclosed in the context of distributed computing, the skilled person would not have considered it for improving a system related to the management of mobile communication groups.
- 2.9 The Board disagrees. The skilled person, faced with the problem of providing a unique identifier for mobile communication groups, would have looked for solutions in the wider field of networked systems. D7 is a general disclosure of a unique identifier that can be used for multiple purposes to reliably identify objects across a network. Although it has not been established that the particular format described in D7 was part of the skilled person's general knowledge at the priority

date, the Board considers that the concept of UUIDs as such was widely known at the date of the invention. Thus, the skilled person would have looked in the direction of UUIDs, and he would have considered the teachings in D7.

- 2.10 The appellant furthermore argued that, even if the skilled person had combined the teachings of D1 and D7, he would nevertheless not have arrived at the invention as defined in claim 1. The appellant considered that the "UTC-based timestamp" in D7 was different from the time of forming the group as measured by an "internal timer" in claim 1, because an internal timer operated without reference to any external clock.

The appellant's arguments do not persuade the Board. The application does not provide any definition of the "internal timer" other than that it provides a date and time (paragraph [0062] of the published application). In the Board's view, this does not exclude the use of a UTC-synchronised clock.

- 2.11 For these reasons, the Board concludes that the subject-matter of claim 1 does not involve an inventive step (Article 56 EPC).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



T. Buschek

W. Chandler

Decision electronically authenticated