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**Datasheet for the decision
of 21 May 2014**

Case Number: T 1779/09 - 3.5.07

Application Number: 99943514.2

Publication Number: 1171836

IPC: G06F17/30

Language of the proceedings: EN

Title of invention:

Function key for computer data handling

Patent Proprietor:

Arendi S.A.R.L.

Headword:

Function key for data handling/ARENDI

Relevant legal provisions:

EPC Art. 123(2), 123(3)

Keyword:

Amendments - allowable (yes) - broadening of claim (no) -
inescapable trap (no)
- occasioned by ground for opposition

Decisions cited:

G 0001/93, G 0002/98, G 0002/10, T 0135/86, T 0384/91,
T 0340/05

Catchword:

See points 8.2 to 8.2.12



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Case Number: T 1779/09 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 21 May 2014

Appellant: Arendi S.A.R.L.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 9 July 2009
revoking European patent No. 1171836 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman R. Moufang
Members: P. San-Bento Furtado
R. de Man
M. Rognoni
T. Karamanli

Summary of Facts and Submissions

- I. Arendi Holding Limited (the then appellant and patent proprietor) lodged an appeal against the Opposition Division's decision revoking European patent No. 1 171 836 in accordance with Article 101(2) and (3)(b) EPC.

- II. Claim 1 of the granted patent read as follows:

"Method of providing a function item tied to a user operation in a document handling computer program, said user operation initiating retrieval of a name, address and/or other person or company related information from outside said program, comprising analysing said document, previously typed by a user, to identify only parts of the document, said parts comprising name, address and/or person or company related information and being used as search terms, a single activation of said function item leading to a search, using said search terms, in a database or file containing name, address, and/or other person or company related information available on or through the computer, and displaying said information found in said database or said file."

- III. Notice of opposition was filed by the former opponent (former respondent) against the patent as a whole on the basis of Article 100(a), (b) and (c) EPC.

- IV. In the contested decision posted on 9 July 2009 the Opposition Division held that the ground for opposition mentioned in Article 100(c) together with Article 123(2) EPC prejudiced the maintenance of the patent. The decision was based on the claims as granted

as main request and on the claims of auxiliary requests 1 to 16 filed with the letter dated 26 March 2009. The amended auxiliary requests 1 to 6 filed during the oral proceedings at 15.30 hrs and said to replace the previously filed auxiliary requests in case they were admitted into the proceedings were not admitted by the Opposition Division because it was *prima facie* apparent that they did not comply with Article 123(2) EPC. A further amended auxiliary request 1 filed during the oral proceedings at 18.00 hrs was not admitted as being not clearly allowable under Article 123(2) EPC.

- V. The Opposition Division concluded that claim 1 of the patent as granted extended beyond the content of the application as filed in view of two amended features, namely the feature "in a document handling program" and the feature "to identify only parts of the document, said parts comprising ... and being used as search terms". The auxiliary requests 1 to 16 were also found to infringe Article 123(2) EPC since claim 1 of all these requests contained the second above-mentioned feature. With respect to the amended auxiliary requests filed during the oral proceedings, the Opposition Division considered that all of them contained features that were not clearly and unambiguously disclosed in the application as filed. *Inter alia*, the feature "to identify only a name, and/or address or email address, mailing list/category name[,] telephone number, or fax number and being used as a search term" which was contained in the amended auxiliary requests 1 to 6 filed at 15.30 hrs and the corresponding feature "to identify only a name and/or address and being used as a search term" of the further amended auxiliary request 1 filed at 18.00 hrs were found to infringe Article 123(2) EPC, since the application disclosed only the use of a name or of a name together with an

- address as a search term, but not of any other item and not of an address alone.
- VI. The then appellant requested with the statement of grounds of appeal dated 19 November 2009 that the patent be maintained in amended form on the basis of a new main request or one of five new auxiliary requests, all filed with the statement. It further requested that the matter be remitted to the Opposition Division if the requirements of Article 123(2) EPC were met.
- VII. In its reply dated 25 March 2010 the former respondent filed requests and detailed arguments with respect to objections under Article 100(a), (b) and (c) EPC.
- VIII. A transfer of the patent in suit to Arendi S.A.R.L., with effect from 9 December 2010, was registered. Arendi S.A.R.L. thereby obtained the status of appellant.
- IX. With letter dated 2 December 2011 the former respondent withdrew the opposition.
- X. In reply to the submissions of the former respondent, with letter dated 29 May 2012 the appellant filed an amended main request and five auxiliary requests, as well as further arguments.
- XI. The Board summoned the appellant to oral proceedings. In a communication accompanying the summons, the Board summarised the issues likely to be discussed at the oral proceedings. None of the requests appeared to fulfil the requirements of Article 123(2) EPC. Furthermore, the Board stated that it was not fully convinced that any of the requests was compliant with Article 123(3) EPC. It informed the appellant that it

was inclined, in case all objections were overcome, to remit the case to the Opposition Division for assessment of novelty and inventive step, in line with the appellant's request.

- XII. With letter dated 22 April 2014 the appellant filed a new main request and four auxiliary requests. All requests included the same dependent claims 2 to 15.
- XIII. At the oral proceedings held on 21 May 2014, following a discussion of issues related to Article 123(3) EPC, the appellant filed amended requests. After further discussion, the appellant replaced all pending requests with a sole request comprising claim 1 as filed at 17.00 hrs during the oral proceedings and claims 2 to 15 as filed with the letter dated 22 April 2014. At the end of the oral proceedings the chairman announced the Board's decision.
- XIV. The appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution.
- XV. Claim 1 of the sole request reads as follows:

"Method of providing a function item within a word processor displaying a document, tied to a user operation in said word processor, said user operation initiating retrieval of a name, address and/or other person or company related information from outside said word processor, comprising
a single activation of said function item leading
to an analysis of what a user has previously typed
in said document to identify only a name and/or
address, being used as search terms, wherein said
analysis is performed by a computer program, and,

after the analysis, to a search, using said search terms, in a database or file containing the name, address, and/or other person or company related information available on or through the computer, and
to a display of said retrieved information found in said database or said file."

Reasons for the Decision

1. The appeal is admissible.
2. The appellant's sole request was filed at a very late stage, i.e. during the oral proceedings before the Board. Nevertheless, in the exercise of its discretion under Article 13(1) RPBA, the Board admits this request since it was filed as a reaction to the specific objections raised against the appellant's previous requests during the oral proceedings. It does not raise any issue which the Board could not reasonably be expected to deal with without adjournment of the oral proceedings (see Article 13(3) RPBA).
3. In accordance with established case law, the former respondent, by withdrawing the opposition, ceased to be party to the appeal proceedings in respect of all the substantive issues, which are the only issues under consideration in the present case. The proprietor's appeal against the decision to revoke its patent and its request to maintain the patent in amended form are not affected by the former respondent's withdrawal of the opposition. The Board has to re-examine the substance of the Opposition Division's decision insofar as it is still relevant for the allowability of the appellant's new request. Relevant arguments of the

former respondent should also be considered in the appeal proceedings (see e.g. T 135/86 of 19 June 1989, Reasons 2, T 340/05 of 6 June 2007, Reasons 2, and the further decisions cited in Case Law of the Boards of Appeal of the EPO, 7th ed., sub IV, C.4.1.2, penultimate paragraph).

4. The patent relates to a method for providing a function item such as a key, button, icon, or menu, in a program such as a word processor, which, upon activation by the user, initiates a program to look up data corresponding to the name and/or address that the user typed, or partly typed. The data is retrieved from an external database or file, and includes name and addresses and/or other person or company related information. The retrieved data is displayed and possibly entered into the word processor.

According to an exemplary embodiment (see paragraph [0017] of the patent description) the program examines what the user has typed in the document, analysing for example line separations, paragraphs or formatting of the document or strings commonly used in addresses and names, such as "street", "avenue", "lane", "Mr.", "Mrs.", "Frau", "Herr", designators and abbreviations, or names from a database of common male/female names.

5. The contested decision held that all the requests submitted by the appellant in the first-instance proceedings (i.e. the claims of the patent as granted, auxiliary requests 1 to 16 and the further auxiliary requests filed in the oral proceedings) did not comply with Article 123(2) EPC (see sections IV and V above). The Board therefore has to examine whether claim 1 of the appellant's sole request (see section XV) contains

- subject-matter which extends beyond the content of the application as filed. Insofar as this claim has been amended over claim 1 of the patent as granted (see section II), the Board furthermore has to assess whether these amendments comply with the requirements of Articles 84 and 123(3) as well as of Rule 80 EPC.
6. Whereas claim 1 of the patent as granted was to a "method of providing a function item tied to a user operation in a document handling computer program ...", the claimed method is now defined as being a "method of providing a function item within a word processor displaying a document, tied to a user operation in said word processor, ...". Similarly, the feature "from outside said program" was changed into "from outside said word processor". In the Board's understanding these amendments essentially aim at replacing the broader term "document handling computer program" with the term "word processor" in order to overcome the Opposition Division's objection that the feature "in a document handling program" was more general than the original disclosure. The amended wording has a basis in the application as filed (see e.g. page 2, lines 3 to 10, and page 4, lines 5 to 11, of the published application), is sufficiently clear and occasioned by a ground for opposition, i.e. Article 100(c) EPC. The amendments therefore comply with Articles 84 and 123(2) and (3) and Rule 80 EPC.
7. The method according to claim 1 of the granted patent was defined as "comprising analysing said document ..., a single activation of said function item leading to a search ... and displaying said information ...". The definition has now been restructured as "comprising a single activation of said function item leading to an analysis ... and, after the analysis, to a search ...

and to a display ...". This amendment clarifies that the analysis of what the user has previously typed in the document is performed upon activation of the function item. It is based on the disclosure of the application as filed (see e.g. page 5, lines 22 to 25, of the description and the flowcharts of Fig. 1 and Fig. 2) and is aimed at overcoming a corresponding objection raised by the Board under Article 123(2) EPC. The amendment is clear and does not extend the scope of protection of the patent as granted since, according to the Board's understanding, claim 1 as granted did not prescribe a particular sequence in which the steps of "analysing" and "activation of the function item" were to be performed. The restructuring of claim 1 therefore complies with Articles 84 and 123(2) and (3) as well as with Rule 80 EPC.

8. The definition of the analysing step in claim 1 as granted ("analysing said document, previously typed by a user, to identify only parts of the document, said parts comprising name, address and/or person or company related information and being used as search terms") has been replaced by the following definition:
"analysis of what a user has previously typed in said document to identify only a name and/or address, being used as search terms, wherein said analysis is performed by a computer program".

- 8.1 A first issue to be addressed is whether this amendment extends the scope of protection conferred by the patent as granted. The former respondent argued that the formulation "to identify a name (and/or address)" was not a mere restriction of the analysis step of granted claim 1, but amounted to a completely different step. The identification of e.g. a specific paragraph or even a complete document (which also had to be regarded as a

part of this document within the meaning of claim 1 as granted) had nothing in common with the identification of a very specific item of information. Deletion of the terms "parts of the documents, said parts comprising" therefore amounted to an inadmissible replacement of the kind of identification step, i.e. to an *aliud*. The Board considers that, in a similar vein, it could furthermore be argued that replacing the object of the analysis ("said document") with the term "what a user has previously typed in said document" constituted an *aliud*.

In the Board's view, the above arguments could only be followed if the definition of the analysing step in granted claim 1 had to be understood in a very narrow sense, i.e. as requiring an analysis of the full document and thereby excluding an analysis of only parts of the documents (such as "what the user has previously typed in said document") or as requiring an identification of something more than specific items of information (such as "a name and/or address").

The wording of granted claim 1 gives little support for such a narrow understanding. "Analysing said document" is a broad formulation which encompasses the analysis of merely a part of the document. Granted claim 1 defines a method carried out in a document handling computer program, on a document that is in the process of being created. Thus "analysing said document" in the granted claim is not limited to the analysis of the whole document. "To identify only parts of the documents, said parts comprising name, address and/or ..." is likewise a broad formulation which encompasses the identification of only a name and/or an address. Both expressions refer to the underlying aim of identifying the name and/or address in order to use

them as search terms. In the context of the method as described in amended claim 1 the identified name and/or address are also understood as parts of the document typed by the user. This interpretation of claim 1 is also in line with the description (see the exemplary embodiment referred to in point 4 above).

The further amendments made to the analysing step of claim 1, i.e. the restriction of the items of information to "name and/or address" and the added feature according to which the analysis is performed by a computer program, are of limiting nature and do not extend the scope of protection.

The amended definition of the analysing step therefore complies with Article 123(3) EPC.

8.2 A second issue to be addressed is whether the definition of the analysing step in claim 1 fulfils the requirements of Article 123(2) EPC.

8.2.1 The former respondent objected to the term "to identify" as having no basis in the application as filed. Even though the original application did indeed not use this term explicitly, it is clear from its description (see, for example, the passages on page 5, lines 24 and 29 to 38, and page 6, lines 3, 15 and 16) that strings corresponding to names or addresses are recognised, i.e. identified, by an analysis of what the user has typed in the document and are thereafter used as search terms.

8.2.2 The Opposition Division was of the opinion that the application as filed did not disclose that an identified address could be used as a search term alone. For this reason the Division refused to admit

the further amended first auxiliary request 1 filed during the oral proceedings at 18.00 hrs into the proceedings (see section V above). However, in the Board's view, the original description contains passages which unambiguously disclose the feature objected to. The passage on page 2, lines 20 to 30, reads as follows: "The click on the function item initiates a program [...] to search a database [...] in order to look up data corresponding to what the user types, or partly types, e.g. name and/or address [...]". The further passage on page 14, lines 27 to 34, states the following: "Although the present invention is defined in terms of a program retrieving a name or portion thereof from a document before searching a database, the program may retrieve an address or portion thereof from the document before searching the database and insert, correct, complete, etc., the retrieved address based on the information found in the database corresponding to the retrieved address or portion thereof, [...]".

- 8.2.3 A further feature of the analysing step of claim 1 is the identification of **only** a name and/or address, being used as search terms. The term "only" was already contained in claim 1 as granted, albeit in relation to "parts of the document, said parts comprising name, address ...", and therefore, as a feature of the granted claim, cannot be objected to for lack of clarity under Article 84 EPC. However, in both contexts, i.e. in claim 1 as granted and in claim 1 as now amended, the term leaves room for interpretation.

In the appeal proceedings the appellant argued that the term "only" did not restrict the search items to be exclusively those mentioned in the claim. It merely specified that that which had to be identified was one

of the listed items of information, i.e. only a part of the document and not the whole document. Also the identification of the specifically mentioned items together with other items would be encompassed by the claim.

However, the Board is reluctant to give the term "only", which was introduced into claim 1 during the examination proceedings and which is now maintained in the appellant's amended claim 1, a meaning which would make it basically redundant. The granted claim 1 could be reasonably interpreted as restricting that which had to be identified exclusively to those document parts comprising the specifically listed items. Similarly, the amended claim 1 has to be understood as restricting the items to be identified (and afterwards used as search terms) exclusively to a name and/or address.

- 8.2.4 The application as filed does not contain explicit teaching according to which the identifying step must be directed only (in the sense of exclusively) to a name and/or an address. The Board also has strong doubts whether such teaching can be regarded as implicitly disclosed in the context of all three claimed alternatives (i.e. identifying only a name, identifying only an address and identifying only a name and an address). During the appeal proceedings the appellant did not provide any detailed argument as to which passages of the original description could provide a sufficient basis for such an implicit disclosure. The appellant nevertheless maintained that, notwithstanding the possible lack of basis of an unambiguous disclosure, claim 1 should be found to comply with Article 123(2) EPC, since the feature at issue was added during examination, did not provide a technical contribution to the subject-matter of the

claimed invention and merely limited the protection conferred by the patent. In this respect, the appellant relied on Enlarged Board of Appeal decision G 1/93 (OJ EPO 1994, 541 - Limiting feature/ADVANCED SEMICONDUCTOR PRODUCTS).

8.2.5 In decision G 1/93 the Enlarged Board answered the referred question of law by stating (as Headnote 1, point 1 of the Order) the following principles: "If a European patent as granted contains subject-matter which extends beyond the content of the application as filed in the sense of Article 123(2) EPC and which also limits the scope of protection conferred by the patent, such patent cannot be maintained in opposition proceedings unamended, because the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent. Nor can it be amended by deleting such limiting subject-matter from the claims, because such amendment would extend the protection conferred, which is prohibited by Article 123(3) EPC. Such a patent can, therefore, only be maintained if there is a basis in the application as filed for replacing such subject-matter without violating Article 123(3) EPC."

8.2.6 The Enlarged Board recognised and accepted that these principles could operate rather harshly against an applicant, who ran the risk of being caught in an inescapable trap and losing everything by amending his application, even if the amendment is limiting the scope of protection (see Reasons 13).

The Enlarged Board, however, went on to consider whether a limiting feature (without basis) necessarily had always to be regarded as subject-matter extending beyond the content of the application as filed. This

question had to be answered in the light of the overall purpose of Article 123(2) and (3) EPC to create a fair balance of interests (see Reasons 15).

As emphasised in point 2 of the Enlarged Board's answer (Order) to the referred question (Headnote II), "a feature which has not been disclosed in the application as filed but which has been added to the application during examination and which, without providing a technical contribution to the subject-matter of the claimed invention, merely limits the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, is not to be considered as subject-matter which extends beyond the content of the application as filed within the meaning of Article 123(2) EPC. The ground for opposition under Article 100(c) EPC therefore does not prejudice the maintenance of a European patent which includes such a feature."

- 8.2.7 The above principles have been confirmed in subsequent Enlarged Board case law. Opinion G 2/98 (OJ EPO 2001, 413) concerned the interpretation of the concept of "the same invention" referred to in Article 87(1) EPC. While the Enlarged Board criticised a former decision by a technical board which, in this context, had made a distinction between technical features which are related to the function and effect of the invention and technical features which are not, it did not see any conflict with its earlier decision G 1/93 and stated: "In decision G 1/93 [...], relating to the conflicting requirements of Article 123(2) and (3) EPC, a distinction is made between features providing a technical contribution to the subject-matter of the claimed invention and features which, without providing

such contribution, merely exclude protection [...]. Hence, decision G 1/93 deals with a completely different legal situation."

8.2.8 Decision G 2/10 (OJ EPO 2012, 376 - Disclaimer/SCRIPPS), which dealt with the issue of so-called "positively disclosed disclaimers", thoroughly discussed the requirement of Article 123(2) EPC and the basic principle underlying it. Considering the conclusions reached in decision G 1/93, the Enlarged Board stated (Reasons 4.3) the following: "It is, however, evident from the context of these findings that by introducing the 'technical contribution' criterion the Enlarged Board did not intend to amend the definition concerning when an amendment is allowable under Article 123(2) EPC generally, but that it only sought a way of avoiding the potentially fatal consequences of the patentee being caught in the 'inescapable trap' between the requirements of paragraphs (2) and (3) of Article 123 EPC (Reasons 13)."

8.2.9 It follows from the above that a limiting feature which generally would not be allowable under Article 123(2) EPC can, under certain conditions, nevertheless be maintained in the claim of an opposed patent in the particular situation addressed in decision G 1/93. It then complies with Article 123(2) EPC by way of a legal fiction.

8.2.10 In the present case, the appellant has found itself exactly in the situation envisaged in decision G 1/93. The term "only" was introduced during the examination proceedings and successfully objected to under Article 100(c) EPC in proceedings before the Opposition Division by the former respondent. Since the Board

considers the term to be truly limiting (see above point 8.2.3), its deletion would extend the protection conferred and thereby infringe Article 123(3) EPC.

8.2.11 Consequently it has to be examined whether the limiting feature "only" provides a technical contribution to the subject-matter of the claimed invention. The application describes that the text typed by the user is analysed to find strings corresponding to names and/or addresses, for example, "street, avenue, drive, lane, boulevard, [...] Mr., Mrs., Sir, Frau, Herr, Madam, Madame" or common names. The fact that these identified items (which are then used as search terms) are now limited to **only** a name and/or address, excluding the possibility of additionally identifying other items to be used as search terms, does not change the solution of identifying common strings corresponding to search terms. In particular the other features of the claimed invention do not have to be changed or adapted due to the now mandatory exclusion of other search terms. The principle of the invention aiming at identifying search terms based on the name and/or address, by finding common strings, does not have to be modified. No program code is needed to exclude other items from the search. Therefore, the exclusive limitation of the search terms to a name and/or address does not influence the solution of the technical problem as understood from the application as originally filed, and hence provides no technical contribution to the claimed invention (see also decision T 384/91, OJ EPO 1995, 745, Headnote II). It merely excludes protection of part of the invention described in the application, thus not giving any unwarranted advantage to the applicant.

- 8.2.12 The definition of the analysing step in claim 1 of the appellant's sole request is therefore deemed to comply with Article 123(2) EPC.
- 8.3 Insofar as the definition of the analysing step contains amendments compared with claim 1 as granted (see point 8 above), the Board has no objection under Article 84 or Rule 80 EPC. In particular, it is noted that the limiting feature "performed by a computer program" appears to have been introduced by the appellant in view of prior art cited by the former respondent and is therefore occasioned by a ground for opposition.
9. It follows from the above that independent claim 1 of the appellant's sole request is allowable under Articles 84, 123(2) and (3) and Rule 80 EPC.
10. In accordance with the appellant's procedural request and in order not to deprive it of the possibility of having the remaining substantive issues considered by two instances, the Board remits the case to the department of first instance for further prosecution. Depending on the assessment of the remaining issues, the claims may have to be amended further. Under these circumstances, the Board refrains from dealing with the dependent claims.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



I. Aperribay

R. Moufang

Decision electronically authenticated