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**Datasheet for the decision
of 23 October 2014**

Case Number: T 2105/09 - 3.5.07

Application Number: 01934948.9

Publication Number: 1281133

IPC: G06F17/00, G06F17/30

Language of the proceedings: EN

Title of invention:

Method and system for retrieving search results from multiple
disparate databases

Applicant:

Webfeat, Inc.

Headword:

Retrieving search results/WEBFEAT

Relevant legal provisions:

EPC R. 111(2), 103(1) (a)

Keyword:

Substantial procedural violation - appealed decision
sufficiently reasoned (no)
Remittal to the department of first instance - fundamental
deficiency in first instance proceedings (yes)

Decisions cited:

T 0278/00, T 1709/06

Catchword:



**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 2105/09 - 3.5.07

**D E C I S I O N
of Technical Board of Appeal 3.5.07
of 23 October 2014**

Appellant: Webfeat, Inc.
(Applicant) Suite 15E,
865 1st Avenue
New York, NY 10017 (US)

Representative: Rupp, Christian
Mitscherlich PartmbB
Patent- und Rechtsanwälte
Postfach 33 06 09
80066 München (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 25 May 2009
refusing European patent application No.
01934948.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman R. Moufang
Members: R. de Man
M. Rognoni

Summary of Facts and Submissions

- I. The applicant (appellant) lodged an appeal against the decision of the Examining Division refusing European patent application No. 01934948.9.
- II. The Examining Division decided that neither the main request nor the auxiliary requests I and II fulfilled the requirements of Article 123(2) EPC. In an *obiter dictum*, it gave reasons why the subject-matter of "claim 1" was not inventive, albeit with reference to documents identified only as D1, D6 and D7.
- III. With the notice of appeal, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims according to the main request or according to "the auxiliary request" filed with the letter of 7 April 2009.
- IV. With the statement of grounds of appeal the appellant "deleted in their entirety" the claims of the main request and of auxiliary request I, and filed an auxiliary request II and an auxiliary request III. Both auxiliary request II and auxiliary request III were based on auxiliary request II as refused by the Examining Division. In particular, auxiliary request II corresponded to auxiliary request II as refused by the Examining Division with a minor editorial amendment of the independent claims.

The appellant further requested oral proceedings.
- V. The Board issued a communication pursuant to Rule 100(2) EPC.

The appellant was understood to request that the decision under appeal be set aside and that a patent be granted on the basis of the claims of auxiliary request II or, in the alternative, on the basis of the claims of auxiliary request III.

The Board expressed the preliminary view that the contested decision was at least insufficiently reasoned, that this deficiency amounted to a substantial procedural violation, and that the Board was minded to set aside the decision under appeal, to remit the case to the department of first instance for further prosecution, and to order reimbursement of the appeal fee under Rule 103(1)(a) EPC.

The appellant was asked to indicate whether it agreed to a remittal, or whether it wished to maintain its unconditional request for oral proceedings.

- VI. With a letter dated 20 August 2014, the appellant agreed to remittal of the case to the department of first instance for further prosecution, provided that reimbursement of the appeal fee was ordered by the Board.

Reasons for the Decision

1. The appeal complies with the provisions referred to in Rule 101 EPC and is therefore admissible.
2. *The decision under appeal*
 - 2.1 According to Rule 111(2) EPC, decisions of the European Patent Office which are open to appeal shall be reasoned. The reasoning given has to enable the

appellant(s) and the board of appeal to examine whether the decision was justified or not. A decision therefore should discuss in detail the facts, evidence and arguments which are essential to the decision. It has to contain a logical chain of reasoning which led to the relevant conclusion. See e.g. decision T 278/00, OJ EPO 2003, 546, reasons 2.

2.2 According to the decision under appeal, the then main request, auxiliary request I and auxiliary request II did not fulfil the requirements of Article 123(2) EPC. In order to comply with Rule 111(2) EPC, the decision should be sufficiently reasoned with respect to each of these findings.

2.3 Claim 1 of the then main request reads as follows:

"A searching system for retrieving search results from a plurality of databases (18a-h), comprising computer software that transparently and automatically manages one or more disparate authorization steps, including: an interface (12) configured to receive search information;
an authentication manager for accessing authentication information of a user stored in a central database; and a plurality of translators (16a-h) configured to access, query and retrieve and display search results concurrently from said plurality of databases (18a-h) respectively based on said search information;
wherein each of the plurality of translators (16a-h) includes a first set of sub-session managements which authenticate by user basis to licensed information resources or to databases, and a second set of sub-session managements which authenticate by system basis to licensed information resources or to databases;

wherein each of said plurality of translators (16a-h) formulates a search request using said search information and syntax and protocol information specific to its corresponding database; and wherein said plurality of translators (16a-h) use said respective search requests to retrieve said search results from their corresponding databases (18a-h) in a concurrent manner; and wherein each of said translators (16a-h) is further configured to perform one or more authorization steps without any user interaction, so as to communicate with its corresponding database (18a-h), wherein the authentication information is used to gain database access on the user's behalf."

Claim 1 of the then auxiliary request I reads as follows:

"A searching system comprising computer software that transparently and automatically manages one or more disparate authorization steps, including:

authentication and session management, required for one or more users to access, query and retrieve and display results concurrently from multiple licensed information resources or databases,

wherein the session management comprises:

a first set of sub-session managements which authenticate by user basis to licensed information resources or to databases; and

a second set of sub-session managements which authenticate by system basis to licensed information resources or to databases."

Claim 1 of the then auxiliary request II reads as follows:

"A searching system for retrieving search results from a plurality of databases (18a-h), comprising computer software that transparently and without any user interaction manages one or more authorization steps, including:
an interface (12) configured to receive search information and to display search results;
a plurality of translators (16a-h) configured to concurrently access the databases (18a-h), concurrently query search requests and concurrently retrieve the search results from said plurality of databases (18a-h) respectively based on said search information;
wherein each of the plurality of translators (16a-h) is configured to perform one or more authorization steps without any user interaction, so as to communicate with its corresponding database (18a-h), and is configured to use userIDs and passwords and IP authentication, when databases (18a-h) are accessed;
wherein each of said plurality of translators (16a-h) formulates a search request using said search information and syntax and protocol information specific to its corresponding database (18a-h); and
wherein said plurality of translators use said respective search requests to retrieve said search results from their corresponding databases (18a-h) in a concurrent manner."

2.4 The first paragraph of section II ("Grounds for the decision") of the decision under appeal reads:

"The main request and first auxiliary request do not fulfil the requirements of Article 123(2) EPC because the amendment 'wherein each of a plurality of translators includes a first set of sub-session managements which authenticate by user basis to licensed information resources or to databases, and a

second set of sub-session managements which authenticate by system basis to licensed information resources or to databases' can not be derived directly and unambiguously from the whole application as originally filed, and particularly not from the basis provided by the applicant."

No further reasoning is given as to why said amendment infringes Article 123(2) EPC.

- 2.4.1 This paragraph does not refer to any particular claim, but it appears that the Examining Division intended to refer to claim 1. The wording objected to is indeed present in claim 1 of the then main request. Claim 1 of the then auxiliary request I does not refer to "a plurality of translators", but it does contain the wording "a first set of sub-session managements ... and a second set of sub-session managements ...".
- 2.4.2 The statement that a particular feature cannot be derived directly and unambiguously from the whole application as originally filed is merely an allegation that has still to be substantiated. The addition "and particularly not from the basis provided by the applicant", without indicating what basis was provided by the applicant together with an explanation why the Examining Division considered this basis insufficient, is unsuitable to serve as the required substantiation.
- 2.4.3 The Board notes in this respect that in its letter of 7 April 2009 the appellant referred to the description on page 12, line 15, to page 13, line 15, which disclosed the authentication of the system 10 by the translators 16 on the databases 18, and to page 13, lines 2-4, which disclosed that "the same translator 16 can be used in one environment that uses user IDs and

passwords, and in a different environment where IP authentication is used". The decision should have contained a statement, however short, that enables the appellant and the Board to understand why these indications did not convince the Examining Division, but it does not.

The Board could of course itself examine the compliance of the amended claims with Article 123(2) EPC and then compare its findings with those of the Examining Division, but the point of the requirement for a decision to be reasoned is that the deciding body does not merely state its findings, but also explains how it arrived at them in a verifiable manner.

2.4.4 This objection is hence insufficiently reasoned in respect of the then main request and of the then auxiliary request I.

2.5 Section II of the decision under appeal further contains the following objection:

"Additionally the amendments introduced with the three requests combine features from different embodiments:

- in claim 1 the authentication manager for accessing authentication information of a user stored in a central database is based on the embodiment described on page 13, lines 8-10. In the last paragraph of claim 1 the '...wherein the authentication information is used to gain database access on the user's behalf' is based on the same embodiment described on page 13, lines 12-13.
- in the last paragraph of claim 1 'wherein each of said translators is further configured....so as to

communicate with its corresponding database ...'
is based in originally filed claim 7.

- also in the last paragraph of claim 1 the '...
without any user interaction...' is based on a
different embodiment on page 12, lines 24-25.

No basis has been found or provided to justify clearly
and unambiguously the combination of two different
embodiments plus a dependent claim."

- 2.5.1 A comparison with the text of claim 1 of each of the
three requests shows that the references to "claim 1"
in this objection can only be understood as referring
to claim 1 of the then main request.
- 2.5.2 In fact, none of the features referred to is present in
claim 1 of the then auxiliary request I. The objection
is hence insufficiently reasoned in respect of the then
auxiliary request I.
- 2.5.3 Claim 1 of the then auxiliary request II refers neither
to an authentication manager nor to authentication
information stored in a central database. This claim
does contain, albeit not in its last paragraph, the
wording "wherein each of the plurality of translators
(16a-h) is configured to perform one or more
authorization steps without any user interaction, so as
to communicate with its corresponding database".

The objection is to a particular combination of
features. This combination is not present in claim 1 of
the then auxiliary request II. It could be argued that
the objection is to be understood as also applying to a
subset of these features, but the decision contains no
such suggestion and a reasoned decision should not

leave it to the reader to speculate what might have been meant.

The objection is hence insufficiently reasoned in respect of the then auxiliary request II as well.

- 2.5.4 The Board also considers the reasoning recited in point 2.5 above to be deficient in respect of the then main request.

The Examining Division did not explain how, in its view, the two passages from the description and originally filed claim 7 exactly related to each other. It is however evident that originally filed claim 7 corresponds to the embodiment described on page 12, line 15, to page 13, line 6. The point of the objection hence appears to be that the application as filed provides no basis for a combination of the passage on page 12, line 15, to page 13, line 6, with the passage on page 13, lines 8 to 14. In essence, the first passage relates to authentication to databases 18a-h by translators 16a-h "without any user interaction", and the second relates to an authentication manager accessing a central database to acquire authentication information for the various databases 18a-h.

In its letter dated 7 April 2009 on page 4, first full paragraph, the appellant, although consistently referring to "authorization" instead of "authentication", specifically addressed this point. The appellant essentially submitted that the skilled person reading the application as a whole would understand that the authentication information which was to be used to gain access to databases 18a-h was used by the translators 16a-h, which the application

disclosed as the entities gaining access to databases 18a-h.

In its decision, the Examining Division merely stated that "[n]o basis has been found or provided to justify clearly and unambiguously the combination of two different embodiments plus a dependent claim". This failure to address the appellant's specific argument on a crucial point of dispute constitutes an infringement of Rule 111(2) EPC (see e.g. decision T 1709/06, reasons 1.2.4).

2.6 The Board hence concludes that the contested decision is insufficiently reasoned within the meaning of Rule 111(2) EPC. This deficiency amounts to a substantial procedural violation.

3. *Remittal to the department of first instance*

3.1 According to Article 11 RPBA, a board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first-instance proceedings, unless special reasons present themselves for doing otherwise. The duration of the grant proceedings could in principle qualify as such a special reason. The Board has therefore considered whether it should take a decision on the substantive merits of the application, in particular in view of the inventive step reasoning included in the appealed decision by way of *obiter dictum*.

However, as explained in the Board's communication under Rule 100(2) EPC, this inventive step reasoning is of a rather schematic nature and not based on a detailed analysis of the full wording of any claim then pending. While this reasoning, not formally being part

of the grounds for the refusal, cannot be criticised for failing to meet any procedural requirements of the EPC, it also does not constitute a proper basis for examination of inventive step by the Board.

It is therefore appropriate to remit the case to the department of first instance for further prosecution.

- 3.2 Since the decision under appeal was affected by a substantial procedural violation in respect of the refusal of the then auxiliary request II, and as the primary claim request filed by the appellant with the statement of grounds (also labelled "auxiliary request II") essentially corresponds to this request, the substantial procedural violation was causal for the appeal. Reimbursement of the appeal fee under Rule 103(1) (a) EPC is therefore equitable.

4. Given that the appellant was asked to indicate whether it agreed to a remittal or whether it wished to maintain its unconditional request for oral proceedings, and responded in its letter dated 20 August 2014 by agreeing to a remittal provided that the appeal fee was reimbursed, the Board interprets said letter as implying a conditional withdrawal of the request for oral proceedings. Since the condition for the withdrawal is fulfilled, the present decision can be taken without holding oral proceedings.

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.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:



I. Aperribay

R. Moufang

Decision electronically authenticated