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Datasheet for the decision
of 17 September 2013

Case Number: T 2379/09 - 3.5.06

Application Number: 00977108.0

Publication Number: 1337920

IPC: G06F 11/00

Language of the proceedings: EN

Title of invention:
A system and method for replaying a predefined path through
the internet

Applicant:
BMC Software

Headword:
Replaying web page requests/BMC

Relevant legal provisions:
EPC Art. 123(2)

Relevant legal provisions (EPC 1973):
EPC Art. 84

Keyword:
"Ground for refusal (added subject matter) overcome by
amendment"
"Clarity objections made *obiter* also overcome by amendment"
"Inventive step not conclusively discussed during examination"
"Remittal for further prosecution"

Decision cited:
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Catchword:
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                       It can be changed at any time and without notice.

Case Number: T 2379/09 - 3.5.06

D E C I S I O N
of the Technical Board of Appeal 3.5.06
of 17 September 2013

Appellant:　　　　　　　BMC Software
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Decision under appeal:　**Decision of the Examining Division of the**
　　　　　　　　　　　　　　European Patent Office posted 21 July 2009
　　　　　　　　　　　　　　refusing European patent application
　　　　　　　　　　　　　　No. 00977108.0 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman:　　　D. H. Rees
Members:　　　　M. Müller
　　　　　　　　　M.-B. Tardo-Dino

C9573.D

Summary of Facts and Submissions

I.   The appeal lies against the decision of the examining
       division, with written reasons dispatched on 21 July
       2009, to refuse the European patent application no.
       00977108.0 because it did not comply with Article 123(2)
       EPC. In an *obiter dictum* the decision also raised
       objections under Article 84 EPC 1973.

II.   A notice of appeal was filed on 21 September 2009, the
       appeal fee being paid on the same day. A statement of
       grounds of appeal was received on 20 November 2009. The
       appellant requested that the decision under appeal be
       set aside and that a patent be granted based on
       claims 1-23 filed with the grounds of appeal, in
       combination with the description pages 1, 1a, 1b, 3, 3a,
       3b, 4, 4a, 4b, 9 and 9a and drawings sheet 1/1 as filed
       with the grounds of appeal and description pages 2 and
       5-8 as published.

III.   With a summons to oral proceedings, the board informed
       the appellant about its preliminary opinion according
       to which the main ground for refusal, Article 123(2)
       EPC, was overcome by the amended claims. The board
       raised a few clarity objections and expressed its in-
       tention to remit the case for further prosecution
       should these clarity objections be overcome.

IV.   In response to the summons, with letter dated 10 August
       2013, the appellant filed an amended set of claims 1-23
       and requested that the case be remitted to the
       examining division without holding oral proceedings.

V.   The board then cancelled the oral proceedings.

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VI.   Independent claims 1 and 13 read as follows:

"1. An iterative process for replaying a predefined
path from an intermediate server (10) through a set of
web pages in the order the web pages were originally
made,

    wherein requests for the web pages have been saved
in a request history built by the intermediate server
(10) prior to the replay process, during the process
beginning from a starting URL of an originating web
page (35) repeating the following steps until the path
has been fully replayed or an error has occurred:

    selecting a saved request for a target web page (36)
from the request history;

    if the selected request is a form request, selecting
(90) a best-fit form to which a replay request for the
target web page (36) should be later made from a set of
forms in the originating web page (35), in order to
avoid errors due to expiration or change in dynamic
content when replaying the target web page (36);

    if the selected request is not a form request,
selecting (110) a best-fit URL in the originating web
page (35) as a target URL to which a subsequent replay
request should be made; and

    sending (140) the replay request for the target web
page (36) to a target web server (30), the replay
request made to the selected best-fit form or to the
best-fit URL.

13. A system for replaying a predefined path through a
set of web pages from an intermediate server (10) in
the order the web pages were originally made,

wherein requests for the web pages have been saved in a request history built by the intermediate server (10) prior to replaying the path,

the system comprising: a computer readable medium; and a set of software instructions stored on the computer readable medium operable to cause a computer to beginning from a starting URL of an originating web page (35) repeat the following steps until the path has been fully replayed or an error has occurred:

select a saved request for a target web page (36) from the request history;

if the selected request is a form request, select (90) a best-fit form to which a replay request for the target web page (36) should be later made from a set of forms in the originating web page (35), in order to avoid errors due to expiration or change in dynamic content when replaying the target web page (36);

if the selected request is not a form request, select (110) a best-fit URL in the originating web page (35) as a target URL to which a subsequent replay request should be made; and

send (140) the replay request for the target web page (36) to a target web server (30), the replay request made to the selected best-fit form or to the best-fit URL."

Reasons for the Decision

The invention

1.   The application generally relates to the problem of assessing whether a web site achieves the company's per-formance goals and quality standards. A known way to do

this is, according to the description, to record the a
"user's path" through a web site in terms of the HTTP
requests made by the user and to "replay" it later so
that the owner of the web site can reproduce the user
experience of the web site (see description, p. 1,
lines 11-19; this and all further references herein to
the description relating to the application as pub-
lished). It is explained that this technique, when limi-
ted to "simply replaying a series of requests", does not
work for dynamic content (session IDs, forms) because
some of it may no longer be available at the time of
replay. A naive replay of dynamic content will thus
cause errors (see p. 1, lines 21-23; p. 6, line 33 - p.
7, line 1).

1.1   The invention is meant to modify known replay methods so
as to be suitable for dynamic content, too.

1.2   As a solution, the application discloses that an "inter-
mediate server" builds a "request history" of the user
requests and that the user's path is replayed "from"
that intermediate server (see p. 3, lines 1-2, and p. 4,
10-11). The replay process iterates over the request
history and "sends out the requests in the order they
were originally made" (p. 4, lines 15-16). Each request
is from an "originating page" to a "target web page".
The iteration begins with a "starting URL" (see *e.g.*
p. 3, lines 4-7) as the initial "originating page" and
in each iteration step tries to replay the next request
"for a target web page" from the current "originating
page" (p. 3, lines 29-31). Doing this, it is determined
whether the currently "selected request" is a form re-
quest or not (see p. 5, line 5 ff. and p. 7, line 5 ff.).
In the former case, "a best-fit form from the potential

forms located on the current configuration of [the current] originating page" is selected and sent as the replay request, in the latter case, a "best-fit URL" is selected (p. 5, lines 12-14; p. 8, lines 15-20; fig. 2).

1.3   The invention is claimed as an iterative process and a system adapted to carry it out (claims 1 and 13).

Article 123(2) EPC

2.   The decision under appeal, as the board understands it, found the then pending independent claims 1 and 14 not to comply with Article 123(2) for the following reasons:

a)   These claims referred to a saved request merely "corresponding to" an originating web page, which language implied a broader association between the saved request and the web page than what was originally disclosed (reasons of the decision, p. 5, 2nd and 3rd pars.).

b)   The claims implied that the selected request read from the request history had the effect of loading the *originating web page*, whereas the disclosed process in each iteration step rather started from the originating web page "already present (loaded) on the intermediate server" and determined "the best match from within the originating web page" for the *target web page* according to the selected request (reasons, p. 5, 4th par. - p. 6, 1st par.).

c)   Even if, as the applicant had argued, the original application disclosed that also the starting URL could be read from the request history (see par.

bridging pp. 5-6), the claims implied that also the
"starting URL" would be subject of the "best-fit"
analysis which was not originally disclosed (reasons,
p. 6, 2nd par.).

2.1   *Re. a)* The amended claims no longer refer to "a saved
request corresponding to the originating web page" nor
to a "selected request for an originating web page". Ra-
ther, they now refer to a "saved request for a target
web page".

2.2   *Re. b)* The amended claims now clarify that each itera-
tion step analyses the "saved request for a target web
page" with respect to the originating web page so as to
determine a web page to be replayed. The amended claims
thus avoid the implication that the selected request has
the effect of loading the originating web page.

2.3   *Re. c)* The amended claims also specify the application
of a "best-fit" analysis only with reference to the
"target web page[s]" of selected requests and thus do
not specify that the "starting URL" is subject to a
best-fit analysis.

2.4   The board therefore agrees with the appellant that the
amendments overcome the objections under Article 123(2)
EPC in the decision under appeal.

3.   The board notes that claims 1 and 13 refer to a "set of
web pages in the order the web pages were originally
made". In the board's view the skilled person would
clearly recognize this as an obvious drafting mistake:
It is apparent for the skilled that the order of replay
is not meant to be determined by the order in which the

web pages were originally made but by the order in which
the *requests to the web pages* were originally made. In
the board's view this is evident, *inter alia*, from the
term "request history" in which, according to the claims,
"requests for the web pages have been saved" and from
the description (see esp. p. 4, lines 15-16). This draf-
ting mistake thus does not constitute a deficiency under
Article 123(2) EPC, and is correctable under Rule 139
EPC.

4.   Also beyond the above the board is satisfied that the
     amended claims are disclosed in the application as ori-
     ginally filed (see the references given under point 1)
     and therefore conform with Article 123(2) EPC.

Article 84 EPC

5.   In a section entitled "obiter dicta" the decision under
     appeal argues that then claims 1 and 14 do not conform
     with Article 84 EPC 1973 for not being clear and for be-
     ing broader than justified by the description and draw-
     ings, because the claims

     i)   did not specify where the request history is situ-
          ated in the system whereas the description and the
          drawings conveyed the impression that the saved
          request history can only be located in the inter-
          mediate server (reasons 3.1);

     ii) left unclear the structure of the request history
          (reasons, 3.2);

     iii) lacked the feature of "receiving/loading at the in-
          termediate server the originating web page prior to

the execution of [then] steps (a) to (d)", *i.e.* be-
fore "the content of the originating web page is
analysed" (reasons 3.3); and

iv)   were unclear as to how "a form can be selected as a
      URL" (reasons 3.4).

5.1   *Re. i)* Amended claims 1 and 14 now specify that the path
      of web pages is to be replayed "from an intermediate
      server", using a "request history built by the interme-
      diate server" in which "requests for the web pages have
      been saved" . The term "saved requests" in the iteration
      as claimed is a clear reference to the requests saved in
      the request history. In the board's view, therefore,
      amended claims 1 and 14 now imply that the request his-
      tory is "located in the intermediate server" so that the
      examining division's objection has become moot.

5.2   *Re ii)* From the claim language it is clear that the
      "saved requests" selected from the request history are
      "for a target web page" and that the iteration relates
      to this target web page when selecting a best-fit form
      or a best-fit URL as a page "to which a replay request
      for the target web page ... should be later made". That
      the claims lack further detail about the structure of
      the request history does not, in the board's view, ren-
      der the claims unclear as the structure of the request
      history has no impact on the replay mechanism itself.

5.3   *Re iii)* By way of amendment the claims now make clear
      that the "originating web page" must be available before
      and for the subsequent analysis. The amendments also
      specify sufficiently, in the board's view, the rôle of

the intermediate server for the claimed process and
system of replaying web pages.

5.4   *Re. iv)* The amended claims now specify that a "best-fit
        form" is selected "from a set of forms in the origina-
        ting web page" and, separately, a "best-fit URL" from
        within the originating web page. The claims distinguish
        between "saved requests" which are "form requests" from
        others which are not. The skilled person would under-
        stand that the form requests thus are a special form of
        saved requests which are identifiable as relating to
        "forms". The description explains that this could be
        done by noting in the request history that the URL of a
        given request was "associated with a 'FORM' tag" (see
        sentence bridging pp. 4-5). Once form requests are dis-
        tinguished, the determination of a best-fit form would
        not have to be substantially different from the determi-
        nation of a best-fit URL as the skilled person would un-
        derstand. Although the notion of "best-fit" itself is
        not detailed further in the claim, the board considers
        that the skilled person would know ways of comparing
        URLs with each other according to some suitable metric
        which identifies certain matches as "best" ones. The
        board therefore is of the opinion that the selecting of
        a "best-fit form ... from a set of forms in the origina-
        ting web page" may be broad but is not in conflict with
        Article 84 EPC 1973 for being unclear.

Articles 54 and 56 EPC 1973

6.   The appellant also provides arguments why the claimed
        invention were new and inventive over two documents D1
        and D2.

6.1   These documents were introduced by the examining divi-
       sion in its first communication dated 22 August 2005 to-
       gether with the objection that the original claims 1-27
       lacked an inventive step over D1 and D2 (see that commu-
       nication, point 2). The argument was detailed however
       only with regard to original claims 1-3 and 13-15 (see
       points 2.1-2.3). In response to this communication, with
       submission of 6 March 2006, the appellant filed amended
       claims and argued why it were believed they overcame the
       inventive step objection.

6.2   After that, the examining division did not address in-
       ventive step again. However, in response to objections
       under Article 84 EPC 1973 and 123(2) EPC the claims were
       amended several times. *Prima facie* at least the initial
       inventive step objections do not apply to the amended
       claims anymore.

Summary

7.   Since the amended claims have overcome, to the board's
       satisfaction, the main ground for refusal, the objection
       under Article 123(2) EPC, and the clarity objections
       made *obiter* the decision under appeal must be set aside.
       Since however at least the inventive step of the claimed
       invention has not been conclusively examined for the
       pending claims, the board exercises its discretion under
       Article 111(1) EPC 1973 and remits the case to the de-
       partment of first instance for further prosecution.

Order

For these reasons it is decided that:

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

The Registrar: The Chairman:

B. Atienza Vivancos   D. H. Rees