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Datasheet for the decision of 17 December 2015

Case Number: T 2467/09 - 3.5.07

Application Number: 01924674.3

Publication Number: 1277132

IPC: G06F17/00

Language of the proceedings: EN

Title of invention:
Custom stores

Applicant:
Apple Inc.

Headword:
Custom stores/APPLE

Relevant legal provisions:
PCT Art. 17(2)(a)
EPC R. 103(1)(a), 111(2)

Keyword:
Substantial procedural violation - appealed decision sufficiently reasoned (no)
Notorious prior art - (no)
Reimbursement of appeal fee - (yes)

Decisions cited:
T 0278/00, T 1242/04, T 1924/07, T 1411/08, T 0359/11

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

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Case Number: T 2467/09 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 17 December 2015

Appellant: (Applicant)	APPLE INC. 1 Infinite Loop Cupertino, CA 95014 (US)
Representative:	Barton, Russell Glen Withers & Rogers LLP 4 More London Riverside London, SE1 2AU (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 7 May 2009 refusing European patent application No. 01924674.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	M. Rognoni
Members:	R. de Man
	C. Brandt

Summary of Facts and Submissions

I. The applicant (appellant) lodged an appeal against the decision of the Examining Division refusing European patent application No. 01924674.3. The application was refused for lack of inventive step on the basis of undocumented prior art.

II. The application was filed on 4 April 2001 as international application PCT/US/01/10977 with a priority date of 6 April 2000. Its independent claim 1 read as follows:

"A system comprising:

a server system adapted to produce a custom-store web page for a vendor, the custom-store web page being associated with and for the use of a group other than the vendor, the custom-store web page being constructed using data from a database; and

a custom-store-administrator computer operably connectable to the server system, the custom-store-administrator computer being associated with a custom-store administrator for the group, wherein the custom-store-administrator computer is adapted to provide configuration data to the server system, the server system being adapted to use the configuration data to arrange at least a portion of the custom-store web page for the use of group members, the configuration data being stored in the database."

III. Acting in its capacity of International Searching Authority, the European Patent Office issued a declaration under Article 17(2)(a) PCT to the effect that no international search report would be established for the reason that the subject-matter of

the international application related to schemes, rules or methods of doing business.

IV. With its request for entry into the European phase, the applicant replaced the originally filed claims with a set of claims 1 to 32.

V. In a communication under Article 96(2) EPC 1973 dated 27 September 2004, the Examining Division noted that the subject-matter of claims 1 to 32 had technical character, but lacked an inventive step as no technical solution to an identified technical problem had been proposed and no technical effect or result which would be unexpected or surprising to the person skilled in the art was apparent. According to the Examining Division, it was not necessary to refer to any particular art "due to the paucity of technical definition going beyond the banal for the person skilled in the technical art". The communication made no reference to the wording of any of the claims.

VI. With its reply, the applicant filed new claims 1 to 59. It explained that the invention related to a system, method and apparatus for providing custom-store web pages, specialised for certain groups. Conventionally, a store web page offered products for all potential customers. The problem or object solved was that of dynamically providing specific information for a specific group, without the necessity of maintaining one web page for each group.

VII. On 26 February 2008, the Examining Division issued a summons to oral proceedings. In a communication annexed to the summons, it essentially maintained its position. Systems such as that of claim 1 had been common knowledge at the priority date of the application and

specific proof of that was not believed to be necessary.

VIII. In its written submission in preparation for the oral proceedings, the applicant replaced its claims with a main request and first and second auxiliary requests. It commented that it was not apparent why the particular combination of features defined in claim 1, which went beyond the mere recitation of a networked computer system, was common knowledge at the priority date. The Examining Division had not referred to any encyclopaedias, textbooks, dictionaries and handbooks, or other documentation which would allow the applicant to understand the obviousness objection of the Examining Division and to respond to such an objection by including additional limitations in the independent claims. The applicant therefore requested to be provided with suitable documents representing the knowledge of the skilled person at the priority date. A rejection based on mere assumptions concerning the prior art would violate the principles of a fair procedure before the European Patent Office and the applicant's right to be heard.

IX. Claim 1 of the main request filed in preparation for the oral proceedings read as follows:

"A system comprising:

a server system (20) adapted to produce a web page (124) for a vendor, the server system (20) comprising a database (26);

characterized in that

the server system (20) is adapted to produce a custom-store web page (124) for the vendor, the custom-store web page (124) being associated with and for the use of a group other than the vendor, the custom-store web page (124) being constructed based upon data from the database (26); and

a custom-store-administrator computer (40) operably connectable to the server system (20), the custom-store-administrator computer (40) being associated with a custom-store administrator (82) for the group, wherein the custom-store-administrator computer (40) is adapted to provide configuration data to the server system (20), the server system (20) being adapted to store the configuration data in the database (26), the server system (20) being further adapted to arrange, based upon the stored configuration data, at least a portion of the custom-store web page for the use of members of the group."

X. In a communication sent by fax one week before the oral proceedings, the Examining Division informed the applicant of its preliminary opinion that none of the requests overcame the objection of lack of inventive step. The relevant technology had been available long before the priority date of the application and no specific document was necessary as proof.

XI. At the oral proceedings, which were held on 27 May 2008 in the absence of the applicant, the Examining Division decided to refuse the application. According to the minutes, issued almost one year later together with the written decision, the Examining Division considered that dynamic generation of web pages had been "notorious" at the priority date.

XII. According to the written decision, the subject-matter of claims 1 to 59 of the main request, of claims 1 to 58 of the first auxiliary request and of claim 1 of the second auxiliary request lacked an inventive step within the meaning of Article 56 EPC. Its reasons explained that "strictly technically" what was claimed in independent claim 1 of the main request was "a server system, adapted to produce a web page, the server system comprising a database an and [sic] administrator computer adapted to provide (configuration) data to the database based on which the web page is produced". As acknowledged by the applicant, "server systems providing web pages" were known from the prior art. In addition, "technologies for the dynamic building of web pages were notoriously known and widely used at the priority date of the application". Due to the notoriety of these features no specific proof was necessary. The particular combination of features of independent claim 1 did not go beyond these commonly known architectures, and the mere use of "commonly known technologies (dynamic web page generation)" for the specifically defined commercial purpose of the "custom store web pages generation" of the application did not involve inventive activity.

XIII. With the statement of grounds of appeal, the appellant filed six sets of claims for a main request and first to fifth auxiliary requests.

In particular, the appellant requested as a main request that the decision under appeal be set aside and that a patent be granted on the basis of the claims for the main request or, alternatively, that the case be remitted to the Examining Division for a search for prior art to be carried out.

The claims for the main request essentially corresponded to claims 1 to 72 of the international publication with reference signs added. The claims for the first and second auxiliary requests corresponded to the claims of, respectively, the main request and the first auxiliary request considered in the decision under appeal.

As a sixth auxiliary request, the appellant requested that a summons to oral proceedings be issued in the event that none of its higher-ranking requests was allowed.

XIV. In the statement of grounds of appeal, the appellant pointed out that no search for relevant prior art had yet been conducted. The Examining Division had merely stated that "technologies for the dynamic building of web pages were notoriously known ... at the priority date of the application" and that the invention did not go beyond these commonly known architectures. A mere statement that abstract notoriously known prior art anticipated the invention without further proof or reasoning did not allow a feature-by-feature analysis and was thus not adequate for assessing the novelty (or inventive step) of an invention. At the priority date of April 2000 mainstream use of dynamic web pages had still been in its infancy. It was therefore questionable whether any of the technologies for implementing them were "notorious". In addition, claim 1 was not directed to a technology for the dynamic building of web pages, but to a technology for building differently customised web pages from one and the same database.

Since it was clear that the invention comprised technical features and combinations of features which were not notorious at the priority date, the application should not have been refused for lack of inventive step without a search being conducted. It was further clear from the Guidelines for Examination that a search should be conducted on the basis of all of the claims and not merely the independent claims. The dependent claims contained many more technical features which were not notorious at the priority date. This confirmed that a search should have been carried out.

Reasons for the Decision

1. The appeal complies with the provisions referred to in Rule 101 EPC and is therefore admissible.

2. Before considering the appellant's substantive requests, the Board will comment on the decision of the Examining Division.

3. The Examining Division refused the application for lack of inventive step without making reference to documentary evidence. In fact, no prior art search was carried out in either the international phase or the European phase.

4. According to the established case law of the boards of appeal, an application should normally not be refused for lack of inventive step as long as no search has been performed. An exception may however be made in cases where the objection is based on knowledge that is "notorious" or indisputably forms part of the common general knowledge (see decision T 1242/04, OJ EPO 2007, 421, reasons 9.2).

5. In point 2.2.3 of the reasons of the decision under appeal, the Examining Division argued that the technical content of the subject-matter of claim 1 of the then main request consisted in the following combination of features: "a server system, adapted to produce a web page, the server system comprising a database an and [sic] administrator computer adapted to provide (configuration) data to the database based on which the web page is produced".

It further remarked that the applicant acknowledged that server systems providing web pages were known at the priority date of the application, and noted that "technologies for the dynamic building of web pages were notoriously known and widely used at the priority date of the application".

The Examining Division then apparently concluded that the subject-matter of claim 1 lacked an inventive step over this prior art (see section XII. above).

6. In the Board's view, there are two issues with this reasoning.

The first issue is that, after describing the relevant prior art as "server systems providing web pages" and "technologies for the dynamic building of web pages", no reasons are given that explain either why this prior art would anticipate the combination of technical features of claim 1 previously identified, or why the skilled person, starting from this prior art, would arrive at that combination in an obvious manner. The Examining Division might have had in mind a certain specific technology, but the decision fails to properly

identify it in the detail necessary for arguing lack of inventive step of the invention as claimed.

Since the decision lacks a logical chain of reasoning leading to the relevant conclusion, it does not comply with Rule 111(2) EPC, which requires that decisions open to appeal be reasoned (see decision T 278/00, OJ EPO 2003, 546, reasons 2). This constitutes a substantial procedural violation.

7. The second issue concerns the absence of documentary evidence. While it cannot be reasonably disputed that server systems providing web pages were known at the priority date of the present application, in the Board's view this is less evident for "technologies for the dynamic building of web pages". While such technologies were probably well-known in 2008, which is when the Examining Division for the first time explicitly relied on their existence, it must be kept in mind that the field of web technology evolved considerably in the eight years following the filing of the priority application in April 2000.

8. When an examining division raises an objection to the grant of a patent, it must also provide the applicant with the information necessary for understanding the objection and for verifying its validity. Only then is the applicant enabled to defend its case, for example by contesting the validity of the objection, by providing evidence for its factual assertions, or by amending the application. That is why, if an applicant contests an assertion that something was known at the effective filing date, the examining division must normally back up that assertion with evidence and can only exceptionally confine itself to giving cogent reasons. The argument that certain knowledge is

notorious is only a sufficiently cogent reason if it satisfies any reasonable addressee, i.e. if, at the time the argument is to be assessed by the applicant and, in case of an appeal, by a board of appeal, it cannot be reasonably disputed that that knowledge formed part of the common general knowledge of the skilled person at the effective filing date. Such knowledge will almost necessarily be limited to generic features, defined in such a way that technical details are not significant (cf. decisions T 1411/08 of 6 June 2011, reasons 4.2, and T 359/11 of 13 May 2015, reasons 3.11).

9. In the present case the Board does not consider it to be indisputable that "technologies for the dynamic building of web pages", let alone specific technologies that could take away the novelty or inventive step of the invention as claimed, were generally known in April 2000. It follows that, without documentary evidence, the Examining Division's reasoning against the allowability of the then main request also fails to convince in this respect.

10. In several decisions, the boards of appeal have held that whether an examining division committed a substantial procedural violation by failing to carry out an "additional" search (i.e. a search carried out at the examination stage) before refusing an application for lack of inventive step turns on whether it acted despite realising that at least one technical claim feature was not notorious, or whether it erroneously regarded this feature as notorious and therefore made an error of judgment (see in particular decision T 1924/07 of 22 June 2012, reasons 11).

In the present case the Examining Division referred to what it considered to be the relevant prior art as being "notorious" for the first time in the minutes of the oral proceedings and the written decision. Earlier in the written proceedings, despite the appellant's request for documents representing the knowledge of the skilled person at the priority date, the Examining Division essentially stated that documentary evidence for its assertions was "not necessary". This arguably leaves open the possibility that, at least initially, the Examining Division considered an additional search to be unnecessary not because it judged that the existence of the relevant knowledge at the priority date could not be reasonably disputed, but only because the Examining Division itself did not need a document to know that such prior art existed.

It may further be noted that at least some of the dependent claims which were part of both the originally filed claims and the claims refused by the Examining Division contain features which evidently are neither non-technical nor notorious.

However, since the Board has already identified a substantial procedural violation which warrants reimbursement of the appeal fee (see point 13. below), it need not decide whether the Examining Division in the circumstances of the present case also committed a substantial procedural violation by refusing the application for lack of inventive step without first conducting an additional search.

11. The claims of the main request filed with the statement of grounds of appeal essentially correspond to claims 1 to 72 of the international publication, which were amended several times during the first-instance

proceedings. Since original claim 1 does not differ substantially from claim 1 of the refused main request, it too cannot be objected to for lack of inventive step on the basis of undocumented prior art. In the circumstances of the present case, the Board considers it appropriate to permit the appellant to revert to its original claims. The Board therefore admits the main request into the proceedings.

12. The Board will hence remit the case to the department of first instance for further prosecution on the basis of the main request. The Examining Division will have to carry out an additional search on the basis of the claims, including the dependent claims, with due regard to the description and drawings (Article 92 EPC).

In these circumstances, there is no need to consider the auxiliary requests.

13. The decision under appeal was affected by a substantial procedural violation in respect of the refusal of the then main request, corresponding to the present first auxiliary request. The Board does not consider that the filing of the present main request takes away from the fact that the substantial procedural violation was causal for the appeal. Reimbursement of the appeal fee under Rule 103(1)(a) EPC is therefore equitable.

14. Since the appellant requested oral proceedings only in the event that none of its higher-ranking requests was allowed, 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 M. Rognoni

Decision electronically authenticated