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**Datasheet for the decision
of 25 June 2014**

Case Number: T 0094/10 - 3.5.06

Application Number: 00937677.3

Publication Number: 1192515

IPC: G06F1/00, G06F17/21

Language of the proceedings: EN

Title of invention:

SYSTEM AND METHOD FOR PUBLISHING MANUSCRIPTS

Applicant:

Scholarone, Inc.

Headword:

Document management system / Scholarone

Relevant legal provisions:

EPC Art. 123(2)
EPC 1973 Art. 84, 83
EPC R. 137(3)

Keyword:

"Admissibility of the request - no"

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 0094/10 - 3.5.06

D E C I S I O N
of Technical Board of Appeal 3.5.06
of 25 June 2014

Appellant: Scholarone, Inc.
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Representative: Haley, Stephen
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 3 July 2009
refusing European patent application No.
00937677.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman D. Rees
Members: G. Zucka
C. Heath

Summary of Facts and Submissions

I. The appeal is against the decision by the examining division dispatched 3 July 2009, to refuse European patent application 00 937 677.3, on the basis that the subject-matter of the independent claims 1 and 20 was not inventive, Article 56 EPC 1973. The following documents were cited during the first instance procedure:

D1: WO 98/01807 A

D2: WO 99/04370 A

D3: WO 94/08310 A

D4: Tribute A.: "SII Adopts Lotus Notes As Basis for Its New Editorial Systems. (cover story)", Seybold Report on Publishing Systems, 12 October 1998, Vol. 28 Issue 3, XP002934600

D5: US 5 778 367 A

II. A notice of appeal was received on 4 September 2009, the appeal fee being paid on the same day. A statement of the grounds of the appeal was received on 4 November 2009.

III. The appellant requested that the decision under appeal be set aside and a patent granted on the basis of the claims filed with the grounds of appeal. The appellant made a conditional request for oral proceedings.

IV. The board issued a summons to oral proceedings. In an annex to the summons, the board set out its preliminary, negative opinion on the appeal.

V. As announced by letter dated 18 June 2014, the appellant was not present at the oral proceedings, which took place on 25 June 2014. The appellant also had not filed a substantive response to the board's communication.

VI. The text on file is:

claims 1 to 41 filed with the grounds of appeal

description pages

2 to 32 as originally filed

1 as received on 13 October 2006

drawing sheets 1 to 30 as originally filed.

VII. The independent claim 1 reads as follows:

A computer-implemented method for managing and reviewing documents, said method:

providing an author module (106) for execution at a computer system located at a first location to enable an author to provide a submission for publication consideration to the system, the author module being adapted to upload text and graphics, accept flexible submission file formats, produce at least one selectable output format of said submission, produce complete proofs of said submission for user approval, enable immediate review of said submission, display submission status at any time, and generate automatic email correspondence;

providing an administrator module (107) to enable administration of the system, the administrator module being adapted to search a database and

display results, track said submission, track author data, track decisions, grant or change user permissions, and download said submission for editing and production;

providing an editor module (110) to enable delegation of review and approval of the submission, the editor module being adapted to display full text and graphics for review of said submission, enter accept/reject/revise decisions into the database at any stage, add comments/notes to said submission, and generate automatic email correspondence, and

providing a reviewer module (109) to enable review of the submission, the reviewer module being adapted to provide all aspects of said submission to said reviewer for peer review, and enable entry of accept/reject/revise recommendations for said submission into the database;

characterised by

inputting using said author module said submission to the computer system from a location displaced remotely from the first location, said submission having been input in a native word processor format and including symbols selected and input from a set of symbols provided by said author module apart from the native word processing format;

automatically translating by the author module said submission from said native word processor format to a format compatible with said browser, the browse-compatible format incorporating said selected symbols for display in editing and review processes;

storing within said database said submission in both said native word processor format and said

browser-compatible format and along with said selected symbols;
said author module (106) being adapted to shield an identity of at least one reviewer from said author of said submission, and capture data to facilitate a peer review process;
said administrator module (107) being adapted to track reviewer and editor data and performance, and automatically notify late reviewers/editors;
said editor module (110) being adapted to search for and select reviewers from the database, view reviewer history and current workload, and invite reviewers to review all aspects of said submission; and
said reviewer module (109) being adapted to provide a common score sheet specific to the meeting to an editor.

VIII. The independent claim 20 is a system claim with features corresponding to the method features of claim 1.

IX. At the end of the oral proceedings, the chairman announced the board's decision.

Reasons for the Decision

1. *Admissibility of the appeal*

In view of the facts set out at points I and II above, the appeal is admissible, since it complies with the EPC formal admissibility requirements.

2. *Admissibility of the request*

The reasoning below follows exactly that given in the annex to the summons to oral proceedings.

The amendments that were introduced in the claims raise several new issues.

- 2.1 The introduction in claim 1 of the feature "said submission having been input in a native word processor format and including symbols selected and input from a set of symbols provided by said author module apart from the native word processing format" raises the issue of compliance with Article 123(2) EPC.

The appellant states in the grounds for the appeal that the amendments are based on the originally filed claims 13 and 19. However, the original claim 13 is silent about symbols and the original claim 19 only mentions what happens with special characters that are contained in the document; nothing is said in either claim about how the "symbols" or "special characters" are entered by the user into the document, let alone that the author of the document would have some possibility to select them from a set of symbols. It could very well be, as is the case in many existing authoring systems, that no selection can be made but that the author needs to know how to produce certain special characters, e.g. by entering the character sequence "\alpha" or "α", in respectively a TeX or an HTML document, to represent the symbol α . Nor is there apparently any indication that the symbols are provided by the author module. Moreover the only reference to such symbols in the description is in the penultimate paragraph (page 32, lines 17 to 26). This paragraph too does not provide any disclosure of the newly claimed features.

Further there is no apparent basis for the feature "the browser compatible format incorporating said selected symbols for display". This feature is not in either of the cited claims, nor is it disclosed in the description, which merely says that there are "translated codes" inserted in the document, without giving any indication of how or even whether these codes are displayed.

In the absence of any response to these concerns explaining how the presently claimed subject-matter was originally disclosed, the board concludes that the requirements of Article 123(2) EPC have not been satisfied.

2.2 The newly filed claims are further unclear, in violation of Article 84 EPC. It is not clear, as a matter of English, what is intended by the expression "apart from" in the phrase, "a set of symbols provided by said author module apart from the native word processing format". It is also not clear what qualifies as a "native" word processor format. Another clarity objection arises from the fact that the last line of each of the independent claims mentions "the meeting", where no meeting has previously been specified.

2.3 The board also has doubts whether the features relating to "special character fonts" are even described clearly enough to be carried out by the person skilled in the art (Article 83 EPC). It would appear to the board that it is assumed throughout the application that the submitted manuscript is in a known word processing format (e.g. RTF, as mentioned in the description). It is therefore unclear how the manuscript can nonetheless contain "special characters not recognized by" said word processing format, at least without taking

undisclosed special measures. It is also unclear how the system 300 may have "known conversions" for such non-standard fonts.

- 2.4 The appellant states in the grounds for the appeal that "...we have introduced features into the independent claims which refer specifically to particular technical operational steps of the method and operational components of the corresponding system that solve a particular technical problem and which are therefore technical in nature and should be used as the basis for assessing inventive step. These particular features relate to the provision of an arrangement in which accurate insertion of symbols can be made by the author without any fear of incorrect conversion occurring such that inaccurate documents are taken forward for review or even for publishing". Although the appellant has not explicitly identified the features concerned, it is implicitly evident that he refers, in particular, to the features mentioned in 2.1 above.

Even if one assumes, for the sake of argument, that said features were in fact disclosed in the original application documents, the board has established that neither the claims nor the appellant's arguments during the first instance procedure ever highlighted the possibility of selecting and inputting symbols from a set of symbols provided by an author module. There was therefore no reason for the first instance to try and find a document which would disclose this feature. Consequently, if the board were to admit the insertion of the feature into the independent claims, it would need to remit the case to the first instance in order that a further search could be carried out. This would be contrary to the principle of procedural economy and further raise the question whether the request should

be admitted in view of Article 12(4) of the Rules of Procedure of the Boards of Appeal.

2.5 In view of all of the above issues, the board does not admit the request under Rule 137(3) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



B. Atienza Vivancos

D. Rees

Decision electronically authenticated