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**Datasheet for the decision
of 27 May 2010**

Case Number: T 0182/10 - 3.5.03

Application Number: 04003332.6

Publication Number: 1418773

IPC: H04Q 7/22

Language of the proceedings: EN

Title of invention:

Method of transferring data being stored in a database

Applicant:

European Research Technology s.a.

Opponent:

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Headword:

-

Relevant legal provisions:

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

Relevant legal provisions (EPC 1973):

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Keyword:

"Decision reasoned (no)"

"Substantial procedural violation (yes)"

"Reimbursement of the appeal fee (yes)"

Decisions cited:

G 0003/03

Catchword:

-



Case Number: T 0182/10 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 27 May 2010

Appellant: European Research Technology s.a.
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Decision under appeal: Decision of the examining division of the
European Patent Office posted 16 July 2009
refusing European application No. 04003332.6
pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: F. van der Voort
R. Moufang

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division refusing European patent application No. 04003332.6 (publication number EP 1 418 773 A).
- II. The refusal was based on the ground that the subject-matter of claim 1 of a main request and first and second auxiliary requests, all as filed in the course of oral proceedings before the examining division, did not involve an inventive step (Articles 52(1) and 56 EPC).
- III. In the statement of grounds of appeal, which was received on 25 November 2009, the appellant requested that the decision be set aside and a patent be granted on the basis of claims of a main request or, failing that, on the basis of claims of a first or a second auxiliary request, all requests as filed with the statement of grounds of appeal. The appellant further requested that in view of a substantial procedural violation committed by the examining division the appeal fee be reimbursed. Arguments in support were submitted and oral proceedings were conditionally requested.
- IV. With a decision dated 1 February 2010 the examining division rectified the impugned decision pursuant to Article 109(1) EPC (interlocutory revision), but did not allow the request for reimbursement of the appeal fee.

V. The appellant's arguments in connection with the alleged substantial procedural violation may be summarised as follows:

The examining division had committed a substantial procedural violation because the reasoning of the decision on the main request was not in line with the requirements of Rule 111(2) EPC. More specifically, the decision on the main request was not based on the correct claim set. In particular, claim 1 of the main request included the feature "and wherein the manager sends an SMS message (4) comprising said URL address to the recipient's mobile phone number". This feature was however not considered in the reasoning concerning lack of inventive step of the claimed subject-matter. In fact, when considering claim 1 of the first auxiliary request, which also included this feature, the examining division considered that claim 1 of this auxiliary request differed from claim 1 of the main request by, *inter alia*, the above-cited feature. Hence, when assessing the main request, the examining division did not take this feature into account. Further, the examining division had failed to identify the differences between the closest prior art and claim 1 of the main request and did not apply the problem-solution approach in substantiating its inventive step objection. The appellant further argued that for similar reasons the decision on the auxiliary requests was not based on the correct claim sets.

VI. The claims of the main request presently on file are identical to the claims of the main request as annexed to the minutes of the oral proceedings before the examining division. In view of the board's conclusion

it is not necessary to give details of the claims of the first and second auxiliary requests presently on file.

VII. Claim 1 of the main request as annexed to the minutes of the oral proceedings before the examining division reads as follows (underlining by the board):

"Method of retrieving data being stored in a database (14), said method existing in the form of a service being offered by one or more providers of the service to the public via the Internet, said data belonging to an owner who is a subscriber to said service, by a recipient who is a mobile phone user, in relationship with a managing software application, called 'manager' (12), said database and said manager being in connection with a web site (10), towards a recipient, said method comprising the following steps :

- the recipient enters into connection via said mobile phone, with the manager by sending an identifier (40) to said manager, said identifier allowing said manager to identify said owner,
- said manager identifies the recipient through his mobile phone number,
- said manager associates an e-mail address provided by the recipient or a URL address with the recipient's mobile phone number,
- retrieving said data stored in database (14) on said recipient's email address or URL address

wherein the manager associates a URL address with the recipient's mobile phone number and wherein the manager sends an SMS message (4) comprising said URL address to the recipient's mobile phone number and wherein said data are retrieved on said URL address,

when the recipient's e-mail address is not know [sic] by said manager (12)."

Claim 1 of the first auxiliary request as annexed to the minutes of the oral proceedings before the examining division reads as follows (underlining by the board):

"Method of retrieving data being stored in a database (14), said method existing in the form of a service being offered by one or more providers of the service to the public via the Internet, said data belonging to an owner who is a subscriber to said service, by a recipient who is a mobile phone user and whose mobile phone number and e-mail address are not known by any of said providers, in relationship with a managing software application, called 'manager' (12), said database and said manager being in connection with a web site (10), said method comprising the following steps :

- the recipient enters into connection via said mobile phone, with the manager by sending an identifier (40) to said manager, said identifier allowing said manager to identify said owner,
- said manager identifies the recipient through his mobile phone number,
- said manager associates a URL address with the recipient's mobile phone number, wherein the manager sends an SMS message (4) comprising said URL address to the recipient's mobile phone number
- retrieving said data stored in database (14) on said URL address."

In view of the board's conclusion it is not necessary to give details of claim 1 of the second auxiliary request as annexed to the minutes of the oral proceedings before the examining division.

Reasons for the Decision

1. *Request for reimbursement of the appeal fee*
- 1.1 Since the examining division rectified the impugned decision pursuant to Article 109(1) EPC (interlocutory revision), the only issue to be decided on by the board is the appellant's request that the appeal fee be reimbursed (see G 3/03, OJ EPO 2005, 344).
- 1.2 In accordance with Rule 103(1)(a) EPC, in the event of interlocutory revision, the appeal fee is to be reimbursed if the reimbursement is equitable by reason of a substantial procedural violation. For the reasons set out below, in the present case this requirement is met.
- 1.3 The board notes that the impugned decision does not include the wording of claim 1 of each of the requests *expressis verbis*. In the section "Facts and Submissions", it is merely stated that the decision is based on "the current requests of the Applicant", in which claim 1 of each of the requests is referred to as "filed during Oral proceedings on 24.06.2009".

The wording of claim 1 of each request was annexed to the minutes of the oral proceedings. Since the appellant does not contest it, the board sees no reason

to question the correctness of these minutes and their annexes.

- 1.4 Claim 1 of the main request as annexed to the minutes of the oral proceedings before the examining division includes, in handwriting, the feature "and wherein the manager sends an SMS message (4) comprising said URL address to the recipient's mobile phone number" (cf. point VII above).

The impugned decision is however silent on this feature. The board can therefore only conclude that, when assessing inventive step of the subject-matter of claim 1 of the main request, the examining division did not take this feature into account. This is also supported by the fact that in connection with claim 1 of the first auxiliary request the examining division explicitly states that this claim differs from claim 1 of the main request by, *inter alia*, the above feature.

- 1.5 The board further notes that the decision is also silent on another feature of claim 1 of the main request, namely that the owner is a subscriber to the service (see point VII above, "said data belonging to an owner who is a subscriber to said service"). Hence, this feature was apparently also not taken into account.

- 1.6 In order to comply with the requirement of Rule 111(2) EPC, a decision must contain, in a logical sequence, those arguments which justify its tenor. Hence, all the facts, evidence and arguments which are essential to the decision must be discussed in sufficient detail in order to enable the applicant and, in the case of an

appeal, the board of appeal to examine whether the decision was justified or not.

In the present case, since the features referred to at points 1.4 and 1.5 above were not considered by the examining division, neither the appellant nor the board is in a position to examine whether the rejection of the main request was justified or not.

- 1.7 The board notes that the feature referred to at point 1.4 was considered by the examining division in connection with claim 1 of the first auxiliary request. The board therefore considered whether it could be argued that it is implicit from the decision that the reasoning in connection with this feature of claim 1 of the auxiliary request applies, *mutatis mutandis*, to claim 1 of the main request. The board concludes that it cannot, since it would in fact involve mere speculation by the board as to the reasoning of the examining division, which, in the board's view, is not in line with the judicial character of an appeal procedure. In any case, even if the argument were accepted, the decision would still leave the appellant and the board in the dark as to the reasoning in respect of the feature referred to at point 1.5, particularly as to the question of whether or not this feature was held to be known from closest prior art and, if not, whether or not it implied a technical feature and, if so, whether or not it contributed to an inventive step, e.g. in connection with the formulation of an objective technical problem underlying the claimed method or in connection with the claimed solution.

- 1.8 The board therefore concludes that, at least in respect of the main request, the decision is not reasoned within the meaning of Rule 111(2) EPC.
- 1.9 Following the established case law concerning Rule 68(2) EPC 1973 which corresponds to Rule 111(2) EPC, a violation of Rule 111(2) EPC amounts to a substantial procedural violation in the sense of Rule 103(1)(a) EPC.
- 1.10 It follows from the above that the appellant had to file an appeal in order to obtain a reasoned decision on the main request, it being noted that, as pointed out above, the claims of the main request presently on file are identical to the claims of the main request as annexed to the minutes of the oral proceedings before the examining division.
- 1.11 Under these circumstances the board judges that it is equitable to reimburse the appeal fee (Rule 103(1)(a) EPC).
2. Since the appeal fee is to be reimbursed, there is no need to consider the further arguments of the appellant concerning the auxiliary requests. Nor is it necessary to hold oral proceedings, as conditionally requested by the appellant.

Order

For these reasons it is decided that:

The appeal fee is reimbursed.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland