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Datasheet for the decision of 26 February 2013

Case Number: T 0654/10 - 3.5.05

Application Number: 98950859.3

Publication Number: 1034651

IPC: H04L 29/08

Language of the proceedings: EN

Title of invention:
Systems and methods for managing messages

Patent Proprietor:
j2 Global Communications, Inc.

Opponent:
Protus IP Solutions Inc.

Headword:
Searchable message storage system/J2 GLOBAL COMMUNICATIONS

Relevant legal provisions:
EPC Art. 56, 123(2)
RPBA Art. 13(1)

Keyword:
"Admissibility of late-filed request and documents - yes"
"Inventive step - yes (after amendments)"

Decisions cited:
T 0789/89, T 0340/05

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0654/10 - 3.5.05

D E C I S I O N
of the Technical Board of Appeal 3.5.05
of 26 February 2013

Appellant: (Patent Proprietor)
j2 Global Communications, Inc
6922 Hollywood Boulevard
Suite 500
Los Angeles CA 90028 (US)

Representative:
Weston, Robert Dale
PHILLIPS & LEIGH
5 Pemberton Row
London EC4A 3BA (GB)

Respondent: (Opponent)
Protus IP Solutions Inc.
2379 Holly Lane, Suite 210
Ottawa ON K1V 7P2 (CA)

Representative:
Frost, Alex John
Boult Wade Tennant
Verulam Gardens
70 Gray's Inn Road
London WC1X 8BT (GB)

Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 25 January 2010 revoking European patent No. 1034651 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chair: A. Ritzka
Members: P. Cretaine
D. Prietzel-Funk

Summary of Facts and Submissions

I. This appeal is against the decision of the opposition division dispatched 25 January 2010 to revoke the European patent 1 034 651. The patent was revoked for lack of inventive step of the main and first auxiliary requests having regard to the disclosure of

A1: WO 96/34341

and the common general knowledge as evidenced by

A7: US 5 530 852.

II. Notice of appeal was submitted by the patentee on 26 March 2010 and the appeal fee was paid on the same day. The statement setting out the grounds of appeal was submitted on 25 May 2010.

The appellant (patentee) requested that the decision under appeal be set aside and the patent be maintained in amended form according to a main request or one of the two auxiliary requests filed with the statement setting out the grounds of appeal. In addition, oral proceedings were requested as an auxiliary measure.

III. In its letter dated 30 September 2010 the respondent (opponent) commented on the statement setting out the grounds of appeal and filed the request to admit the following documents into the proceedings:

A16: Ulf Schereiser et al.: "Alert: An Architecture for Transforming a Passive DBMS into an Active DBMS",

Proceedings of the 17th International Conference on Very Large Data Bases, pages 469 -478, 1991,

A17: The Practical SQL Handbook, Third Edition, Judith S. Bowman et al., pages 309 - 312, 1996,

A18: D. Goldberg et al.: "Using Collaborative Filtering to Weave an Information Tapestry", Communications of the ACM archive, Volume 35, Issue 12, December 1992, Pages 61 -70,

A19: D. Terry et al.: "Continuous Queries over Append-Only Databases", Proceedings of the 1992 ACM SIGMOD International Conference on Management of Data, pages 321 - 330, 1992.

The respondent further requested that the appeal be dismissed because the requests of the appellant were not allowable under Articles 100(a) (main, first and second auxiliary request) and 100(c) (first and second auxiliary request). Oral proceedings were requested in case the board intended to maintain the patent in any form.

IV. By letter dated 17 December 2010, the respondent withdrew the opposition.

V. In its letter of 12 December 2011, the appellant filed amended claims according to a main request, as well as a first, a second, and a third auxiliary request, in replacement of the previous requests. The request for oral proceedings was maintained.

VI. In a communication accompanying the summons to oral proceedings, dated 31 October 2012, the board stated that the appellant remained the sole party to the present opposition proceedings, following T 789/89. The board further gave its preliminary opinion that the main request was not admissible because the amendments to the claims did not appear to be occasioned by the ground for opposition under Article 100(a) EPC and that the first, second and third auxiliary requests were not admissible because the amendments to the claims appeared to introduce features which had not been searched. Further, the board expressed the preliminary opinion that, even if the requests were considered to be admissible, they did not appear to meet the requirements of Articles 54 or 56 EPC, having regard to the disclosure of documents A1, A7 and A16 to A19.

VII. In its letter of 25 January 2013 in response to the board's communication, the appellant filed amended claims according to a main request and to an auxiliary request, in replacement of the previous main request and first to third auxiliary requests, and provided arguments with respect to the admissibility and allowability of these requests.

VIII. The oral proceedings took place on 26 February 2013, in the presence of the representative of the appellant as the sole party. The appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of the sole request submitted as main request during the oral proceedings. All other requests were withdrawn. At the end of the oral proceedings the Chair announced the board's decision.

IX. Claim 1 of the sole request reads as follows:

"A method of storing and delivering a message to a user over a network comprising the steps of:
a) receiving an incoming call (15) and detecting an address signal associated with the incoming call, the address signal being associated with a system user (32);
b) receiving a user message, in a first file format, accompanying the address signal;
c) converting the user message from the first file format to a standard generalized mark-up language format;
d) storing the standard generalized mark-up language format user message in a separate directory established for each user in a storage area (11);
e) receiving (321) a system user request for the standard generalized mark-up language format message and identifying the user message in the storage area, the received system user request comprising a search query form from the system user (32) specifying at least one parameter for the search request;
f) transmitting at least a portion of the standard generalized mark-up language format user message to the system user over a network (30);
g) storing a data entry (300) comprising a plurality of fields (301-309) for identifying the user message for each received user message;
h) receiving (324) the system user search request (321), which specifies data field message information parameters for a desired search;
i) performing (324) the requested search through the storage area (11) in response to the user search

request by identifying all user messages satisfying the search parameters;
j) sending (325) the search results to the system user (32);
characterized by:
k) storing (326) the search results as a user named:
i) open search wherein the search is reactivated in response to a user request;
or
ii) closed search wherein the messages in a named search are limited to those existing at the time of the search."

Independent claim 6 of the sole request seeks protection for a corresponding network message storage and delivery system.

Reasons for the Decision

1. *Admissibility of the appeal*

The appeal has been filed by the patentee and complies with the provisions of Article 106 to 108 EPC (see Facts and Submissions point II above). Therefore it is admissible.

The opponent and respondent to the appeal has withdrawn its opposition. According to the case law of the Boards of Appeal, it has thus ceased to be a party to the appeal proceedings as far as the substantive issues were concerned (see T 789/89). However the evidence submitted prior to the withdrawal, in the present case

documents A16 to A19, can still be used in the appeal proceedings (see T 340/05).

2. *Amendments*

2.1 *Admission of the request*

The appellant has submitted the new main request during the oral proceedings. Independent claims 1 and 6 have been substantially amended with respect to the independent claims according to the requests on which the impugned decision was based by adding the following features:

1) a received user message is stored in **a separate directory established for each user** in a storage area;

2) a **data entry comprising a plurality of fields for identifying the user message** is stored for each received user message;

3) the system user request specifies **data fields message information parameters for a desired search**;

4) the search results are **stored as a user named open search wherein the search is reactivated in response to a user request or as a user named closed search wherein the messages in a named search are limited to those existing at the time of the search.**

The addition of these technical features aims at overcoming the objection under Article 56 EPC which was the basis for the revocation of the patent. The added features were present either in the granted claims or

in the description. With respect to the features taken from the description, namely the features related to the storage of the search results as an open or closed search, the board notes that they were present in the requests submitted with the statement setting out the grounds of appeal and that the respondent filed related prior art documents A16 to A19 and arguments based thereupon in response to the introduction of said features in the claims.

The board thus considered that the amendments introduced by the appellant's request were occasioned by the ground for opposition under Article 100(a) EPC and that the issue of inventive step can be decided based on the prior art documents on file and the late-filed documents A16 to A19. Taking into account the fact that the opponent was no longer party to the appeal procedure as far as the substantive issues were concerned, the board exercising its discretion under Article 13(1) RPBA decided in favour of admitting the appellant's latest request and, accordingly, documents A16 to A19 to the appeal proceedings.

2.2 *Article 123 EPC*

2.2.1 *Article 123(2) EPC*

The board is satisfied that the amendments to the claims do not extend the subject-matter of the patent beyond the content of the application as filed.

In that respect, the added features 1) to 4) (see point 2.1) are supported by the following passages of

the application as originally filed (see the PCT published application WO 99/18716):

– feature 1): page 27, lines 6 to 8;

– feature 2): from page 37, line 27 to page 38, line 8; Figure 17; claim 10;

– feature 3): page 38, lines 8 to 10; page 41, lines 2 to 11;

– feature 4): page 42, lines 9 to 11; from page 42, line 18 to page 43, line 1.

2.2.2 *Article 123(3) EPC*

The claims have been amended with respect to the granted claims by adding the feature that the user request comprises a search query form and features 1) to 4) as defined in point 2.1.

The board is satisfied that these amendments to the claims specify further limitations and do not extend the protection conferred by the patent as granted.

3. *Inventive step*

3.1 *Prior art*

A1 is a patent application document filed by the appellant and comprising several description passages and drawings in common with the present application. It discloses an Internet-based message storage and delivery system adapted to receive user requests,

including user mailbox number, message or page identifiers, and, in response, to provide the user with information indicating the total number of different messages with a number of anchors as links or references. A list of all the retrieved messages is displayed to the user which can select them for downloading their content via the internet.

A7 discloses a system for storing news articles as hypertext documents (HTML) with search attributes, created from e-mail messages sent by news providers. The e-mail messages are provided by a news source and have no particular destination other than the address of the server hosting the hypertext documents. A system user may request articles defined by search parameters by sending a search query form comprising these parameters to the server (see Figures 9 and 10).

A16 discloses the use of active queries, defined over past, present, and future in a database management system.

A17 is an excerpt of a textbook representing the common general knowledge in the query languages field. It relates to the use of automatic triggers which, upon modification of data in a database, initiates actions in the database itself.

A18 discloses an e-mail system, denominated the "Tapestry" system, comprising an e-mail database accessible by user's queries.

A19 relates to the "Tapestry" e-mail system. This document discloses the use of triggers for enabling

queries to a database to be executed and for notifying users whenever data matches their queries.

3.2 It was common ground during the procedure before the opposition division and during the appeal procedure that A1 represented the closest prior art.

Features 1) to 4) (see point 2.1) have been added with respect to the claims on which the decision under appeal was based. Feature 1) however is already disclosed on page 35, lines 17 to 20 of A1. Features 2) and 3) are, in the board's judgement, implicitly disclosed in A1, page 16, lines 21 to 24. This passage teaches that the user request includes the user's mailbox number and the message identifier. These data represent data entries or parameters identifying the message in the storage area, as specified in features 2) and 3) of claim 1.

3.3 The differences between the subject-matter of claim 1 and the disclosure of A1 are thus feature 4) (see point 2.1), i.e. that:

- 4) **the search results are stored as a user named open search wherein the search is reactivated in response to a user request or as a user named closed search wherein the messages in a named search are limited to those existing at the time of the search,**

and the feature that:

- 5) **the system user request comprises a search query form specifying at least one parameter for the search request.**

3.4 Feature 5) provides the technical effect that the entry of the search parameters is standardized for all users and solves the technical problem of improving the search procedure, especially if the number of users and message identifying parameters are scaled up. The board judges that the skilled person would, in order to solve this problem, take into account the teaching of A7 (see Figures 9 and 10) with respect to searching for mark-up language documents stored on a server by using search forms. The skilled person would thus implement the use by every user of a search query form to be filled in with a plurality of search parameters, in order to both standardize the requests of all users and achieve a more detailed and scoped search in a user's mailbox. Therefore feature 5) does not contribute to an inventive step of the subject-matter of claim 1.

3.5 Feature 4) provides the technical effects:
- that the messages corresponding to a previously performed search are retrievable at a later time, and
- that, in case the search has been stored as an open search, the messages corresponding to a previously performed search are augmented, upon user request, by newly stored messages satisfying the search parameters.
In both cases, closed or open search, search time and resources are saved since previous results are re-used without having to be searched again.

The objective technical problem solved by feature 4) may thus be formulated as how to improve the performance and flexibility of the message storing and

delivering method of A1 with respect to saving time and resources.

3.6 Documents A16 to A19 have been cited by the former opponent as a result of the introduction of features related to the storage of the search results as a closed or open search into the claims by the appellant. These documents are thus relevant for the assessment of the contribution of feature 4) to an inventive step of the subject-matter of claim 1.

A16 discloses a method for implementing open searches over databases, which are being **continually** updated. In particular, A16 describes in page 469, section 1, "Introduction", that the database management system actively monitors the arrival of desired information and provides it to the interested users as it becomes available. The open search disclosed in A16 is thus always active in the sense that results are returned to the user as soon as new information matching the search query arrives in the database. There is however no disclosure of storage of search results and of reactivation of a search in response to a user request, as defined in feature 4).

A17 discloses the use of triggers for initiating actions in a database upon modification of data. There is however no disclosure in A17 that these triggers could initiate the return of results of a search query to a user. Moreover, the disclosed triggers are automatic (see page 310, line 8) which implies that, even if they were used for returning results to a user, the user would have no influence on the reactivation of a search.

A18 discloses that the search queries in the "Tapestry" system are continuous (see page 66, middle column, lines 3 to 19). If a message database update results in new query matches, the new results are returned to the user. Therefore, the reactivation of the search query does not occur in response to a user request, as defined in feature 4), but automatically in response to a database update.

A19 discloses in further details the continuous queries of the "Tapestry" system. This document recognizes that a straightforward implementation of a continuous query by periodically executing the query may be inefficient in terms of cost (see page 322, left-hand column, first paragraph). To address this issue, A19 further discloses that a user query may, after a first execution, be transformed in a continuous incremental query, i.e. a query limited to the portion of the database that might newly match the query, and that the user may decide on the frequency of its running queries (see page 330, left-hand column, paragraph "Flexible scheduling"). This frequency is however determined by the user at the time of writing the continuous query in the specific query programming language. Therefore, reactivation of the search query is not performed in response to a user request, as defined in feature 4), but automatically at periodic predefined time intervals.

Therefore, even if the skilled person were to combine the teachings of any of A16, A17, A18, or A19, in order to solve the objective technical problem as formulated in point 3.5 above, it would at most arrive at

designing a method wherein the open search is continuously reactivated at fixed time intervals predefined by the user at the time of programming the search request, but not at the solution of the patent in question.

The appellant plausibly argued in this regard that reactivation of the open search in accordance with feature 4), i.e. under the control of the user, results in improved efficiency of use and reduction of waste of resources. The board agrees in particular that it has to be considered that the storage capacity for personal computers was a critical issue at the priority date of the patent (year 1997) and that continuously sending search results to a user's computer, without any control by the user itself, would often have caused overflow of the memory portion dedicated to messages.

3.7 For the afore-mentioned reasons the board judges that feature 4) confers an inventive merit on the subject-matter of claim 1 (Article 56 EPC). For the same reasons, the corresponding independent system claim 6 also meets the requirements of Article 56 EPC. Since claims 2 to 5 refer to independent claim 1, they also meet the requirements of Article 56 EPC.

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 with the order to maintain the patent on the basis of the claims according to the main request, submitted during the oral proceedings, and a description to be adapted.

The Registrar: The Chair:

K. Götz A. Ritzka