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**Datasheet for the decision
of 26 July 2013**

Case Number: T 0772/10 - 3.5.03

Application Number: 01961109.4

Publication Number: 1330906

IPC: H04L 29/00

Language of the proceedings: EN

Title of invention:

E-mail proxy

Applicant:

Research in Motion Limited

Headword:

E-mail proxy/RESEARCH IN MOTION

Relevant legal provisions:

EPC Art. 54, 111(1)

Relevant legal provisions (EPC 1973):

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Keyword:

"Novelty (yes) - after amendment"

"Remittal to the department of first instance (yes)"

Decisions cited:

-

Catchword:

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Case Number: T 0772/10 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 26 July 2013

Appellant: Research in Motion Limited
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Decision under appeal: Decision of the examining division of the
European Patent Office posted 7 October 2009
refusing European patent application
No. 01961109.4 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: F. van der Voort
Members: A. J. Madenach
R. Moufang

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division refusing European patent application No. 01961109.4. The reason given for the refusal, as indicated by reference to a previous communication, was that the subject-matter of claim 1 did not fulfil the requirement of novelty (Articles 52(1) and 54 EPC) having regard to the disclosure of:

D2: WO 99/14909 A

and the common knowledge.

II. A further document:

D1: US 5 781 901 A

was referred to in the examination procedure.

III. In the statement of grounds of appeal the appellant requested that the decision be set aside and a patent be granted on the basis of a set of claims 1 to 7 of a main request or, in the alternative, on the basis of a set of claims 1 to 6 of an auxiliary request, both requests as filed with the statement of grounds of appeal. Oral proceedings were requested in the event that the decision could not be set aside.

In a fax letter dated 10 July 2013 the appellant requested the board to continue the procedure with the pending auxiliary request as a main request and to set aside the impugned decision and remit the case for further examination on the basis of this request.

IV. Independent claim 5 of the main request reads as follows:

"A system for selectively downloading a multi-part e-mail message for a user, the multi-part e-mail message including a text part and at least one attachment, the at least one attachment being encoded, the system comprising an e-mail server (22) for receiving the multi-part e-mail message from a sender and an e-mail client (14) operated by a user for receiving e-mail messages, the system characterized by further comprising:

an e-mail proxy (20) in communication with said e-mail server and said e-mail client, adapted for retrieving the text part of the multi-part e-mail message from the e-mail server, adapted for downloading the at least one attachment of the multi-part e-mail message separately from the text part from the e-mail server, adapted for decoding the at least one attachment, adapted for preparing a formatted message containing the text part and a link to the at least one attachment, and adapted for sending the formatted message to the e-mail client to be displayed to the user, such that the decoded attachment is selectable to be displayed to the user in response to a selection of the link by the user, wherein downloading of the at least one attachment of the multi-part e-mail message from the e-mail server and preparing of the formatted message are performed in parallel."

Independent claim 1 of the main request relates to a corresponding e-mail proxy method.

Independent claim 6 of the main request relates to a corresponding e-mail proxy.

More specifically, it is noted that claims 1 and 6 each comprise the feature "wherein downloading of the at least one attachment of the multi-part e-mail message from the e-mail server and preparing of the formatted message are performed in parallel".

Reasons for the decision

1. *Main request: Novelty (Article 54 EPC)*

- 1.1 Claim 5 of the main request comprises the feature that the e-mail proxy is adapted for downloading the attachment of the multi-part e-mail message **separately** from the text part.

This feature was originally disclosed at page 4, lines 26-28 of the published application.

Claim 5 of the main request further comprises the feature that "downloading of the at least one attachment of the multi-part e-mail message from the e-mail server and preparing of the formatted message are performed in parallel".

This feature derives from original claim 9.

- 1.2 D2 discloses a system in which a multi-part e-mail message 20 (Figure 2), which originates from a sender or server, is destined for a client or user. The multi-

part e-mail message 20 comprises a text part 21 and an attachment 22. The system comprises a message filter 2 in communication with the server and the client. The filter is adapted for downloading the attachment from the server, separating the attachment from the multi-part e-mail, decoding it, and storing it in a store (page 12, lines 12-20). The filter is furthermore adapted for preparing a formatted message, *i.e.* reference message 23, containing the text part and a reference to the stored attachment, *i.e.* stored message part 24 (page 13, lines 1 and 16), and for sending this reference message to the e-mail client (page 12, lines 18-26) in order to be displayed to the user. The decoded attachment is selectable to be displayed to the user in response to a selection of the reference by the user (page 12, line 32 to page 13, line 2).

Given the configuration and the function of the message filter 2 (page 11, lines 5-12) and the reference (page 22, line 34, to page 23, line 4), the board considers the filter as constituting an e-mail proxy and the reference as constituting a link to the at least one attachment.

In the embodiment shown in Figure 5 and described at page 20, line 1, to page 21, line 30, the incoming e-mail is a reference message which contains a reference to a part of the message stored elsewhere and not conveyed (page 18, lines 20-25). If the stored message part is stored overseas the filter may arrange to transfer the stored message part to a more local store (page 20, lines 5 to 10).

This means that the filter (the proxy in the terms of the claim) first downloads the text part of the incoming message, *i.e.* the reference itself, in order to be able to determine that the message part is stored overseas, and then downloads the message part from the overseas store to a more local store.

Since attachments within the meaning of the present application correspond to referenced messages (page 4, line 18, of the application as published), the filter, *i.e.* the proxy, of D2 is adapted for downloading an attachment of the multi-part e-mail message separately from the text part.

- 1.3 The feature of claim 5 of the main request according to which the downloading of the attachment and the preparation of the formatted message are performed **in parallel** is not disclosed in D2.

More specifically in D2, amendment of the reference message to reference to the local store and, hence, the preparation of the formatted message occur **after** the downloading of the attachment to the local store (page 20, lines 14-16).

- 1.4 The subject-matter of claim 5 of the main request is thus novel over D2.

- 1.5 With respect to the disclosure of D1, the board notes that according to D1 an e-mail attachment may, like in D2, be transferred to a post office which is closer to the receiver (column 9, lines 19 to 33). The disclosure of D1 does not however show a proxy which is adapted to decode the attachment.

The subject-matter of claim 5 of the main request is thus novel over D1 too.

1.6 The above considerations apply *mutatis mutandis* to independent claims 1 and 6, since they comprise the same feature which relates to the downloading of the attachment and the preparation of the formatted message **in parallel** (see point IV above).

1.7 The board concludes that the amendments made to the claims according to the main request overcome the only ground for the refusal, *i.e.* lack of novelty.

The decision is therefore to be set aside.

2. *Remittal (Article 111(1) EPC)*

The board considers it appropriate to remit the case to the department of first instance for further prosecution.

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 on the basis of the claims of the main request.

The Registrar:

The Chairman:

G. Rauh

F. van der Voort