

Internal distribution code:

- (A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 23 October 2014**

Case Number: T 1199/10 - 3.5.07

Application Number: 98950864.3

Publication Number: 1019846

IPC: G06F17/00, H04L12/58

Language of the proceedings: EN

Title of invention:

Network message redirection

Applicant:

Oracle America, Inc.

Headword:

Network message redirection/ORACLE AMERICA

Relevant legal provisions:

EPC Art. 54, 113(1)

EPC R. 103(1) (a)

Keyword:

Novelty - (yes)
Remittal to the department of first instance - (yes)
Right to be heard - substantial procedural violation (yes)
Reimbursement of appeal fee - (yes)

Decisions cited:

T 0763/04, T 1557/07

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1199/10 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 23 October 2014

Appellant: Oracle America, Inc.
(Applicant) 500 Oracle Parkway
Redwood City, CA 94065 (US)

Representative: Davies, Simon Robert
D Young & Co LLP
Briton House
Briton Street
Southampton SO14 3EB (GB)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 15 January 2010 refusing European patent application No. 98950864.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman R. Moufang
Members: R. de Man
M. Rognoni

Summary of Facts and Submissions

I. The applicant (appellant) filed an appeal against the decision of the Examining Division refusing European patent application No. 98950864.3.

II. The contested decision cited *inter alia* the following documents:

D4: Birrell A. et al.: "Implementing Remote Procedure Calls", ACM Transactions on Computer Systems, Vol. 2, No. 1, February 1984, pages 39 to 59;

D5: Narender V.R. et al.: "Dynamic RPC for Extensibility", Proceedings of the 11th Annual International Phoenix Conference on Computers and Communications, April 1992, pages 93-100;

D6: Notkin D. et al.: "Interconnecting Heterogeneous Computer Systems", Communications of the Association for Computing Machinery, vol. 31, no. 3, March 1988, pages 258 to 273; and

D7: WO 97/19415, published on 29 May 1997.

The Examining Division came to the conclusion that the subject-matter of independent claims 1 and 15 of the sole request lacked novelty in view of document D4.

In point 7 of the section "Facts and submissions", the decision mentioned that the subject-matter of the independent claims of an earlier set of claims had been found to lack novelty over documents D4, D5 and D6.

III. With the statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the application documents considered in the contested decision, i.e. on the basis of the claims filed with a

letter dated 2 February 2009. The appellant further requested that oral proceedings be appointed in the event that the Board refused the substantive request.

- IV. In a communication pursuant to Rule 100(2) EPC, the Board drew the appellant's attention to the following document cited in the international preliminary examination report:

D10: Long, V.: "Multiplayer Goes Global: Play on the Internet for Free", Computer Life, June 1996, pages 145-149.

The Board expressed the provisional opinion that the subject-matter of independent claim 1 was new over document D4 and that it was minded to allow the appeal and to remit the case to the Examining Division for further prosecution. The appellant was invited to comment on whether the Examining Division had committed a substantial procedural violation and, if so, whether this merited reimbursement of the appeal fee.

- V. With a letter dated 14 July 2014, the appellant amended its requests. It accepted that the case should be remitted to the department of first instance for further prosecution without oral proceedings on the understanding that the original decision "ha[d] in effect been overturned". It requested reimbursement of the appeal fee under Rule 103(1)(a) EPC, having regard to Article 113(1) EPC, on the basis that the decision under appeal did not allow verification that the appellant's submissions had been heard. Such reimbursement was equitable because an appeal would not otherwise have been necessary.

VI. Independent claim 1 reads as follows:

"A method for redirecting communication (20) on a network (16) between a client (10) and a network resource (14), comprising the steps of:

executing a software program (24) on the client (10), the software program (24) configured to listen to at least one communications port (26a-26c) of the client during a communication session, the software program (24), upon detecting a message sent to the communications port by an application executing on the client, redirecting the message to the network resource (14) across a network, thereby, enabling the application to communicate with the network resource (14) by communicating with the communications port of the client (10)."

Independent claim 15 reads as follows:

"A storage device tangibly storing a software program (24) which, when executed on a client (10), causes communication on a network (16) between the client (10) and a network resource (14) to be redirected, wherein the software program (24) is configured to listen to at least one communications port (26a-26c) of the client during a communication session, the software program (24), upon detecting a message sent to the communications port by an application executing on the client, redirecting the message to the network resource (14) across a network, thereby, enabling the application to communicate with the network resource (14) by communicating with the communications port of the client (10)."

Reasons for the Decision

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

The present invention relates to means by which network communication originating from a client computer and directed to a communications port of the client computer is redirected to a network resource.

Redirection is performed by a software program running on the client computer. This software program is configured to listen on the communications port of the client computer. Upon detection of a network message sent to this communications port by an application executing on the client computer, the software program redirects the message to the network resource.

The communications port may be a port at the local host address or the local IP address of the client computer. Before being redirected, the message may be manipulated, for example encrypted or compressed.

3. *Document D4*

Document D4 relates to remote procedure calls (RPCs).

Section 1.1 explains that RPCs are a technique for performing procedure calls across a network. When a remote procedure is invoked, the calling environment is suspended, the parameters are passed across the network to the environment where the procedure is to execute, and the desired procedure is executed. The results are passed back to the calling environment, where execution

resumes as if returning from a regular local procedure call.

Section 1.5 discloses a program structure used for RPCs and based on the concept of "stubs". When a user program on a caller machine wishes to invoke a remote procedure on a callee machine, it makes a normal local call to a corresponding "user-stub" on the caller machine. The user stub places a specification of the target procedure and the arguments to the procedure into one or more packets. These packets are relayed, by an "RPCRuntime", to the callee machine and passed to a "server-stub", which unpacks them and makes a normal local call to the appropriate procedure in a server program running on the callee machine.

4. *Novelty - Article 54(1) and (2) EPC*

4.1 According to the decision under appeal, claim 1 is fully anticipated by document D4. The decision equates the "software program" of claim 1 to the "user-stub" of Figure 1 of document D4. In respect of the features "the software program configured to listen to at least one communications port of the client during a communication session" and "the software program, upon detecting a message sent to the communications port by an application executing on the client, redirecting the message to the network resource across a network", the decision refers to page 43, section 1.5, of document D4 and in particular to the sentence on lines 35 to 38:

"The user-stub is responsible for placing a specification of the target procedure and the arguments into one or more packets and asking the RPCRuntime to transmit these reliably to the callee machine."

- 4.2 In the statement of grounds of appeal, the appellant repeated arguments filed with its earlier letter dated 2 February 2009.
- 4.2.1 According to the appellant, the present invention had nothing to do with remote procedure calls. A number of examples were given of what the skilled person would understand to be fundamental differences between network communication as in the present invention and remote procedure calls.
- 4.2.2 Focusing on the language of claim 1, the appellant objected to equating the "software program" of claim 1 with the "user stub" of document D4. According to claim 1, the software program was for "detecting a message sent to the communications port by an application executing on the client". The user stub instead waited to receive a procedure call from a calling routine. Calling a procedure was very different from sending a message. Furthermore, in an RPC the calling routine directly called the user stub, and this did not involve anything that could correspond to a communications port. In addition, the user stub did nothing that could be regarded as "listening" on a communications port, and the skilled person would not regard a procedure call as a "message".
- 4.3 The Board concurs with the appellant's view that the novelty reasoning presented in the contested decision is unconvincing. Document D4, page 43, lines 33 to 35, explains that when the user (i.e. an application program, see lines 28 to 30) wishes to make a remote call, it makes a "perfectly normal local call which invokes a corresponding procedure in the user-stub". In other words, the user stub is invoked as a regular

procedure and is not "configured to listen to at least one communications port" and does not act upon "detecting a message sent to a communications port".

4.4 The subject-matter of claim 1 and of corresponding independent claim 15 is therefore novel over document D4 within the meaning of Article 54(1) and (2) EPC.

5. *Remittal to the department of first instance*

5.1 Since document D4 is concerned with the redirection of local procedure calls and not with the redirection of network messages, it does not appear to represent a suitable starting point for the assessment of inventive step. The same applies to documents D5 and D6, which likewise relate to RPC technology. Nevertheless, the Board considers that it is not in a position to decide on inventive step.

5.2 Firstly, the "software program" of claim 1 appears to bear a similarity to known network proxy programs such as the Krakatoa proxy server discussed in document D7 on page 21, line 9, to page 22, line 2, and conventional HTTP proxy servers, which redirect network messages from a web browser application to a web server. Although it might not have been usual practice at the priority date to run such a proxy program on the same computer as the application connecting to it, it may still have to be examined whether this distinction involves an inventive step.

5.3 Secondly, the Board has noticed the inventive step objection raised in the international preliminary examination report based on document D10. It is not apparent from the file that this document was considered by the Examining Division.

- 5.4 The Board will therefore allow the appeal, but refrain from taking a position on inventive step. The case is hence to be remitted to the department of first instance for further prosecution.
6. *Right to be heard - Article 113(1) EPC*
- 6.1 The right to be heard under Article 113(1) EPC encompasses the right of a party to have its comments considered in the written decision (see decision T 763/04 of 22 June 2007, reasons 4.3 and 4.4). Although a decision does not have to address each and every argument of a party in detail, it must comment on the crucial points of dispute in order to give the losing party a fair idea of why its arguments were not considered convincing (cf. decision T 1557/07 of 9 July 2008, reasons 2.6).
- 6.2 In the examination proceedings, the crucial point of dispute was whether document D4 actually disclosed the features of claim 1 in combination. With its letter dated 2 February 2009 the appellant gave arguments as to why it did not. These arguments are summarised in points 4.2.1 and 4.2.2 above.
- 6.3 With respect to these arguments, the decision under appeal merely states that "[t]he applicant mainly argued that his invention has nothing to do with remote procedure calls, remote procedure calls being just one form of communications", to which it responds with "there may certainly be differences of the prior art from claim 1, but [...] the decisive question is whether the claim differs from the prior art, which is not the case".

6.4 With this statement, the Examining Division apparently intended to express that the subject-matter of a claim may still lack novelty if the prior art shows features that are absent from the claim. If the appellant had only argued, without referring to the language of claim 1, that differences existed between network communication and remote procedure calls, this general statement might have been sufficient.

However, the arguments in the letter of 2 February 2009 summarised in point 4.2.2 above refer to specific features of claim 1 and explain why the appellant did not consider these to be disclosed by the cited passages of document D4. The Examining Division's decision does not explicitly address these arguments, nor can its novelty reasoning as summarised in point 4.1 above be said to implicitly refute them. There is in fact nothing in the decision that proves that the Examining Division took these arguments into account.

6.5 By failing to comment on a crucial point of dispute, the Examining Division infringed the appellant's right to be heard and thereby committed a substantial procedural violation. The novelty objection being the only ground for the refusal, this procedural violation was causal for the appeal, and reimbursement of the appeal fee under Rule 103(1)(a) EPC is therefore equitable.

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 request for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:



I. Aperribay

R. Moufang

Decision electronically authenticated