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**Datasheet for the decision
of 9 September 2016**

Case Number: T 2170/10 - 3.5.07

Application Number: 04757503.0

Publication Number: 1606738

IPC: G06F17/30

Language of the proceedings: EN

Title of invention:

A meta-search web service-based architecture for peer-to-peer collaboration and voice-over-IP

Applicant:

Siemens Corporation

Headword:

Peer-to-peer collaboration/SIEMENS CORPORATION

Relevant legal provisions:

EPC Art. 108
EPC R. 99(2)

Keyword:

Admissibility of appeal - appeal sufficiently substantiated
(no)

Decisions cited:

Catchword:



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Boards of Appeal
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Case Number: T 2170/10 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 9 September 2016

Appellant: Siemens Corporation
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Representative: Maier, Daniel Oliver
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 18 May 2010 refusing European patent application No. 04757503.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

I. With decision taken in oral proceedings on 28 April 2010 in the absence of the then applicant "Siemens Corporate Research, Inc." and dispatched on 18 May 2010, the Examining Division refused the European patent application no. 04757503.0.

II. In the contested decision, the Examining Division found, *inter alia*, that the subject-matter of claim 1 filed with letter dated 26 March 2010 was not new with respect to the following document:

D1: EP-A-1 229 442.

III. Claim 1 considered by the Examining Division reads as follows:

"A system for discovering potential collaborators (535A, 535B, 535C) on a peer-to peer [*sic*] (P2P) network comprising:

- a seeker device (510); and
- a plurality of collaborator devices operatively connected to the P2P network;

wherein each of the plurality of collaborator devices is associated with one or more identity files, each of the identity files comprising a plurality of searchable elements forming a collaborator profile;

wherein one or more of the plurality of collaborator devices post their one or more identity files on the P2P network;

wherein the seeker device searches the P2P network to discover one or more of the plurality of collaborator devices based on one or more elements of

the one or more identity files of the plurality of the collaborator devices; and

wherein the seeker device initiates a collaboration session with the one or more collaborator devices."

- IV. As indicated in a communication dated 3 August 2010, Siemens Corporation was registered as new applicant in view of a merger with effect from 26 July 2010.

- V. With notice of appeal dated 27 July 2010, the new applicant, Siemens Corporation, (appellant) appealed against the decision of the Examining Division and requested that the contested decision be set aside and a patent be granted on the basis of the claims rejected by the Examining Division.

In case these requests were not allowable by means of written proceedings, the appellant requested oral proceedings.

- VI. A statement setting out the grounds of appeal was filed on 27 September 2010.

- VII. With letter dated 26 February 2016, the appellant was summoned to oral proceedings to be held on 26 July 2016.

- VIII. With letter dated 10 March 2016, the appellant requested that a different date be fixed for the oral proceedings and provided a justification for its request.

- IX. Following the appellant's request, oral proceedings were rescheduled for 9 September 2016.

- X. With letter dated 28 April 2016 the appellant filed claims 1 to 9 according to an auxiliary request, and requested that a patent be granted on the basis thereof, if the Board intended to reject the main request.
- XI. In a communication pursuant to Article 15(1) RPBA, the Board, *inter alia*, expressed its doubts as to the admissibility of the appeal. In particular, it questioned whether the appellant's opinion on the novelty of the claimed subject-matter, succinctly expressed in the statement of grounds of appeal without any reference to passages of the prior art document, could be regarded as a sufficient substantiation of the reasons, facts and evidence on which the appeal was based (Rule 99(2) EPC).
- XII. In reply to the Board's communication, the appellant essentially argued, with letter dated 13 June 2016, that the statement of grounds was sufficiently substantiated, as it made clear that, contrary to the Examining Division's opinion, document D1 did not disclose an essential feature of the claimed invention.
- Furthermore, the appellant withdrew the main request and asked the Board to take the auxiliary request on file as the new main request.
- XIII. Oral proceedings were held as scheduled on 9 September 2016. The appellant confirmed its final requests, namely that the decision under appeal be set aside and a patent be granted on the basis of the claims of the sole request, filed as auxiliary request with letter dated 28 April 2016. At the end of the oral proceedings, the Chairman pronounced the Board's decision.

XIV. As claim 1 of the new main request is not relevant to the present decision, its wording need not be given.

XV. The appellant's arguments may be summarised as follows:

According to the decision of the Examining Division, all features recited in claim 1 were disclosed in document D1. In the statement of grounds of appeal, it was made clear that the appellant contested the Examining Division's conclusion because document D1 did not disclose that the elements (fields) of an advertisement of a peer resource were searchable elements, *i.e.* that the elements could be used as search criteria for searching a particular peer resource, as recited in claim 1. At the time of filing of the statement of grounds of appeal, the appellant believed that it was neither necessary nor possible to provide further evidence or arguments that a feature of claim 1 was not to be found in the closest prior art. As the reasons for setting aside the contested decision were sufficiently substantiated in the statement of grounds, the appeal should be regarded as admissible.

Reasons for the Decision

Admissibility of the appeal

1. Under Article 108, third sentence, EPC a statement setting out the grounds of appeal shall be filed within four months after the date of notification of the decision in accordance with the Implementing Regulations.

In the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the impugned decision, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based (see Rule 99(2) EPC).

- 1.1 According to the case law of the boards of appeal (see Case Law of the Boards of Appeal of the EPO, 8th edition 2016, IV.E.2.6.3 a)), whether the requirements of Article 108, third sentence, EPC are met has to be decided on the basis of the statement of grounds of appeal and of the reasons given in the contested decision, taking into account any amendments made to the claims.

In particular, if the appellant submits that the decision under appeal is incorrect, then the statement setting out the grounds of appeal must enable the board to understand immediately why the decision is alleged to be incorrect and on what facts the appellant bases its arguments, without first having to make investigations of its own.

2. In the present case, the application was refused, *inter alia*, because of lack of novelty of the subject-matter of claim 1 of the then pending sole request in view of document D1. In paragraph 2.1.1 of its decision, the Examining Division listed all the features of the system according to claim 1 and indicated where in D1 each claim feature was considered to be disclosed.
 - 2.1 In particular, with reference to the feature "*wherein each of the plurality of collaborator devices is associated with one or more identity files, each of the identity files comprising a plurality of searchable elements*", the Examining Division identified in

document D1 the following passages of paragraphs [0134] and [0139]:

- *"the peer-to-peer protocol may use advertisement to describe and publish the existence of a peer"* (paragraph [0134]);
- *"peer advertisement is to hold specific information about the peer, such as its name, identifier and registered services"* (paragraph [0139]).

Furthermore, with regard to the feature *"wherein the seeker device searches the P2P network to discover one or more of the plurality of collaborator devices based on the one or more identity files of the plurality of the collaborator devices"*, the Examining Division identified paragraphs [0173] and [0213] of D1, and commented that the latter described the discovery query and criteria which could be used for the search.

2.2 Additionally, the Examining Division, noting in paragraph 2.2.1 of the decision that, according to the (former) applicant's submissions made in writing with letter dated 26 March 2010, document D1 did not disclose a search mechanism for elements of a published collaborator profile, drew the (former) applicant's attention to paragraphs [0173] and [0213] which described the discovery query that could be used for the search.

2.3 Although the Examining Division did not further elaborate on the content of the cited paragraphs of document D1, there can be no doubt that they are relevant to the claimed subject-matter and, at least *prima facie*, appear to give support to the Examining Division's lack-of-novelty objection.

In fact, it is stated in paragraph [0139] of document D1 that *"[a] peer advertisement may describe the peer resources. One use of a peer advertisement is to hold specific information about the peer, such as its name, peer identifier, registered services and available endpoints"*.

Paragraph [0173] in the section titled *"Peer Discovery Protocol"* indicates that the peer-to-peer platform may include a peer discovery protocol that may allow a peer to find advertisements on other peers. *"The peer discovery protocol may be used to discover any published peer resources including other peers, peer groups, pipes, services and any other resource that has an advertisement in the peer-to-peer network"*.

According to paragraph [0213], a discovery query message may be used to send a discovery request to find advertisements (e.g. for peers or peer groups).

3. In the statement of grounds of appeal, the appellant made the following submissions against the refusal of the application and in particular against the objection under Article 54 EPC on which the Examining Division's decision was based:

(a) *"Disclosure of Document D1 (EP-A-1 229 442):*

According to document D1 (view par [0173]) the peer discovery protocol is used to discover any published peer resource (i.e. peer, peer groups, pipes, services, etc.) that has an advertisement in the peer-to-peer network.

Document D1 discloses that the advertisement of a peer resource comprises particular elements (view paragraph 139) "

(b) "Difference between the disclosure of document D1 and claim 1"

According to claim 1 of the invention, the elements of an identity file of a collaborator device are searchable elements, i.e. the elements can be used as search criteria for searching one or more particular collaborator [sic].

Document D1 does not disclose that the elements (fields) of an advertisement of a peer resource are searchable elements, i.e. that the elements can be used as search criteria for searching a particular peer resource.

(The difference explained above is based on the attempt to equate the terms "identity file" and "collaborator" as used according to claim 1 of the invention with the term "advertisement" and "peer" as used according to document D1)."

- 3.1 Hence, in the statement of grounds of appeal, the appellant gave the impression of acknowledging that D1 used "advertisements" to publish peer resources on a peer-to-peer network and that an advertisement comprised "particular elements". However, it then merely stated that the elements of an advertisement were not searchable elements, without providing any justification for its different interpretation of the content of document D1 (see (b) above). In doing so, the appellant failed to comment in particular on the content of paragraph [0213] of document D1 which, according to the Examining Division, described the discovery query and criteria used for the search of peer resources. Furthermore, the appellant did not make clear whether, in its view, the Examining Division was wrong in equating an "advertisement" with the "identity file" according to claim 1, and in equating the term "collaborator" with the term "peer".

- 3.2 In summary, the Board finds that the content of the statement of grounds is not sufficient to identify which reasons would support the appellant's essential argument in favour of the novelty of the then claimed subject-matter, namely that the elements of an advertisement of a peer resource according to document D1 could not be used as search criteria for searching a particular peer resource.
4. The Board furthermore notes that in the letter dated 26 March 2010, to which the Examining Division referred in paragraph 2.2 of its decision, the former applicant had already asserted that document D1 did not disclose *"a search mechanism for elements (single or combined) of a published user profile (collaborator identity)"*, and that according to the invention *"peer resources"* were *"posted/published on a collaborator profile base ..., whereas the elements of the collaborator profile"* were *"(single or combined) searchable"*.
- 4.1 In other words, the appellant appears to have replied to the Examining Division's refutation of its submissions in the first instance proceedings by repeating essentially the same assertions in the statement of grounds of appeal.
- 4.2 As the case law of the boards of appeal has made abundantly clear (cf. Case Law of the Boards of Appeal of the EPO, 8th edition 2016, IV.E.2.6.3a), third paragraph), the appeal procedure is not a mere continuation of the examination procedure. Where the applicant in the grounds of appeal repeats its arguments set out during the examination phase without taking into account the decision under appeal, it mistakes the function of the boards of appeal. They are

not a second go at the examination procedure, but are meant to review decisions made by the examining divisions, based on the objections raised against the decision in the grounds of appeal, which must therefore relate to the reasons on which the decision under appeal is based.

5. For the above reasons and in accordance with the case law of the boards of appeal, the Board comes to the conclusion that the statement of grounds of appeal does not sufficiently substantiate the appeal. Hence, the appeal is inadmissible.

5.1 As the appeal has to be rejected as inadmissible, no substantive issues can be considered.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:



I. Aperribay

R. Moufang

Decision electronically authenticated