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**Datasheet for the decision
of 13 May 2015**

Case Number: T 0359/11 - 3.4.03

Application Number: 08759496.6

Publication Number: 2150949

IPC: G09B5/00, G09B7/00

Language of the proceedings: EN

Title of invention:
SYSTEM AND METHOD FOR MANAGING AND DELIVERING E-LEARNING TO
HAND HELD DEVICES

Applicant:
Intuition Publishing Limited

Headword:

Relevant legal provisions:
EPC Art. 56, 111(1), 113(2), 123(2)
EPC R. 137(3)
EPC 1973 R. 45
PCT Art. 15, 17(2)(a), 18
PCT R. 39.1(v)
Notice from the European Patent Office dated 26 March 2002
concerning business methods (OJ 2002, 260-261)
Notice from the European Patent Office dated 1 October 2007
concerning business methods (OJ 2007, 592-593)

Keyword:

Amendments - consent of examining division (no)
Examination procedure - correct exercise of discretion (no)
Inventive step - mixture of technical and non-technical
features
Additional search
Remittal to the department of first instance

Decisions cited:

G 0007/93, T 0939/92, T 1242/04, T 0690/06, T 1411/08,
T 0698/11

Catchword:

Where the relevant search authority has stated, either in a search report or in a declaration that no search report will be established, that it is not necessary to cite any documentary evidence of the prior art on the grounds that all of the technical features of the claimed invention are notorious, it is always incumbent upon the examining division to consider whether an additional search is necessary. The criterion to be applied is that if the invention as claimed contains at least one technical feature which is not notorious, the application should normally not be refused for lack of inventive step without performing an additional search (see Reasons, point 3.9, and T 690/06, Reasons, point 8).



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Case Number: T 0359/11 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 13 May 2015

Appellant: Intuition Publishing Limited
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Representative: Moore, Barry
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 23 November 2010 refusing European patent application No. 08759496.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Eliasson
Members: S. Ward
C. Heath

Summary of Facts and Submissions

- I. The appeal is against the decision of the Examining Division refusing European patent application No. 08 759 496. The ground for refusal was stated as follows: "Since the division does not consent to the amendments leading to the main and auxiliary requests (Rule 137(3) EPC) there is no text on file which has been agreed by the applicant (Article 113(2) EPC)."
- II. In the statement of grounds of appeal the appellant requested that the decision be set aside and that the application be allowed to proceed to grant based on the main or the auxiliary request (both filed with the letter of 8 September 2010), or alternatively that the application be remitted to the Examining Division for further examination.
- III. The application was originally filed under the PCT with International Application number PCT/EP2008/055765. An International Search Report (ISR) was drawn up according to Article 18 PCT by the EPO acting as the International Searching Authority (ISA) in which no specific prior art documents were cited. Instead, section C (entitled "DOCUMENTS CONSIDERED TO BE RELEVANT") contained the following statement (said to apply to claims 1-24, i.e. all claims then on file):
- *"The technical aspects identified in the present application (Art. 15 PCT) are considered part of common general knowledge. Due to their notoriety no documentary evidence is found to be required. For further details see the accompanying Opinion and the reference below. XP002456414".*

Furthermore, no evidence of the prior art was cited during the examination of the European application or in the contested decision.

IV. Claim 1 of the main request reads as follows:

"A computer implemented distributed learning system including:

- a) a central server having provided thereon a management module and a datastore configured to store one or more coursework modules, the management module being interfaceable with the datastore and configured to manage a distribution of one or more of the stored coursework modules to one or more defined remote users, each of the remote users having an associated hand held device,*
- b) a storage module being provided on each handheld device for storing the distributed coursework modules;*
- c) an application locally stored and executable on the handheld device of the remote user, the application being configured to enable an interface of the handheld device with the central server to obtain periodic downloads through a wireless communication network of selected coursework from the central server and to provide such coursework locally to the user, the application enables the handheld device to locally run the coursework modules,*
- d) a tracking module having components provided on each of the central server and the local handheld device, the tracking module component on the local handheld device being configured to track user interaction with the locally stored coursework and to periodically provide that information to the*

corresponding tracking module component on the server."

V. The Examining Division found essentially as follows:

The claims of the main request corresponded to the claims filed on entry into the European regional phase with some minor clarifying amendments which introduced no further limiting feature. Thus, the reasoning already given with respect to lack of inventive step of the claims filed upon entry in the European phase remained *prima facie* unaffected; it could not be expected that a non-limiting "clarification" of subject-matter could overcome an objection under Article 56 EPC. As this assessment still held, consent to the amendments leading to the formulation of the main request was withheld under the provisions of Rule 137(3) EPC.

Claim 1 of the auxiliary request also *prima facie* did not overcome the objection under Article 56 EPC, and hence consent to the introduction of this request was also withheld under the provisions of Rule 137(3) EPC.

In relation to inventive step, the reasoning previously given to the applicant could be summarised as follows: claim 1 of the main request was made up of technical and non-technical features, the technical details not going beyond the mention of commonplace and generic computer related components (server, handheld device), and the remaining features relating to a non-technical administrative method for supporting teaching. There was no technical interaction between the technical and non-technical features, besides the fact that a client server system was used to support the administrative method.

The use of a commonplace networked computer system to distribute and display information was regarded as being the closest prior art, claim 1 differing in that the administrative method ran as software on that client server system.

The administrative method was not relevant for assessing inventive step (Guidelines, C-IV, 11.5.2), and since the difference between a commonplace (possibly networked) computer and the subject matter of claim 1 could only be found in the administrative method the problem to be solved might be regarded as partially automating the administrative method on a commonplace client server system. The skilled person (a computer programmer) would employ commonplace programming skills and computer knowledge to arrive at the subject-matter of claim 1 which did not therefore involve an inventive step (Article 56 EPC).

Concerning the additional feature of the auxiliary request, no technical feature could be unambiguously derived from the prescription, and a programmer could implement such an administrative scheme if instructed to do so. In any event, associating data essentially equivalent to the identity of a user to coursework was to be expected in any classroom or teaching environment, independently of any technical implementation of such a scheme.

VI. The appellant argued essentially as follows:

Claims substantially corresponding to the claims filed on entry into the European phase had been reinstated in order to address the objections under Article 123(2)

EPC which had been raised in the summons. In refusing to examine the main request pursuant to Rule 137(3) EPC the Examining Division had failed to give the Applicant an opportunity to overcome this Article 123(2) EPC objection.

Furthermore, in trivializing and incorrectly categorizing the invention as an administrative method for supporting teaching, the Examining Division had completely ignored the applicant's inventive step argument.

The features of claim 1 provided a technical solution to a technical problem. When connectivity between the central server and the handheld devices was intermittent, the arrangement allowed a user's interaction with the handheld device to be logged offline and then transmitted to the server when the communication link was re-established.

The closest prior art was in fact the prior art detailed in the background of the present application and not a commonplace client server system.

The arguments supporting the main request applied equally to the auxiliary request. In addition, by associating a user logon with a specific set of coursework modules it was possible to log the activities of any one user and also to allow two or more users to use the same device.

Reasons for the Decision

1. The appeal is admissible.
2. *Non-admittance of requests*
 - 2.1 In the contested decision, the Examining Division elected to use its discretion under Rule 137(3) EPC not to admit either the main request or the auxiliary request into the proceedings, and subsequently refused the application as "there is no text on file which has been agreed by the applicant (Article 113(2) EPC)."

It is not disputed by the appellant that the main and auxiliary requests were filed at a stage in the proceedings where the provisions of Rule 137(3) EPC applied, and hence that the admission of these amended requests required the consent of the Examining Division. The appellant argues, however, that the Examining Division should not have withheld its consent.

Hence, the first question which the Board has to answer is whether the Examining Division used its discretion correctly.

- 2.2 According to established case law, "a Board of Appeal should only overrule the way in which a first instance department has exercised its discretion if it comes to the conclusion either that the first instance department in its decision has not exercised its discretion in accordance with the right principles ... or that it has exercised its discretion in an unreasonable way, and has thus exceeded the proper

limits of its discretion." (G 7/93, OJ 1994, 775, Reasons, point 2.6; see also Case Law of the Boards of Appeal, 7th edition, 2013, III.K.5.)

There is no doubt that the applicant (now the appellant) filed the present main request in an attempt to remove subject-matter which had been objected to by the Examining Division under Article 123(2) EPC. The attempt was apparently successful as there was no objection under Article 123(2) EPC in the contested decision. Clearly there could be no reasonable objection to a successful amendment of this kind, nor does this appear to have been the basis of the Examining Division's refusal to consent to the introduction of the new requests.

It seems to the Board that the position of the Examining Division in this regard is best summarised under point 3 of the minutes of the oral proceedings, which reads as follows:

- *"It was found that the main request was trying to overcome only the objections under Art. 123(2) EPC, but not addressing prima facie any objections under Art. 56 EPC as the amendments were substantially returning to a former set of claims already objected under Art. 56 with only clarifications made by introducing explicitly features that had been implicit."*

Hence, the amendments to overcome the objections under Article 123(2) EPC were seen as unproblematic, but the failure to attempt to overcome, *by amendment*, objections raised under Article 56 EPC led the Examining Division to refuse to admit the main request under Rule 137(3) EPC.

2.3 The Board wishes to point out that when faced with an objection raised by the examining division that the application fails to meet a requirement of the EPC, the applicant is under no obligation to amend the application documents. An equally legitimate response open to the applicant is to argue that the objection is not well-founded.

Throughout the examination procedure it was the position of the applicant that the objections of lack of inventive step raised against the subject-matter of the claims filed on entry into the European phase were invalid. In the letter of 4 June 2010 the applicant noted the Examining Division's negative assessment of inventive step in relation to the claims filed on entry into the European phase, and introduced amendments in an attempt to overcome these concerns. However, the position of the applicant in this regard was clearly stated as follows:

- *"It is respectfully submitted that the Applicant strongly disagrees with this assessment. However, in an effort to expedite proceedings to grant claim 1 has been amended to further enhance its technical aspects."*

Hence, while maintaining that the claims filed on entry into the European phase were inventive, the applicant introduced amendments in an attempt to reach agreement with the Examining Division over allowable subject-matter. This attempt having failed due to the proposed amendments being judged not to meet the requirements of Article 123(2) EPC, the applicant should have been allowed simply to remove the offending subject-matter

without being penalized for having made an attempt to bring the case to a conclusion.

By refusing its consent to the main request, the Examining Division effectively took the position that any admissible request had to incorporate amendments aimed at overcoming its objections under Article 56 EPC. This unreasonably deprived the applicant of the opportunity of simply disagreeing with the Examining Division and obtaining a decision based on a set of claims, duly admitted into the procedure, reflecting what had been its fundamental position throughout.

- 2.4 Since the subject-matter claim 1 of the auxiliary request corresponds to the subject-matter of claim 1 of the main request plus an additional feature, there seems to be even less justification for refusing consent to this request.
- 2.5 Furthermore, the Board can see no reason for withholding consent to the admittance of the requests based on grounds of procedural efficiency.

The requests were received at the EPO prior to the final date for making written submissions and/or amendments (Rule 116 EPC) indicated in the summons. Moreover, the contested decision included the reasons why the Examining Division considered that the requests did not meet the requirements of Article 56 EPC, and the question of inventive step had been extensively discussed in the written procedure. The oral proceedings afforded a further opportunity to comment, and it was the choice of the applicant not to attend. It is therefore not clear to the Board why the Examining Division did not simply refuse the application for lack of inventive step. Invoking Rule

137(3) EPC appears merely to have introduced additional and unnecessary complications.

2.6 For these reasons the Board concludes that the Examining Division did not exercise its discretion under Rule 137(3) EPC in a reasonable manner, and that the main and auxiliary requests should have been admitted into the procedure.

3. *Additional Search*

3.1 Although the Board judges that it was formally incorrect not to admit the main and auxiliary requests into the proceedings, this does not preclude the Board from addressing the question of inventive step in relation to these requests, since the positions of both the Examining Division and the appellant on this matter are clearly set out in the contested decision and the statement of grounds of appeal respectively.

The Examining Division did not consider it necessary to cite any documentary evidence of the prior art in the contested decision, as "the use of a commonplace networked computer system to distribute and display information is regarded as being the closest prior art to the subject-matter of claim 1".

The Board therefore believes that it is necessary to start by asking whether this approach was appropriate in the present case, or whether, given that no documentary evidence of the prior art was cited in the ISR, the Examining Division should have performed an additional search.

In what follows, and in accordance with common usage, the term "additional search" refers to a search

performed by, or at the instigation of, an examining division. In this context the word "additional" does not necessarily imply that a search has previously been carried out.

3.2 The boards have dealt with a number of cases similar to the present one, in which the relevant search authority chose not to cite any specific prior art on the grounds that the claimed subject-matter comprised a mix of technical and non-technical features, and that the technical features were indisputably well-known or "notorious" at the priority date.

3.3 T 1242/04 (OJ 2007, 421) concerned a case in which, during the search phase, a declaration under Rule 45 EPC 1973 was sent to the effect that no search had been possible as the claims related to non-technical subject-matter or to commonly known features for technological implementation of such subject-matter.

Responding to the appellant's objection that no additional search had been carried out, the Board took the view that it was "not always necessary in such circumstances to carry out an additional search in the documented prior art." According to the established case law of the boards of appeal it was possible to raise an objection of lack of inventive step without documented prior art based on "notorious knowledge" (referring to T 939/92, OJ 1996, 309, Reasons, point 2.3), and in such cases "it would be inappropriate to carry out an additional search for documented prior art on purely formal grounds." An additional search was necessary, however, "if the claim features do not form part of the common general knowledge and the appellant also does not acknowledge them to be known." (Reasons, points 9.1 and 9.2.)

3.4 In the case leading to decision T 690/06, the EPO acting as ISA had declined to carry out a search, and instead issued a Declaration of Non-Establishment of International Search Report according to Article 17(2) (a) PCT dated 26 February 2003 on the grounds that the claims related to subject-matter for which no search was required pursuant to Rule 39.1(v) PCT ("mere presentations of information") or "merely specify commonplace features relating to its technological implementation". The application entered the European phase and was ultimately refused for lack of inventive step without any additional search having been carried out.

Commenting on the European examination procedure, the Board was "of the opinion that the examining division should have performed an additional search" since certain claimed features (database partitioning and access control) were "neither non-technical nor notorious." The Board concluded that:

- *"as long as no search has been performed an examining division should normally not refuse an application for lack of inventive step if the invention as claimed contains at least one technical feature which is not notorious. The term 'notorious' should be interpreted narrowly."*
(Reasons, point 8.)

3.5 A similar pattern was followed in the case leading to decision T 698/11 in which the EPO acting as ISA had, for the same reasons, issued a Declaration of Non-Establishment of International Search Report according to Article 17(2) (a) PCT dated 16 March 2006. In the European phase the application was refused for lack of

inventive step without an additional search having been performed.

The Board noted that objections based on notorious knowledge or indisputable common general knowledge were allowable, but that such cases "are exceptional, and a search is otherwise essential." The Examining Division had "overstretched the concept of a notorious networked general-purpose computer" by alleging that a packaging machine constituted a commonplace computer peripheral. The Examining Division should have carried out "a search into the documented prior art pertaining to packaging machines controlled by (networked) computers", and taken the result of the search into account during examination (Reasons, points 2.1-2.3).

- 3.6 T 1411/08 also concerned a case in which the EPO acting as ISA had, again for similar reasons, issued a Declaration of Non-Establishment of International Search Report according to Article 17(2) (a) PCT dated 20 September 2001. The application was ultimately refused on the grounds of lack of inventive step based on an argument in which no documentary evidence was cited.

The Board's view was that an objection of lack of inventive step based on notorious prior art represented an exceptional case, and that the term "notorious" was to be understood firstly as referring to "prior art which is so well known that its existence at the date of priority cannot be reasonably disputed," and secondly "as implying that technical detail is not significant." The term therefore refers to "prior art reflecting ... *generic* features" (emphasis in the original, see Reasons, point 4.2).

The Board found that two claimed features could not be considered to fall within the meaning of "notorious", and hence "the Examining Division could and should have ensured that a search was performed before refusing the application for lack of inventive step." (Reasons, point 6.)

- 3.7 All of the above cases follow a similar pattern in that a declaration by the competent search authority that no search would be established was followed by a European examination procedure in which no additional search was performed, the applications being subsequently refused for lack of inventive step.

The present case is formally different in that the EPO acting as ISA did not make a Declaration of Non-Establishment of International Search Report, but issued an ISR with a mailing date of 30 October 2008 purporting to cover all claims (1-24). However, the ISR established by the ISA contains no documentary evidence of the prior art, but merely the statement referred to under point III, above.

This difference of approach appears to be a consequence of a change in EPO policy, reflecting the fact that the "Notice from the European Patent Office dated 26 March 2002 concerning business methods" (OJ 2002, 260-261) had been superseded by the "Notice from the European Patent Office dated 1 October 2007 concerning business methods" (OJ 2007, 592-593).

- 3.8 It is not necessary for the Board to discuss the respective merits of these different approaches as far as they affect the drawing up of search reports by the EPO. For the present case the relevant question is whether this difference has any implications for the

subsequent examination of inventive step, and the answer is clearly no. Where the result of the search phase is a document referring only to "notorious" prior art, it makes no difference to the subsequent substantive examination of inventive step whether that document is a search report or a declaration of no search.

- 3.9 The opinion of the Board is therefore that where the relevant search authority has stated, either in a search report or in a declaration that no search report will be established, that it is not necessary to cite any documentary evidence of the prior art on the grounds that all of the technical features of the claimed invention are notorious, it is always incumbent upon the examining division to consider whether an additional search is necessary. The criterion to be applied is that if the invention as claimed contains at least one technical feature which is not notorious, the application should normally not be refused for lack of inventive step without performing an additional search (see T 690/06, Reasons, point 8).

Hence, in the present case, the choice of the Examining Division to decide on the issue of inventive step without performing an additional search could only be considered justifiable if the claimed subject-matter comprises no technical features which are non-notorious.

- 3.10 In the Board's view, even a relatively cursory examination of the subject-matter of claim 1 of the main request would strongly indicate *prima facie* that an approach based on notorious prior art is inappropriate.

Claim 1 is directed to a computer implemented distributed learning system. The hardware and software components and the interactions between them are defined at a level of technical detail which must be seen as going beyond merely generic features in which "technical detail is not significant" (T 1411/08 Reasons, point 4.2).

3.11 This impression is confirmed by a detailed analysis of the features of the claim. Even if it were accepted *arguendo* that the central server, the handheld device, the storage module and the application, as well as their defined mutual interactions, are "notorious" - a highly questionable assumption - claim 1 also defines the following feature:

- *"a tracking module having components provided on each of the central server and the local handheld device, the tracking module component on the local handheld device being configured to track user interaction with the locally stored coursework and to periodically provide that information to the corresponding tracking module component on the server."*

Monitoring the interaction of a user with locally stored (downloaded) data on a handheld device and providing information relating to this interaction to a central server clearly must be regarded as a technical process. Hence, a tracking module configured to carry out this process - whether implemented by means of hardware or software - is a technical feature of the claim.

As noted above, the term "notorious" implies that there can be no reasonable doubt that the feature in question

was well known at the date of priority. In the opinion of the Board it is perfectly possible to entertain a reasonable doubt that the tracking module defined in claim 1 was well-known at the priority date. Moreover, this feature is defined in considerable detail, and cannot legitimately be dismissed as merely "generic" or such that "technical detail is not significant." This feature therefore does not meet either of the requirements for being considered notorious set out in T 1411/08 (Reasons, point 4.2).

Since claim 1 of the main request comprises at least one feature - the tracking module - which is technical and non-notorious, the Examining Division should have carried out an additional search before concluding that the claimed subject-matter lacked an inventive step (T 690/06, Reasons, point 8).

3.12 It is also pointed out that, having concluded that a search should have been performed, the Board does not agree with the appellant's suggestion that the analysis of inventive step should have been based on "the prior art detailed in the background of the present application". The purpose of a search is to enable examination to be carried out on the basis of the most relevant prior art, which may turn out not to be the prior art known to the applicant at the priority date.

4. *Inventive Step*

4.1 The Board does not agree with the analysis of inventive step in the contested decision. The Examining Division considered the closest prior art to be a "commonplace networked computer system to distribute and display information", which was considered to comprise all of the technical features of claim 1. Hence the subject-

matter of claim 1 differed only in having a non-technical administrative method for supporting teaching running as software on the client server.

For the reasons set out above, however, the Board finds that there is no reason to suppose that a notional commonplace networked computer system would, at the priority date, have comprised all of the technical features recited in claim 1, and hence the basis for judging inventive step in the contested decision was flawed.

- 4.2 This is not to say that the subject-matter of claim 1 necessarily involves an inventive step, but only that the argument used in the contested decision to prove the opposite is not considered valid. The question of inventive step (and also the question of novelty) can only be properly addressed once the relevant prior art has been determined.

5. *Further procedure*

- 5.1 In the light of the above findings, the Board considers it appropriate to exercise its discretionary power under Article 111(1) EPC to remit the case to the department of first instance for further prosecution based on the main and first auxiliary requests filed with the letter of 8 September 2010. Examination for novelty and inventive step should be preceded by an additional search to identify the relevant prior art.

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.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Eliasson

Decision electronically authenticated