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Datasheet for the decision of 13 May 2016

Case Number: T 0435/11 - 3.5.07

Application Number: 04733534.4

Publication Number: 1629403

IPC: G06F17/30

Language of the proceedings: EN

Title of invention:
Data importation and exportation for computing devices

Applicant:
SAP SE

Headword:
Data export and import/SAP

Relevant legal provisions:
EPC Art. 56
RPBA Art. 12(4), 13(1)

Keyword:
Inventive step - main request (no)
Remittal to the department of first instance (yes)

Decisions cited:
T 0021/08, T 0922/08

Catchword:

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Case Number: T 0435/11 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 13 May 2016

Appellant: (Applicant)	SAP SE Dietmar-Hopp-Allee 16 69190 Walldorf (DE)
Representative:	Müller-Boré & Partner Patentanwälte PartG mbB Friedenheimer Brücke 21 80639 München (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 18 October 2010 refusing European patent application No. 04733534.4 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) appealed against the decision of the Examining Division refusing European patent application No. 04733534.4, filed as international application PCT/EP2004/005358 and published as WO 2004/102420.

II. The decision cited the following documents:

D1: US 5963955 A, 5 October 1999;

D2: "Winzip Version 6.0a", © Copyright 1991-1995 Niko Mak Computing, Inc., EPO-internal document identifier: XP002908148;

D3: WO 03/009071 A, 30 January 2003; and

D4: Agarwal S. et al.: "On the Scalability of Data Synchronization Protocols for PDAs and Mobile Devices", IEEE Network, Vol. 16, No. 4, pp. 22-28, July/August 2002.

The Examining Division decided that claim 1 of the then sole request did not comply with Article 123(2) EPC. Under the heading "OBITER DICTA", it gave reasons why claim 1 was not clear and why its subject-matter lacked inventive step over document D4.

III. With the statement of grounds of appeal, the appellant replaced its sole request with a main request and first, second and third auxiliary requests.

IV. In a communication under Article 15(1) RPBA following a summons to oral proceedings, the Board questioned the admissibility of the main request. It expressed the preliminary opinion that the subject-matter of claim 1 of each request lacked inventive step. In addition, objections under Article 84 EPC were raised.

V. With a letter dated 5 April 2016, the appellant filed a new main request and new first to fourth auxiliary requests and stated that they replaced the previous requests "[p]rovided that the new requests are admitted into the procedure". The new main request and second to fourth auxiliary requests corresponded to the previous main and first to third auxiliary requests, respectively, with an amendment in response to objections raised by the Board under Article 84 EPC.

VI. In the course of oral proceedings held on 13 May 2016, the appellant amended the new first auxiliary request and clarified its requests. At the end of the oral proceedings, the chairman pronounced the Board's decision.

VII. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request filed with the letter of 5 April 2016 or, in the alternative, on the basis of claim 1 filed in the oral proceedings at 17:55 and claims 2 to 14 of the first auxiliary request filed with the letter dated 5 April 2016 or of the claims of one of the second, third and fourth auxiliary requests filed with the letter of 5 April 2016.

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

"A method for copying data elements and related data elements from a source database (20) of a source system (12) to a target database (28) of a target system (26) by a user, the method comprising:

accessing at least one data element representing a data change from the source database (20) of the source system (12), the data change existing in a first collection of data in the source database (20);

copying the at least one data element to an export data file (22);

transporting the export data file (22) from the source system (12) to the target system (26) having the target database (28);

displaying, at the target system (26), a user interface (24) that identifies ones of the at least one data element stored in the export data file (22), to prompt a user selection of desired ones of the at least one data element to be copied in the target database (28); and

copying selected ones of the at least one data element to the target database (28)."

IX. Claim 1 of the first auxiliary request reads as follows:

"A method for copying data elements from a source database (20) of a source system (12) to a target database (28) of a target system (26) by a user to update information stored in the target database from the source database, the method comprising:

displaying, at the source system (12), a user interface that displays to the user available data elements for copying from the source database (20);

selecting, by the user, at least one data element representing a data change from the source database (20) of the source system (12), the data change existing in a first collection of data in the source database (20);

providing a copy operation menu that allows the user, for each data element, to specify a copy operation (54) to be executed upon copying to the target database (28);

accessing the at least one user selected data element and copying it to an export data file (22);

transporting the export data file (22) from the source system (12) to the target system (26) having the target database (28);

displaying, at the target system (26), a user interface (24) that identifies ones of the at least one data element stored in the export data file (22), to prompt a user selection of desired ones of the at least one data element to be copied in the target database (28); and

copying selected ones of the at least one data element to the target database (28) by executing the specified copy operation."

The remaining claims of the first auxiliary request are independent claim 8 and dependent claims 2 to 7 and 9 to 14 of the first auxiliary request filed with the letter of 5 April 2016. Their text is not relevant to this decision.

X. In view of the outcome of the appeal, the text of the claims of the second to fourth auxiliary requests need not be given.

XI. The appellant's arguments relevant to the decision are discussed in detail below.

Reasons for the Decision

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

2. *The application*

2.1 The application relates to the copying of data between computing devices. The background section of the

application explains that mobile computing devices generally store information in a local database and that it may be necessary to update this information by copying subsets of data held in a central database on a different system to the local database. However, a user may himself have made modifications to the information stored in the local database and may not want to lose those modifications. The application therefore proposes a system that allows users of computing devices to control the copying of business information between computing systems (see page 2, lines 20 to 23).

2.2 The detailed description discloses a "data importation and exportation system" as shown in Figure 1. The system comprises a source system 12 including a source database 20 and a target system 26 including a target database 28. Data items may be copied from the source database to the target database by means of export application 14 and import application 15.

Export application 14 includes a graphical user interface (shown in Figures 2 to 4) that displays a list of data items stored in the source database for selection by the user. The selected data items are copied from the source database to export data file 22.

Import application 15 includes a graphical user interface (shown in Figures 6 and 7) that displays a list of data items stored in export data file 22 for selection by the user. The selected data items are copied from export data file 22 to the target database.

3. *Main request - admission*

3.1 In its communication, the Board questioned whether the main request filed with the statement of grounds of

appeal should be admitted into the proceedings under Article 12(4) RPBA. Claim 1 of that request essentially corresponded to a claim on which the Examining Division had expressed a negative opinion with respect to novelty and which had subsequently been withdrawn in favour of more restricted claims.

3.2 The present main request corresponds to the main request filed with the statement of grounds of appeal with an amendment intended to address objections under Article 84 EPC raised in the Board's communication. That amendment is not an obstacle to admission of the present main request under Article 13(1) RPBA, but any reason for not admitting the previous main request in principle applies also to the present main request.

3.3 Article 12(4) RPBA refers to "the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings". The appellant argued that since independent claim 1 of the previous main request corresponded to an independent claim filed during the examination proceedings, that request had already been "presented" in the first-instance proceedings. The Board therefore had no power to hold the main request inadmissible.

This argument is not persuasive and goes against the well-established interpretation of Article 12(4) RPBA that this provision applies in particular to requests that were presented in the first-instance proceedings but withdrawn before a decision could be taken on it (see e.g. decision T 922/08 of 13 October 2011, reasons 2.1).

3.4 The appellant further submitted that, in the first-instance proceedings, it had focused on more specific requests for efficiency and business reasons. Furthermore, in its decision the Examining Division had included an inventive step reasoning which applied also to the broader independent claim 1 of the main request.

Also these arguments do not speak in favour of admission of the main request. Appeal proceedings are not intended to accommodate for a change of mind based on business considerations, and, while it is true that the Examining Division in its decision commented on inventive step by way of obiter dictum, such observations cannot be equated to an actual decision on the (withdrawn) request.

3.5 Nevertheless, the Board has to take into account the special circumstances of the case. In the first-instance proceedings, the appellant had introduced limitations against which the Examining Division had raised objections under Article 123(2) EPC, and the appellant had not been able to overcome those objections by further amendment. The appellant had thereby manoeuvred itself into a difficult position. If the appellant in these appeal proceedings is to be afforded a way out at all, it has to be allowed to revert to a claim with the offending features removed, i.e. to claim 1 of the previous main request. The Board therefore decides to exercise its discretion in the appellant's favour and to admit the main request into the proceedings.

4. *Main request - inventive step*

4.1 *Claim 1 and the invention as disclosed in the detailed description*

4.1.1 As explained in point 2.2 above, the detailed description of the application relates to a "data importation and exportation system" comprising an export application and an import application by means of which a user may selectively copy data items from a source database at a source system to an export data file and from the export data file to a target database at a target system.

Independent method claim 1 of the main request reflects this embodiment in so far as it recites steps of copying at least one data item from a source database to an export data file, transporting the export data file from a source system to a target system, displaying at the target system a user interface prompting a user selection of data elements stored in the export data file, and copying the selected data items to a target database.

In respect of the selection of data elements from the source database, however, claim 1 only includes a feature reading "accessing at least one data element representing a data change from the source database of the source system, the data change existing in a first collection of data in the source database".

4.1.2 According to claim 1 of the previous main request, the accessed at least one data element represented a "delta data change". Although this expression is present in claim 1 as originally filed, it is not used in the detailed description.

In the field of computing, the term "delta" commonly refers to data representing the differences between two versions of a data entity. For example, if a data entity is stored both in a first repository and in a second repository and the entity in the first repository is modified, it is well known to transmit the "delta" between the old version and the new version of the entity to the second repository in order to update the old version of the entity still stored in the second repository to the new version.

The feature "accessing at least one data element representing a delta data change" as present in claim 1 of the previous main request hence appeared to refer to a special kind of data element that represents the "delta" between a new and an old version of some other data element. But such a feature is not part of the detailed embodiment described in the detailed description of the application, and so that embodiment appeared not to be within the scope of independent claim 1 of the previous main request. For that reason, in its communication the Board raised an objection to lack of support by the description.

4.1.3 In present claim 1, the word "delta" has been deleted. At the oral proceedings, the appellant argued that "at least one data element representing a data change" is to be understood as a data element that is new or was changed compared to a previous version of the element. The feature "accessing at least one data element representing a data change ..." was broad and encompassed the scenario where the at least one data element had been selected by a user by means of the user interface of an export application.

The Board notes that, in that scenario, the feature "at least one data element representing a data change" is in fact a limitation on the selection made by the user: if the user does not select a data element that represents a "data change", the copying procedure does not fall within the scope of the claim. Since claim 1 is a method claim, the Board considers such a limitation to be possible in principle.

4.2 *Document D4*

4.2.1 In the obiter dictum of the contested decision, the Examining Division commented on inventive step starting from document D4. In its submissions and at the oral proceedings, the appellant, too, took the view that document D4 represented the closest prior art.

Document D4 bears the title "On the Scalability of Data Synchronization Protocols for PDAs and Mobile Devices" and includes an overview of known protocols for synchronising data between a mobile device such as a PDA and another device such as a desktop PC. The Examining Division concentrated on the "Palm HotSync Protocol" discussed on page 23. This protocol requires a PDA to maintain status flags for each data record, which are toggled whenever data is inserted, deleted or modified. Upon a synchronisation request by the user, the PDA transmits to a desktop PC the records whose status flags have changed since the last synchronisation. The desktop PC processes these changes and sends back its corrections.

4.2.2 In the Board's view, document D2 is a more suitable starting point for assessing inventive step of the subject-matter of claim 1. Although given the fate of the main request the Board is not required to justify

why document D2 represents a "closer" prior art than document D4 (see e.g. decision T 21/08 of 2 September 2010, reasons 1.2.3), it will now explain why it does not regard the latter as a promising starting point.

4.2.3 The synchronisation method disclosed in document D4 differs in important aspects from the embodiment discussed in the detailed description of the present application.

First, it is an essentially fully automated method of synchronising data in two databases. It includes a mechanism to automatically determine which records have changed since the last synchronisation. It therefore does not offer the user the possibility to manually input a (sub)selection of the data records to be copied either at the PDA or at the desktop PC and such manual intervention arguably would go against the teaching of this section of document D4. Although claim 1 of the main request does not include a limitation corresponding to a manual selection of data items at the source system, it does recite such a feature with respect to the target system.

Second, the method involves direct two-way communication between the PDA and the PC. A method according to claim 1, on the other hand, copies changes to an "export data file", which is then transferred from the source system to the target system and potentially to many target systems. It is not apparent to the Board how the method of document D4 could be modified in a natural way to make use of such an export data file.

4.2.4 The appellant submitted that document D4 was the closest prior art because it was the only prior-art document on file that dealt with data synchronisation and mobile devices.

It is true that document D4 deals with data synchronisation and mobile devices, but claim 1 does not. Claim 1 is directed to "a method for copying data elements and related data elements from a source database of a source system to a target database of a target system by a user". Such a method may of course be used to synchronise the content of the source database with that of the target database in the context of mobile devices, but nothing in claim 1 restricts the method to data synchronisation or to mobile devices. And even if the method were so restricted, it would still leave it up to the user (or to further technical means not specified in the claim) to figure out which data elements have to be copied to and from the export data file to achieve proper synchronisation.

4.2.5 At the oral proceedings, the appellant alleged that it was clear from the description, in particular the background section and the summary of the invention, that the invention was about data synchronisation. Yet the description never mentions the term, and it does not describe anything that is similar to the data synchronisation of document D4. The closest it gets is in the passage on page 4, line 25 to 31, which states that if a user makes changes to data on a mobile device and wishes to propagate those changes to other computing devices, "[t]he propagation of data changes may be easily supported by the disclosure". Indeed, the export and import applications described in the detailed description support a user-controlled

selective copying of updated data elements. But that is not data synchronisation in the sense of document D4.

4.3 *Document D2*

4.3.1 In view of the structural similarity of the export and import applications as described in the detailed description to the "WinZip" program, the Board considers document D2 to be a more promising starting point for assessing inventive step of the present invention.

Document D2 contains screenshots and printouts of help files of version 6.0a of the WinZip program. The "Copyright 1991-1995" notice in the scanned image of a diskette storing the program indicates that the program was available to the public in 1995 or shortly thereafter. Since the earliest priority date of the present application is 19 May 2003, the content of document D2 is prior art under Article 54(2) EPC. The appellant did not argue otherwise.

4.3.2 Document D2, page 23, section "Working with Existing Archives", discloses that WinZip allows a user to open an "archive", i.e. a file that contains other files (see page 21, first paragraph, and page 23, section "Terminology"). The files present in the archive are displayed in a list box in the main WinZip window. The user can extract files from the archive to a directory on the hard disk and can add files from the hard disk to the archive.

The addition of files from the hard disk to the archive is described in more detail on page 24, section "Adding Files to an Archive", and on pages 44 and 45. After selecting an "Add" menu option, the user is presented

with a "Select Files" list box in which he can select multiple files. When he is done selecting files, he selects an "Add" button. WinZip then compresses the selected files and adds them to the archive (see page 23, section "Terminology").

The extraction of files from the archive to the hard disk is described in more detail on page 47. After selecting an "Extract button" or "Extract" menu option, the user selects a directory on the hard disk. The user can then choose to extract all files from the archive to that directory (option "All Files") or only the files previously selected in the main WinZip window (option "Selected Files").

According to page 21, first paragraph, "Archives make it easy to group files and make transporting and copying these files faster". Hence, document D2 discloses adding files to an archive on a source computer, transporting the archive from the source computer to a target computer and extracting files from the archive on the target computer.

4.3.3 In the Board's view, a file system on a hard disk is a specific example of a "database" and the archive of document D2 corresponds to the "export data file" of claim 1. Document D2 hence discloses a method for copying, controlled by a user, data elements (i.e. files) from a source database of a source system to a target database of a target system comprising the steps of claim 1. Only two potential differences remain:

- claim 1 is directed to a method for copying data elements and related data elements from a source database to a target database; and

- according to claim 1, the at least one data element copied to the export data file represents "a data change".

4.3.4 Claim 1 does not define what it means for one data element to be "related" to another data element, and none of its steps refers to "related data elements". Since it is obvious that some of the files selected for copying may be in some sense "related" to each other (for example in terms of their cognitive content), the first distinguishing feature cannot support an inventive step. On this point the appellant did not argue otherwise.

4.3.5 The second feature distinguishes the method of claim 1 from the method of document D2 only in the sense that at least one selected file represents a "change" as compared to an earlier situation or as compared to the target system. The appellant submitted that document D2 was completely silent about changes in data. But since it would make little sense to copy data files from a source system to a target system if those data files are already known to be present on the target system, the Board considers that this feature, too, is obvious.

4.4 It follows that the subject-matter of claim 1 lacks inventive step. The main request therefore does not meet the requirements of Article 52(1) and 56 EPC.

5. *First auxiliary request - admission*

5.1 Claim 1 of the first auxiliary request was filed at the oral proceedings before the Board and is based on the first auxiliary request filed with the letter of 5 April 2016. That request introduced into the independent claims features to the effect that, at the

source system, the user specifies an action or operation controlling the manner how, at the target system, the selected at least one data item is to be copied to the target database.

5.2 Such features, relating to a user interaction at the source system, were not present in the original claims, in the claims considered in the decision under appeal or in the claims filed together with the statement of grounds of appeal. But as the appellant pointed out, the decision to refuse was based only on the ground of added subject-matter, and in the first-instance proceedings the starting point for the assessment of inventive step had mainly been document D4. Taking those circumstances into account, at the oral proceedings the Board decided to exercise its discretion and to admit the first auxiliary request filed with the letter of 5 April 2016 into the proceedings.

5.3 Subsequently, the appellant filed claim 1 of the present first auxiliary request to address objections under Articles 84 and 123(2) EPC brought up by the Board. Since these amendments do not raise further issues, the Board admits the first auxiliary request into the proceedings.

6. *First auxiliary request - added subject-matter*

6.1 Claim 1 is directed to a method for copying data elements "to update information stored in the target database from the source database". Claim 1 being a method claim, this feature is considered to limit the subject-matter claimed. It is based on the background section and on page 4, lines 26 to 31, of the application as filed, both passages disclosing that the

invention may be used for updating a target database with information from a source database.

6.2 Claim 1 further adds the following steps:

- displaying, at the source system, a user interface that displays to the user available data elements for copying from the source database;
- selecting, by the user, at least one data element representing a data change from the source database of the source system, the data change existing in a first collection of data in the source database;
- providing a copy operation menu that allows the user, for each data element, to specify a copy operation to be executed upon copying to the target database.

In addition, the step of "accessing" and the first step of "copying" now read "accessing the at least one user selected data element and copying it to an export data file". And to the second step of "copying" the text "by executing the specified copy operation" was added.

6.3 The steps added to claim 1 are based on the passages on page 7, lines 13 to 23, and on page 12, line 27, to page 13, line 9, of the description, which disclose with reference to Figure 2 that the export application provides a user interface allowing the user to select data elements from the source database for copying to the export data file, the user interface including a copy operation menu allowing the user to specify, for each selected data element, a copy operation ("action") to be executed on the data element upon copying of the element to the target database. The example actions given on page 13, lines 1 to 9 (e.g. an "insert" action meaning that a data element existing in the target

database is to be overwritten) confirm that the action is indeed a copy operation; see also page 17, lines 20 to 25 ("and the copy operation 54 selected for the data item").

The passage on page 12, line 27, to page 13, line 9, also serves as a basis for the addition of "by executing the specified copy operation" to the second step of "copying".

The amended step of "accessing" finds support in original claim 1 and on page 15, lines 6 to 8.

6.4 The Board is hence satisfied that claim 1 of the main request complies with Article 123(2) EPC.

7. *First auxiliary request - remittal*

7.1 Since claim 1 now also includes limitations corresponding to a manual selection of data items at the source system, the observations made in points 4.2.3 to 4.2.5 above with respect to the unsuitability of document D4 as a starting point for assessing inventive step are all the more applicable.

7.2 Document D2 does disclose manually selecting data items at the source system for copying to the export data file (see point 4.3.2 above), but the user is not given the option to specify, at the source system, a copy operation determining, for example, whether a file included in the archive is, upon extraction at the target system, to overwrite a file with the same filename already present at the target system. Document D2 discloses only that, at the target system, the user may decide by means of a check box whether he is prompted before existing files are overwritten with

files from the archive (see document D2, page 47, lines 18 to 20, "The Overwrite Existing Files check box ...").

7.3 The Board accepts that document D2 contains no hint prompting the skilled person to incorporate into the "export user interface" of the WinZip program a "copy operation menu" as claimed in order to allow the user at the source system to exercise control over the update process taking place at the target system. For that reason it considers that document D2 on its own does not deprive the subject-matter of claim 1 of inventive step.

7.4 However, since the features now added to claim 1 were not included in any of the originally filed claims and hence may not have been searched, the Board considers it appropriate to remit the case to the Examining Division for further examination of inventive step. In addition, the Board has not examined independent system claim 8. Furthermore, the dependent claims and the description may need to be adapted.

7.5 The case is, thus, to be remitted to the Examining Division for further prosecution on the basis of the first auxiliary request.

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:

I. Aperribay R. Moufang

Decision electronically authenticated