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**Datasheet for the decision
of 23 June 2016**

Case Number: T 0779/11 - 3.5.07

Application Number: 05704890.2

Publication Number: 1704499

IPC: G06F17/30

Language of the proceedings: EN

Title of invention:

Systems, methods, software and interfaces for integration of case law with legal briefs, litigation documents, and/or other litigation-support documents

Applicant:

Thomson Reuters Global Resources

Headword:

Case law database/THOMSON REUTERS GLOBAL RESOURCES

Relevant legal provisions:

EPC Art. 56

EPC R. 111(2)

PCT Art. 17(2) (a)

Keyword:

Inventive step - main request (no)

Remittal to the department of first instance - additional search (yes)

Decisions cited:

G 0003/08, J 0003/14, T 0154/04, T 1242/04, T 0688/05,
T 0823/08, T 1707/08, T 2467/09, T 0359/11

Catchword:



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Case Number: T 0779/11 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 23 June 2016

Appellant: Thomson Reuters Global Resources
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 18 November 2010 refusing European patent application No. 05704890.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman R. Moufang
Members: R. de Man
P. San-Bento Furtado

Summary of Facts and Submissions

I. The applicant (appellant) appealed against the decision of the Examining Division refusing European patent application No. 05704890.2, filed as international application PCT/US2005/000042 and published as WO 2006/083241.

II. Acting in its capacity of International Searching Authority, the European Patent Office issued a declaration under Article 17(2)(a) PCT to the effect that no international search report would be established because no meaningful search was possible. The declaration explained that "[t]he claims relate to subject matter excluded from patentability under Art. 52(2) and (3) EPC [sic]".

The declaration further mentioned that a search might be carried out during examination before the EPO should the problems which led to the declaration be overcome.

III. The Examining Division refused the application without carrying out a search. It decided on a main request and two auxiliary requests, refusing the main request and auxiliary request 1 for lack of inventive step and not admitting auxiliary request 2 into the proceedings.

IV. With the statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and that the case be remitted to the Examining Division to perform a prior-art search. The appellant resubmitted the main request and auxiliary requests 1 and 2 considered in the contested decision. It argued, in particular, that the Examining Division's decision not to perform a prior-art search at all was against the established case law of the boards of appeal.

V. In a communication under Article 15(1) RPBA following a summons to oral proceedings, the Board expressed the provisional view that the Examining Division had acted in accordance with the established case law in refusing the application for lack of inventive step on the basis of what it considered to be notorious knowledge. The main request and auxiliary request 1 appeared not to comply with Articles 52(1) and 56 EPC. Auxiliary request 2 appeared not to comply with Article 123(2) EPC.

VI. Oral proceedings took place on 23 June 2016. 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 the case be remitted to the department of first instance for further prosecution, in particular to carry out an additional search, on the basis of the main request or, in the alternative, on the basis of one of auxiliary requests 1 and 2.

VIII. Independent claim 1 of the main request reads as follows:

"A system (100) comprising:

 a server (120) for an online legal-research provider, the server coupled to one or more databases (110), including:

 a subscriber database (123) containing authentication credentials for a plurality of subscribers to an online legal research service;

 a caselaw database (111) containing a plurality of judicial decision documents; and

a database (112, 113, 114) containing a plurality of litigation documents associated with at least one judicial decision; and

means associated with the server (120) for returning search results to a client access device (130) in response to a submitted legal-research query, wherein the search results identify one or more of the judicial decision documents and at least one user-interface element (1382) operable to enable a user of the access device to request information regarding litigation documents related one [sic] or more of the identified judicial decision documents."

Independent claim 9 of the main request reads as follows:

"A computer-implemented method comprising:

receiving a query for judicial decision documents;
responding to the query with a listing of one or more judicial decision documents, wherein one or more of the listed judicial decision documents includes a link for accessing at least one litigation document associated with the judicial decision."

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

"A system (100) to retrieve litigation documents, the system comprising:

a caselaw database (111) containing a plurality of judicial decision documents associated with legal disputes;

a litigation database (112, 113, 114) containing a plurality of litigation documents, each litigation document filed in a legal dispute associated with at least one judicial decision document;

a relationship database relating at least one of the judicial decision documents of the caselaw database to one or more litigation documents of the litigation database; and

a server (120) coupled to the caselaw database, litigation database and relationship database, the server configured to:

return to a client access device (130) one or more user-interface elements (1382) associated with respective one or more of the judicial decision documents in response to a submitted legal-research query;

receive from the client access device (130) a selection of at least one judicial decision document via its associated user-interface element;

determine from the relationship database at least one litigation document based on the selected at least one judicial decision document; and

transmit to the client access device at least one user-interface element associated with the determined at least one litigation document configured to enable a user of the client access device to request the server to retrieve the determined at least one litigation document from the litigation database."

- X. In view of the outcome of the appeal, the text of auxiliary request 2 need not be given.

- XI. The appellant's arguments relevant to this 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 invention*

The background section of the application explains that in the American legal system, judges and lawyers are continually researching an ever-expanding body of existing judicial opinions for those opinions most relevant to the resolution of new disputes. To facilitate these searches, various companies collect and publish judicial opinions in both paper and electronic forms. Many opinions are published with cites or hyperlinks to related opinions. These cites and hyperlinks enable researchers to locate the related opinions in printed volumes of opinions or to access them electronically over a computer network. The Westlaw online research system is specifically mentioned as an online research system giving users access to over 100 million documents.

The inventors are said to have recognised that numerous other types of document may be of use to legal researchers that are not available through the "same legal research system and interface". The application therefore proposes a system facilitating the retrieval of related non-opinion legal documents in response to queries for legal opinions.

3. *Lack of a prior-art search*

3.1 The appellant contested the correctness of the declaration issued under Article 17(2) (a) PCT and argued that the Examining Division had committed a substantial procedural violation by not carrying out a prior-art search. Article 92 EPC required the EPO to perform a search on the basis of the claims, including the dependent claims, with due regard to the

description and any drawings. As confirmed by the Guidelines for Examination, the description was to be consulted with a view to establishing the technical problem and the existence of fallback positions. The Examining Division had focused only on claim 1, which had made it difficult for the appellant to know how to proceed. In addition, applicants paid money for having a search performed.

- 3.2 In the statement of grounds of appeal, the appellant stated that the Examining Division's decision not to perform a prior-art search on the basis of Rule 45 EPC 1973 at all was against the established case law of the Boards of Appeal. This statement is somewhat inaccurate in that it is not the Examining Division that issues the declaration under Rule 63 EPC (previously Rule 45 EPC 1973) that it is impossible to carry out a meaningful search, but the Search Division. And in the present case, it was the EPO acting in its capacity of International Searching Authority that issued the declaration under Article 17(2)(a) PCT taking the place of the European search report (Article 153(6) EPC).
- 3.3 This appeal lies from the decision of the Examining Division to refuse the application and not from the declaration under Article 17(2)(a) PCT. The Board is competent to review the correctness of the decision under appeal. In the context of that review, it may review the correctness of other decisions at most indirectly and only in so far as they form part of the legal foundation of the decision under appeal. In the present case, the decision of the EPO acting as International Searching Authority to issue a declaration under Article 17(2)(a) PCT did not have direct legal consequences for the examination

proceedings and the decision to which those proceedings led. Its correctness is therefore not a subject of this appeal.

In this context it may be noted that Rule 137(5), second sentence, EPC as amended by decision CA/D 3/09 (OJ EPO 2009, 299) states that amended claims "may [not] relate to subject-matter not searched in accordance with Rule 62a or Rule 63". The EPC contains no provision providing for a similar legal effect of a declaration under Article 17(2)(a) PCT.

- 3.4 Rather than having legal consequences, the issuing of the declaration under Article 17(2)(a) PCT had the practical effect that no results of a prior-art search were available when the examination proceedings commenced. The Board may examine whether the Examining Division correctly handled this situation and in particular whether it should have carried out an "additional search" (i.e. a search carried out at the examination stage as provided for in the Guidelines for Examination, C-IV, 7.2) to make up for the lack of a search report.
- 3.5 In decision T 1242/04 (OJ EPO 2007, 421), the deciding board stressed the fundamental importance of the search as an element of the grant procedure (see reasons 8.2) and concluded that where an application's subject-matter had non-technical aspects, a declaration under Rule 45 EPC 1973 could be issued only in exceptional cases in which the claimed subject-matter, i.e. the entire set of claims including all independent and dependent claims, clearly had no technical character (see reasons 8.4). Although that provision is not identical to Article 17(2)(a) PCT (in combination with Rule 39.1 PCT), there appears to be no good reason why

the same should not apply to the issuing of a declaration under Article 17(2)(a) PCT. In the present case, originally filed independent claim 1, directed to a system comprising a server coupled to one or more databases and a client access device coupled to the server via the Internet, already undeniably had technical character.

The board in decision T 1242/04 took the view, however, that in such circumstances it was not always necessary for the examining division to carry out an additional search in the documented prior art. In particular, it was legitimate to refuse an application for lack of inventive step where the objection was based on knowledge that was "notorious" or indisputably formed part of the common general knowledge (see reasons 9.2). This approach has been followed in a number of other decisions (see e.g. decisions T 688/05 of 19 September 2007, reasons 3; T 823/08 of 12 July 2011, reasons 12.4; T 1707/08 of 16 February 2012, reasons 3.4; T 359/11 of 13 May 2015, reasons 3.3 to 3.9; T 2467/09 of 17 December 2015, reasons 4).

- 3.6 Although the Board acknowledges that it is unfortunate if no prior-art search is undertaken where a search should be carried out, it sees insufficient reason to deviate from this established case law. In particular, it is not persuaded by the appellant's argument that a search is always necessary to allow the applicant to identify suitable amendments to overcome an objection of lack of inventive step. The requirement to reason its objections obliges an examining division raising an objection of lack of inventive step on the basis of undocumented notorious prior art to properly identify that prior art in the detail necessary to allow a comparison to be made between the prior art and the

subject-matter claimed. The applicant is thus not confronted with "secret" prior art that it can only speculate about when drafting amended claims.

3.7 In the present case, the Examining Division based its objections of lack of inventive step on what it considered to be notorious prior art. The Board will therefore not remit the case to the Examining Division to perform an additional search without further examination of its merits.

4. *Main request - claim 9*

4.1 Independent claim 9 of the main request defines a computer-implemented method comprising two steps. In the first step, a query for "judicial decision documents" is received. In the second step, this query is responded to with a listing of one or more "judicial decision documents". The claim further specifies that one or more of these documents include a link "for accessing at least one litigation document associated with the judicial decision".

4.2 In view of the description on page 6, line 29, to page 7, line 2, in combination with Figure 1, the returned "listing" of documents may consist of (hyper)links to documents ("control features 2A1, 2A2, 2A3 for accessing or retrieving one or more corresponding search result documents"). Selection by the user of one of the links may result in the full document being displayed, the full document including a link for accessing related "litigation documents". Indeed, in Figure 1, selection in area 1382A of link 2A2 corresponding to document Y results in the display of document Y in area 1382B. That displayed document includes a link 1382C ("LIT"). Selection of

the link results in the display in area 1383 of a list of links to related litigation documents.

- 4.3 In its decision, the Examining Division argued that "internet browsers connecting to search engines on remote servers to which they addressed their queries of various kinds and received results containing clickable links to further documents pertinent to the search criteria" were notorious. The appellant has not disputed this.

The Board agrees that web-based search engines were notorious at the priority date of the application, i.e. on 31 December 2003. Such engines responded to a search query with a listing of links to documents (typically web pages) matching the search query. Selection of such a link resulted in the display of the corresponding document. If the selected document was a web page, it typically included links to related documents.

- 4.4 The subject-matter of claim 9 differs from this notorious prior art only in that the query results are "judicial documents" and that the link included in one or more of these documents points to a "litigation document associated with the judicial decision". These features relate only to the non-technical cognitive content of the documents and therefore do not contribute to inventive step.

- 4.5 It follows that the subject-matter of claim 9 lacks inventive step (Article 56 EPC).

5. *Main request - claim 1*

- 5.1 At the oral proceedings, the appellant expressed the wish to submit a request comprising only claims 1 to 8

of the main request in case the Board considered lack of inventive step of the subject-matter of claim 9 to be a reason for not allowing the main request. Although the appellant did not actually file a corresponding request, the Board nevertheless considers it appropriate to deal also with claim 1.

5.2 Claim 1 of the main request defines a system comprising a server coupled to the following databases:

- a first "subscriber" database containing authentication credentials for a plurality of subscribers to an online legal research service;
- a second "caselaw" database containing a plurality of judicial decision documents; and
- a third database containing a plurality of litigation documents associated with at least one judicial decision.

The system further comprises "means associated with the server" for returning search results to a client access device in response to a search query.

The search query is a "legal-research query". The search results "identify" one or more of the judicial decision documents and at least one "user-interface element". This user-interface element is "operable to enable a user of the access device to request information regarding litigation documents related [to] one or more of the identified judicial decision documents".

5.3 The Board understands "means associated with the server" to refer to a search engine accessible over a network by a (client) access device.

The user-interface element may be a hyperlink (see page 6, lines 10 to 21, of the published application). Activating this link results in the retrieval of litigation documents related to one of the identified judicial decisions. In this case, the access device may be a computer running an internet browser.

In view of the description (see point 4.2 above), the identified "one or more of the judicial decision documents" may be a listing of (hyper)links to judicial decision documents matching the search query. The user-interface element (or hyperlink) "identified" by the search results is again a hyperlink included in, or displayed together with, the document that is shown upon selection of one of those links.

5.4 Claim 1 hence adds to the subject-matter of claim 9 that the query is processed by a web-based search engine that is part of a system comprising a server coupled to the first, second and third databases. The "legal-research" query for judicial decision documents results in a search performed on the second "caselaw" database.

5.5 Although the Board agrees with the Examining Division that the features defining the cognitive meaning of the documents in the second and third databases ("judicial decision documents" and "litigation documents") are non-technical, this is less evident for the feature specifying that the first "subscriber" database contains "authentication credentials for a plurality of subscribers". It is, however, notorious that access control to online services may be implemented using "authentication credentials" such as usernames and passwords and that such information is stored in a suitable database. In addition, claim 1 defines no

interaction between the subscriber database and other claim features.

The appellant did not contest that the claimed subscriber database could not support an inventive step.

5.6 The Board does not agree with the Examining Division that the claimed enumeration of first, second and third databases, each database containing a different collection of data, implies no technical features but is merely of a conceptual nature. Although the term "database" is broad and in certain contexts may even denote non-technical collections of data (see e.g. decision T 154/04, OJ EPO 2008, 46, reasons 21), in the context of a computer system it is a technical entity - in its broadest form a particular data storage area - and three distinct databases are, consequently, three such distinct technical entities.

5.7 The notorious prior art relied on by the Examining Division does not describe a web-based search engine as part of a system comprising a server coupled to first, second and third databases (or coupled to a single physical database comprising three different data storage areas such as database tables).

In case the Examining Division had in mind a web-based Internet search engine such as the Google search engine, the Board notes that such search-engine systems in principle do not include document databases but maintain and search an index of web pages located on an unlimited number of web servers reachable over the Internet. If the databases of the claim are equated to such web servers reachable over the Internet, a search carried out using an Internet search engine would

normally be performed on an index of the web pages stored in all those web-server databases and not be limited to one particular ("caselaw") web-server database.

Although web-based Internet search engines at the priority date of the application may have offered users the option of limiting a search to a particular web server or domain name, such details can reasonably be disputed and hence go beyond what may be considered notorious knowledge.

It follows that the Examining Division's reasoning with respect to claim 1 is not convincing.

5.8 Nevertheless, the existence of online-accessible document databases at the priority date of the present application cannot reasonably be disputed. The "Westlaw online research system" mentioned in the background section of the application is one example (see page 2, lines 1 to 10). Such a system accepts a search query from an online user terminal, searches its document database for matching documents, and returns a listing of matching documents to the user terminal.

The subject-matter of claim 1 as interpreted by the Board (see point 5.3 above) differs from such a general online-accessible document database in that

- the claimed system's document database contains two sets of documents: judicial decision documents and litigation documents;
- the system comprises a subscriber database;
- the system is web-based; and
- returned judicial documents contain hyperlinks to related litigation documents (or are displayed

together with hyperlinks to related litigation documents).

5.9 The Board considers that

- the subscriber database does not add anything inventive (see point 5.5 above);
- at the priority date it was obvious to provide online access via a web-based interface. Such interfaces employ hyperlinks; and
- the non-technical cognitive content of the documents (judicial documents, litigation documents) cannot contribute to inventive step.

The remaining question is whether it was inventive to return the results of a search in a first document database together with links to related documents in a second document database.

5.10 In the Board's view, it was not. The idea or wish to retrieve not only documents from a first document collection that match the search query but also documents from a second document collection that are somehow related to the matching documents is non-technical. This is confirmed by the particular example of judicial documents and related litigation documents: it is undoubtedly useful for legal researchers to be informed, not only of the actual search results in the form of matching judicial documents, but also of litigation documents related to those judicial documents, but this idea does not solve a technical problem. The implementation of the idea is technical, but at the priority date it was obvious to implement it in a web-based context by means of hyperlinks.

5.11 The appellant argued that the system of claim 1 solved the problem of integrating a number of heterogeneous document databases. Judicial decision documents and litigation documents were maintained by different courts using different systems. The application was focused on relating the litigation documents from disparate court sources to disparate judicial decisions. The amalgamation of such disparate data from different sources was not trivial. The invention mitigated the necessity of doing multiple searches in the systems maintained by various courts.

However, these arguments are not based on specific limitations expressed in claim 1. The claim merely recites a system comprising (in addition to the subscriber database) a database containing judicial decision documents, a database containing litigation documents, and "means" which the Board understands to refer to an online-accessible search engine with a web-based interface. Whether and how disparate data from different sources is or was amalgamated is not part of the claim. The appellant's arguments hence have no bearing on the Board's reasoning.

5.12 Thus, the subject-matter of claim 1 lacks inventive step (Articles 52(1) and 56 EPC).

6. *First auxiliary request - remittal*

6.1 Claim 1 of auxiliary request 1 adds to claim 1 of the main request *inter alia* that the system comprises a "relationship database" that "relates" judicial decision documents to litigation documents. It is used to determine at least one litigation document related to a selected judicial decision document.

6.2 In its communication, the Board suggested that it would have been obvious to relate documents in a first collection to documents in a second collection by means of "relations" and that it would have been obvious to use a "relationship database" for storing such relations.

At the oral proceedings, the appellant argued that other ways could be conceived to implement the determination of a document in a first document collection related to a particular document in a second document collection. For example, a document may itself include an identification of the documents related to it.

6.3 The Board does not rule out that, at the priority date of the application, it was common general knowledge to relate or link data items in two different data collections by means of a separate database or database table listing the relations between the data items in the two collections. But the Board is not convinced that the existence of this knowledge at the priority date cannot reasonably be disputed, and at the oral proceedings the appellant in fact did dispute it. In such circumstances, the existence of common general knowledge needs to be proved by evidence. This means that an additional search has become necessary.

6.4 The case is therefore to be remitted to the Examining Division for further prosecution on the basis of auxiliary request 1 and in particular for carrying out an additional search.

7. *Ex officio examination under Rule 103(1) (a) EPC*

7.1 In the statement of grounds of appeal, the appellant criticised the reasoning of the contested decision as well as the lack of a prior-art search. In particular, the Examining Division had stated that certain claim features were part of the common general knowledge, but had not given reasons why that was so, and it had considered only an incomplete "condensed" version of claim 1 of the main request. In addition, it had not given reasons why features that it considered to be non-technical formed part of the common general knowledge; decision T 1242/04 in point 9.2 of its reasons made no distinction between technical and non-technical features. Also, the decision did not refer to any provision in the EPC on which the refusal of the main request was based.

Although the appellant did not formally request reimbursement of the appeal fee, it did note that in view of the allowability of the appeal, under Rule 103(1) (a) EPC the Board was to examine *ex officio* whether reimbursement was equitable by reason of a substantial procedural violation (cf. decision J 3/14 of 8 September 2014, reasons 8).

7.2 For the reasons given under point 3 above, the Board considers that no substantial procedural violation occurred in connection with the lack of a prior-art search.

7.3 The appellant's assertion that the decision fails to indicate the ground for refusing the main request is factually incorrect, as can be seen from point 1.7 of the decision's facts and submissions ("because the main request and first auxiliary request lack an inventive

step in the sense of Art. 56") and from points 2.2.2 ("in the assessment of an inventive step in the sense of Art. 56 EPC") and 2.2.6 ("lacks an inventive step") of its reasons.

- 7.4 The Board further finds that the decision under appeal fully considers claim 1 of the main request. Although at first sight it may appear that the Examining Division overlooked the "subscriber database" feature in points 2.2.1 and 2.2.2 of the reasons for the decision, where a distinction is drawn between the technical and non-technical features of the claim, it is clear from point 2.2.5.1 that it also considered the subscriber information to be non-technical. Given that the claim does not specify any functional interaction between the subscriber database and other claim features, this required no further explanation.
- 7.5 The decision explains that the claimed combination of technical features was part of the common general knowledge by describing in some detail what in its view was notorious prior art (see point 4.3 above). It can be understood why the Examining Division considered this notorious prior art to anticipate the technical content of claim 1.
- 7.6 It is established case law that features not contributing to the technical character of the invention are not taken into account in assessing inventive step (see decision T 154/04, *supra*, reasons 5, under (F), and opinion G 3/08, OJ EPO 2011, 10, reasons 10.7.1). Hence the Examining Division did not need to give reasons why those features were part of the common general knowledge of the skilled person. The appellant appears to have read point 9.2 of the reasons of decision T 1242/04 out of context.

- 7.7 It may further be noted that independent claim 9 of the main request is still broader than claim 1 and that the Board considers the decision's reasoning as applied to claim 9 not only sufficient but also sound (see points 4.3 and 4.4 above).
- 7.8 The Examining Division also gave reasons why the additional features included in claim 1 of the first auxiliary request did not overcome the objection of lack of inventive step and why it did not admit the second auxiliary request under Rule 137(3) EPC. The decision was thus sufficiently reasoned in accordance with Rule 111(2) EPC.
- 7.9 The appellant has not alleged any other substantial procedural violation which could render reimbursement of the appeal fee under Rule 103(1)(a) EPC equitable, and the Board is not aware of one either.

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