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Datasheet for the decision of 2 May 2017

Case Number: T 2445/11 - 3.5.07

Application Number: 08804326.0

Publication Number: 2195751

IPC: G06F17/21

Language of the proceedings: EN

Title of invention:
Systems and methods for generating personalized dynamic presentations from non-personalized presentation structures and contents

Applicant:
Moet Hennessy

Headword:
Personalized presentations/MOET HENNESSY

Relevant legal provisions:
EPC Art. 109(1), 111(1), 113(1)
EPC R. 103(1)(a)

Keyword:

Interlocutory revision - department of first instance should have rectified decision (yes)
Remittal to the department of first instance - (yes)
Reimbursement of appeal fee - violation of the right to be heard (yes)
Oral proceedings - before board of appeal (no)

Decisions cited:

T 0494/92, T 0201/98, T 1060/13

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

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Case Number: T 2445/11 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 2 May 2017

Appellant: (Applicant)	Moet Hennessy 65 Avenue Edouard Vaillant 92100 Boulogne-Billancourt (FR)
Representative:	Regimbeau 20, rue de Chazelles 75847 Paris Cedex 17 (FR)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 22 June 2011 refusing European patent application No. 08804326.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

I. The applicant (appellant) appealed against the decision of the Examining Division refusing European patent application No. 08804326.0, filed as international application PCT/EP2008/062376 and published as WO 2009/037282.

II. After a single substantive communication under Article 94(3) EPC, the application was refused for not meeting the requirements of Article 84 and Rule 43(2) EPC.

Under the heading "OBITER DICTUM", the decision contained objections under Articles 82, 84 and 123(2) EPC as well as a novelty objection based on the following document:

D1: US 6 694 482 B1, 17 February 2004.

III. With the statement of grounds of appeal, the appellant filed a new set of claims 1 to 12, effectively deleting former claims 13 to 15. It submitted that the application now contained only one independent method claim and one independent system claim. It further made observations on the objections raised under "OBITER DICTUM".

IV. The appellant requested that the decision under appeal be set aside and that the case be remitted to the Examining Division for further prosecution. It requested that oral proceedings be held "for whatever purpose it may serve".

V. Independent claim 1 of the sole substantive request reads as follows:

"A computer system for generating a dynamic presentation, comprising:

a master storage containing master presentation data having a master nodal structure and master contents associated with content nodes of said structure,

a structure editor capable of copying said master nodal structure into a personalized data structure in a dedicated storage and of selectively changing the copied master nodal structure into a personalized nodal structure in direct response to personalization instructions by the user, wherein said personalized nodal structure comprises all or part of the nodes of the master nodal structure,

a contents editor capable of copying a master content into said personalized data structure in said dedicated read/write storage and of selectively changing the copied master content into a personalized content in response to user inputs,

a dynamic presentation generator for generating a personalized presentation by accessing said personalized data structure, determining which content nodes in said structure belong to personalized presentation, and for any such content node selectively accessing master contents or personalized content if the latter is present in said personalized data structure."

Claims 2 to 11 are directly or indirectly dependent on claim 1.

Independent claim 12 reads as follows:

"A method for generating a personalized dynamic presentation in a computer system having a master

storage containing master presentation data having a master nodal structure and master contents associated to the nodes of said nodal structure, defining together a non-personalized dynamic presentation, said method comprising:

copying said master nodal structure from said master storage to a personalized data structure contained in a dedicated read/write storage,

editing said copied structure into a personalized nodal structure in direct response to personalization instructions by the user, wherein said personalized nodal structure comprises all or part of the nodes of the master nodal structure,

for at least one of said nodes, copying a master content to said personalized data structure contained in said dedicated read/write storage,

editing said copied master content into a personalized content in response to user inputs, and

generating said personalized dynamic presentation by accessing said personalized data structure, determining which content nodes in said structure belong to the personalized presentation, and for any such content node selectively accessing master contents or personalized content if the latter is present in said personalized data structure."

Reasons for the Decision

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

2. The application as amended with the statement of grounds of appeal contains one independent claim in the "apparatus" category and one independent claim in the "process" category and thus complies with Rule 43(2)

EPC. Hence, the sole ground for refusal has been overcome.

3. As to the objections raised under "OBITER DICTUM", the deletion of claims 13 to 15 has removed the basis for the objections under Articles 82 and 84 EPC.

4. The objection under Article 123(2) EPC is directed against the substitution in independent claims 1 and 12 of "in direct response to personalization instructions by the user" for "in response to user inputs". The Examining Division reasoned this objection only by stating that the terms "direct response" and "personalization instructions" could not be found in the description as filed. This reasoning is incomplete, since Article 123(2) EPC does not turn on literal disclosure (cf. Guidelines for Examination, H-IV, 2.2).

5. The objection of lack of novelty over document D1 recites the previous wording of claim 1 rather than that of the version on which the decision is said to be based. The Board further notes that the reasoning given is best described as schematic.

For example, the claim feature "a master storage containing master presentation data having a master nodal structure and master contents associated with content nodes of said structure" is said to be anticipated by the "content database" shown in Figure 7 of document D1. But Figure 7 discloses nothing more about the "content database" than what the term "content database" itself implies. The Examining Division's reasoning on this point therefore does not explain why, in its view, document D1 discloses the content database as containing (master) presentation

data with a nodal structure and contents associated with the nodes of that structure.

Likewise, the reasoning given in the decision does not allow the Board to verify whether document D1 does indeed disclose a "structure editor", a "contents editor" and a "dynamic presentation generator" having all the details as claimed.

6. The objections raised under "OBITER DICTUM" are not formally part of the grounds for refusal and so cannot be criticised for failing to meet a procedural requirement of the EPC. The Board has analysed them to make up its mind on how best to deal with the case. Given the lack of maturity of the novelty objection in particular and the fact that the Examining Division has cited four more documents but has referred to them only sweepingly in its communication, the Board considers it justified to accede to the appellant's request to set the decision aside and remit the case to the Examining Division for further prosecution (Article 111(1) EPC).

7. In view of this outcome, it would have been preferable for the Examining Division to have granted interlocutory revision under Article 109(1) EPC. The Board accepts in principle that there are cases where amended application documents presented on appeal as main request overcome the grounds for refusal yet do not warrant rectification of the decision because of other obvious deficiencies: deficiencies which are newly introduced and immediately apparent or deficiencies which are well explained by remarks or objections included as *obiter dicta* in the decision to refuse and on which the applicant has had an opportunity to comment. In this respect, the Board takes the view that the expression "considers the

appeal to be ... well founded" in Article 109(1) EPC leaves the examining division room for exercising judgment while bearing in mind that the purpose of interlocutory revision is to speed up the procedure. But where, as here, the application was refused on grounds which have subsequently been overcome, and the more fundamental objections have not yet been well developed in the proceedings up to the refusal, there is little point in remitting the case to the boards of appeal.

8. As an aside, the Board is aware that its interpretation of Article 109(1) EPC is not fully in line with the views expressed in decision T 1060/13 of 16 December 2013, reasons 4.1 to 4.3, although the outcome in the present case is the same. According to that decision, interlocutory revision must be allowed if the main request filed with the statement of grounds of appeal clearly overcomes the grounds for refusal, it being irrelevant whether amended claims give rise to new objections or suffer from deficiencies that are the subject of observations included by way of *obiter dicta*.

In the Board's view, this approach may sometimes be too rigid, as it leaves no room for a pragmatic assessment of the situation with a view to procedural efficiency and may result in a needless repetition of the first-instance proceedings, forcing the applicant to pay a second appeal fee. And in practice, when exercising their powers under Article 111 EPC, the boards of appeal often do take into account and benefit from *obiter dicta*, which in many instances cannot be included in the reasons for the contested decision - as would normally be preferable - for lack of a pending

request to which they directly apply or because they were not dealt with during oral proceedings.

9. As for the Examining Division's decision not to issue a further communication, it is established case law that an application may be refused after a single substantive communication, provided that the decision to refuse complies with Article 113(1) EPC (see decision T 201/98 of 27 July 1999, reasons 1.4). For the reasons given below, the Board considers that it does not do so here.

10. In its communication, the Examining Division reasoned its objection of multiple independent claims in the same category essentially by stating that claims 1, 12 and 15 were drafted as separate independent claims and that none of the exceptional situations set out in paragraphs (a), (b) and (c) of Rule 43(2) EPC applied because the claims "merely seem to describe the same features in a different wording".

The appellant replied to this communication by observing that claim 1 was directed to "a computer system", claim 12 to "a method for generating a personalized dynamic presentation" and claim 15 to "a method for assisting salespersons in the presentation of products/services on offer". It argued that those claims corresponded to three different categories and could not be presented differently without rendering them unclear.

In the decision, the Examining Division then argued that claims 1 and 12 to 15 had been drafted as separate independent claims and that none of the exceptional situations applied because "claims 12 and 15 clearly fall into the category of process claims" and "claims 1

and 14 clearly fall into the category of apparatus claims using a different wording".

11. A reasoned objection under Rule 43(2) EPC should state which claims are considered to be independent claims in the same category; it is not sufficient to list three claims and state that they are "separate independent claims". Of the three claims mentioned in the Examining Division's communication, claim 1 was in fact not in the same category as claims 12 and 15. Also, claims 12 and 15 certainly did not "describe the same features in a different wording". As is apparent from the appellant's reply, the objection as presented in the communication failed to direct the appellant to the real issue.

The decision under appeal does reason the objection under Rule 43(2) EPC in so far as it identifies claims 12 and 15 as independent claims in the "process" category and claims 1 and 14 as independent claims in the "apparatus" category (but leaving claim 13 unmentioned). But this reasoned objection was communicated to the appellant for the first time in the decision, and so, contrary to Article 113(1) EPC, the appellant was not given an opportunity to comment on it.

12. Hence, the contested decision is affected by a substantial procedural violation in respect of the sole ground for refusal. Reimbursement of the appeal fee under Rule 103(1)(a) EPC is therefore equitable.

13. The appellant made an unconditional request for oral proceedings before the Board. Since the conclusions reached by the Board are in the appellant's favour, there is, however, nothing left to be discussed. Oral

proceedings serving no purpose in the absence of a point of contention, the decision can be taken without arranging them (cf. decision T 494/92 of 13 June 1993, reasons 2).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution.

3. The appeal fee is to be reimbursed.

The Registrar: The Chairman:

I. Aperribay R. Moufang

Decision electronically authenticated