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**Datasheet for the decision
of 31 August 2015**

Case Number: T 0526/12 - 3.5.05

Application Number: 99306742.0

Publication Number: 0984354

IPC: G06F3/16

Language of the proceedings: EN

Title of invention:

Method for creating dictation macros

Applicant:

Nuance Communications, Inc.

Headword:

Method for creating dictation macros/NUANCE

Relevant legal provisions:

EPC 1973 Art. 54(2)
EPC Art. 111(1)
EPC 1973 R. 68(2)
RPBA Art. 11

Keyword:

Substantial procedural violation - appealed decision
sufficiently reasoned (no)
Reimbursement of appeal fee - appealed decision sufficiently
reasoned (no)
Novelty - availability to the public - public prior use -
burden of proof
Remittal to the department of first instance - fundamental
deficiency in first instance proceedings

Decisions cited:

T 0070/02, T 0037/96, T 0929/94, T 0750/94, T 0472/92,
T 0493/88

Catchword:

see reasons point 1.6 and points 2.2 to 2.5



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 0526/12 - 3.5.05

**D E C I S I O N
of Technical Board of Appeal 3.5.05
of 31 August 2015**

Appellant: Nuance Communications, Inc.
(Applicant) One Wayside Road
Burlington, MA 01803 (US)

Representative: Driver, Virginia Rozanne
Page White & Farrer
Bedford House
John Street
London WC1N 2BF (GB)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 31 October 2011
refusing European patent application No.
99306742.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair A. Ritzka
Members: M. Höhn
G. Weiss

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division, posted on 31 October 2011, refusing European patent application No. 99306742.0 on the ground of lack of inventive step (Article 56 EPC 1973) with regard to prior-art publications:

D1: FIORE CAROLYN: "DragonDictate 2.0 voice recognition software", INTERNET CITATION, [Online] 1997, Retrieved from the Internet: URL:<http://www.htctu.fhda.edu/trainings/manuals/contributions/carolyn/Drago.pdf> [retrieved on 2007-08-02],
D2: EP 0 394 614 A2 and
D3: WO 96/13827 A1.

II. The notice of appeal was received on 22 December 2011. The appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 27 February 2012. The appellant requested that the appealed decision be set aside and that a patent be granted on the basis of the main request or first to fifth auxiliary requests, all filed with the statement setting out the grounds of appeal. Oral proceedings were requested on an auxiliary basis.

III. With a communication dated 3 March 2015 the board noted that it considered the reasoning in the decision under appeal to be incomplete and deficient, constituting a substantial procedural violation, and that the examining division had not sufficiently substantiated that D1 constituted prior art within the meaning of Article 54(2) EPC 1973. The board therefore intended to exercise its discretion according to Article 111(1) EPC and to remit the case to the department of first instance in accordance with Article 11 RPBA with the

order to reimburse the appeal fee. It therefore did not appear necessary to hold oral proceedings. The appellant was invited to indicate whether it would maintain its request for oral proceedings. In case this request was withdrawn, the board would issue a decision directly in the written procedure, following the analysis and reasoning given in the communication.

- IV. By letter dated 27 May 2015 the appellant submitted that it did not maintain the request for oral proceedings.

Reasons for the Decision

1. Prior art

In the decision under appeal D1 was considered to be the closest prior art with regard to claim 1. Document D1 was referred to as an Internet citation in the decision and in the Search Report. However, no details and reasons were given as to whether and why D1 actually belongs to the state of the art in the sense of Article 54(2) EPC 1973.

- 1.1 According to the minutes of the oral proceedings before the department of first instance this issue was extensively discussed (see in particular pages 1 and 3 of the minutes). It could therefore have been expected to be dealt with in the reasons of the written decision. This was not the case.

- 1.2 On page 1 of the letter dated 5 September 2011 the appellant expressed doubts about document D1 having been available to the public at the priority date of

the application. The argument was discussed at oral proceedings before the examining division and it was repeated in the statement setting out the grounds of appeal (see in particular page 2). It was essentially argued that D1 was an internal manual of a university apparently written in Fall 1997, as indicated on the front page, for their students. The date mentioned on D1 was merely a revision date, which may correspond to the date of creation of the document by the author, with no relation to the date of publication. On page 1 of D1 it was indicated that it was based on a software called "DragonDictate 2.0", also known as, or part of the software package "NaturalSpeaking Version 2.0", which had been released around the very same time, namely in November 1997.

Since D1 contained several errors (considering that document D1 presented some typographical errors, such as wrong page numbering, and, on page 9, an incomplete table), it appeared from its unfinished nature that this revision might not have been intended for publication.

With reference to the Guidelines for examination C-V-6.4(a) the appellant argued that they carried out an Internet Search for D1 using the "Wayback Machine" which indicated that the first time D1 was found on the Internet was 20 October 2003, i.e. after the priority date of the present application.

The examining division's assertion that D1 was available to the public, in this case the students, at the date of revision was unsubstantiated. No evidence was provided to suggest that D1 was made available at the date of revision, and as such the question of whether D1 was available to the public before the

priority date of the present application could not be decided definitively based on the evidence produced. In accordance with the Guidelines for examination C-IV-6.2.2 it is not sufficient that the alleged fact (e.g. the publication date) is merely probable. The examining division must be convinced that it was correct. It is difficult to see how the examining division could be convinced that D1 was made available to the public before the priority date of the present application without any evidence to support such a conclusion. The revision date – not the publication date – being stated as "Fall 1997", is not sufficient to determine when the document was made available to the public.

The examining division's reference to "the software to which said document refers was released in a previous date, and that document D1 represents an illustration of said software" did not seem to be relevant to the question of whether D1 was prior art for the present application since the prior art relied upon by the examining division was document D1 rather than the software.

- 1.3 As is reflected in the minutes of the oral proceedings before the department of first instance, the examining division, in view of the appellant's arguments presented during oral proceedings, stated that it was still convinced of the correctness of using D1 as a prior art document. The applicant was invited to provide proof that the software "DragonDictate 2.0" had been released after the priority date of the current application in case of further doubts.

1.4 While the appellant provided details in order to substantiate his arguments, the examining division merely stated that they were still convinced of the correctness of using D1 as a prior art document during oral proceedings and did not provide reasons for this in the written decision.

This, however, is not considered by the board to be sufficient to refute the appellant's detailed arguments.

The board does not consider that the fact that the particular issue of the manual D1 is printed with the date "rev. Fall 1997" by itself to constitute more than prima facie evidence that it was "made available to the public" within the meaning of Article 54(2) EPC on that date. "Prima facie evidence" means evidence which, if not challenged, may be regarded as sufficient to establish the matter in question. In the present case, the appellant did challenge this prima facie evidence by letter dated 5 September 2011, and also submitted detailed arguments during oral proceedings to refute such prima facie evidence.

1.5 As can be seen from the minutes there was confusion as to what the examining division actually intended to rely on. Whether it considered D1 to be an Internet citation available before the priority date, or to be a pre-published document, or whether it referred to the software itself as a public prior use. Furthermore, it was not correct to place the burden of proof on the appellant. In particular, if the applicant states its disagreement with the establishment of a document as prior art and provides detailed arguments challenging prima facie evidence concerning the nominal publication date of a document, the burden of proof shifts to the

examining division to establish that the document was made available to the public within the meaning of Article 54(2) EPC 1973 on that date (see T929/94 of 7 July 1998 with reference to T 750/94, OJ EPO 1998, 32).

- 1.6 According to Rule 68(2) EPC 1973 (applicable here) decisions of the EPO shall be reasoned. The decision at hand does not comply with Rule 68(2) on the issue of the publication date of D1, which is a crucial aspect in the chain of arguments regarding lack of inventive step, on which the decision under appeal hinges, i.e. the establishment of the closest prior art.

Whilst reasoning does not mean that all the arguments submitted should be dealt with in detail, it is a general principle of good faith and fair proceedings that reasoned decisions should contain at least some reasoning on crucial points of dispute, as in the present case the issue of whether D1 is prior art under Article 54(2) EPC 1973, in order to give the party concerned a fair idea of why its submissions were not considered convincing and to enable it to base its grounds of appeal on relevant issues (see e.g. T 70/02 of 15 March 2002). In the decision under appeal, the appellant's submissions concerning the publication date of D1 presented during oral proceedings as outlined in the minutes have not been dealt with in the written decision.

The decision under appeal was based primarily on the finding that D1 was available to the public. This premise, and the conclusion drawn from it, formed part of the chain of reasoning, and thus part of the "essential legal and factual reasoning" which led to the decision to refuse the application. Without such a finding (that D1 had been made available to the public

before the priority date) there could be no basis for the consequential finding that the claimed subject-matter lacked inventive step having regard to the prior publication of D1, and that the application should therefore be refused.

This is regarded as an incomplete and deficient reasoning which contravenes the requirement of Rule 68(2) EPC 1973 (applicable here) and constitutes a substantial procedural violation (see e.g. T 493/88 of 13 December 1989).

2. D1 has been cited as an Internet citation in the decision under appeal as well as in the Search Report. The date on which the document was retrieved is indicated as being 2 August 2007, which is after the priority date of the present application. Furthermore, a Search carried out by the appellant using the "Wayback Machine" revealed a date after the priority date (20 October 2003). The examining division did not provide evidence that D1 was actually available on the Internet prior to the priority date of the present application. It has therefore not been established that D1 was available to the public on the Internet before the priority date of the present application.
 - 2.1 Apparently the examining division concluded that D1 was pertinent prior art from the information found in the document.
 - 2.2 Availability of technical information to the public is governed by Article 54(2) EPC 1973 according to which everything made available to the public before the date of filing of the European patent application forms part of the state of the art. In the case of a written description it is sufficient to be regarded as made

available to the public, if it was possible for the public to have knowledge of the content of the document without any obligation of confidentiality restricting the use or dissemination of such knowledge.

When an issue of fact is being examined and decided by the EPO on the balance of probabilities, the more serious the issue, the more convincing the evidence must be to support it. If the decision on an issue under examination may result in the refusal or revocation of a European patent, for example in a case concerning alleged prior publication or prior use, the available evidence must be examined very critically and strictly, for example in order to ascertain whether or not something happened (the alleged prior publication or prior use) before the relevant filing or priority date. In any such case, a finding that a publication or use forms part of the state of the art for the purpose of Article 54(2) EPC 1973 should only be made if the available evidence, when subjected to a strict and careful evaluation, establishes that a prior publication or use is likely to have occurred. A European patent should not be refused or revoked unless the grounds for refusal or revocation are fully and properly proven: that is it must be proven "up to the hilt" - see decision T 472/92, OJ EPO 1988,161.

In answering the question of whether the written information contained in a document has been made publicly available (see e.g. T 37/96 of 7 February 2000), it is generally necessary to establish all the facts relating to

- where the documents turned up,
- the circumstances in which the information contained in said documents was made accessible to the public, including the determination of who was the public in

the specific case and whether there existed any explicit or implicit confidentiality agreement and - the date or the period of time of the public availability of said documents.

2.3 In the absence of any argument or reasoning in the decision under appeal, the board can only refer to the minutes of the oral proceedings before the department of first instance. According to those minutes the examining division pointed out that there was no reason to assume that students of "High Tech Center College of San Mateo" - which were considered to be "the public" - had been deprived of using this document D1 for more than half a year after the software release, and that document D1 could also be considered as just a pointer to the disclosures by the software itself, in which case "the public" would not even be limited to the students.

2.4 While the board tends to agree that there is no need for the final version of a document to be divulged to the public, it would however require evidence to substantiate that D1 in this particular form as a revision paper, as it was referred to in the decision under appeal, was made available to the public. In particular, the examining division did not substantiate that D1 was made available to the public, in this case assumed to be the students, at the date of revision (see minutes, page 3, third paragraph). The appellant is correct in stating that a revision date "Fall 1997" may correspond to the date of creation of the document by the author and therefore does not necessarily relate to the publication of the document. Hence, further evidence would be required in order to establish that D1 was available to the public before the priority date of the present application.

- 2.5 The examining division further pointed out that the software to which D1 referred was released on a previous date, and that document D1 represented an illustration of said software.

The board notes that the decision under appeal is neither based on a prior use of such a software nor have details been provided to substantiate such a public prior use.

While the appellant, according to the minutes (see page 3, paragraph 4), agreed with the fact that the software existed, the board concurs with the appellant's argument that the content of document D1 may just be the author's opinion and may not necessarily reflect the features of the software product available on the market correctly. It would have to be taken into account that D1 is not an official manual of the software developer.

- 2.6 Therefore, the Board concludes that it has not been sufficiently substantiated by the examining division that D1 constitutes prior art within the meaning of Article 54(2) EPC 1973.
3. In view of points 1 and 2 above, the board exercises its discretion according to Article 111(1) EPC and remits the case to the department of first instance in accordance with Article 11 RPBA with the order to reimburse the appeal fee.

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.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chair:



K. Götz-Wein

A. Ritzka

Decision electronically authenticated