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**Datasheet for the decision
of 30 March 2017**

Case Number: T 0660/12 - 3.5.06

Application Number: 00911907.4

Publication Number: 1257899

IPC: G06F7/00

Language of the proceedings: EN

Title of invention:

AUTOMATIC DOCUMENTATION OF CONFIGURABLE SYSTEMS

Applicant:

Ecora Software Corporation

Headword:

Automatic documentation/ECORA

Relevant legal provisions:

EPC R. 103(1) (a)
EPC 1973 Art. 52(2), 54, 56

Keyword:

Substantial procedural violation - (no)
Inventive step - (no)

Decisions cited:

T 0775/90, T 1175/02, T 0438/06, T 0850/06

Catchword:



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Case Number: T 0660/12 - 3.5.06

D E C I S I O N
of Technical Board of Appeal 3.5.06
of 30 March 2017

Appellant: Ecora Software Corporation
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 4 November 2011
refusing European patent application No.
00911907.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman W. Sekretaruk
Members: G. Zucka
M. Müller

Summary of Facts and Submissions

I. The appeal is against the decision by the examining division, dispatched with reasons on 4 November 2011, to refuse European patent application 00911907.4, on the basis that the subject-matter of independent claim 1 of the main request and independent claims 1 and 20 of the auxiliary request was not novel, Article 54 EPC 1973, in view of the following document:

D1 = A. Aimar *et al.*: "Using WWW to improve software development and maintenance: application of the LIGHT system to ALEPH programs", [Online] 1995, CERN, CERN preprint, CERN document server, Switzerland, XP002542246, Retrieved from the Internet: URL:<http://preprints.cern.ch/cgi-bin/setlink?base=preprint&categ=cern&id=ECP-95-024>

II. A notice of appeal was received on 23 November 2011, the appeal fee being paid on the same day. A statement of the grounds of the appeal was received on 3 March 2012.

III. The appellant requested that the decision under appeal be set aside and a patent granted on the basis of claims 1 to 25 filed with the grounds of appeal. He further requested a reimbursement of the appeal fee and made a conditional request for oral proceedings.

IV. The board issued a summons to oral proceedings. In an annex to the summons, the board set out its preliminary, negative opinion on the appeal.

V. On 28 February 2017, the appellant filed auxiliary requests 1 and 2, comprising respectively claims 1 to 25 and 1 to 24.

- VI. The oral proceedings took place as scheduled on 30 March 2017, in the absence of the appellant as previously announced.
- VII. The appellant requests that the decision under appeal be set aside and a patent be granted on the basis of claims 1 to 25 of the main request filed with the statement of grounds, or on the basis of claims 1 to 25 of auxiliary request 1 or claims 1 to 24 of auxiliary request 2, both filed with the letter of 28 February 2017.
- VIII. Independent claim 1 of the main request reads as follows:

A method for automatic production of documentation for a specific system instance of at least one configurable system, said specific system instance representing the configurable system in a specific configuration, comprising the steps of:

- a) retrieving (1605) configuration parameters having values associated therewith, from the configurable system;
- b) outputting (1650) explanatory information corresponding with at least one of said configuration parameters and the value associated therewith; and
- c) organizing said explanatory information, based on at least one of a content of said information and said value associated with said parameter, into an integrated narrative format descriptive of the configuration of the configurable system, the integrated narrative format constituting the documentation, or a portion of the documentation, for said configurable system.

IX. Independent claim 1 of auxiliary request 1 differs from that of the main request in that the following text is added before the semicolon at the end of step (a):
"said configuration parameters are [sic] retrieved by using a collector computer program (1520, 120) coupled to said configurable system".

X. Independent claim 1 of auxiliary request 2 differs from that of the main request in that the following text is added after the semicolon at the end of step (a):

"- creating a generic model that represents the configurable system;
- creating a specific model that relates to a specific instance of the configurable system and to a specific instance of the generic model, and
- creating documentation that is specific to the configurable system instance and the instance model.
[sic]".

XI. The further text on file is:

description pages
1 to 3 and 5 to 21 as originally filed,
3a, 4, 22 received on 1 June 2010;

drawing sheets
1 to 14 as originally filed.

XII. At the end of the oral proceedings, the chairman announced the board's decision.

Reasons for the Decision

1. *The admissibility of the appeal*

The appeal is admissible

2. *Possible substantial procedural violation; Rule 103(1) (a) EPC*

2.1 In the grounds of appeal (section I, first paragraph), the appellant requests a reimbursement of the appeal fee. Although the appellant provides no explicit reasons for this request, it would seem that it should be seen in the context of the statement in section II, last paragraph of the grounds of appeal, *i.e.* "that circumstances defined in the Guidelines, C-VI-33-7.1, indicating when the execution of Oral Proceedings would be appropriate, were not reached". In his letter dated 28 February 2017 (section II), the appellant implicitly seems to acknowledge that this is indeed the motivation behind his request.

2.2 It would seem that the appellant refers to section C-VI, 7.1 of the Guidelines in their version of July 2010.

The board firstly points out that said passage of the Guidelines merely states that "oral proceedings may be suggested by the examiner [to the Examining Division] or requested by the applicant because an impasse has been reached". The passage does not say or even imply that oral proceedings should *only* take place when an impasse has been reached.

According to Article 116(1) EPC 1973, oral proceedings at the instance of the EPO shall take place if the EPO considers this to be expedient. As stated in the July 2010 version of the Guidelines, C-III 4, second paragraph, "Oral proceedings will *normally* only be expedient if after an attempt at written clarification there are still questions or doubts which have a crucial bearing on the decision to be reached and which may be more efficiently or surely settled by oral discussion with the party" (emphasis added by the board). In the current version of the Guidelines (November 2016), the same text appears in section E-II, 4, second paragraph.

The wording of both Article 116(1) EPC and the Guidelines makes it clear that the only criterion for oral proceedings to have taken place at the instance of the EPO was that (in the present case) the *examining division* considered it expedient. This was obviously the case, as is apparent from the "brief communication" of the examining division dated 13 October 2011, point 1, second paragraph. Even if it were at all possible to argue, at the present time in retrospect, that the holding of oral proceedings was not "expedient" in some objective sense, such argument would ignore the wording of Article 116(1) EPC, which makes the decision to hold oral proceedings dependent on the subjective assessment of the division.

- 2.3 In his reply to the summons (section II), the appellant additionally argues that the principle of the protection of legitimate expectations has been violated, referring to the "Case Law of the Boards of Appeal 2016, chapter III-A, page 513".

The board observes that said page in the "Case Law" book is merely the table of contents of chapter III-A and that the appellant has not indicated which section of said chapter or which board of appeal decisions that are discussed in it would be relevant in the present case, let alone in how far the reasoning contained in such decisions would presently apply.

2.4 The appellant submits (*ibid.*, fifth paragraph) that not substantially discussing the irrelevance of D1 in writing has affected the outcome of the proceedings. According to the board however, this would only be true if the applicant could somehow have argued more effectively in writing than orally that D1 is not relevant. The appellant has however provided no arguments why the nature of oral proceedings would have prevented him from presenting a convincing case.

2.5 The board also observes that it has not considered D1 irrelevant, as stated by the appellant (*ibid.*, penultimate paragraph), but that it only considers that the document does not demonstrate lack of novelty, and that it is a less suitable starting point than the prior art acknowledged in the application for the discussion of inventive step.

2.6 Further according to the appellant (*ibid.*, sixth and following paragraphs), the statement in the summons to the first instance oral proceedings that "Nevertheless, refusal according to Article 97(2) EPC should be expected even during oral proceedings" signified that the division had already made up its mind.

The board however notes that said sentence should be read together with the sentence that precedes it, *viz.* "Should the applicant decide not to attend the oral

proceedings, notice is kindly requested by the 20 September 2011". In this context, it is apparent that the contentious statement of the division, admittedly in grammatically incorrect English, constitutes nothing more than the usual warning that the application could be refused, in the absence of the applicant, during the oral proceedings itself.

2.7 The board therefore holds that no procedural violation, let alone a substantial one, has taken place.

3. *Patentability (all requests); Article 52(2) EPC 1973*

The independent method and system claims in all requests relate to the production of documentation, *i.e.* a presentation of information, which would as *such* be excluded from patentability (Article 52(2) (d) and (3) EPC 1973). However, given that the claims refer to an *automatic* production of documentation, which according to the board is a technical feature, the board considers that the claims do not relate to a presentation of information as such and are therefore not excluded under Article 52(2) (d) EPC 1973.

4. *Main request*

4.1 The board agrees with the appellant that D1 does not disclose a method for the automatic production of documentation for a specific instance of a configurable system. Instead, D1 describes how to make available all documents relating to a given software on the World Wide Web, with cross-connections. The software in D1 is a given, there is no mention of configuring it.

The subject-matter of claim 1 is therefore considered novel; Article 54 EPC 1973.

- 4.2 Given that D1 does not disclose a method for the automatic production of documentation for a specific instance of a configurable system, the board chooses to start the assessment of inventive step not from D1 but from a configurable system such as is acknowledged as prior art in the description of the present application, page 1, lines 6-13.
- 4.3 As set out in the description, page 2, lines 3-12, the claimed method consists in the automation of an activity that was previously carried out by human labour. The board agrees with the general practice adopted by the boards of appeal (see e.g. T 775/90, Reasons 5.3; T 1175/02, Reasons 4.9.5; and T 438/06, Reasons 2.5), according to which such automation *in itself* cannot be considered inventive. The question is then whether something more is involved than a mere automation.
- 4.4 The board considers that, if the documentation were produced by a human, he or she would typically provide the reader with information that is tailored to the specific configuration of the system being described, as is implicitly acknowledged by the appellant on page 2, lines 4-5 of the description: "Since the configuration of such systems changes with time, the task is a continual one, taxing information technology personnel".
- 4.5 The person producing the documentation would therefore need to know how the system is configured, *i.e.* he or she would normally need to retrieve in some manner configuration parameters having values associated therewith from the configurable system.

It could be argued that, alternatively, said person may retrieve said information not from the system itself but e.g. from some specification that is available externally. The board however considers that, given the risk of error, it would then in any case be an obvious step to double-check the parameters by inspecting the system directly.

- 4.6 In order to produce the necessary information for the reader of the documentation, he or she would then output (e.g. to a printed or electronic document) "explanatory information corresponding with at least some of the configuration parameters and the values associated therewith".
- 4.7 In order to be useful, the information should be easy to read, *i.e.* it should preferably be presented using natural language. This means that the explanatory information, which will constitute the documentation or a portion thereof for the configurable system, would typically be organised in a narrative format which is descriptive of the configuration of the configurable system. The narrative format should obviously relate to the system as it is, *i.e.* it should be "based on at least one of a content of said information and said value associated with said parameter".
- 4.8 According to the appellant (reply to the summons, section III.1, sixth to ninth paragraph), the skilled person would look at the behaviour or the performance of the configurable system. He or she would run test routines and record the external properties and behaviour of the system over the entire spectrum of performance.

According to the board however, such testing would only be necessary in specific cases. It is not apparent why any testing should take place for example if the goal were merely to produce documentation that enables a user to operate the configurable system.

4.9 The board's conclusion is that the claimed method, apart from the fact that it is automated, does not contain any steps going beyond what a skilled human operator would typically do when producing the required documentation. It therefore constitutes a mere automation of a human activity, which according to the board does not involve an inventive step.

4.10 The board does not exclude that automatic production of documentation for a specific instance of a configurable system may, in principle, be inventive. No features are however discernible in claim 1 of the main request which might aim to solve a particular technical problem that would arise in the automatic production of documentation. For example, in view of the fact that the claim's wording covers *all* possible types of configurable systems, the implementation of such a generally applicable method could cause technical problems that at first seem unsurmountable but for which the application would have proposed some non-obvious solution. Or perhaps, assuming that the claim had been limited to some particular type of configurable system with certain peculiarities that would render automation difficult, the claim could have contained technical features to deal with that particular situation.

Claim 1 however contains no technical features which would deal with either situation. The board furthermore notes that neither the dependent claims nor the

description contain such features. Instead, all further features seem to concern standard tools available to a programmer, used to achieve their known, individual, non-synergistic effects.

4.11 It would actually appear that the claimed method depends at least to some extent on human actions which cannot readily be automated and to which no features in the claim correspond, e.g. the choice of the appropriate pre-determined text segments that would effectively improve the understanding of meaning and effects of the configuration parameters in the resulting narrative format (see the description page 8, lines 19-21).

4.12 The board therefore holds that the subject-matter of claim 1 of the main request is not inventive; Article 56 EPC 1973.

5. *Auxiliary request 1*

5.1 Claim 1 of auxiliary request 1 differs from that of the main request by the additional feature that "[the] configuration parameters are retrieved by using a collector computer program (1520, 120) coupled to [the] configurable system".

5.2 According to the board, the automation of the activity mentioned under 4.5 above would normally take place by means of software, i.e. by means of a "collector computer program". This program would necessarily need some connection to the configurable system in order to retrieve the required parameters.

5.3 The board therefore holds that the subject-matter of claim 1 of auxiliary request 1 is also not inventive; Article 56 EPC 1973.

6. *Auxiliary request 2*

6.1 Claim 1 of auxiliary request 2 differs from that of the main request by the following additional features:

- creating a generic model that represents the configurable system;
- creating a specific model that relates to a specific instance of the configurable system and to a specific instance of the generic model, and
- creating documentation that is specific to the configurable system instance and the instance model.

6.2 The board considers it common practice for an automated method to create and use a model of a system with certain characteristics which the method needs to know, if only to avoid having to enter all the data manually or alternatively building all physical connections necessary for the automated method to retrieve the characteristics from the physical system itself. In this regard, the board agrees with T 850/06, Reasons 3.5.2, last sentence, according to which a skilled person, when developing an automated process from a known manual process, apart from simply automating the individual steps of the manual process, will also tend to make use of typical possibilities offered by automation.

6.3 The board therefore holds that the subject-matter of claim 1 of auxiliary request 2 is also not inventive; Article 56 EPC 1973.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



B. Atienza Vivancos

W. Sekretaruk

Decision electronically authenticated