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**Datasheet for the decision  
of 22 May 2014**

**Case Number:** T 2038/13 - 3.5.06  
**Application Number:** 94305058.3  
**Publication Number:** 634719  
**IPC:** G06F9/46  
**Language of the proceedings:** EN

**Title of invention:**

System and method for distributed computation based upon the movement, execution, and interaction of processes in a network

**Applicant:**

Ben Franklin Patent Holding LLC

**Headword:**

Remote programming/BEN FRANKLIN

**Relevant legal provisions:**

EPC Art. 107  
EPC R. 111(2)

**Keyword:**

Admissibility of appeal - (yes)  
Appealed decision - reasoned (no)  
Substantial procedural violation - (yes)  
Reimbursement of appeal fee - (yes)

**Decisions cited:**

T 1182/05, T 0292/90

**Catchword:**



**Beschwerdekammern  
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Case Number: T 2038/13 - 3.5.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.06**  
**of 22 May 2014**

**Appellant:** Ben Franklin Patent Holding LLC  
(Applicant) 1422 130th Avenue N.E.  
Bellvue, WA 98005 (US)

**Representative:** Kazi, Ilya  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 2 May 2013  
refusing European patent application No.  
94305058.3 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman:** D. Rees  
**Members:** G. Zucka  
W. Sekretaruk

## Summary of Facts and Submissions

I. The appeal is against a decision by the examining division to refuse European patent application 94 305 058.3 "according to the state of the file" (Guidelines for Examination in the European Patent Office, C-V, 15), with "Grounds for the decision" dispatched by means of EPO Form 2061 on 2 May 2013. The Grounds refer to the communication of the examining division dated 18 October 2012 and to the applicant's request, received on 16 April 2013, for "a decision on the written record".

According to said communication of the examining division, the application does not satisfy the requirements of Articles 84 and 56 EPC 1973. The communication also questioned whether Article 123(2) EPC is satisfied.

The arguments in said communication refer to the following documents:

- D1: Corradi A. *et al.*: "Distributed environments based on objects: upgrading Smalltalk toward distribution", Ninth Annual International Phoenix Conference on Computers and Communications (Cat. No. 90CH2799-5), Scottsdale, AZ, USA, 21 to 23 March 1990, pages 332 to 339, ISBN 0-8186-2030-7, 1990, Los Alamitos, CA, USA, IEEE Comput. Soc. Press, USA
- D2: Ogata Ketal: "The design and implementation of HoME (Smalltalk version)", ACM SIGPLAN '92 Conference on Programming Language Design and Implementation, San Francisco, CA, USA, 17 to 19 June 1992, pages 44 to 54, SIGPLAN Notices, July 1992, USA

II. A notice of appeal was received on 28 June 2013, the appeal fee being paid on the same day. A statement of the grounds of the appeal was received on 29 August 2013.

III. The appellant requested "that the case be remitted back to the Examining Division to provide a fully reasoned decision on the written record". He also requested a reimbursement of the appeal fee on the grounds that the failure to provide adequate reasoning in the appealed decision constituted a substantial procedure violation.

As an auxiliary request, the appellant requested "the grant of a patent based on claims 1 to 5 filed on 28th January 2011".

The appellant made a conditional request for oral proceedings.

IV. The independent claim, *i.e.* claim 1, of the claims referred to in the auxiliary request, reads as follows:

A method for implementing remote programming in a computer network having a plurality of computers (120A, 120B) using a plurality of object-oriented classes including an agent class and a place class, the method comprising:

forming, by a computer, instructions for a computer process, said instructions including a transport operation for transporting data between processes; interpreting a set of instructions for an agent object on a processor in said computer network to generate an agent process wherein said set of instructions is based on an instantiation of one or more of said object oriented classes, wherein

said agent process owns one or more objects so that said one or more objects owned by said agent process can be transported along with said agent process, wherein: said interpretation of said set of instructions includes performing said transport operation, and wherein said one or more objects includes at least one class object; and in response to performing said transport operation, representing said agent process in a standardized form and transporting said standardized form of said agent process to a destination place process wherein said agent process is a member of said agent class and said destination place process is a member of said place class, wherein said transportation of said standardized form of said agent process includes transportation of said one or more objects and said at least one class object.

## **Reasons for the Decision**

### *1. The admissibility of the appeal*

The appellant was clearly negatively affected by the decision to refuse the patent, whether or not it was well-reasoned. However, the appellant's main request is nothing more than that the examining division issue a fully reasoned decision and the appeal fee be paid back. It is questionable whether this is an admissible request (even when interpreted by the board - see below). The fact that the appealed decision did not contain any arguments beyond those that were contained

in the summons for oral proceedings dated 18 October 2012 is a direct consequence of the appellant's request, in its reply to the summons, to issue "a decision on the written record", which the board judges to be an unambiguous request, following the suggestion made to that effect in the summons (section 14), to issue a decision according to the state of the file (as foreseen under the Guidelines for Examination C-V, 15, of which an appellant represented by a professional representative should be aware). It could be argued therefore that the appellant got precisely what it requested and hence that an appeal against that action is inadmissible. However the board considers that, independent of the appellant's actions, a decision to refuse an application must be reasoned. This is a requirement of the EPC (Rule 111(2)) and is necessary for the Boards of Appeal to perform their function of reviewing decisions of the first instance. An applicant is also negatively affected by such a decision, since it may not be in a position to make out a proper and complete case in the grounds of appeal, as required by the Rules of procedure of the Boards of Appeal (Article 12(2)). If, as seems likely, it was not possible for the examining division to produce a proper reasoning without introducing additional arguments that would have infringed Article 113(1) EPC, it should have followed the procedure also laid down in the Guidelines (C-V 15.4), that is it should have refused the request and issued a further communication. The board concludes that the issuance of an inadequately reasoned decision can be the subject of an appeal, even if it might appear to have been invited by the appellant.

2. *Interpretation and admissibility of the requests*

2.1 *Main request*

The appellant's main request is that (1) the case be remitted back to the Examining Division "to provide a fully reasoned decision on the written record" and (2) that the appeal fee be paid back.

Part (1) of the request is obviously not correctly formulated, as it would obviously not be possible for the board to remit the case to the first instance simply with the order to find reasons why the application should be refused, *i.e.* without giving the first instance the possibility to grant a patent if no such reasons exist or can be found. It is therefore obvious that part (1) of the request should be interpreted as follows: remit the case back to the examining division, which should provide a full reasoning *if it decides to refuse the application*. Since a fully-reasoned decision in the case of refusal is anyway required, part (1) of the request is in fact simply for remittal for further prosecution.

## 2.2 *Auxiliary request*

The appellant's auxiliary request is "the grant of a patent based on claims 1 to 5 filed on 28th January 2011". The board interprets this request as meaning that the description and the drawings which were part of the request that was refused by the appealed decision are also part of the current auxiliary request, *i.e.* the auxiliary request comprises the following application documents:

Description pages

- 2 to 12, 15, 17, 20, 22, 25 to 206 as originally filed
- 1 received on 1 May 2003



- 13, 14, 16, 18, 19, 21, 23, 24 received on  
28 January 2011

Claims numbers 1 to 5 received on 28 January 2011

Drawing sheets 1 to 106 as originally filed

3. *The appellant's arguments*

The appellant argues (page 2 of the grounds of appeal) that the summons to which reference is made in the appealed decision does not provide a clear reasoning for refusing the application but merely sets out a preliminary opinion of the examining division, essentially stating that various matters are to be discussed at the oral proceedings. It is submitted that the present case is identical to that in T 1182/05 and reference is also made to T 292/90.

The board observes that a summons to oral proceedings by its very nature can only contain a preliminary opinion and, assuming that oral proceedings do take place, the examining division necessarily can only have a final opinion at the conclusion of these proceedings, after having heard the applicant's arguments. In the present case, no oral proceedings took place, following the applicant's withdrawing his request for oral proceedings. The applicant further had not provided any additional arguments. Only further considerations by the examining division itself could therefore possibly have led to it changing its opinion, but this obviously did not happen. For this reason, the appellant's argument does not hold.

Contrary to the appellant's statement, the present case is not identical with or even similar to that in

T 1182/05. In the latter case, the appellant had filed substantive arguments in reply to the division's summons, which were subsequently ignored by the examining division. In the present case, no arguments were filed in reply to the summons.

T 292/90 is also different from the present case, in that the examining division in the former case had not issued a decision "according to the state of the file".

4. *Remission to the department of first instance; Rule 11 RPBoA; No reasoned decision; Rule 111(2) EPC*

4.1 Notwithstanding the above, the board holds that the appealed decision is not reasoned within the meaning of Rule 111(2) EPC. This is a fundamental deficiency in the first instance proceedings which results in the remittal to the examining division (Article 11 RPBoA).

4.2 First, the board observes that section 12 of the first instance summons does not reach a conclusion on the issue of possibly added subject-matter (Article 123(2) EPC). This is however immaterial, given that the summons only mentions Articles 84 and 56 EPC as the basis for its preliminary opinion that the application should be refused (see section 13, last paragraph).

4.3 *Prima facie*, section 13 of said summons provides arguments which justify the examining division's objections under Article 84 and 56 EPC. A closer examination of this section however reveals that such is not the case, for the following reasons:

4.3.1 No logical chain can be detected in the argumentation given under section 13. The section starts with a sentence which implies that the object is to "arrive at

a provisional opinion about claim 1 regarding inventive step". It then compares the features of claim 1 with the disclosure of D1, most of those features being considered disclosed by D1 or part of common knowledge. In the course of this comparison, certain features are considered unclear, viz. the concept of "owning" and the wording "own one or more objects so that said one or more objects owned by said agent process can be transported along with said agent process", the latter being considered to "attempt the specification of a result to be achieved". The examining division however does not explain the relevance of the alleged lack of clarity of these features for the inventive step argumentation, i.e. in how far the lack of clarity would imply that the features are known or obvious.

Within the same chain of arguments that supposedly aim to demonstrate the lack of an inventive step, the division further considers the subject-matter of claim 1 to be "merely textually novel". Presumably this was intended to mean that the text of claim 1 is as such not disclosed in the prior art but what is actually claimed is known. Such a reasoning however does not belong to an inventive step objection but to a novelty objection.

After apparently having dismissed the features which allegedly attempt to define a result to be achieved as merely contributing to "textual novelty", the argumentation continues by saying that said result to be achieved has a known solution in D1. However, it does not say whether and why the skilled person would implement that solution to achieve said result.

The argumentation further continues by saying that "Because claim 1 in its breadth of scope actually

covers the technical features previously disclosed in D1, there can be no inventive step present". One can only speculate that the division possibly intended to say that D1 discloses in combination all the technical features of claim 1, the subject-matter of which is consequently not inventive. After this sentence, one would think that the division has reached a conclusion based on what it said before. However, the argumentation then continues, and goes into a different direction, *i.e.* it now says that "The general problem to be solved has already been considered by D1 and various solutions have been indicated in it". Based on this new argument, the division concludes a second time that the inventive step requirement has not been met. No indication is however given of what is the "general problem" or what are the "various solutions" allegedly disclosed by D1.

The arguments in section 13 of the division's summons therefore cannot be said to form a reasoning against the presence of an inventive step. Such a reasoning should at the very least clearly indicate what the examining division considers to be the difference between the claimed subject-matter and the closest prior art. It should not leave the reader guessing what is the division's actual opinion in this respect, as is presently the case. After the difference is established, the reasoning should explain why a skilled person, starting from the closest prior art, would arrive at the claimed subject-matter without the need for an inventive step. This should in principle be done according to the "problem and solution approach", which is the standard approach at the European Patent Office. However, neither this approach nor any other verifiable approach was used in the division's summons.

- 4.3.2 As said above, the division's summons stated that the concept of owning is not clear. No reasons are however given to support this statement.
- 4.3.3 Also no reasons are given why the above mentioned "result to be achieved" entails a lack of clarity. The board observes that a claim definition which includes a result to be achieved is in principle allowable and does not necessarily lead to a lack of clarity.
- 4.3.4 The examining division also considers D2 to be a "valid basis" to demonstrate the lack of an inventive step (section 13, paragraph 8 of the summons). No arguments are however given in this respect. Even if, as stated by the division, D2 had already been used in an earlier communication to raise an inventive step objection, the reasoning given in that communication should at least have been adapted to the new wording of claim 1.
- 4.4 The board concludes that (1) the division's summons contains no arguments demonstrating lack of clarity, although this is said to be the main objection (section 13, last paragraph), and (2) what seems at first sight to be a reasoning against inventive step is of such a nature that it amounts to no reasoning.

For these reasons, the requirements of Rule 111(2) EPC have not been satisfied. Consequently, under Rule 18 RPBoA the board shall remit the case to the department of first instance, unless special reasons present themselves for doing otherwise. The board notes that the request for grant of a European patent was already filed on 8 July 1994, but does not consider this alone as being a sufficient reason for an exceptional treatment of the case and depriving the applicant the opportunity of having heard the substantive issues of

the case in two instances. The board considers the lack of a reasoning to be a substantial procedural violation, justifying also the reimbursement of the appeal fee (Rule 67 EPC 1973). The board therefore judges that the appellant's main request, interpreted as indicated above, should be accepted.

## Order

### For these reasons it is decided that:

1. The appealed decision is set aside.
2. The appeal fee is reimbursed.
3. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:



B. Atienza Vivancos

D. Rees

Decision electronically authenticated