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Datasheet for the decision of 25 May 2020

Case Number: T 0097/14 - 3.5.01

Application Number: 02756343.6

Publication Number: 1412869

IPC: G06F15/16

Language of the proceedings: EN

Title of invention:
WEB SERVICE DEVELOPMENT PLATFORM FOR ASYNCHRONOUS WEB SERVICES

Applicant:
Oracle International Corporation

Headword:
Asynchronous web service/ORACLE

Relevant legal provisions:
EPC R. 111(2), 103(1)(a)
EPC Art. 113(1), 111(1)
RPBA 2020 Art. 11

Keyword:
Substantial procedural violation - appealed decision sufficiently reasoned (no) - opportunity to comment (no)
Appeal decision - remittal to the department of first instance (yes - the Board cannot decide the case on the merits because the search was not complete)

Decisions cited:
G 0010/93

Catchword:
See point 3.

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Case Number: T 0097/14 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 25 May 2020

Appellant: (Applicant)	Oracle International Corporation 500 Oracle Parkway Redwood Shores, CA 94065 (US)
Representative:	Gill Jennings & Every LLP The Broadgate Tower 20 Primrose Street London EC2A 2ES (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 16 July 2013 refusing European patent application No. 02756343.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	W. Chandler
Members:	A. Wahrenberg
	C. Schmidt

Summary of Facts and Submissions

I. This is an appeal by the applicant (appellant) against the decision of the examining division to refuse the European patent application No. 02756343.6.

II. In the statement setting out the grounds of appeal, the appellant requested that the decision of the examining division be set aside and that a patent be granted on the basis of the main request, or one of the first to third auxiliary requests.

III. The examining division had found that the corresponding requests (the first to forth auxiliary requests in the decision under appeal) lacked an inventive step over the "acknowledged prior art" in the background section of the application.

IV. The appellant argued that the inventive step objection starting from the acknowledged prior art, which was raised for the first time during oral proceedings, was insufficiently reasoned and completely unsubstantiated. The appellant did not have sufficient opportunity to hear the proposed reasoning, and to fairly comment thereon. Consequently, the appellant was effectively denied its right to be heard under Article 113 EPC. Nevertheless, rather than requesting that the case be remitted to the examining division, the appellant requested that the case be settled in appeal proceedings.

V. In a communication pursuant to Rule 100(2) EPC, the Board agreed with the appellant that there had been a substantial procedural violation which warranted the remittal of the case back to the examining division.

The Board did not consider itself to be in a position to settle the case, however, because the search did not cover all the relevant fields.

VI. The appellant replied that it was wrong to remit the case and effectively restart the examination including a new prior art search. The appellant had a legitimate expectation that a decision on patentability would be made based on the prior art cited by the International and European search authorities and the examining division. Furthermore, the Board should have raised this issue earlier. Nevertheless, the appellant requested that, if the case had to be remitted, the Board order expedited prosecution of the application. The appellant's request for oral proceeding was said to be withdrawn in those circumstances.

VII. In a communication accompanying a summons to oral proceedings, the Board informed the appellant that, due to the appellant's pending requests, the case could only be decided after oral proceedings. The Board could not accede to the appellant's request to order expedited examination, because the Board had no influence on this aspect of the procedure before the examining division.

VIII. In a letter of reply dated 18 March 2020, the appellant withdrew the request for oral proceeding and requested that the case be remitted to the examining division as soon as possible for further prosecution. The oral proceedings were thus cancelled.

Reasons for the Decision

1. *The invention*

1.1 The invention concerns asynchronous web services.

1.2 Traditional web services are synchronous i.e. a client calling the web service has to wait for the server to return the result. The client cannot process other tasks while waiting.

Asynchronous web services, on the other hand, do not require the client to wait. The client calls the web service and then goes on to process other tasks. Once the web server has completed, it returns the result in a callback to the client.

The callback is made to a callback address indicated in the original call.

1.3 Claim 1 of the main request reads:

An apparatus comprising:

a storage medium having stored therein a plurality of programming instructions, which when executed cause the apparatus to operate as a server to implement an asynchronous web service by, in use:

receiving a message from a client requesting that a web service method be invoked;

parsing the message to identify the requested web service method, in addition to a callback address

indicating a location where the client is listening for callbacks from the web service;

storing the callback address in association with a client proxy object for interacting asynchronously with the client; and

invoking the requested web service method;

the apparatus further comprising at least one processor coupled to the storage medium to execute the programming instructions.

2. *The decision under appeal*

2.1 The examining division found that the subject-matter of claim 1 of the present main request, corresponding to the first auxiliary request in the decision under appeal, lacked an inventive step (Article 56 EPC) over "synchronous web services", which were said to be "acknowledged prior art" in the background section of the application (see point 2.2 of the decision under appeal).

2.2 Although the Board cannot find any mention of synchronous web services in the background section of the application, it has not been disputed that such web services were well known at the priority date. In the Board's view, however, the examining division has failed to provide a reasoned argument why the claimed subject-matter would have been obvious over synchronised web services.

2.3 In the decision under appeal (see point 2.2), the examining division lists the features of claim 1 which

it considers to be known from synchronous web services. However, the decision does not specify which features of a synchronised web service anticipate those features of claim 1. In particular, it is not clear what, in a synchronous web service context, corresponds to the callback address in claim 1.

2.4 A reasoned objection of lack of inventive step must establish the state of the art and set out, in a clear and complete manner, which features of the claimed invention are known from the prior art and where those features can be found in the prior art. In other words, a proper feature mapping is required. This is all the more important when the objection relies on non-documentary prior art, because such evidence is more difficult to verify.

In the Board's judgment, the decision of the examining division fails to meet this requirement.

2.5 The examining division found that the claimed invention differed from the synchronous web service in that the web service was an *asynchronous* one which used a proxy object for interacting asynchronously with the client. This was considered to be an obvious modification for the skilled person.

In the Board's view, the decision of the examining division does not sufficiently explain why the skilled person would have modified the known synchronous web service into an asynchronous one.

The examining division did not rely on a document but rather referred to the skilled person's knowledge; The skilled person was said to have known "how to implement asynchronous communication".

However, knowing how to implement something does not mean that one would necessarily do so. There has to be a motivation for the skilled person to modify the prior art in the way claimed.

The appellant had argued that the skilled person would not have considered teachings relating to asynchronous communication in other technical fields. In particular, the skilled person would not have considered the documents D1 and D2, relating to asynchronous remote procedure calls, to be relevant for web services. Instead of considering and replying to this argument, the examining division dropped the reference to D1 and D2 and asserted, without evidence, that the skilled person had knowledge of "asynchronous communications" in general. This is not a fair way of dealing with the applicant's argument. The reference to general asynchronous communication rather obfuscates the weakness of the previous reasoning based on D2.

2.6 For the reasons set out above, the Board finds that the decision under appeal is not sufficiently reasoned. Furthermore, the appellant's arguments have not been properly taken into account. Thus, there has been a violation of both Rule 111(2) and Article 113(1) EPC. This is a substantial procedural violation in the sense of Rule 103(1) EPC.

3. *Remittal to the examining division*

3.1 In deciding on the appeal, the Board may either exercise any power within the competence of the department which was responsible for the decision under appeal or remit the case to that department for further

prosecution (Article 111(1) EPC).

3.2 According to Article 11 RPBA 2020, the Board *shall not* remit a case *unless special reasons* present themselves for doing so. As a rule, fundamental deficiencies which are apparent in the proceedings before that department constitute such special reasons.

The substantial procedural violations in this case are, in the Board's judgment, a fundamental deficiency and consequently a special reason for remitting the case.

3.3 In the grounds of appeal, the appellant requested that the Board settle the case in appeal proceedings rather than remit the case to the examining division for further prosecution. Although the request has since then been withdrawn, the appellant certainly had a valid point. The present application has been pending for 18 years, and in those circumstances, it would be preferable if the case could be finally settled without further delay.

3.4 However, the Board does not consider itself to be in a position to settle the case for the following reasons:

3.5 Before granting a patent, the Board of Appeal, just like the examining division, must ensure that the conditions for patentability exist (see G 10/93, reasons point 3). In order to do so, the state of the art must be established.

3.6 The appellant has consistently argued that, since the claimed invention relates to web services, the closest prior art for the purpose of assessing inventive step should be in that field. Consequently, the documents cited in the supplementary European search report and

during examination (D1 and D2), relating to remote procedure calls, were argued to be unsuitable as starting point for inventive step. The examining division seems to have accepted the appellant's arguments, because, during oral proceedings, it discarded D2 as closest prior art and instead argued lack of inventive step starting from synchronous web services.

3.7 The Board agrees with the appellant that the closest prior art should be in the field of web services. The Board furthermore finds it inconceivable that "synchronous web services" constitutes a complete representation of the state of the art in that field. The examining division's choice of closest prior art rather seems to have been based on what was available at the oral proceedings when the examining division decided to discard D2.

3.8 The Board notes that the supplementary European search report indicates the field of search as "G06F". This IPC class is defined as "electric digital data processing", which in plain English means computer systems. In the Board's view, this field of search seems too narrow. A complete search for web services should probably include the field "H04L" ("transmission of digital information" or telecommunications). Indeed, the CPC class H04L67/02 seems relevant.

3.9 The appellant expressed doubts whether a Board of Appeal was at all competent to review the field of search. The present Board does not have any doubts in this regard. The Board may exercise any power within the competence of the examining division (Article 111(1) EPC). Since the examining division may review the search, so may the Board.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside and the case is remitted to the examining division for further prosecution.

2. The appeal fee is to be reimbursed.

The Registrar: The Chairman:

T. Buschek W. Chandler

Decision electronically authenticated