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**Datasheet for the decision
of 12 November 2019**

Case Number: T 0866/15 - 3.5.03

Application Number: 10171606.6

Publication Number: 2337310

IPC: H04L29/08, G06F9/46

Language of the proceedings: EN

Title of invention:

System and method for communicating with a network of printers using a mobile device

Applicant:

Xerox Corporation

Headword:

Communicating with a network of printers/XEROX

Relevant legal provisions:

EPC Art. 84

Keyword:

Claims - clarity - main request (no)



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Case Number: T 0866/15 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 12 November 2019

Appellant: Xerox Corporation
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 17 December
2014 refusing European patent application No.
10171606.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman F. van der Voort
Members: J. Eraso Helguera
J. Geschwind

Summary of Facts and Submissions

- I. An appeal was lodged by the applicant against the decision of the examining division refusing European patent application No. 10171606.6 with publication number EP 2 337 310 A2. The refusal was based on lack of clarity of claim 1 (Article 84 EPC) and lack of inventive step of the subject-matter of claims 1 to 4 (Articles 52(1) and 56 EPC).
- II. In the statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of a main request filed with the statement of grounds of appeal.
- III. In a communication accompanying a summons to oral proceedings, the board gave its preliminary opinion that claim 1 of the main request lacked clarity (Article 84 EPC).
- IV. With its letter dated 19 September 2019, the appellant filed a new main request including a set of claims 1 to 4 and submitted arguments in support the clarity of claim 1.
- V. Oral proceedings were held on 12 November 2019.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims 1 to 4 filed with the letter dated 19 September 2019.

At the end of the oral proceedings, the chairman announced the board's decision.
- VI. Claim 1 reads as follows:

"A method (200) for a mobile client (106) to interact with nodes (102; 104; 104a; 104b) coupled to a network (108), the method comprising:

coupling the mobile client via hardware and software to the network, wherein in addition to the mobile client a plurality of nodes (102; 104; 104a; 104b) are coupled to the network, said plurality of nodes including at least one printer device and at least one index node (102) coupled to the network;

wherein one or more nodes of the plurality of nodes respectively includes a software application (138) executable by a processor (131) associated with the respective node on a software platform (130) executed by the processor, wherein the application can interact with a printer device (162) of the at least one printer device to cause the printer device to perform a function;

wherein each index node forms a membership community with at least itself;

wherein the index node of each membership community maintains information related to applications included with the at least one member in its community;

wherein the index node of each membership community exchanges information with other index nodes of the at least one node, including the information maintained by the respective index nodes;

the method further comprising

executing on a hardware processor (141) of the mobile client a software platform (140);

wherein executing the platform includes discovering (201, 202) one or more index nodes of the plurality of nodes (102; 104; 104a; 104b) that is coupled to the network (108);

wherein the mobile client (106) discovering an index node includes:

ascertaining the existence of the index node and successfully exchanging data with the discovered index node by performing the steps of;

transmitting to the plurality of nodes via the network a request for an address associated with respective index nodes of the plurality of nodes;

receiving at least one address in response to the request;

selecting an address from the received at least one address;

and wherein the method further comprises the mobile client joining (203) the discovered index node's membership community, and wherein the joining its membership community comprises:

sending a request to the index node having the selected address to join the index node's membership community; and

receiving (204) a message from the index node which confirms acceptance of the mobile client as a member of its membership community,

wherein the method further comprises discovering (205, 206) by the mobile client while executing the software platform the at least one application executable by the respective processors associated with the plurality of nodes;

wherein discovering the application comprises: ascertaining that the application is available for execution when the at least one index node (102) presents the application as being available;

filtering out from the at least one available application each application of the at least one available application that requires a user to perform a physical action with a printer device of the at least one printer device; and

providing (206) information via a user interface (147) wherein the provided information includes

information providing the ability to activate the at least one application that was not filtered out; and selecting and activating (207) by the mobile client the at least one application that was not filtered out."

Reasons for the Decision

1. Claim 1 - clarity (Article 84 EPC)

- 1.1 As a preliminary remark, the board notes that claim 1 of the main request addresses a method "for a mobile client to interact with nodes coupled to a network" comprising fifteen steps, namely:
- "coupling",
 - "executing ... a software platform",
 - "discovering one or more index nodes",
 - "ascertaining the existence of the index node and successfully exchanging data with the discovered index node",
 - "transmitting ... a request for an address",
 - "receiving at least one address",
 - "selecting an address",
 - "joining the discovered index node's membership community",
 - "sending a request to the index node",
 - "receiving a message from the index node",
 - "discovering ... the at least one application",
 - "ascertaining that the application is available",
 - "filtering out",
 - "providing information via a user interface", and
 - "selecting and activating".

Some of these steps are explicitly included in other steps, whereas other steps are not. Some steps set out

explicitly which entity carries them out, other steps do not.

1.2 In the present case, claim 1 of the main request fails to clearly define the matter for which protection is sought, the reasons being as follows:

1.3 Firstly, claim 1 makes a distinction between a "mobile client" and "a plurality of nodes including at least one printer device and at least one index node". At least the following steps can plausibly be understood as being carried out by the mobile client according to a well-defined hierarchy (bold, indenting and numbering by the board):

(1) "coupling **the mobile client** via hardware and software to the network",

(2) "executing on a hardware processor **of the mobile client** a software platform", including

(2.1) "discovering one or more index nodes", wherein **the mobile client** discovering an index node includes:

(2.1.1) "ascertaining the existence of the index node and successfully exchanging data with the discovered index node" by

(2.1.1.1) "transmitting to the plurality of nodes via the network a request for an address"

(2.1.1.2) "receiving at least one address in response of the request" and

(2.1.1.3) "selecting an address from the received at least one address"

(3) "**the mobile client** joining the discovered index node's membership community", comprising:

(3.1) "sending a request to the index node"

(3.2) "receiving a message from the index node".

1.4 The remaining steps of claim 1, i.e. the last five paragraphs of the claim, read as follows (bold und underlining by the board):

"wherein the method further comprises discovering (205, 206) **by the mobile client** while executing the software platform the at least one application executable by the respective processors associated with the plurality of nodes;

wherein discovering the application comprises: ascertaining that the application is available for execution when the at least one index node (102) presents the application as being available;

filtering out from the at least one available application each application of the at least one available application that requires a user to perform a physical action with a printer device of the at least one printer device; and

providing (206) information via a user interface (147) wherein the provided information includes information providing the ability to activate the at least one application that was not filtered out; and

selecting and activating (207) **by the mobile client** the at least one application that was not filtered out."

1.5 The presence of "and" in both the penultimate and the second penultimate paragraph renders the claim ambiguous and allows for different readings, for example:

1.5.1 According to a first reading, the first "and" would end an enumeration of three sub-steps (bold, indenting and numbering by the board) as follows:

wherein the method further comprises

(4) "discovering **by the mobile client** while executing the software platform the at least one application", comprising:

(4.1) "ascertaining that the application is available for execution when the at least one index node presents the application as being available"

(4.2) "filtering out" **and**

(4.3) "providing information via a user interface"

and

(5) "selecting and activating **by the mobile client** the at least one application that was not filtered out".

1.5.2 According to a second reading, which corresponds to the appellant's interpretation of the claim during the oral proceedings, the two "and"s link steps at the "top level" of the claim, in which "discovery the at least application" comprises a single sub-step as follows:

wherein the method further comprises

(4) "discovering **by the mobile client** while executing the software platform the at least one application", comprising:

(4.1) "ascertaining that the application is available for execution when the at least one index node presents the application as being available"

(5) "filtering out"

and

(6) "providing information via a user interface"

and

(7) "selecting and activating **by the mobile client** the at least one application that was not filtered out".

1.6 The board notes that the ambiguous wording makes the claim prone to even more readings and that different readings lead to different subject-matter. For instance, according to the above-mentioned first reading, "filtering out" and "providing information via a user interface" are understood as being carried out by the mobile client, like every other step in the claim. According to the second reading, as argued by the appellant with reference to page 10, lines 3 to 10 of the description as filed, at least the step of "filtering out" may also be performed by another entity, e.g. the index node. As regards "providing via a user interface", according to the second reading, the claim does not explicitly set out which entity carries it out, although according to the appellant, the reference to "a user interface" made it clear that this step was carried out by the mobile client, even though

no "user interface" was previously mentioned in the claim. The appellant submitted that with a mind willing to understand, as referred to in the Guidelines, the skilled person would know how to correctly interpret the claim.

1.7 The board is not convinced. The above-mentioned first reading of the claim makes technically sense, yet it defines a more limited subject-matter than the second reading. Article 84 EPC stipulates that the claims shall be clear. As set out above, this requirement is not met in view of the complex and ambiguous drafting of the claim, which, instead of clearly and concisely setting out the technical features of the invention, calls for speculation as regards the intended protection.

1.8 Furthermore, the language of the claim raises further questions concerning clarity, for instance:

- whether the feature "wherein the index node of each membership community exchanges information with other index nodes of the at least one node ..." is mandatory or merely optional in view of the fact that the wording "said plurality of nodes including at least one printer device and at least one index node" earlier in the claim appears to include embodiments in which there is only one index node, i.e. in which cases there would be no "other index nodes";

- how "selecting an address from the received at least one address" is to be understood in embodiments in which only one address is received (see the preceding feature "receiving at least one address in response to the request"); and

- whether "the mobile client joining (203) the discovered index node's membership community", i.e. drafted in singular, encompasses the mobile client joining more than one community simultaneously or not, account being taken of the fact that the claim includes the feature "executing the platform includes discovering (201, 202) one or more index nodes".

The appellant argued that, with a mind willing to understand, the skilled person would understand what was actually meant: the above-mentioned exchange of information would only take place when there were two or more index nodes in the network, and the "selection" in case of only one address being received meant that the address would be actively used for further communication (instead of merely being passively received). Further, the claim did not exclude embodiments in which the mobile client joined more than one community simultaneously.

The board is not convinced. The drafting of the claim, however broad, should allow the reader to objectively ascertain what subject-matter is meant to be protected. In the present case, the ambiguities referred to above cannot be resolved by giving the features in question a broader or narrower interpretation dependent on what could possibly be understood by the skilled reader.

2. *Conclusion*

As there is no allowable request, it follows that the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Rauh

F. van der Voort

Decision electronically authenticated