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**Datasheet for the decision
of 23 February 2021**

Case Number: T 1884/18 - 3.5.07

Application Number: 09811130.5

Publication Number: 2327028

IPC: G06F17/22, H03M7/30

Language of the proceedings: EN

Title of invention:

Method and device for encoding elements

Applicant:

InterDigital CE Patent Holdings

Headword:

Method and device for encoding elements/INTERDIGITAL

Relevant legal provisions:

EPC Art. 54, 87(1), 111(1)

RPBA 2020 Art. 11, 12(2)

Keyword:

Novelty - publication date of document D1

Remittal to the department of first instance - (yes)

Decisions cited:

T 0545/08, T 1066/13



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Case Number: T 1884/18 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 23 February 2021

Appellant: InterDigital CE Patent Holdings
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Representative: Cammas, Nathalie
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 17 January 2018
refusing European patent application
No. 09811130.5 pursuant to Article 97(2) EPC**

Composition of the Board:

Chair J. Geschwind
Members: M. Jaedicke
P. San-Bento Furtado

Summary of Facts and Submissions

- I. The applicant (appellant), which at the time of filing was Thomson Licensing, appealed against the decision of the examining division refusing European patent application No. 09811130.5, filed as international application PCT/EP2009/061479 (published as WO 2010/026223) on 4 September 2009. The application claims a priority date of 8 September 2008 from European patent application No. 08305534.3.
- II. In the course of the appeal proceedings, the application was transferred to InterDigital CE Patent Holdings, which is now the appellant.
- III. The document cited in the contested decision was:
D1 Ramez Alkhatib et al., "Efficient Compression and Querying of XML Repositories", 19th International Conference on Database and Expert Systems Applications 2008, pp. 365-369, 1 September 2008.
- IV. With respect to the then-pending main request, the examining division decided that the subject-matter of independent claims 1 and 7 was excluded from patentability under Article 52(2) and (3) EPC, the subject-matter of independent claims 9, 12, 14 and 15 lacked inventive step in view of a general-purpose computer or a DVD, the subject-matter of claims 1, 9 and 14 lacked novelty over document D1, and that of claims 7, 12 and 15 lacked inventive step in view of D1.

As to the then-pending auxiliary request, the examining division decided that the subject-matter of independent

claims 1, 9 and 14 lacked novelty over D1 and that of independent claims 7, 12 and 15 lacked inventive step in view of document D1.

- V. In its statement of grounds of appeal, the appellant requested that the decision be set aside and that a patent be granted on the basis of the main request or any of three auxiliary requests, all requests submitted with the grounds of appeal. The appellant argued that the claimed priority was valid and that document D1 was published online on 12 September 2008, i.e. only after the priority date. Consequently, document D1 was not prior art for the present application. The appellant filed the following documents in support of its line of argument:

- D11 web page of the 19th International Conference on Database and Expert Systems Applications 2008, conference program, www.dexa.org/dexa2008/dexadriver/2.html;
- D12 IEEE Xplore Digital Library, Abstract and bibliographic web page relating to document D1, <https://ieeexplore.ieee.org/document/4624743/>.

- VI. In a communication pursuant to Rule 100(2) EPC, the board expressed in particular its provisional opinion that the main request was admissible and that document D1 had not been publicly available before the claimed priority date of 8 September 2008, which was valid. Consequently, the board could not review the contested decision on the basis of document D1 and intended to remit the case for further prosecution.

The board cited the following documents:

- D13 Proceedings 19th International Workshop on Database and Expert Systems Applications 2008,

front cover, <https://ieeexplore.ieee.org/stamp/stamp.jsp?tp=&arnumber=4624652&tag=1>;

- D14 Proceedings 19th International Conference on Database and Expert Systems Applications DEXA 2008, table of contents, <https://ieeexplore.ieee.org/stamp/stamp.jsp?tp=&arnumber=4624656>;
- D15 DEXA 2008 Fourth International Workshop on Data Management in Global Data Repositories - GRep'08 Fifth International Workshop on Mobile P2P Data Management, Security and Trust - MPDMST'08, <https://ieeexplore.ieee.org/stamp/stamp.jsp?tp=&arnumber=4624676>;
- D16 4th International Workshop on Data Management in Global Data Repositories (GRep) 2008, call for papers, <https://web.archive.org/web/20080912183322/http://www.tkl.iis.u-tokyo.ac.jp:80/~anirban/GREP08.html>.

VII. In reply, the appellant agreed with the case being remitted to the examining division.

VIII. Claim 1 of the main request reads as follows:

"A method for encoding a set of elements of an XML file or of a fragment of an XML file, wherein each element comprises a data structure of a type and at least one attribute value, characterized by:

receiving said XML file or said fragment of an XML file;

selecting a current element of said XML file or said fragment of an XML file for encoding;

determining whether the current element has the same data structure type as a previously encoded element;

in the negative, encoding the data structure of the current element and the at least one attribute value of the current element; and

in the affirmative, encoding the at least one attribute value of the current element and providing an indication value indicating the current element has the same data structure type as the previously encoded element."

Claims 2 to 6 are dependent, directly or indirectly, on claim 1.

Claim 7 reads as follows:

"A method for decoding encoded data of a set of elements of an XML file or of a fragment of an XML file wherein each element comprises a data structure of a type and at least one attribute value, characterized by:

selecting the encoded data of a current element for decoding; and

if determining said current element has the same data structure type as a previously decoded element based on a portion of the encoded data indicating the current element has the same data structure type as the previously decoded element, deriving the at least one attribute value by decoding said encoded data and deriving the data structure of said current element by using the data structure of said previous decoded element."

Claim 8 is dependent on claim 7.

Claim 9 reads as follows:

"An encoder for encoding a set of elements of an XML file or of a fragment of an XML file wherein each element comprises a data structure of a type and at least one attribute value, characterized by comprising:

an input module (402) configured to receive said XML file or said fragment of an XML file; and

a process module (403) configured to determine whether a current element to be encoded has the same data structure type as a previously encoded element, encode the data structure of the current element and the at least one attribute value in response to the negation of said determination, and in response to the affirmation of said determination, encode the at least one attribute value of the current element and provide an indication value indicating the current element has the same data structure type as the previously encoded element."

Claims 10 and 11 are dependent, directly or indirectly, on claim 9.

Claim 12 reads as follows:

"A decoder for decoding encoded data of a set of elements of an XML file or of a fragment of an XML file wherein each element comprises a data structure of a type and at least one attribute value, characterized by comprising:

an input module (502) configured to receive the encode data of a current element for decoding; and
a process module (503) configured to determine whether said current element has the same structure type as a previously decoded element based on a portion of the encode data indicating the current element has the same data structure type as the previously decoded element, and responsive to the affirmation of the determination derive the at least one attribute value by decoding said encoded data and derive the data structure of said current element by using the data structure of said previous decoded element."

Claim 13 is dependent on claim 12.

Claim 14 reads as follows:

"A storage medium for encoding a set of elements of an XML file or of a fragment of an XML file wherein each element comprises a data structure of a type and at least one attribute value, characterized by comprising instructions for:

receiving said XML file or said fragment of an XML file;

selecting a current element of said XML file or said fragment of an XML file for encoding;

determining whether the current element has the same data structure type as a previously encoded element;

in the negative, encoding the data structure of the current element and the at least one attribute value of the current element; and

in the affirmative, encoding the at least one attribute value of the current element and providing an indication value indicating the current element has the same data structure type as the previously encoded element."

Claim 15 reads as follows:

"A storage medium for decoding encoded data of a set of elements of an XML file or of a fragment of an XML file wherein each element comprises a data structure of a type and at least one attribute value, characterized by comprising instructions for:

selecting the encoded data of a current element for decoding; and

if determining said current element has the same data structure type as a previously decoded element based on a portion of the encoded data indicating the current element has the same data structure type as the previously decoded element, deriving the at least one attribute value by decoding said encoded data and deriving the data structure of said current element by

using the data structure of said previous decoded element."

In view of the outcome of the appeal, the auxiliary requests are not relevant to the present decision.

Reasons for the Decision

The invention

1. The application relates to the encoding and decoding of XML data files.

Main request

2. *Document D1 as state of the art*
 - 2.1 The appellant argued for the first time in appeal that document D1 had been published online by the IEEE on 12 September 2008 and that there was no evidence of an earlier publication. While D1 had been published in the proceedings of the 19th International Workshop on Database and Expert Systems Applications 2008, there was no evidence that it had been published on 1 September 2008 as assumed by the examining division and as indicated by the international search report.

Moreover, document D1 had not been published in the proceedings of the 19th International Conference on Database and Expert Systems Applications 2008 but in the above-mentioned proceedings of the workshop. It was uncertain that printed proceedings had been published before the online publication. As the claimed priority of the present application was valid, the effective filing date was 8 September 2008. Consequently,

document D1 had not been made available before the date of filing of the present application and was not included in the state of the art. Hence it could not be used to attack novelty or inventive step.

2.2 Publication date of document D1

The board agrees with the appellant that there is no sufficiently convincing evidence on file that document D1 was indeed publicly available before the priority date. The board shares the appellant's view that the earliest publication date proved by the evidence on file is 12 September 2008, i.e. the date of the online publication (see D12, "Date Added to IEEE Xplore"). It is possible that the workshop proceedings had already been publicly available when the workshop took place (e.g. they may have been distributed to the participants in printed form or on a USB stick), but it is also possible that document D1 had not been made publicly available before 12 September 2008. For example, the preparations for the proceedings may not have been finished when the workshop took place (a cover page, see D13, and other documents needed to be prepared, even though the papers themselves had had to be submitted back in April 2008 - see D16).

It is probable that all or a substantial part of the content of document D1 had been made publicly available by oral disclosure when and if a presentation was given at the workshop between 1 and 5 September 2008 (as required according to D16), but there is no conclusive evidence of this and the board cannot know what technical details, if any, were made publicly available by oral disclosure. Consequently, based on the evidence presently available, the board is not convinced that document D1 was publicly available before the claimed

priority date of 8 September 2008 (see Case Law of the Boards of Appeal of the EPO, 9th edition 2019, I.C. 3.2.3, and the decisions cited therein, especially decisions T 545/08 of 24 March 2017 and T 1066/13 of 9 July 2018).

The appellant argued that D1 had not been publicly available before the effective filing date (see statement of grounds of appeal, page 3, paragraph 3). Hence it needs to be assessed whether the priority date is valid.

2.3 Validity of priority date

2.3.1 The appellant argued that claims 1 to 14 of the international application were identical to the corresponding claims of the priority application. Claims 15 and 16 of the international application were based on claims 1 and 6 of the priority application.

2.3.2 As to the validity of the priority for the subject-matter of independent claims 1, 7, 9 and 12, the board considers that these claims are supported by claims 1, 7, 10 and 13 and the description, paragraph [0058] ("XML file or a fragment thereof"), of the priority application.

While the board is not aware of an explicit description of a storage medium comprising instructions in the priority application, it considers that the skilled person reading the priority application will understand that the encoding and decoding in some embodiments is performed by a suitably-programmed general-purpose computer or the like. As such a computer stores the program on a storage medium (such as main memory or hard disk), the board considers that there is a basis

for claims 15 and 16 in the priority application. Since the priority application and the subject-matter of the independent claims of the main request relate to the "same invention" and the present application was filed within twelve months of the priority application (Article 87(1) EPC), the priority is valid for the independent claims of the main request.

2.4 Conclusion

In view of the above conclusions regarding the publication date of document D1 and the validity of the priority date, the board finds that, unless further evidence supporting a publication date earlier than the priority date is presented, document D1 is not to be considered prior art for the claims of the main request.

3. *Novelty and inventive step*

As the contested decision based its assessment of novelty and inventive step solely on document D1, and the board is not convinced, on the basis of the evidence currently at hand, that document D1 is included in the state of the art for the present application, it is not expedient to review the contested decision with regard to novelty and inventive step.

4. *Remittal*

4.1 The appellant requested that a patent be granted. In view of the above objection regarding document D1, the

board is not in a position to order that a patent be granted as the publication date of document D1 needs further assessment.

4.2 Under Article 111(1) EPC, the board may either proceed further with the examination of the application or remit the case to the department responsible for the decision under appeal for further prosecution. In addition, Article 11 RPBA 2020, which applies since the present appeal was pending on 1 January 2020 (Article 25(1) RPBA 2020), provides that the board should not remit a case for further prosecution unless special reasons present themselves for doing so. This provision should be read in conjunction with the principle that the primary object of appeal proceedings is to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020), not to conduct a complete examination of the application, including an additional search for relevant prior-art documents.

4.3 In reaction to the appellant contesting document D1 as prior art, an investigation is required to clarify the facts underlying the publication of D1. In view of their character of judicial review, the appeal proceedings are not a suitable context for performing such an investigation. The date of publication of document D1 having been contested for the first time in appeal proceedings, the board considers it appropriate to remit the case to the examining division for further prosecution on the basis of the main request, considering the new situation that document D1 is objected to as valid prior art.

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 for further prosecution.

The Registrar:

The Chair:



S. Lichtenvort

J. Geschwind

Decision electronically authenticated