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**Datasheet for the decision
of 31 March 2022**

Case Number: T 2864/19 - 3.5.03

Application Number: 06300486.5

Publication Number: 1724990

IPC: H04L29/06

Language of the proceedings: EN

Title of invention:

Communication network security risk exposure management
systems and methods

Applicant:

Huawei Technologies Co., Ltd.

Headword:

Insufficient inventive-step reasoning/HUAWEI

Relevant legal provisions:

EPC Art. 56, 111(1)

EPC R. 103(1)(a), 111(2)

RPBA 2020 Art. 11, 12(8)

Keyword:

Decision in written proceedings - (yes): no oral proceedings necessary or appropriate

Substantial procedural violation - (yes): inventive-step objection not sufficiently reasoned

Remittal - (yes): fundamental deficiency in first-instance proceedings

Reimbursement of appeal fee - (yes): equitable by reason of a substantial procedural violation

Decisions cited:

J 0007/82, T 0493/88, T 0292/90, T 1709/06, T 1051/20,
T 1713/20



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Case Number: T 2864/19 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 31 March 2022

Appellant: Huawei Technologies Co., Ltd.
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Shenzhen, Guangdong 518129 (CN)

Representative: Kreuz, Georg Maria
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 26 April 2019
refusing European patent application
No. 06300486.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair K. Bengi-Akyürek
Members: J. Eraso Helguera
R. Romandini

Summary of Facts and Submissions

- I. The appeal was lodged against the decision of the examining division to refuse the present European patent application for lack of inventive step (Article 56 EPC) with respect to the independent claims of each of a main request and auxiliary requests 1, 3, 4 and 5 and for added subject-matter with respect to the independent claims of auxiliary request 2.
- II. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of any of six requests (**main request** and **auxiliary requests I to V**) filed with the statement of grounds of appeal. If none of these requests could be granted, the appellant requested oral proceedings.
- III. In view of the reasons below, it is not necessary to reproduce the wording of the present claim requests filed with the statement of grounds of appeal.

Reasons for the Decision

1. *Decision in written proceedings*
- 1.1 The appellant requested oral proceedings in the event that none of the request filed with the statement of grounds of appeal could be granted (cf. point II above).
- 1.2 The board's decision to set aside the decision under appeal and to remit the case to the examining division (cf. point 4 below) is not adverse in substance to the appellant. A hearing before the board solely to discuss

whether or not the case should be remitted is not deemed to be necessary or appropriate (see e.g. T 1051/20, Reasons 4.2, and the decisions cited there).

1.3 Therefore, the decision may be handed down in written proceedings without holding oral proceedings (Article 12(8) RPBA 2020).

2. *Substantial procedural violation*

Claim 1 of the main request underlying the decision under appeal comprises the following limiting features (board's outline):

- (a) A risk analysis system comprising
- (b) a risk analyser configured to determine a security risk to a feature of a communication network
- (c) by analysing only certain assets of the communication network which are associated with the communication network feature and vulnerabilities affecting the only certain assets which are associated with the communication network feature,
- (d) the security risk to the feature of the communication network is not a risk to the comprehensive network that is analysed based on all assets of the communication network;
- (e) wherein the feature of the communication network comprises a service provided by the communication network, and/or a mission which is carried out using the communication network.

2.1 In Reasons 16 of the decision under appeal, the following reasoning for lack of inventive step with respect to claim 1 of the main request was given:

"16 Main request

16.1 Claim 1 (compared to claim 1 received on 26 February 2019) comprises the additional feature 'the security risk to the feature of the communication network is not a risk to the comprehensive network that is analyzed based on all assets of the communication network' and 'and/or' in the penultimate line of claim 1. As the feature 'the security risk to the feature of the communication network is not a risk to the comprehensive network that is analyzed based on all assets of the communication network' is also disclosed in section 4.2 of D1, as an asset is not equivalent to the comprehensive network. Also unambiguously derivable from this section is that the asset analysis module is able to analyse one or more assets. Thus, applicant's argument that the application cannot be seen obvious over D1 is not convincing.

In addition, said additional feature is related to the problem and not providing a solution.

The applicant argued that the prior art cited in the search report is cited long after the priority of the application and thus the person skilled in the art could know more as at date of priority. This argument is deemed invalid, as the application was filed on 18 May 2006, claiming priority of 18 May 2005 and the Search Report was established on 27 September 2006, four months after receipt of the application.

Thus, the Examining Division decides that claim 1 of the main request does not fulfill the requirements of Article 56 EPC."

- 2.2 The first paragraph of Reasons 16.1 is a copy of point 2 of the minutes of a telephone consultation held, prior to the first-instance oral proceedings, between the first examiner and the representative on 12 March 2019 and dispatched on 14 March 2019. This paragraph merely explains that, in claim 1, **feature (d)** (now replaced in all the claim requests filed with the statement of grounds of appeal) and the "and/or" in **feature (e)** have been added vis-à-vis the version received on 26 February 2019 and that feature (d) is disclosed in section 4.2 of D1. The examining division concludes that "said additional feature is related to the problem and not providing a solution", but it does not mention *which* passages of D1 indeed disclose the remaining features claimed. Nor does it indicate the distinguishing features or the objective problem that those should actually solve.
- 2.3 According to Rule 111(2) EPC, decisions of the EPO which are open to appeal must be reasoned. The decision must address the facts, evidence and arguments which were relevant for reaching the decision, and must contain a logical chain of reasoning which led to the relevant conclusions (see T 292/90, Reasons 2).
- 2.4 In the case at hand, the inventive-step reasoning appearing in Reasons 16 of the decision under appeal seems to be based on the "problem-solution approach", at least to the extent that it mentions "the problem" and "a solution". At most, the reasoning implicitly uses D1 as the "closest prior art". It fails to properly identify the features distinguishing the subject-matter of present claim 1 from the disclosure of D1, the resulting technical effect and the objective technical problem derived therefrom. Furthermore, it does not explain the reasons why the skilled person

would have arrived at the claimed subject-matter in view of the problem defined, e.g. according to the "could-would approach" (see e.g. the Guidelines for Examination, G-VII, 5).

- 2.5 This substantial lack of reasoning deprives the board from the possibility of reviewing the examining division's conclusions, which are relevant even if the appellant has filed new claim requests with the statement of grounds of appeal. Rather than assessing whether the examining division's findings were correct, the board would be forced to perform a completely independent examination almost from scratch. In other words, the impugned decision merely contains statements that, at best, give rise to speculations about what the deciding body might have intended to express (see e.g. T 1713/20, Reasons 1.3.3).
- 2.6 Thus, the reasoning against the main request underlying the decision under appeal is insufficient under Rule 111(2) EPC. As lack of inventive step was the sole reason for rejecting the main request, this amounts to a substantial procedural violation.
- 2.7 The board is aware that point 2 of the annex to the summons to oral proceedings issued by the examining division, referring to *method* claim 16 (rather than *system* claim 1), explains the following:

"2 The subject-matter of claim 16 lacks an inventive step (Article 56 EPC).

2.1 D1 discloses according to the subject-matter of claim 16

A communication network security risk analysis method comprising providing vulnerabilities affecting assets of a communication network, the method being characterized by further comprising: determining a security risk to a feature of a communication network by analyzing the assets which are associated with the communication network feature and the vulnerabilities affecting the assets which are associated with the communication network feature (section 4.2).

This objection was raised in the communication dated 24.03.2017 and confirmed by communication dated 18.10.2017.

2.2 The subject-matter of claim 16 differs from the disclosure in d1 in that: wherein the feature of the communication network comprises a service provided by the communication network, or a mission which is carried out using the communication network.

2.3 The difference belongs to the problem of how to improve security assessment and management therefor.

2.4 As the person skilled in the art is aware that service or missions are provided over network, the additional feature does not contribute to solve the technical problem."

2.8 On the face of it, a plausible interpretation of the inventive-step reasoning against claim 1 of the main request in the decision under appeal could arguably be obtained through the establishment of an analogy with

the objection against claim 16 appearing in point 2 of the annex to the summons, e.g. by inferring that **feature (e)** of claim 1 should be the distinguishing feature and that the same reasoning used for claim 16 should apply *mutatis mutandis*. Yet this possibility cannot make up for the deficiencies identified in point 2.4 above. First, Reasons 16 of the decision under appeal does not refer to *any* of the objections raised in previous communications during the written proceedings. Second, even if it did, it is not up to a Board of Appeal to construct the applicable reasons by "mosaicking" various arguments from the file (see e.g. T 1709/06, Reasons 1.2.1), however obvious the board's speculations may seem and even if the appellant did not raise any complaints in this respect.

3. *Reimbursement of the appeal fee (Rule 103(1)(a) EPC)*

3.1 According to established case law, failure to provide sufficient reasons pursuant to Rule 111(2) EPC constitutes a substantial procedural violation justifying reimbursement of the appeal fee (see e.g. T 493/88, Reasons 7). In the present case, there is also a causal link between the above substantial procedural violation and the necessity of filing an appeal against the examining division's decision.

3.2 Hence, reimbursement of the appeal fee is ordered on the board's own motion (see e.g. J 7/82, OJ EPO 1982, 391, headnote III).

4. *Remittal to the examining division for further prosecution (Article 111(1) EPC)*

4.1 Pursuant to Article 11 RPBA 2020, fundamental deficiencies (such as substantial procedural

violations) which are apparent in the first-instance proceedings constitute "special reasons" for a remittal of an appeal case to the first-instance department for further prosecution.

- 4.2 Accordingly, the board has decided that the case is to be remitted to the examining division for further prosecution on the basis of the six claim requests filed with the statement of grounds of appeal.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.
3. The appeal fee is to be reimbursed in full.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated