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**Datasheet for the decision
of 20 September 2021**

Case Number: T 0195/20 - 3.5.06

Application Number: 04784877.5

Publication Number: 1700416

IPC: G06F21/33, G06F21/41,
H04L29/06, H04L9/32

Language of the proceedings: EN

Title of invention:

ACCESS CONTROL FOR FEDERATED IDENTITIES

Patent Proprietor:

Google LLC

Opponent:

Bundesdruckerei GmbH

Headword:

User access/GOOGLE

Relevant legal provisions:

EPC 1973 Art. 100(c), 111
RPBA 2020 Art. 11, 13(1), 13(2)

Keyword:

Amendments - added subject-matter (no)

Decisions cited:

T 1294/16

Catchword:



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Case Number: T 0195/20 - 3.5.06

D E C I S I O N
of Technical Board of Appeal 3.5.06
of 20 September 2021

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 3 December 2019
revoking European patent No. 1700416 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. Müller
Members: S. Krischer
A. Jimenez

Summary of Facts and Submissions

- I. The appeal lies from the interlocutory decision of the opposition division, with reasons dispatched on 3 December 2019, to revoke European patent EP 1 700 416 on the basis of Article 100(c) EPC (1973) and with further reference to Articles 123(2,3) EPC.
- II. Opposition had been filed on the grounds for opposition according to Article 100(a) EPC in combination with Articles 52(2), 54, and 56 EPC, 100(b) and 100(c) EPC (1973).
- III. The proprietor/appellant filed a notice of appeal on 15 January 2020 along with a statement of grounds of appeal and paid the required appeal fee on the same day. It requested that the decision be set aside and the patent be maintained as granted or, alternatively, on the basis of claims according to an auxiliary request 1, 2a-2d, 3, 4, 5a-5d or 6a-6d. Furthermore, oral proceedings were requested in case the board were not to follow any of the higher-ranking requests.
- IV. The opponent/respondent replied with letter dated 27 May 2020, requesting that the appeal be "refused" (i.e. dismissed) and the decision be upheld.
- V. The appellant provided comments on the respondent's submission with letter dated 20 July 2020 and the respondent further commented on this submission with letter dated 27 October 2020.
- VI. The board issued a communication under Rule 100(2) EPC dated 11 January 2021 containing its preliminary opinion according to which the reasons in the decision

under appeal did not establish that Article 100(c) EPC 1973 prejudiced the maintenance of the patent as granted, that it intended to remit the case to the opposition division for further prosecution, and inquired whether, on that basis, the parties maintained their requests for oral proceedings.

VII. In response, the appellant conditionally withdrew its request for oral proceedings (see the letter dated 11 March 2021), but the respondent did not (see the letter dated 17 March 2021). Instead, the respondent filed a declaration by Loretta Gray, Professor of English at the Central Washington University, and an expert opinion by Britta Mondorf, Professor of English Linguistics at the University of Mainz, in order to support its case. It also argued that the amendment under scrutiny was made by the appellant/proprietor in response to an inventive step objection by the examining division and must, therefore, have been intended to change the meaning of the claimed invention. Thus, the appellant's present allegation that the amendment did not change the meaning of the claim was against the principle of good faith and the prohibition of "venire contra factum proprium" and must therefore not be followed.

VIII. With a summons to oral proceedings, the board informed the parties that the expert opinions had not swayed its preliminary opinion. It also noted that the respondent had not established the appellant's intention when filing the amendment in question and that speculations as to what it might have intended could not be relied upon.

IX. In response to the summons, the respondent filed (see the letter of 21 May 2021) a clarification by Prof.

Gray, a "Stellungnahme" by Karl Christoph Ruland, professor emeritus at Siegen University (see the submission dated 25 May 2021) and a comment on the Federal Supreme Court (BGH) decision X ZR 6/91 relating to the question of whether "file wrapper estoppel" existed under German law. It also requested that Prof. Ruland be allowed to make oral submissions during the oral proceedings to explain his Stellungnahme (see the letter dated 9 June 2021). Justifications for the various late submissions were filed letter dated 13 September 2021.

- X. According to the respondent's request (see the letter dated 6 May 2021), the oral proceedings were held as a video conference. Just before the oral proceedings took place on 20 September 2021, the respondent filed two further procedural requests (see the letter dated 17 September 2021) according to which the board should refer a question to the Enlarged Board of Appeal if it were to "reject any of the opponent's submissions" (auxiliary request 1) and give a number of specific instructions on claim interpretation to the first instance if it were to remit the case for further prosecution (auxiliary request 2).
- XI. During the oral proceedings, the respondent withdrew these two procedural requests. At the end of the oral proceedings, the chair announced the decision of the board.
- XII. Claim 1 of the patent as granted reads as follows (numbering as used in the decision, see point 11.1.1 of the reasons):
- "(1) A method for providing secured access in a network environment, comprising:

(1.1) receiving (100) a request for secured access to a content site within an enterprise network from a user;
(1.2) authenticating (112) the user; and
(1.3) providing (112) secured access by the user to the content site upon confirmation of authentication, characterized by:
(1.4) responsive to the received request, forwarding (110) the user to a home site associated with a third-party that manages a primary profile for the user, to obtain a third-party security token after authentication at the home site;
(1.5) receiving (108; 112) the third-party security token issued by a third-party that is administered separately from the enterprise network and presented to the enterprise network by the user, wherein the third-party security token includes information about the authentication act at the home site and information from the primary profile;
(1.6) and authenticating (112) the user using the received third-party security token and linking the authenticated user to a secondary profile hosted at the content site,
(1.6a) wherein secured access to the content site is enforced by a security policy associated with the secondary profile."

The precise wording of claim 1 according to the auxiliary requests is immaterial for this decision.

Reasons for the Decision

Admittance of late submissions

1. Admittance of the submissions by the respondent filed after the summons to oral proceedings (cf. point IX above) are governed by Article 13(2) RPBA 2020, those

made in response to the board's communication under Rule 100(2) EPC and before expiry of the two-month period specified therein - which ended on 21 March 2021, see Rule 126(2) EPC - (cf. point VII above) are governed by Article 13(1) RPBA 2020.

- 1.1 The board considered that admittance of the expert opinions by Prof. Gray and Mondorf were not detrimental to procedural economy and could be dealt with without delay in the board's annex to the summons to oral proceedings. Accordingly, the board decided to admit these submissions. Likewise, the board admitted the clarification by Prof. Gray filed after the summons on its own volition because it can, without undue delay, deal with that ancillary submission, too (see T1294/16, point 18.4 of the reasons).
- 1.2 However, the Stellungnahme by Prof. Ruland filed after the summons to oral proceedings was not admitted pursuant to Article 13(2) RPBA 2020.
 - 1.2.1 The respondent argued in its letter of 13 September 2021 (see point 3) that the submission by Prof. Ruland (filed 25 May 2021) was made in response to the board's communication dated 25 March 2021 (i.e. the summons), especially its point 4.4, in order to "explain that a person of skill in the art will in fact make sense out of the claim feature at issue".
 - 1.2.2 In that communication, however, the board only addressed the statements by Prof. Gray and Mondorf, the issue of "venire contra factum" and Article 69 EPC but not - either in point 4.4 or elsewhere - whether the skilled person would or would not "make sense" of feature 1.3. The board takes it that Prof. Ruland's

Stellungnahme was rather meant to address point 9.1 in the communication under Rule 100(2) EPC.

1.2.3 Therefore, the board cannot accept the respondent's reasons as cogent ones which would establish exceptional circumstances that could justify the very late submission of Prof. Ruland's Stellungnahme. With a further view to the appellant's disagreement with the admittance, the board decided not to admit it under Article 13(2) RPBA 2020. As a consequence, the respondent's subsidiary request to allow Prof. Ruland to explain his written statement was moot.

1.2.4 The board notes in passing that the respondent, during the oral proceedings, stated that an expert statement like that by Prof. Ruland might, in fact, not have been necessary to explain why the interpretation of feature 1.3 favoured by the respondent did make technical sense and the representative was allowed and able to explain that point orally without referring to Prof. Ruland's Stellungnahme.

The issue at stake

2. The opposition division objected to feature 1.3 according to claim 1 as granted, arguing (see point 17.1 of the reasons in the decision under appeal) that the description (page 14, lines 1-3) disclosed that it was "'the system' that validate[d] credentials and provide[d] access to the resource" and that "from original claim 1, it" could "be understood that the access [was] provided to the user instead of by the user" (underlining in the cited decision). The wording of feature 1.3, however, "clearly reads that access is provided by the user, contrary to the original disclosure", so that a non-compliance with Article

123(2) EPC arose. The opposition division further dismissed the proprietor's argument and argued that the difference in meaning between "providing secured access to a user" and "providing secured access by a user" were "very different in their nature and technical meaning," that "their difference c[ould] not be seen as a mere ambiguity in wording, that could be resolved by interpreting the wording of feature 1.3 in the light of the description" and that "They c[ould] also not be seen as two alternative wordings having the same meaning" (see points 17.2 to 17.4 of the reasons).

The opposition division further decided that all auxiliary requests either shared the deficiency under Article 100(c) resp. Article 123(2) EPC with the main request (auxiliary requests 1, 3 and 4) or, in an attempt to overcome it, replaced, effectively, "by" by "to" and thereby did not comply with Article 123(3) EPC (auxiliary requests 2a-2c, 5a-5c and 6a-6c).

3. The appellant argued in its grounds of appeal (page 7, below the recitation of feature 1.3) that the change of "by the user" to "to the user" was made for stylistic reasons only to avoid two "to"s in a row ("to the user to the content site"). Furthermore, it stated that "from a linguistic standpoint" feature 1.3 could not "be regarded as clear and unambiguous" and thus could not "be simply considered by itself, but had to be interpreted in view of the claim systematic and also the description as a whole" (see page 9, paragraph 1). More specifically, it argued that "the phrase 'by the user'" could "be associated with the term 'providing' and also [...] with the term 'access'". In the latter case, feature 1.3 stated that that "access [...] by the user" was "provided" (see page 9, paragraph 3). This was, moreover, the only sensible interpretation of fea-

ture 1.3 (page 9, points e) to g)), so that feature 1.3 fulfilled the requirements of Article 123(2) EPC.

4. The respondent argued that the language of feature 1.3 was clear on its face so that "no interpretation" was "necessary" (see letter of 27 May 2020, point II.a). It further argued that the appellant's position might only be plausible, if a comma were inserted between "access" and "by the user", which however it is not (see page 4, paragraph 4). Moreover, it argued that only "technically illogical interpretations should be excluded" when interpreting the claim language, and that the provision of access "by the user" might be uncommon but is not excluded by the claim language, the description, or for fundamental technical reasons (see page 5, paragraph 3 *et seq.*). As a consequence, the respondent considered that the decision had to be confirmed.

- 4.1 Prof. Gray, in her letter dated 5 March 2021, stated that "the preposition *by*" in the pertinent phrase was "unambiguous in meaning" and implied an "agentive meaning". It also stated that "The prepositional phrase in question, 'by the user,'" was "a postmodifier in the noun phrase 'access by the user' and thus was "modifying the noun 'access'" and did "not modify or relate to 'providing'". In her letter dated 17 March 2021, she stressed the differences between the prepositions "to" and "by" as marking, respectively, "benefactive" and "agent" roles. She stated that "secured access to the user" meant the access was "going to the user" without implying that the user actually "acted upon the receipt of access", whereas "providing secured access by the user" referred to the user's action. She then concluded that, in the given context, "the user would likely click okay to accept cookies or a data protection policy or to install a program". Furthermore, according

to Prof. Gray the user being the "agent of the access" meant that "the access c[ame] from the user" and hence "the user [would be] clearly and unambiguously allowing the access".

- 4.2 Prof. Mondorf, in her letter dated 11 March 2021, stated that the change of preposition in the phrase in question caused a significant change of meaning because the user in the granted version was referred to as agent (AGENS), which would have to enable the secured access, whereas in the original version the user was referred to as benefactive in the sense of profiting from the secured access. Both phrases were not equivalent and the reformulation of one into the other could, from a linguistic perspective, not be motivated.

The board's position

Article 100(c) EPC

5. To begin with, the board notes the following. While it has no occasion to question the linguistic analyses by Prof. Gray or Mondorf, it would seem that Prof. Gray's speculation that the user, in the given context, would "likely click okay to accept cookies or a data protection policy or to install a program" goes beyond a mere linguistic analysis, which is the field of expertise for which both statements were filed. Secondly, the question at stake is not how a linguist would construe the meaning of the sentence but how the person skilled in the art would. Albeit a linguistic analysis may be helpful in determining how a skilled person would understand a phrase in a claim, the skilled person would not stop at determining the semantic roles of words in a phrase but interpret the phrase in the context of the claimed subject-matter and the application as a whole.

Thirdly, the board notes that its findings as to how a claim must be construed is not merely the board's "opinion", as the respondent would have it (see the letter dated 9 June 2021, page 2, penultimate paragraph), but the board's legal judgment at which it arrives after consideration the factual and legal circumstances of the case and the parties' submissions.

6. Turning now to the feature in question:

"(1.3) providing (112) secured access by the user to the content site upon confirmation of authenticating, [...]",

the board considers that, on the face of it, there seems to be an ambiguity between whether the clause "by the user" modifies the "secured access" or the "providing". That is, although the user clearly has an "agent" rule due to the preposition "by" it may be asked whether the user is the "agent" of the access or of the providing.

6.1 Prof. Gray clearly stated in her letter dated 5 March 2021 that "by the user" modified the noun "access" and not the "providing". In the board's judgment, this speaks in favour of the first interpretation. In her letter of 17 May 2021, Prof. Gray implies the contrary: Her statements that "Providing secured access by the user" refers to a "user's action" preceding the access and that the "agent of the access" is "allowing the access" imply, effectively, that "by the user" would be modifying the "providing", not the "access" itself. That position is also taken by Prof. Mondorf, where she states that in the new sentence the user would have to take care of the secured access

("für den sicheren Zugang Sorge zu tragen [hätte]"),
i.e. is an agent of the providing.

- 6.2 The board takes the view that already the mere proximity of the clause "by the user" speaks in favour of it modifying "access" rather than "providing". The latter would be the preferred reading of the different phrase "providing by the user secured access to the content site". Also, if one were to construe "by the user" as modifying the entire clause "providing secured access", then it would become unclear what the following clause "to the content site" referred to.
- 6.3 Moreover, claim 1 as a whole specifies a method "for providing secured access" in response to "a request for" such "secured access to a content site [...] from a user". The request for access coming from the user, the skilled reader will assume that it is the user to eventually (if authenticated) be provided with the access. This would make the user "agent" of the access, also irrespective of whether the user would eventually "act[] upon the receipt of access". This reading is also consistent with the claimed requirement that the user, before secured access is provided, is to be authenticated, that the "authenticated user" will be "link[ed] to a secondary profile" and that "secured access to the content site is enforced by a security policy associated with the secondary profile". In the board's view, the skilled person would understand the so-enforced "secured access to the content site" to be an "access by the user", mediated by the "secondary profile".
- 6.4 In the linguistic terms as used by Prof. Gray and Mondorf, this means that the benefactive and the agent roles coincide in the case to hand. The user "to which"

the access is provided will be the same one "by which" the access is carried out, as the skilled person would understand.

6.5 The board agrees that claim 1 as granted does not exclude the - entirely reasonable - possibility that the user also contributes to the process of providing secured access, for instance "by click[ing] okay to accept cookies or a data protection policy or to install a program". This does not, however, mean that this is implied by the claim language.

6.6 In summary, the board finds that the skilled person would construe feature 1.3 so that it is the user to which access is provided or, in other words, so that "access by the user to the content site" is provided and that the agent of the providing is undefined - as it is, incidentally, in original claim 1.

Venire contra factum proprium

7. The respondent argued that the appellant had replaced "to" with "by" in order to address an objection under Article 56 EPC rather than, as alleged, to address clarity (or style) of the claims. Now stating that this amendment did not change the meaning was "venire contra factum proprium" and should not be allowed. The respondent conceded, however, that the file does not contain an express statement regarding the appellant's intentions and does not establish without doubt the appellant's alleged intentions.

7.1 Therefore, no contradiction can be derived between the appellant's present view on the meaning of feature 1.3

and any clearly documented view that the appellant may have held earlier.

7.2 The respondent's argument fails for this reason alone.

7.3 It may therefore be left open whether and to what extent the principle of "venire contra factum proprium" applied in proceedings before the EPO at all and whether, in particular, it might prohibit a change of mind of a party as to how a claimed feature was to be interpreted. Also the relevance of the BGH decision cited by the respondent need not be determined.

Conclusion

8. The board concludes that that the objection to feature 1.3 under Article 100(c) EPC does not prejudice maintenance of the granted patent.

Remittal for further prosecution

9. The decision under appeal only dealt with feature 1.3, and not with any of the other grounds for opposition according to Article 100(c) EPC, let alone those according to Articles 100(a) and (b) EPC. Even though the opposition division expressed a preliminary opinion on these grounds in the annex to its summons to oral proceedings, none of these grounds were discussed during the oral proceedings before the opposition division.

10. The board considers this - with an additional view to the fact that this case has been taken considerably out of order by the board - as a special reason within the

meaning of Article 11 RPBA 2020 to remit the case to the opposition division for further prosecution.

11. In response to the (meanwhile withdrawn) request by the respondent to remit the case with particular instructions to the first instance, the board notes that the opposition division is bound under Article 111(2) EPC by the ratio decidendi of the above decision, in so far as the facts are the same. No further express instructions by the board are necessary or called for.

Order

For these reasons it is decided that:

1. The decision is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



L. Stridde

Martin Müller

Decision electronically authenticated