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**Datasheet for the decision  
of 2 February 2022**

**Case Number:** T 0955/20 - 3.5.07

**Application Number:** 09151235.0

**Publication Number:** 2043003

**IPC:** G06F17/27

**Language of the proceedings:** EN

**Title of invention:**

Systems and methods for searching using queries written in a different character-set and/or language from the target pages

**Applicant:**

Google LLC

**Headword:**

Query translation/GOOGLE

**Relevant legal provisions:**

EPC Art. 56, 109(1)  
EPC R. 103(1)(a), 103(6)  
RFees Art. 13(2)  
RPBA 2020 Art. 11, 13(2)

**Keyword:**

Inventive step - main request (no)  
Interlocutory revision - substantial procedural violation  
(yes)  
Reimbursement of appeal fee - first appeal fee (no) - second  
appeal fee (yes)  
Remittal to the department of first instance - (yes)

**Decisions cited:**

G 0003/03, J 0021/01, T 0114/82, T 0115/82, T 0252/91,  
T 0919/95, T 0961/00, T 0021/02, T 0242/05, T 1569/05,  
T 0070/08, T 0625/09, T 0206/10, T 1703/12, T 0893/13,  
T 0598/14, T 2008/14, T 2707/16

**Catchword:**

1. A request for reimbursement of the appeal fee under Rule 103(1)(a) EPC can no longer be filed after the department of first instance has granted interlocutory revision (Reasons 2).
2. If the department of first instance grants interlocutory revision only to refine the written reasons which already complied with Rule 111(2) EPC, this may constitute a substantial procedural violation (Reasons 1).
3. Such a substantial procedural violation may justify the reimbursement under Rule 103(1)(a) of the appeal fee paid for a subsequent appeal (Reasons 3.1 and 3.2).



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Case Number: T 0955/20 - 3.5.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.07**  
**of 2 February 2022**

**Appellant:** Google LLC  
(Applicant) 1600 Amphitheatre Parkway  
Mountain View, CA 94043 (US)

**Representative:** Robinson, David Edward Ashdown  
Marks & Clerk LLP  
1 New York Street  
Manchester M1 4HD (GB)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 18 October 2019  
refusing European patent application  
No. 09151235.0 pursuant to Article 97(2) EPC**

**Composition of the Board:**

**Chair** J. Geschwind  
**Members:** R. de Man  
P. San-Bento Furtado

## **Summary of Facts and Submissions**

I. The appellant (applicant) filed an appeal against the decision of the examining division refusing European patent application No. 09151235.0. This was the second refusal decision, taken after the examining division had rectified its first refusal decision. The application is a divisional application of European patent application No. 04783836.2.

II. The reasoning of the contested decision made reference to the following documents:

D1: US 2003/0149686 A1, 7 August 2003;

D11: L. Ballesteros and B. Croft: "Dictionary Methods for Cross-Lingual Information Retrieval", Proceedings of the 7th International Conference on Database and Expert Systems Applications (DEXA '96), September 1996, Lecture Notes in Computer Science, Vol. 1134, pp. 791-801.

The examining division decided that the subject-matter of claim 1 of the sole main request lacked inventive step over document D1. Document D11 was used as evidence of common general knowledge. The examining division noted that it could not allow the appellant's request for reimbursement under Rule 103(1)(a) EPC of the appeal fee paid for the first appeal for lack of a legal basis.

III. In its 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 the claims of the sole main request. It also requested

reimbursement of the appeal fee paid for the first appeal.

- IV. In a communication accompanying the summons to oral proceedings, the board expressed the preliminary opinion that the subject-matter of claim 1 of the sole main request lacked inventive step and that the appeal fee paid for the first appeal could not be reimbursed.
- V. With its written submissions filed in preparation for the oral proceedings, the appellant submitted an auxiliary request.
- VI. Oral proceedings were held on 2 February 2022. At the end of the oral proceedings, the Chair announced the board's decision.
- VII. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request or, in the alternative, of the auxiliary request. It further requested reimbursement of the first appeal fee or, in the alternative, of the second appeal fee.
- VIII. Claim 1 of the main request reads as follows:  
  
"A search method comprising:  
    obtaining a query written in a first format from a user;  
    translating the query into a second format;  
    searching a database for information responsive to the translated query; and  
    returning search results written in the second format to the user, characterized in that,  
    translating the query is based on using a probabilistic dictionary, the probabilistic dictionary

mapping terms from the first format to the second format and wherein the query expressed in one character set is translated into another character set, thereby enabling the user to find documents written in a different character set than the original query, and wherein an actual language of the query is not changed;

wherein the method further comprises: obtaining search result selections from the user; and

using said search result selections to modify the probabilistic dictionary of term mappings wherein the modification comprises adjusting at least one probability associated with at least one mapping in the probabilistic dictionary."

IX. Claim 1 of the auxiliary request reads as follows:

"A search method comprising:

obtaining a query written in a first format expressed in a first character set from a user using a user input device that accepts input in the first character set;

translating the query into a second format that is expressed in a second character set that is different to the first character set;

searching a database for information responsive to the translated query; and

returning search results written in the second format to the user, characterized in that,

translating the query is based on using a probabilistic dictionary, the probabilistic dictionary mapping terms from the first format to the second format and wherein the query expressed in the first character set is translated into the second character set, thereby enabling the user to find documents written in a different character set than the original

query, and wherein an actual language of the query is not changed;

wherein the method further comprises: obtaining search result selections from the user; and

using said search result selections to modify the probabilistic dictionary of the mappings wherein the modification comprises adjusting at least one probability associated with at least one mapping in the probabilistic dictionary."

- X. The appellant's arguments, where relevant to the decision, are discussed in detail below.

## **Reasons for the Decision**

### 1. *Alleged substantial procedural violation*

- 1.1 In its first decision, the examining division refused the application for lack of inventive step over document D1. It then allowed the appeal filed against this decision by granting interlocutory revision under Article 109(1) EPC. Subsequently, it issued a communication as an annex to a summons to oral proceedings, in which the objection of lack of inventive step over document D1 was maintained with only slightly modified reasoning.

According to point 11 of the facts and submissions section of the second refusal decision, the examining division felt that it had not addressed the "probabilistic dictionary" feature of the invention in sufficient detail and had therefore rectified its first decision.

- 1.2 In these second appeal proceedings, the appellant argued that the examining division had committed a substantial procedural violation by granting interlocutory revision under Article 109(1) EPC in relation to the appeal against the first refusal decision and then maintaining its objection of lack of inventive step against the unamended claims in its next communication. Article 109(1) EPC gave the examining division the power to rectify its decision if "the appeal is admissible and well founded" but not the right to "finesse" its previous objections at the expense of an appeal fee and three years of procedural delay.
- 1.3 The purpose of Article 109(1) EPC is to cut short the appeal proceedings in clear and straightforward cases in the interest of procedural efficiency, in particular when the examining division can immediately recognise that the board of appeal, taking into account the statement of grounds of appeal, would set aside the decision (see decisions G 3/03, Reasons 3.4.1; T 919/95, Reasons 2 and 2.1). This purpose is contravened if, as here, the examining division grants interlocutory revision when it still agrees with the grounds for the refusal but considers that some aspect of the decision's reasoning can be improved. In this respect, the board notes that the examining division, when granting interlocutory revision, apparently found its first decision to be sufficiently reasoned within the meaning of Rule 111(2) EPC, since it did not *ex officio* order the reimbursement of the appeal fee under Rule 103(1) (a) EPC.
- 1.4 Hence, the examining division applied Article 109(1) EPC for a purpose for which the provision is not intended and thus committed a procedural violation. In



view of the considerable and unnecessary procedural delays which this has caused, the second refusal decision having been issued just over three years after the first refusal decision, the procedural violation must be considered to be a substantial one (see decision T 2707/16, Reasons 34).

2. *Request for reimbursement of the appeal fee paid for the first appeal (first appeal fee)*

2.1 In its decision to rectify the first refusal decision, the examining division did not order the reimbursement of the first appeal fee. At this time, no request for reimbursement of the appeal fee had been filed and consequently no such request was referred to the board. The appellant requested reimbursement of the first appeal fee for the first time during the first-instance proceedings leading to the second refusal decision.

2.2 According to decision G 3/03, OJ EPO 2005, 344, in the event of interlocutory revision under Article 109(1) EPC, the examining division is not competent to refuse a request for reimbursement of the appeal fee under Rule 67 EPC 1973 (see Order, point 1). Such a request has to be referred to the board of appeal which would have been competent under Article 21 EPC to deal with the substantive issues of the appeal if no interlocutory revision had been granted (Order, point 2; Reasons, point 3.5). These principles are now reflected in Rule 103(1)(a) and (6) EPC (see, with regard to Rule 103(2) EPC as then in force, decisions T 625/09, Reasons 1; and T 206/10, Reasons 3).

In the case underlying the referral decision leading to decision G 3/03, the request for reimbursement had been filed before interlocutory revision was granted

(J 12/01, OJ EPO 2003, 431, point II of the Facts and Submissions).

2.3 In a number of later decisions, it was held that a board of appeal is not competent to decide on a request for reimbursement of the appeal fee referred to it by the examining division if the request was filed only after the examining division had granted interlocutory revision (see T 21/02, Reasons 5 and 6; T 242/05, Reasons 2.2 and 2.3; T 1703/12, Reasons 3 and 4; T 2008/14, Reasons 1). These decisions mention, *inter alia*, that in such cases no appeal exists for which the boards of appeal are responsible.

Decision T 21/02 added that it was the department of first instance which remained the competent body to decide on the reimbursement request (Reasons 6). The appellant could then appeal against a decision of the department of first instance refusing the request (Reasons 7).

2.4 In case T 70/08, the appellant had filed a request for reimbursement of the appeal fee after the examining division had rectified its decision. In a second refusal decision, the examining division had considered this request as "deemed not to have been filed". The board held that neither the examining division nor the board was competent to order reimbursement of the appeal fee under Rule 103(1)(a) EPC for an appeal that had been fully allowed before the request for reimbursement was filed (Reasons 7).

2.5 Decision T 893/13 also dealt with a situation in which a request for reimbursement of the appeal fee was filed after the examining division had rectified its decision. In the second refusal decision, the examining

division had explained that it did not consider a substantial procedural violation to have occurred during the examination proceedings leading to the first appeal and that it was therefore unable to reimburse the appeal fee.

The deciding board took the view that, since the examining division was not competent to decide that the appeal fee should not be reimbursed, a decision granting interlocutory revision without an order for reimbursement could not be construed as a decision not to reimburse the appeal fee (Reasons 5.1 to 5.4). Since Rule 103 EPC entrusted the board with the decision on "all other matters of reimbursement", it was competent to decide on a request for reimbursement whenever the examining division revised its decision without ordering reimbursement itself, and such a request could still be validly filed after the examining division had rectified its decision (Reasons 3.3, 3.4 and 5.5).

2.6 To summarise, decision T 21/02, Reasons 6 and 7, suggests that, in the present case, the examining division was to decide on the request for reimbursement of the first appeal fee. If this approach were followed, the statement in the second refusal decision that there is no legal basis to reimburse the first appeal fee could arguably be considered to be that decision, which could now be reviewed as part of the current appeal proceedings.

Decision T 893/13 suggests, instead, that the request for reimbursement of the first appeal fee can be decided on directly by the board, essentially independently of the proceedings concerning the appeal against the second refusal decision.

Finally, decision T 70/08 suggests that the request for reimbursement of the first appeal fee cannot be dealt with at all, because it was filed after the first appeal had been fully allowed.

- 2.7 This board agrees with the position taken in decision T 70/08. It follows from Rule 103(1)(a) EPC that, in the event of interlocutory revision, the department of first instance has to examine whether the requirements for reimbursement of the appeal fee are met, regardless of whether the appellant has actually submitted such a request (see G 3/03, Reasons 3; T 242/05, Reasons 1.3.1). This assessment is thus to be carried out as part of the proceedings that deal with the appeal. When the appeal, in the absence of a request for reimbursement of the appeal fee, is fully allowed by the grant of interlocutory revision with the result that the appeal proceedings are terminated, the appeal, including the issue of the reimbursement of the appeal fee under Rule 103(1)(a) EPC, becomes settled. In the board's view, contrary to decision T 21/02, Reasons 6 and 7, the issue of reimbursement being a settled matter prevents it from being taken up again in response to a subsequently filed reimbursement request.

- 2.8 The board deciding case T 893/13 took the view that a decision granting interlocutory revision without ordering reimbursement of the appeal fee could not be considered to settle the reimbursement issue because, according to G 3/03, the decision is not supposed to adversely affect the appellant.

However, this board understands the Enlarged Board in decision G 3/03 to have used the expression "adversely affected" in the same formal sense as it is used in Article 107 EPC: a party is adversely affected by a

decision only if the decision does not meet one of its requests (see decisions T 114/82 and T 115/82, OJ EPO 1983, 323, Reasons 1; T 961/00, Reasons 1). Hence, if the appellant has not requested reimbursement of the appeal fee, it is not adversely affected by a decision granting interlocutory revision and settling the reimbursement issue without ordering reimbursement.

2.9 The board notes that a different view would mean that a request for reimbursement of the appeal fee filed for the first time many years after interlocutory revision was granted would still have to be decided on in substance.

In this respect, decision T 893/13, Reasons 7, suggests that Article 13(2) of the Rules relating to Fees (RFees) ("Rights against the Organisation for the refunding ... of fees ... shall be extinguished after four years from the end of the calendar year in which the right arose") limits the possibility of filing a request for reimbursement in time. However, this provision - previously Article 126(2) EPC 1973 - relates to existing rights against, i.e. financial obligations of, the European Patent Organisation, which is the entity having the legal capacity to act in civil matters (Article 5(2) EPC). Such rights are extinguished four years from the end of the calendar year in which they arose, this period being interrupted when the creditor submits a reasoned claim in writing and, if necessary, initiates (national) judicial proceedings to enforce the right (Article 13(3) RFees). In the case of reimbursement of the appeal fee under Rule 103(1)(a) EPC, such a right against the Organisation only arises when, and not before, the department of first instance or the board of appeal orders the reimbursement; within a national legal

system the existence of the right can be established only by ascertaining whether such an order has been given, not by determining whether reimbursement is equitable by reason of a substantial procedural violation. Hence, Article 13(2) RFees does not set a time limit for filing a request for reimbursement of the appeal fee under Rule 103(1) (a) EPC.

- 2.10 The appellant argued that the examining division's rectification decision was an interlocutory decision not allowing a separate appeal, which could therefore be appealed together with the second refusal decision (Article 106(2) EPC).

This argument overlooks the fact that the rectification decision was not an interlocutory decision but terminated the first appeal proceedings. Besides, the appellant could not have appealed the rectification decision since the decision did not adversely affect it by not meeting one of its requests.

- 2.11 The board concludes that it is not competent to deal with the request for reimbursement of the first appeal fee, which therefore has to be rejected.

3. *Request for reimbursement of the appeal fee paid for the second appeal (second appeal fee)*

- 3.1 In view of point 2. above, the appellant was no longer able to request reimbursement of the first appeal fee when it became aware that the examining division might have committed a substantial procedural violation by granting interlocutory revision. To prevent the appellant from being deprived of the possibility to assert its rights under Rule 103(1) (a) EPC, the board considers therefore that the substantial procedural

violation in the decision to grant interlocutory revision may justify the reimbursement of the second appeal fee.

- 3.2 That it is appropriate to link a substantial procedural violation committed in a decision granting interlocutory revision to a potential reimbursement under Rule 103(1)(a) EPC of the appeal fee paid for a subsequent appeal is further confirmed by the observation that the equitability of the reimbursement of an appeal fee in such a case depends on the outcome of the further first-instance proceedings. For example, if they result in the grant of a patent without a second appeal being necessary, there would be nothing inequitable about the non-reimbursement of the first appeal fee.

The board further notes that, in point 1.4 above, it has already based its judgment that the procedural violation in the decision to grant interlocutory revision is a substantial one on the length of the further first-instance proceedings. Thus, whether the procedural violation is substantial may also depend on what happens in the subsequent proceedings.

- 3.3 In the present case, the reimbursement of the second appeal fee is equitable. If the examining division had not granted interlocutory revision, there would have been no second appeal against what is essentially a copy of the first refusal decision (see also decision T 252/91, Reasons 5, last two paragraphs, in which the second appeal fee was reimbursed in similar circumstances).

- 3.4 However, under Rule 103(1)(a) EPC the board cannot order the reimbursement of the second appeal fee if it

does not allow this second appeal. This shows that a fully equitable solution in a situation such as the present one may not always be achievable.

- 3.5 As a rule, a fundamental deficiency which is apparent in the first-instance proceedings constitutes a special reason for remitting the case to the department of first instance for further prosecution (Article 11 RPBA 2020) and consequently allowing the appeal. In the circumstances of this case, however, it is not an option to remit the case before the board has at least examined the main request, which was the subject of both refusal decisions.

*Main request*

4. *The invention as defined by claim 1*

4.1 The application generally relates to performing searches using queries that are written in a character set or language different from the character set or language of the documents being searched by first translating the queries into the appropriate character set or language.

4.2 Claim 1 is directed to such a search method, with the restriction that the character sets are different and "an actual language of the query is not changed".

First, a query, written in a first format, is received from a user and translated into a second format. The document database is then searched using the translated query, and search results written in the second format are returned to the user. The user may then select a search result.



4.3 The translation is performed by means of a "probabilistic dictionary" which maps terms in the first format to terms in the second format. The first and second formats refer to the character sets in which the terms are expressed, for example romaji and kanji (see page 13, line 27, to page 14, line 30, of the description).

4.4 The search-result selections obtained from the user are used to modify at least one mapping probability.

5. *Inventive step*

5.1 Document D1 relates to searching a database which contains documents written in different languages (see abstract and paragraph [0002]). When a user enters a query with keywords in a first language, a keyword dictionary is used to translate the query into a query with keywords in a second language (paragraph [0026]; Figures 3 and 5), which may involve translating into a different character set (paragraph [0028]). Each query is then applied to an inverted index corresponding to its respective language to generate search results (*ibid.*). The user may then select search results, which implies that the search results are shown to the user (*ibid.*).

5.2 The subject-matter of claim 1 differs from the disclosure of document D1 in that

- (a) the first and second formats are not different languages but different character sets for the same language;
- (b) the dictionary is a "probabilistic" dictionary;
- (c) search-results selections are used to modify at least one mapping probability of the dictionary.

5.3 Distinguishing feature (a) expresses the non-technical, linguistic fact that the same language, such as Japanese, may have different representations in different character sets, such as romaji and kanji. It merely concerns the cognitive content of the dictionary (mappings from romaji terms to kanji terms instead of, for example, Greek terms to English terms), not its technical implementation. It therefore cannot contribute to an inventive step.

5.4 Distinguishing features (b) and (c) express that the mappings in the dictionary have probabilities assigned to them, which are updated in response to selections of search results made by the user.

Claim 1 does not specify that the probabilities are used, let alone how they are used. For this reason alone, features (b) and (c) do not contribute to any technical effect.

Furthermore, even if distinguishing features (b) and (c) could be seen to plausibly improve the "quality" of the translated query in the sense that it leads to search results that are "better" in the sense of closer in meaning to the desired search results, this would not be a technical effect (see decisions T 1569/05, Reasons 3.4 to 3.7; T 598/14, Reasons 2.3 and 2.4).

5.5 The appellant argued that features (b) and (c) contributed to solving the technical problem of "how to provide improvements in query input using data input devices that use a format/character set different from the format/character set of at least some of the documents to be searched". The Guidelines for

Examination, G-II, 3.7.1, clarified that features enabling user input made a technical contribution.

However, to the extent that claim 1 solves this problem, it is also solved, in the same way, by the method disclosed in document D1, which allows the searching of documents written in a (language and) character set different from the (language and) character set in which the query was formulated by translating the query. The solution to the problem does not rely on distinguishing features (b) and (c).

- 5.6 At the oral proceedings before the board, the appellant insisted that document D1 was not concerned with allowing a user to input a search query with an input device that did not support the character set in which the documents being searched were written.

It is not fully clear to the board what it would mean for an input device to not support a particular character set, given that the description, on page 1, line 31, to page 2, line 14, explains that conventional methods allow the use of a standard telephone keypad to enter a query for "ben smith", i.e. a query expressed in the Roman alphabet. In any event, claim 1 is not restricted to queries that are entered by means of any particular input device. In fact, the scope of claim 1 encompasses not only methods which translate a query written in romaji (a phonetic, Roman-alphabet representation of Japanese) into kanji, i.e. from a character set directly supported by ASCII keyboards into a character set which arguably is not directly supported by such keyboards, but also methods which translate a query written in kanji into romaji.

Hence, the appellant's observation on document D1 does not call into question the board's finding that the distinguishing features provide no technical contribution over document D1.

- 5.7 Hence, the subject-matter of claim 1 lacks inventive step (Article 56 EPC).

*Auxiliary request*

6. Claim 1 of the auxiliary request essentially adds to claim 1 of the main request that the query is input using a user input device that accepts input in the first character set. The appellant explained that this amendment was intended to tie the claim more clearly to the technical problem being solved, and that it had been made in response to the board's fresh arguments regarding a lack of technical contribution.

7. *Admission into the appeal proceedings*

- 7.1 The amendments made in the auxiliary request are reasonable in the sense that they do not raise major new issues or create a completely fresh case. From a strict procedural point of view, however, it could be argued that the board's objection of lack of inventive step, which is based on the same passages in document D1 as relied on by the examining division, does not give rise to an "exceptional circumstance" within the meaning of Article 13(2) RPBA 2020.

- 7.2 However, the board considers it appropriate to also take into account the exceptional circumstance that the appellant had to file two appeals and pay two appeal fees to finally obtain a judicial review of essentially the same decision. If the board were not to admit the

auxiliary request into the appeal proceedings, the appeal would have to be dismissed, there would be no possibility of reimbursing the second appeal fee, and it would not be possible to settle this case in an equitable manner (see points 3.3 and 3.4 above).

7.3 The board therefore admits the auxiliary request into the appeal proceedings (Article 13(2) RPBA 2020).

8. *Remittal for further prosecution*

8.1 The assessment as to whether the auxiliary request overcomes the objection of lack of inventive step over document D1 requires a certain amount of investigation. In principle, the board is capable of carrying out such an investigation.

8.2 However, if the board were to do so, it cannot be ruled out that it would arrive at the conclusion that the subject-matter of claim 1 still does not involve an inventive step. In that case, the appeal would have to be dismissed, and it would not be possible to settle the case in an equitable manner with respect to the reimbursement of the appeal fee.

8.3 If, on the other hand, the board decided to remit the case to the examining division for further prosecution on the basis of the auxiliary request, the second appeal fee could be reimbursed. Given that the auxiliary request was newly filed in these appeal proceedings, a remittal would have the further advantage for the appellant that it could have its auxiliary request examined by two instances.

8.4 In the board's judgment, the need for an equitable outcome in the present case outweighs the interest of

the EPO and the public in a swift conclusion of these grant proceedings. Special reasons within the meaning of Article 11 RPBA 2020 therefore present themselves for remitting the case to the examining division for further prosecution.

- 8.5 Hence, the case is to be remitted to the examining division for further prosecution on the basis of the auxiliary request, and the second appeal fee is to be reimbursed.

## 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 request for reimbursement of the first appeal fee is rejected.
4. The request for reimbursement of the second appeal fee is allowed.

The Registrar:

The Chair:



S. Lichtenvort

J. Geschwind

Decision electronically authenticated