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**Datasheet for the decision
of 31 March 2014**

Case Number: T 2299/10 - 3.5.05

Application Number: 06720652.4

Publication Number: 1924937

IPC: G06F19/00

Language of the proceedings: EN

Title of invention:

METHOD AND SYSTEM FOR PROVIDING ONLINE MEDICAL RECORDS

Applicant:

MYMEDICALRECORDS.COM, INC.

Headword:

METHOD AND SYSTEM FOR PROVIDING ONLINE MEDICAL RECORDS/
MYMEDICALRECORDS

Relevant legal provisions:

EPC 1973 Art. 56, 84, 111(1), 157(1)

EPC 1973 R. 29(4), 29(5)

Keyword:

Claims - clarity after amendment (yes)

Inventive step - mixture of technical and non-technical
features - closest prior art - common general knowledge

Additional search - necessary (yes - technical features not
notorious)

Remittal to the department of first instance

Decisions cited:

T 0019/87, T 0042/90, T 1434/06, T 1924/07, T 1411/08

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 2299/10 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 31 March 2014

Appellant: MYMEDICALRECORDS.COM, INC.
(Applicant) 10100 Santa Monica Blvd.
Los Angeles, CA 90067 (US)

Representative: Wood, Graham
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 15 July 2010
refusing European patent application No.
06720652.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair: A. Ritzka
Members: M. Höhn
G. Weiss

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division, posted on 15 July 2010, refusing European patent application No. 06720652.4 on the grounds of lack of clarity (Article 84 EPC) and lack of inventive step (Article 56 EPC).
- II. The notice of appeal was received on 1 September 2010. The appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 8 November 2010. 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 filed with the statement setting out the grounds of appeal as main request. Oral proceedings were requested on an auxiliary basis.
- III. Independent claim 1 according to the main request reads as follows:
- "1. A method for providing a consumer with the ability to access and collect health records associated with the consumer through use of a consumer account, the method comprising: assigning a destination address individually associated with the consumer account for receiving communications from at least one healthcare provider; associating access information with the consumer account for the consumer to use to access a secure web site; receiving a communication from one of the at least one health care providers, the communication directed to the destination address, the communication comprising a health record associated with the consumer for which the consumer has requested and given permission to the healthcare provider to

send; storing a representation of the health record; providing the consumer with secure access to the web site using the access information and providing on the web site an interface to the health records of the consumer for the consumer to use characterised in that the destination address is a phone number, to which a private fax communication is sent by the health care provider comprising the personal health record associated with the consumer which the consumer has requested and given permission to the healthcare provider to send; converting the private fax communication into an image file format; storing the health record encoded in the image file format as the representation of the health record on a web server and in the consumer account for access by the consumer using the website interface, wherein the website interface includes means for allowing the stored health record image files to be organised and annotated by the consumer into separate file folders, said means including functionality to allow the consumer to name the file folders and add file folders."

Reasons for the Decision

1. The appeal is admissible.

Main request

2. Amendments

2.1 Independent claim 1 was amended by combining the subject-matter of previous claims 1, 2 and 11 and adding the feature of storing the health record encoded in the image file format which is originally disclosed in claim 1 as filed. The aforementioned amendment

therefore fulfils the requirements of Article 123(2) EPC.

- 2.2 The subject-matter of amended claim 2 is originally disclosed in claim 1 and on page 9, lines 6 to 20, of the application as filed. The added feature of claim 2 is not disclosed as an essential feature of the invention and, in the board's judgment, it is not a technical feature, but an administrative step in the method fulfilling legal requirements rather than contributing to the technical solution. It therefore can be omitted from the independent claim without infringing the requirements of Article 123(2) EPC.

3. Article 84 EPC 1973 - Clarity

The decision under appeal is based *inter alia* on objections under Article 84 EPC 1973 for lack of clarity (see points 6 to 8 of the decision under appeal). Article 84 EPC **1973** is applicable in the present case (see Article 1(1), first sentence, of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC of 29 November 2000 - OJ EPO 2007, Special edition No. 1, 197).

- 3.1 The objections against previous claims 33 to 37 raised in points 7 and 8 of the decision under appeal have been overcome by amendment by deletion of the corresponding claims, which are no longer part of the set of claims according to the present main request.
- 3.2 The objection for lack of clarity under point 6 of the decision under appeal was directed against the whole set of claims for creating "obscurity in the definition of the subject-matter to be protected because it does

not enable the association of related claims to be readily determined and their meaning in association to be readily construed" with reference to Rule 43(4) and (5) EPC. However, no details were given as to the exact reasons for this conclusion.

The appellant has responded to this objection by amending the set of claims, in particular by limiting the number of claims to 14 and by deleting the subject-matter of previous claims 3, 9, 11, 22 and 30 to 32 as well as by combining the subject-matter of previous claims 6 to 8, 15 to 18, 19 to 21, 23 to 26 and 27 to 28 into respective single claims (see also point 13 of the statement setting out the grounds of appeal). Thereby the complexity of dependencies and references between the claims has been reduced, and the board considers the present set of claims to overcome the objections under Article 84 EPC 1973 in combination with Rule 29(4) and (5) EPC 1973 (applicable here, see Article 2 of the Decision of the Administrative Council of 7 December 2006 - OJ EPO 2007, Special edition No. 1, 89) in the decision under appeal.

4. Article 56 EPC 1973 - Inventive step
- 4.1 The decision under appeal is further based on the objection that the subject-matter of claim 1 lacks an inventive step.
- 4.2 No search was carried out for pertinent prior art. The European Patent Office acting as International Searching Authority issued a declaration of non-establishment of the International Search Report under Article 17(2)(a) PCT and Rule 13ter.1(c) and 39 PCT because the claims on file at that date related to subject-matter that did not require an international

search under the PCT provisions. The applicant entered into the European phase before the European Patent Office without amending the application as originally filed in the international phase under the PCT provisions. No supplementary European Search Report was established. According to Article 157(1) EPC 1973 (now Article 153(6) EPC) the declaration replacing the International Search Report took the place of the European Search Report in analogy to Rule 45(2) EPC 1973 (now Rule 63 EPC).

- 4.3 The closest prior art was considered to be a conventional client-server data processing and communication computer architecture as generally known at the time before the priority date of the present application, for which no written evidence was considered necessary.

This has been contested by the appellant (see page 6, second paragraph, of the statement setting out the grounds of appeal).

- 4.4 The examining division identified technical features in claim 1 on which the decision under appeal was based which are still found in present claim 1. In particular, present claim 1 *inter alia* comprises at least the following features which the board considers to contribute to the technical character of the invention:

- the destination address is a phone number (added by amendment),
- converting the private fax communication into an image file format,
- storing the converted data in the image file format.

4.5 The examining division examined the application despite the fact that no search had been carried out. However, this is only possible in exceptional cases and, according to the jurisprudence of the boards, an additional search for pertinent prior art may be dispensed with only if the technical features of the claims are considered to be "notorious", i.e. generic and so well known that they cannot reasonably be refuted (see T 1411/08 of 6 June 2011, point 4).

In the board's judgment, the afore mentioned features (see point 4.4) go beyond the mere common general knowledge (for example the commonly encountered use of a computer, a network, an electronic database) and cannot be considered "notorious". In particular, it is not considered to be notorious knowledge either to use a phone number of a user as a destination address in a client-server computer network or convert a fax communication into an image file format.

4.6 An applicant's acknowledgement in the original application that certain prior art is known is in general not a sufficient reason for not carrying out an additional search since such statements may be - and indeed frequently are - withdrawn or qualified. Moreover, this could only apply in cases where all the technical features in the claim would be acknowledged as known (see T 1924/07 of 22 June 2012, point 9). In the present case, however, the appellant at least did not acknowledge the features of claim 1 mentioned in points 4.4 and 4.5 above to be known.

4.7 Thus, present claim 1 cannot be definitively assessed with respect to novelty and inventive step without knowledge of the relevant documented prior art. Thus the request requires a search for relevant prior art.

Hence the matter must be remitted for an additional search and further examination.

- 4.8 According to Article 111(1) EPC 1973 the board may exercise any power within the competence of the examining division (which was responsible for the decision under appeal) or remit the case to that department for further prosecution. It is thus at the board's discretion whether it examines and decides the case or whether it remits the case to the department of first instance. For the afore mentioned reasons, the board therefore considers that in the present case remittal is the more appropriate course of action.
- 4.9 Regarding the appellant's auxiliary request for oral proceedings submitted with the statement setting out the grounds of appeal (see point 16), it is clear from the mandatory wording of Article 116(1) EPC 1973 that a party which requests oral proceedings is in principle entitled to such proceedings (see for example T 0019/87 of 16 April 1987, OJ EPO 1988, 268). However, in the present case the request for oral proceedings was made on an auxiliary basis and reads: "If, having considered the main request, the Appeal board decide [sic] to refuse the patent [sic] in the current form, Oral Proceedings are hereby requested to allow the issues to be discussed in more detail." Since the board does not refuse the application according to the appellant's request, oral proceedings are not necessary. The board notes that remitting the case does not fall under the conditions set in this request, since the objection for lack of clarity on which the appealed decision was based is not maintained and no further objections are raised by the board. The appellant requested grant of a patent on the basis of the main request. However, as stated in decision T 0042/90 of 25 February 1991, the

decision to remit the case to the department of first instance is not to be considered as being adverse to that party, so that no oral proceedings before the board need to be appointed (see also T 1434/06 of 12 April 2010, point 3).

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 on the basis of the request filed with the statement setting out the grounds of appeal.

The Registrar:

The Chair:



K. Götz

A. Ritzka

Decision electronically authenticated