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**Datasheet for the decision
of 13 March 2017**

Case Number: T 0737/11 - 3.5.07

Application Number: 05108534.8

Publication Number: 1643378

IPC: G06F17/24, G06F17/30

Language of the proceedings: EN

Title of invention:
Web-based data form

Applicant:
Microsoft Technology Licensing, LLC

Headword:
Web-based data form/MICROSOFT TECHNOLOGY LICENSING

Relevant legal provisions:
EPC R. 103(1) (a), 111(2)
RPBA Art. 11
EPC Art. 83, 111(1)

Keyword:

Decision according to the state of the file - reasoned within
the meaning of Rule 111(2) EPC (no)
Enabling disclosure (objections not justified)
Substantial procedural violation - reimbursement of appeal fee
(yes)
Remittal to the department of first instance (yes)

Decisions cited:

G 0012/91

Catchword:



Beschwerdekammern
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Case Number: T 0737/11 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 13 March 2017

Appellant: Microsoft Technology Licensing, LLC
(Applicant) One Microsoft Way
Redmond, WA 98052 (US)

Representative: Grünecker Patent- und Rechtsanwälte
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 12 November
2010 refusing European patent application
No. 05108534.8 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman R. Moufang
Members: M. Jaedicke
P. San-Bento Furtado

Summary of Facts and Submissions

I. The applicant, which at the time was Microsoft Corporation, appealed against the decision of the Examining Division refusing European patent application No. 05108534.8.

II. In the proceedings leading to the refusal, the Examining Division issued a communication, together with a summons to oral proceedings pursuant to Rule 115(1) EPC, on 22 July 2010. According to this communication (hereafter: "communication A") the examination had been carried out on the claims of the sole request submitted with the applicant's letter of 20 November 2008.

(a) Claim 1 of this request reads as follows (reference signs omitted):

"A computer-implemented method for processing a web-based data form, comprising:

receiving a request to retrieve a web page associated with the data form;

associating a control of the data form with a field in a data source;

modifying the control of the data form in response to an input received at the control to modify a value associated with the control, wherein the modifying the control includes expanding the control to include the modified value; and

implementing the modifications to the control in the field of the data source;

wherein the control of the data form is instantiated by; [sic]

processing Extensible Stylesheet Language Transformation, XSLT, code associated with the data form into intermediate code;

retrieving Extensible Markup Language, XML, data associated with the data source; and

generating the control from the intermediate code and the XML data."

- (b) Communication A contained several objections relating to different requirements of the EPC. It began with objections under Article 83 EPC focusing upon two features, i.e.

"transformation of XML data associated with the requested web page into intermediate code using XSLT" (hereinafter: "feature F1") and

"form controls are expanded to include the modified values (by evaluating the XSLT code associated with the form controls)" (hereinafter: "feature F2").

Neither feature F1 nor the terms in the brackets of feature F2 were part of claim 1 of the applicant's sole request. The Examining Division stated that feature F1 was described in the application as an essential feature and cited a passage of the description for the terms added in the brackets of feature F2. It then gave reasons why the skilled person would not have been able to carry out features F1 and F2.

- (c) Communication A furthermore raised various clarity objections under Article 84 EPC. Apart from considering some features of the claims on file to

be unclear, it also contained two lists of three steps each (see point 3.3 of the communication for the first list and point 3.4 for the second list) and maintained that all those steps were essential features which had to be included in any independent claim. Step 1 of the second list was identical to feature F1 above.

(d) The communication also contained detailed objections under Article 56 EPC (lack of inventive step). In the context of this analysis the Examining Division presented a further list of eight features which in its view were essential features of the present application.

III. The appellant reacted to this communication by submitting arguments, a new main request and a new auxiliary request. Claim 1 of the main request reads as follows (reference signs omitted):

"A computer-implemented method for processing a web-based data form object, the data form object comprising a form field, wherein data binding information including an identifier, a name of the form field and a value of the form field is stored in the form field, wherein the form field is associated with a form control and wherein the form field corresponds to a data field within a record in a data source, the record in the data source comprising the data binding information associated with the form field, the method comprising:

submitting a modification to the form control of the data form object by entering a new value in the form field;

generating current data binding information associated with the form control to reflect the modified form field;

storing the current data binding information;

determining if the value of the form field has changed by comparing the current data binding information associated with the form control to the data binding information in the record of the data source; and

if the value has changed, storing the changed form field in the data form object and updating the data source for the changed form field using the stored current data binding information."

IV. The Examining Division sent out a further communication dated 25 October 2010 (hereafter "communication B"). It essentially consisted of a rebuttal of the appellant's arguments with respect to the objections under Article 83 EPC.

(a) Although it cited the appellant's newly filed requests as the application documents on which the examination had been carried out, it did not explain how the objections related to the specific claims of the requests. Rather, it reiterated and expanded on its opinion that features F1 and F2 were not sufficiently disclosed to enable a skilled person to implement them. In this context it referred back to that passage of communication A (see section II(c) above) where, in the assessment of the requirements of clarity (Article 84 EPC), three steps, i.e. steps 1 to 3 of the second list, had been enumerated as essential features.

(b) With respect to the requirement of inventive step, communication B contained on page 1 an introductory remark to the effect that an amendment of the claims based on the description as originally filed in order to arrive at inventive subject-matter seemed impossible. It furthermore stated as a "general remark" that since the present application did not fulfil the requirements of Article 83 EPC there was at present no need to examine the subject-matter of the claims according to the main and first auxiliary requests with regard to inventive step (see communication B, point 2).

(c) The communication furthermore announced that, should the applicant ask for a decision on the state of the file without filing further requests, amendments or comments, the application would then be refused "based on the above arguments taken in combination with the arguments provided in the summons" (see communication B, point 3).

V. The applicant subsequently withdrew its request for oral proceedings and requested an appealable decision according to the state of the file.

VI. Oral proceedings were held on 9 November 2010, as scheduled, in the absence of the applicant. At the end of the oral proceedings, the chairman announced the Examining Division's decision. According to the minutes of the oral proceedings (see EPO Form 2906), the chairman refused the application under Article 97(2) EPC according to the state of the file, because the subject-matter of the independent claims of both the main and auxiliary requests did not meet the requirements of the EPC for the reasons set out in the brief communication and the summons to oral

proceedings. Moreover, the minutes stated that it was noted that the objections with regard to the requirements of Article 83 EPC as raised in the "brief communication" were clear and complete, the "brief communication" being identified as the communication issued on 25 October 2010, i.e. communication B. The minutes furthermore specified on Form 2009.2 that the chairman had announced the decision to refuse the European patent application on the ground that the application did not meet the requirements of Article 83 EPC.

VII. On 12 November 2010 the Examining Division issued a decision "according to the state of the file" on EPO Form 2061. This decision does not mention the oral proceedings held earlier. Its grounds are as follows:

"In the communication(s) dated 22.07.2010, 25.10.2010 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 08.11.2010.

The application must therefore be refused."

VIII. With the statement of grounds of appeal, the appellant resubmitted the main and auxiliary requests pending when the decision "according to the state of the file" was issued. The appellant argued *inter alia* that the independent claims of the main request did not comprise any of the features to which the Examining Division had

objected under Article 83 EPC and that the decision was hence not justified. The appellant also addressed objections under Articles 84 and 56 EPC set out in the first communication. With the grounds of appeal the appellant filed the following document:

D5: "XSL Transformations (XSLT) Version 1.0, W3C Recommendation 16 November 1999", excerpt: 7 pages.

- IX. In the course of the appeal proceedings, the application was transferred to Microsoft Technology Licensing, LLC, which thereby obtained the status of appellant.
- X. In a communication under Rule 100(2) EPC, the Board expressed the provisional opinion that the reasons supporting the contested decision were unclear, as it could not be ascertained which reasons were provided with respect to the pending requests. Consequently, as fundamental deficiencies were apparent in the proceedings (Article 11 RPBA), the Board intended to remit the case to the department of first instance and to reimburse the appeal fee. In view of the age of the application, the Board nevertheless considered the merits of the only recognisable reasons for the decision and expressed the view that none of the objections possibly raised under Article 83 EPC was convincing. Moreover, the appellant was asked to clarify its requests in the light of the Board's communication.
- XI. With a letter dated 17 November 2016, the appellant submitted new requests replacing all prior requests. Its new (procedural) main request was "to set the appealed decision aside, to remit the case for further examination to the Examining Division, and to reimburse

the appeal fee". In the context of the procedural situation as a whole, the Board understands that the substantive main and auxiliary requests underlying the contested decision have not been withdrawn.

Reasons for the Decision

Admissibility of appeal

1. The appeal complies with the provisions referred to in Rule 101 EPC and is therefore admissible.

Deficiencies of the contested decision

2. Rule 111(2) EPC provides that decisions of the European Patent Office which are open to appeal (including decisions "according to the state of the file") must be reasoned. This provision has been interpreted by the boards of appeal as requiring a reasoning which enables the appellant and the board to examine whether or not the decision was justified. The grounds upon which the decision is based and all decisive considerations in respect of the factual and legal aspects of the case must therefore be contained in the decision.

- 2.1 The contested decision is a decision on the state of the file. It is thus in a standard form and does not itself specify the grounds on which it is based; it simply refers to preceding communications where corresponding objections were raised (see Guidelines for Examination in the EPO, E-IX 4.4). According to well-established case law of the boards of appeal, a decision drafted using this standard form complies with the requirement that a decision be reasoned pursuant to Rule 111(2) EPC only if certain conditions are

fulfilled. In particular, the examining division must have fully expressed and reasoned its objections in the cited preceding communication or communications, taking into account all relevant arguments put forward by the applicant.

- 2.2 Moreover, specific problems may arise when a decision on the state of the file refers to several preceding communications in which different objections were raised. Such a decision often causes at least some uncertainty about the reasons on which the refusal decision relies. The danger of uncertainty increases if the claim sets submitted by the applicant change between the communications referred to. It has therefore been held in numerous appeal decisions that a decision on the state of the file does not meet the requirements of Rule 111(2) EPC if it leaves it up to the applicant and the board of appeal to construe the applicable reasons by mosaicking various objections and arguments from several communications, or if it creates doubts as to which objections apply to which claim version (see Case Law of the Boards of Appeal, 8th edition 2016, III.K.4.3.2). This case law is reflected in the following passage of the Guidelines for Examination in the EPO (November 2015), C-V, 15.2:
- "Although it is possible by way of exception to refer to more than one communication in the standard form, the examiner should carefully consider the requirements of Rule 111(2). In particular, if the different communications deal with different sets of claims, such that it is not clear which of the reasons given by the Examining Division in its communications might be essential to the decision to refuse, a fully reasoned decision should be issued instead (see C-V, 15.3)."

3. The contested decision merely refers for its reasons to the communications dated 22 July 2010 and 25 October 2010, i.e. communications A and B. Between these two communications the appellant filed a new main request and a new auxiliary request (see section III above). Both new requests differed substantially from the sole request with which communication A was concerned. This *prima facie* creates doubts as to the extent in which the objections raised in communication A are still relied on by the Examining Division in its refusal decision. The Board therefore assesses in the following whether the present case may be regarded as exceptional in that a combined reading of both communications would make it possible to determine with sufficient certainty the reasons on which the decision is based.

3.1 Communication A raised several objections under Articles 83, 84 and 56 EPC (see section II above). In different parts of it, various features were identified as "essential features" of the invention and regarded as mandatory for the formulation of any independent claim. The discussion of Article 83 EPC focused on two features, i.e. features F1 and F2, which were not (for feature F1) or not completely (for feature F2) part of claim 1 of the then pending sole request. One of these features (F1) was considered to be an "essential feature".

3.2 Although communication B (see section IV above) correctly cited the appellant's new requests, it is wholly unclear whether they were considered in substance. The objections raised under Article 83 EPC did not refer to the claims of the new requests but focused again on features F1 and F2. However, these features are not contained in the independent claims of the new main request, so that it is not self-evident

why the objections raised under Article 83 EPC are relevant for the new main request. The Examining Division argued in communication B that both features F1 and F2 were essential (see communication B, points 1.3 and 1.4), referring to point 3.4 of communication A, where it had objected to certain features of claim 1 of the previously pending request as lacking clarity and had listed three steps as essential, one of these steps being feature F1. Since point 3.4, however, did not contain any observations with respect to feature F2, the reference to this point in communication B is confusing.

3.3 Furthermore, a combined reading of both communications leaves considerable uncertainty about the relevance of other objections raised in communication A. Although communication B stated that there was no need to examine the subject-matter of the new requests with respect to inventive step, it also contained an introductory remark to the effect that an amendment of the claims based on the description as originally filed in order to arrive at inventive subject-matter seemed impossible (see section IV(b) above).

3.4 With respect to Article 84 EPC, the situation is even worse. Communication A raised numerous objections under this provision, arguing partly that some features of the claims then on file were unclear, partly that several features that were not part of the independent claims had to be included in them since they were "essential features". It also mentioned further features as essential in its inventive-step analysis (see section II(c) and (d) above). It is neither stated in communication B nor self-evident that all these objections were no longer to be regarded as pertinent by the Examining Division.

- 3.5 The written decision does not mention at all that oral proceedings had taken place on 9 November 2010 and that in these oral proceedings the Examining Division's chairman had already announced the decision (see section VI above). This amounts to a procedural deficiency in itself since a written decision should in principle be self-contained and make it clear whether the decision was taken following written proceedings or taken in oral proceedings. This is necessary in view of the procedurally crucial distinction between decisions of both kinds, e.g. as regards the point in time when a decision becomes effective (see decision G 12/91, OJ EPO 1994, 285, reasons 2).
- 3.6 Since the written reasoning of the contested decision fails to mention the oral proceedings and to refer to their minutes, it is not possible to interpret the reasons of the decision in the light of these minutes. It may well be that the Examining Division wished to refuse the application only for not complying with Article 83 EPC, as implied by the minutes of the oral proceedings. However, the reasons it provided in its decision by merely referring to communications A and B do not make this clear at all.
- 3.7 The Board concludes that in the present case considerable uncertainty exists as to the precise reasons on which the contested decision was based. The claims were amended substantially between the two communications to which the written reasoning of the contested decision refers. No exceptional case is apparent in which a combined reading of the communications would make it possible to determine the reasons with sufficient certainty. On the contrary: additional uncertainty arises since the objections

under Article 83 EPC were interlinked with objections under Article 84 EPC, the features of the independent claims of the new requests were not explicitly addressed in communication B, numerous objections under Article 84 EPC raised in communication A were neither pursued further nor considered as overcome or as obsolete in communication B, and doubts remain even with respect to the relevance of inventive-step objections. In particular, from the written reasoning of the contested decision, it cannot be ascertained whether the application was refused only under Article 83 EPC or also under Article 84 EPC for lack of essential features and, if so, which features were considered essential. Furthermore, the reasoning with respect to Article 83 EPC was based on features F1 and F2 without explaining against which claims the objections were raised or how those two features related to the subject-matter of each of the new requests.

3.8 The written decision therefore leaves it to the appellant and the Board to speculate on the applicable reasons by mosaicking various objections and arguments from two communications and possibly other elements of the file, such as the minutes of the oral proceedings - to which the written decision does not even refer. It is therefore not reasoned within the meaning of Rule 111(2) EPC. This amounts to a substantial procedural violation according to Rule 103(1) (a) EPC and to a fundamental deficiency according to Article 11 RPBA.

3.9 The presence of fundamental deficiencies in the first-instance proceedings normally leads to a direct remittal to the department of first instance (see Article 11 RPBA). In view of the age of the

application, the Board will nevertheless in the following give its opinion on the only recognisable reason for the refusal decision, i.e. the objection of insufficient disclosure under Article 83 EPC.

Article 83 EPC

4. In the context of Article 83 EPC, the decisive question is whether the original application disclosed, at the filing date, sufficient details to enable a skilled person to carry out, without undue burden, the invention as defined in the claims. According to the established case law (see Case Law of the Boards of Appeal of the EPO, 8th edition 2016, II.C.6.1.4), an objection of insufficient disclosure presupposes that there are serious doubts, substantiated by verifiable facts.
- 4.1 The invention as described in the application concerns the processing of a web-based data form object. A data form is a section of a document containing normal content, markup, special elements called form controls (such as checkboxes, radio buttons, menus), and labels on the controls. Users generally complete a data form by modifying the form controls (for example, by entering text or selecting menu items) before submitting the data form for processing. Each form control has both an initial value and a current value. A form control's initial value may be specified with a value associated with the form control. The form control's current value is first set to the initial value. Thereafter, it may be modified through user interaction. However, according to the description of the background of the invention, the user's interaction with dynamic data from a data source was limited to

read-only functionality with the data source.

- 4.2 According to the invention, a web-based data form enables modifications made to values in a data form to be dynamically reflected in a data source. Form fields of the data form are associated with records in the data source (such as an Extensible Markup Language (XML) file or a database) using data-binding information. When a new value is entered in a form field, the data-binding information is updated. If the updated data-binding information does not correspond to the value of the corresponding record in the data source, the data source is updated.
- 4.3 The objections under Article 83 EPC raised by the Examining Division in its communications A and B focused on features F1 and F2 (see sections II(b) and IV(a) above). None of these features is included in the independent claims of the appellant's substantive main request pending at the time the refusal decision was taken and maintained in the appeal proceedings.
- 4.4 Feature F1 is about the transformation of XML data associated with the requested web page into intermediate code using XSLT. While, as stated above, this feature is not part of the independent claims of the main request cited in communication B, the Board notes that some of the dependent claims (see claim 3, 4, 8 and 10 of the main request cited in communication B) contain features similar to it in that they include a transformation of XML data into intermediate code using XSLT.
- 4.4.1 It was argued in communication A that according to the Guidelines C-II 4.9 a detailed description of at least one way of carrying out the invention had to be given

in the application as filed, with a single example possibly being sufficient. However, the present application provided "no examples of corresponding XSLT code nor of any intermediate code".

- 4.4.2 The Board cannot see any compelling reason why it would have been necessary in the present case to disclose specific examples of code in the application, and the Examining Division did not clearly explain in the decision why in its view this was necessary. Reference is made to the Guidelines for Examination in the EPO (November 2015), F-II, 4.12 which read as follows:

"4.12 Computer programs

In the particular case of inventions in the computer field, program listings in programming languages cannot be relied on as the sole disclosure of the invention."

This passage of the Guidelines which the Board endorses in principle makes it clear that *program code should not be relied on as the sole disclosure*. The appealed decision's argument (see communication A, point 1.1) considering examples of program code as necessary in order to meet the requirements of Article 83 EPC is therefore not convincing.

- 4.4.3 The Examining Division did not point out any particular technical difficulties for a skilled person in carrying out the claimed invention. It appears to have argued in essence that the disclosure did not provide sufficient technical details and in particular no examples for the generation of intermediate code using XSLT. The Examining Division argued that neither examples of corresponding XSLT code nor examples of any intermediate code were disclosed in the application, so

it was not clear how to generate intermediate code compatible with Microsoft's ASP.NET functionality.

Apart from the fact that the independent claims of the main request cited in communication B do not specify that the intermediate code has to be compatible with ASP.NET functionality, it is not discernible which specific features of XML or ASP.NET would, in the Examining Division's opinion, cause particular technical difficulties for implementing an XSLT transformation generating ASP.NET-compatible intermediate code.

4.4.4 The Board sees no reason to doubt that a skilled person was able to implement an XSLT transformation to transform XML data into intermediate code. In the Board's understanding it is not excluded that such an intermediate code comprises XML data. As stated explicitly in document D5 (see abstract, paragraph 1), XSLT is a language for transforming XML documents into other XML documents. Hence, D5 supports the appellant's arguments that feature F1 is disclosed in an enabling manner.

4.5 Feature F2 is about expanding form controls to include the modified values by evaluating the XSLT code associated with the form controls. The Examining Division's communication A considered it to be unclear how the expansion of the form controls using XSLT was to be carried out. However, feature F2 is not verbatim part of any claim of the appellant's requests which were already pending when the refusal decision was taken. In particular, the term "expansion" is no longer used in the claims. Moreover, the Board does not doubt that a skilled person would be able to carry out a modification of a form control to include modified

values. Storing a modified value as current value of a form control can be implemented in a number of ways by a skilled person, even without any further disclosure of details of an exemplary implementation.

- 4.6 For the reasons set out above, the Board concludes that the objections raised by the Examining Division in communications A and B with respect to Article 83 EPC are not convincing and do not preclude the allowability of the requests cited in these communications.

Remittal and reimbursement of the appeal fee

5. In view of the procedural deficiencies mentioned above (see point 3.8), the case is to be remitted to the department of first instance for further prosecution. The Board considers the reimbursement of the appeal fee to be equitable in a situation where, as here, the reasons given for the contested decision were so unclear that no final decision could be taken in the appeal proceedings (Rule 103(1)(a) EPC).

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.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:



M. Cañueto Carbajo

R. Moufang

Decision electronically authenticated