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**Datasheet for the decision  
of 23 November 2012**

**Case Number:** T 0395/12 - 3.5.06

**Application Number:** 04780485.1

**Publication Number:** 1652084

**IPC:** G06F 9/46, G06F 17/30

**Language of the proceedings:** EN

**Title of invention:**

A database management system with efficient version control

**Applicant:**

Oracle International Corporation

**Opponent:**

-

**Headword:**

Database management system/ORACLE

**Relevant legal provisions:**

EPC Art. 108, 113(1)

EPC R. 101(1), 99(2)

**Keyword:**

"Admissibility of the appeal (no)"

**Decisions cited:**

G 0010/91, G 0009/92, G 0004/93, T 0213/85, T 0065/96,  
T 0644/97, T 0934/02, T 1045/02, T 1276/05, T 0095/10

**Catchword:**

Insufficiently reasoned appeal



Case Number: T 0395/12 - 3.5.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.06  
of 23 November 2012

**Appellant:** Oracle International Corporation  
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**Representative:** Skone James, Robert Edmund  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 2 September 2011  
refusing European application No. 04780485.1  
pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** D. H. Rees  
**Members:** C. Heath  
S. Krischer

## Summary of Facts and Submissions

I. The appeal is directed against the decision of the examining division, posted on 2 September 2011 refusing the application 04780485 for lack of clarity and inventive step over the following document:

D1: BERNSTEIN P A ET AL: "Concurrency control and recovery in database systems; MULTIVERSION CONCURRENY CONTROL", CONCURRENCY CONTROL AND RECOVERY IN DATABASE SYSTEMS, READING, ADDISON WESLEY, US, pages 143-166, XP002270876.

II. Against the above decision, the applicant filed a notice of appeal on 11 October 2011 and paid the corresponding appeal fee on 19 October 2011.

III. The grounds of appeal were filed on 12 January 2012. After an introductory section 1. defining the requests, the grounds of appeal read as follows:

"2. Errors in the Decision

2.1. The Examining Division was wrong to decide that the refused claims 1 and 10 lack clarity (Art 84 EPC).

2.2. The Examining Division was wrong to decide that the refused claims 1-18 lack inventive step (Art 56 EPC).

2.3. The Examining Division was wrong to consider our arguments in support of inventive step provided in our letter of 15 June 2007 to not be convincing

2.4. We therefore reprise below the said complete arguments set out in our earlier letter filed during first instance grant

proceedings in support of the inventiveness of the refused claims for consideration by the Boards of Appeal in these second instance proceedings. These arguments also set out why we consider the refused claims to be clear."

What follows on the next three and a half pages is an almost literal copy of the letter dated 15 June 2007, as announced in section 2.4.

The grounds conclude with sections 4.4 to 4.11 which relate to the six new auxiliary requests, combining independent and dependent claims of the main request.

IV. It is helpful at this stage to say something about the appellant's letter of 15 June 2007 which, apart from a response to the objections raised by the examining division, also contained new claims. These were heavily amended; e.g. in claim 1, only the first two steps remained almost identical. The number of steps was increased from four to seven. At least two new steps (lines 9-14) from the description were added.

V. Chronologically, this letter was followed by the examination division's summons dated 1 June 2011, which served as the reasoning for the decision according to the state of the file, and in which new objections with respect to Article 84 EPC were raised for the newly added passages in claim 1 (see summons, section 2). In addition the problem-solution analysis in section 3 related to the amended claim 1. For example, the difference between claim 1 and D1 as laid out in the summons, page 3, paragraphs 6-9 was completely

different from that given in the communication dated 15 February 2007, page 4, paragraph 4.

- VI. In a communication sent with the annex to the summons, the board voiced doubt about the admissibility of the appeal, as it appeared that it was not sufficiently reasoned.
- VII. In its written reply dated 23 October 2012 the appellant maintained its view that the appeal was admissible, and essentially argued as follows: It could not be the function of the appeal to hear new facts and evidence, for which reason the appellant could not be compelled to come up with new arguments, especially where it was obvious that the examining division could not be convinced by those arguments that were already presented. In this respect, the appellant cited decision **T 644/97** of 22 April 1999. The current appeal was more than a mere reference to a previous statement, as seemed to be the case in decisions **T 220/83** (OJ EPO 1986, 249), **T 213/85** (OJ EPO 1987, 482) and **T 95/10** (of 2 August 2011).
- VIII. Oral proceedings were held on 23 November 2012. During these proceedings, the appellant advanced further arguments why the appeal should be held admissible. According to the appellant, the appeal set out a complete appeal case. There was no reason to repeat arguments already made before. The main reason for refusing the application was lack of inventive step, and lack of clarity. In the grounds of appeal, a direct response to these arguments could be found. It should not matter that these arguments had already been presented before. The board did not need to make further enquiries, and there was no opponent whose

interests needed to be considered. The arguments of the examining decision had been taken into account, and the appellant had decided it was unnecessary to make further points. The grounds of appeal were more than a mere reference to the arguments presented before. Further the auxiliary requests provided significant differences to the prior art. Thus, the auxiliary requests changed the case. For all these reasons, the appeal should be admissible. Decision **T 65/96** of 18 March 1998 was referred to. Applicant invited the board to disregard the statements made by the applicant in examination, and simply regard the Grounds of Appeal in their own right. Decision **T 644/97** was cited.

The appellant requested that the decision under appeal be set aside and that a patent be granted according to the Main Request, or one of the auxiliary requests one to six, all filed with the grounds of appeal. The appellant further requests in the auxiliary that an objection contained in the "Auxiliary Request" be entered into the Minutes to comply with Rule 106 EPC. This request reads as follows:

"In the event that the Board of Appeal should be minded to reject this appeal as inadmissible, we hereby object that the conduct of these appeal proceedings has been defective because the Board has misapplied the provisions of the EPC relating to the requirements for admissibility of an appeal to reject the appeal and deny the appellant the right to be heard, resulting in a fundamental violation of Article 113 EPC."

At the end of the oral proceedings, the chairman announced the decision by the board.

## Reasons for the Decision

1. Admissibility of the appeal
  - 1.1 In the present case, the applicant's only statement that directly addresses the decision under appeal was that the examining division was "wrong" (sections 2.1-2.3 of the grounds of appeal). There is no explanation why it should have been wrong, though.
  - 1.2 This as such is not contested by the appellant. Yet the appellant invites the board to look at the grounds of appeal as a document in its own right, without a comparison with statements previously made in examination. Both the nature of the appeal proceedings and previous case law speak against such an approach. Decisions **T 213/85** and **T 95/10** clarify that the appeal procedure is not a mere continuation of the examination procedure (in accordance with decisions **G 10/91** (OJ EPO 1993, 420), **G 9/92** and **G 4/93** (both in OJ EPO 1994, 875), but separate therefrom. Where the applicant in the grounds of appeal repeats its arguments set out during the examination phase without taking into account the decision under appeal, it mistakes the function of the boards of appeal, as the boards of appeal are not a second go of the examination procedure, but are meant to review decisions made by the examining divisions. Such a review is carried out based on the objections raised against the decision in the grounds of appeal. The grounds of appeal must therefore by definition relate to the reasons on which the decision under appeal is based and cannot be looked at in isolation from the appealed decision and the procedure leading to such decision. According to the decision

**T 1045/02** of 13 November 2003, "grounds sufficient to make an appeal admissible must therefore at least implicitly deal with the fundamental reasons in the decision under appeal and must explain in an objective manner why the decision under appeal is considered wrong." (section 1 of the reasons; translation by the board).

- 1.3 As a fallback position, the appellant has argued that the case at issue cannot be likened to cases where the grounds of appeal merely made reference to statements presented in earlier phases of the procedure. It is true that the inadmissibility of an appeal in decisions such as **T 220/83** and **T 1045/02** was also based on the fact that a mere reference was made to previous statements. The grounds of appeal in this case do not merely make reference to the letter of 15 June 2007, but cite this letter almost in its entirety. Rather than "grounds by reference", one could call this "grounds by cut-and-paste", and the board fails to see how this mechanical exercise adds more to the case than a phrase such as "reference is made to the letter of 15 June 2007 in its entirety" would have done. It has not been argued that the cited passages represent a creative selection that would give these statements a new meaning and could thereby be regarded as a response to the decision under appeal. As far as the arguments on Article 56 EPC are concerned, there is an almost literal identity between the grounds of appeal and the letter of 15 June 2007. Decision **T 65/96** of 18 March 1998 does not help the appellant's position, because in addition to the reference to previous statements, three specific points made in the decision under appeal were contested.



1.4 A further argument advanced by the appellant rests upon a passage in the decision **T 644/97** according to which an appellant cannot be compelled to come up with new arguments ("Indeed, a requirement that new arguments must be submitted to render an appeal admissible would imply that the appealed decision, as issued, had necessarily been correct", section 1 of the reasons). In this decision, the board based the admissibility of the appeal on a number of reasons. Apart from the one mentioned above, the admissibility was for the first time contested in oral proceedings, and "a relevant objection [had] already [been] substantiated in the Statement of Grounds of Appeal" (section 1 of the reasons). Apart from that, the fact that the appellant is not required to come up with new arguments does not mean that the decision under appeal should not be addressed at all.

1.5 Decision **T 934/02** of 29 April 2004 found an appeal to be sufficiently substantiated even in the absence of arguments dealing with the contested decision if two criteria were met (section 2 of the reasons):

"(i) The subject of the proceedings has changed eg due to the filing of a new set of amended claims together with the statement of grounds, and

(ii) The reasons for the decision are no longer relevant in view of the change in the subject of the proceedings, (cf in particular J xx/87 dated 17 August 1987, OJ EPO 1988, 323, point 1.4 and T 105/87 dated 25 February 1988, not published in OJ EPO)."

This rather broad statement is qualified in two further decisions. According to decision **T 1045/02**, merely filing new claims makes the appeal admissible only in exceptional cases, and according to decision **T 1276/05** (of 7 February 2008), new claims filed in lieu of any other grounds must be accompanied by an explanation why these requests overcome the objections raised in the decision under appeal, unless this is obvious.

In the present case, six auxiliary requests with new claims have been filed with the grounds of appeal. According to the appellant, this was sufficient to change the case and make the appeal admissible.

1.6 All six auxiliary requests are combinations of independent and dependent claims, and all these combinations were addressed in the appealed decision and held to lack inventive step. Thus, the decision under appeal still remains relevant for these auxiliary requests. In addition, while the appellant has indicated the basis for the new auxiliary requests, there is no explanation why the examination division was wrong in considering these combinations not inventive. The appeal thus does not become admissible by the filing of the auxiliary requests.

1.7 Finally, the appeal must also be considered inadmissible because the grounds fail to deal with all the reasons the examination division has advanced for refusing the application. According to the decisions **T 213/85** (section 4 of the reasons), and **T 1045/02**, the grounds of appeal must deal with all those reasons on which the decision under appeal is based: "According to the Board, the minimum requirements for an admissible appeal have not been met if only one of several reasons

for refusal are addressed ..." (decision **T 1045/02**, section 4 of the reasons; translation by the board). This position is consistent with the requirement of Article 12(2) of the Rules of Procedure of the Boards of Appeal according to which "The statement of grounds of appeal and the reply shall contain a party's complete case". In the case at issue, the summons of 1 June 2011 which served as the reasoning for the decision according to the state of the file, raised new objections with respect to Article 84 EPC for the newly added passages in claim 1 (see summons, section 2). Since these objections were not pertinent and therefore not raised for the previous versions of the claim, the letter of 15 June 2007 and the grounds of appeal that are an almost verbatim copy of this letter do not deal with this objection. As the decision under appeal held that claims 1 and 10 were not clear, Article 84 EPC must be considered as one of the reasons the refusal of the application is based upon. Already the failure to address this ground of refusal makes the appeal insufficiently reasoned and inadmissible.

- 1.8 Summarising, the grounds of appeal consist of an almost verbatim copy of the appellant's letter of 15 June 2007 that predates the summons and cannot take into account the division's subsequent arguments and objections to the amended claims, be it for grounds that have already been raised (lack of inventive step), be it for grounds that became relevant only for the amended claims (lack of clarity). Nor can the above letter furnish arguments to the examining division's comments regarding the amended claims filed with that letter. The auxiliary requests filed with the grounds of appeal are combinations of dependent and independent claims, all

of which were addressed in the decision under appeal and can therefore not be considered to be a change of case vis-à-vis the decision under appeal. The appeal is therefore insufficiently reasoned and does not comply with the requirements of Article 108 EPC. It must therefore be dismissed as inadmissible.

2. In light of the foregoing, the board considers its decision to be consistent with previous case law and is unable to see a "misapplication of the provisions of the EPC", as the appellant has alleged with its auxiliary request. Consequently, while the formal request to record this objection in the minutes is granted, the objection itself must be dismissed.
3. As the appeal is inadmissible, the substantive merits of the case cannot be addressed.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed as inadmissible.

The Registrar:

The Chairman:

B. Atienza Vivancos

D. H. Rees