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# Datasheet for the decision
## of 10 May 2016


**Case Number:**               T 1093/12  -  3.5.07

**Application Number:**         01126387.8

**Publication Number:**         1207462

**IPC:**                        G06F17/30, G06F1/00

**Language of the proceedings:**    EN

**Title of invention:**
A method for altering encryption status in a relation database
in a continuous process


**Applicant:**
Protegrity Corporation


**Headword:**
Database encryption/PROTEGRITY


**Relevant legal provisions:**
EPC Art. 123(2), 84


**Keyword:**
Claims - clarity after amendment (no)
Amendments - extension beyond the content of the application
as filed (yes) (all requests)

**Decisions cited:**


**Catchword:**

Case Number: **T 1093/12 - 3.5.07**

# D E C I S I O N
## of  Technical Board of Appeal 3.5.07
## of 10 May 2016

| | |
|---|---|
| **Appellant:** <br> (Applicant) | PROTEGRITY CORPORATION <br> South Church Street <br> Grand Cayman (KY) |
| **Representative:** | Round, Edward Mark <br> Marks & Clerk LLP <br> 90 Long Acre <br> London WC2E 9RA (GB) |
| **Decision under appeal:** | Decision of the Examining Division of the European Patent Office posted on 23 November 2011 refusing European patent application No. 01126387.8 pursuant to Article 97(2) EPC. |

Composition of the Board:

| | |
|---|---|
| **Chairman** | R. Moufang |
| **Members:** | M. Rognoni |
| | R. de Man |

## Summary of Facts and Submissions

I.      The former applicant (appellant), Protegrity
        Research & Development [AB], appealed against the
        decision of the Examining Division to refuse the
        European patent application no. 01126387.8.

II.     In the decision under appeal, the Examining Division
        held, *inter alia*, that the subject-matter of claim 1
        filed with letter dated 2 February 2009 did not involve
        an inventive step, having regard to the following
        documents:

        D1:    US-A-6 122 640;
        D2:    John Russell: "Oracle8i Application Developer's
               Guide - Fundamentals", Release 2(8.1.6),
               December 1999;
        D3:    WO-A-97/49211.

        In an "Obiter Dictum" annexed to the contested
        decision, the Examining Division also raised, *inter
        alia*, objections under Articles 83 and 84 EPC.

III.    With the statement of grounds of appeal, the appellant
        filed new sets of claims according to a main request
        and auxiliary requests 1 and 2. It furthermore
        requested that:

        -    the decision under appeal be set aside in its
             entirety and that a patent be granted on the basis
             of the claims according to the main request,
        -    or, if this was not possible, on the basis of the
             auxiliary request 1 or 2.

IV.     Registration of the transfer of ownership of the
        present application to Protegrity Corporation took
        effect on 31 July 2014.

V.      With letter dated 9 September 2015, the appellant was
        summoned to oral proceedings to be held before the
        Board on 10 May 2016.

VI.     In a communication dated 29 February 2016 pursuant to
        Article 15(1) RPBA, the Board expressed, *inter alia*,
        the following preliminary opinion:

        -   claim 1 according to the main request appeared to
            relate to subject-matter extending beyond the
            content of the application as originally filed
            (Article 123(2) EPC) and to give rise to objections
            under Article 84 EPC;

        -   as claims 1 of the auxiliary requests 1 and 2 were
            identical to claim 1 of the main request, the same
            objections applied.

VII.    In reply to the Board's preliminary opinion, the
        appellant informed the Board with letter dated
        4 May 2016 that it would not be attending the oral
        proceedings scheduled to take place on 10 May 2016.

VIII.   On 10 May 2016, oral proceedings were held in the
        absence of the appellant. At the end of these
        proceedings, the Chairman pronounced the Board's
        decision.

IX.     Claim 1 according to the appellant's main request reads
        as follows:

"A method for altering encrypting status in a
relational database in a continuous process, comprising
the steps of:
providing a table in said database, said table
including a maintenance area and a base area, said base
area including a first set of records;
copying said first set of records from said base area
to said maintenance area, thereby creating, in said
maintenance area, a second set of records;
altering the encryption status of said second set of
records in said maintenance area in response to a user
instruction to modify data in the first set of records
in said base area; and
after said altering, copying said second set of records
from said maintenance area to said base area to replace
said first set of records, thereby creating in said
base area a third set of records, and modifying data in
said third set of records based on the user instruction
to modify data."

Claims 2 to 9 of the main request are dependent on
claim 1.

Auxiliary request 1 comprises claims 1 to 8 of the main
request.

Auxiliary request 2 comprises claim 1 of the main
request.

X.      The appellant's arguments relevant to the Board's
        decision may be summarised as follows:

        Claim 1 had been amended to reword the provision of the
        table in the database as a specific step of the method
        claimed. This was a clarifying amendment, with basis

from page 5, line 25 to page 6, line 3 of the
application as originally filed.

Reference to the records as comprising a "first set", a
"second set" and a "third set" was of a purely
clarifying nature, the basis for which would be self-
evident to the reader on inspection of the application
as originally filed, notwithstanding the absence of
specific literal language corresponding to these terms.
Distinguishing the terms in this way was consistent
with the original disclosure.

The step of "directing" previously presented had been
amended to "altering" for consistency with the head of
claim 1. This had the added effect of addressing
clarity issues raised in respect to the extent of the
claim.

## Reasons for the Decision

1.      The appeal is admissible.

2.      The present application is concerned with *"a method for
        altering encryption status in a relational database in
        a continuous process reducing the need for taking the
        database offline"* (page 1, first paragraph of the
        application as originally filed).

2.1     The method disclosed in the application is performed on
        a database which comprises at least one base area and a
        corresponding maintenance area. It consists essentially
        in copying records from the base area to the
        maintenance area, directing action commands intended
        for the base area to the maintenance area, altering the
        encryption status of the base area, copying data

records from the maintenance area to the base area and
redirecting action commands to the base area
(application as filed, page 3, first paragraph).

*Admission of the appellant's requests*

3.      In the communication dated 29 February 2016, the Board
        noted that the wording of claim 1 according to the main
        request and to the first and second auxiliary requests
        was substantially different from the wording of the
        method claim considered in the contested decision and
        of claim 1 as originally filed.

3.1     In the statement of grounds of appeal, the appellant
        had pointed out that the amendments made to claim 1
        were meant to address clarity issues that had arisen in
        the first instance proceedings. In particular, the
        appellant considered that *"the existence of such
        deficiencies, right through prosecution,"* seemed *"to
        have obstructed the Examining Division in providing a
        proper assessment of the prospect for the grant of a
        patent"* (statement of grounds of appeal, page 3,
        penultimate full paragraph).

3.2     Despite the fact that the Examining Division had
        addressed clarity issues and that clarifying amendments
        could have been presented in the first instance
        proceedings, the Board accepts that the new requests
        submitted with the statement of grounds of appeal can
        be regarded as a *bona fide* attempt on the part of the
        appellant's new representative to *"move the application
        towards acceptance"* (statement of grounds of appeal,
        page 4, lines 5 to 7).

3.3     In these circumstances, the Board finds it appropriate
        to admit the appellant's requests into the appeal
        proceedings (Article 12(4) RPBA).


*Main request*


4.      Claim 1 according to the main request comprises the
        following steps itemised by the Board:

        (a) providing a table in said database,
            (i)    said table including a maintenance area and
                   a base area,
            (ii)   said base area including a first set of
                   records;

        (b) copying said first set of records from said base
            area to said maintenance area,
            (i)    thereby creating, in said maintenance area,
                   a second set of records;

        (c) altering the encryption status of said second set
            of records in said maintenance area in response to
            a user instruction to modify data in the first set
            of records in said base area; and

        (d) after said altering, copying said second set of
            records from said maintenance area to said base
            area to replace said first set of records,
            (i)    thereby creating in said base area a third
                   set of records, and

        (e) modifying data in said third set of records based
            on the user instruction to modify data.

4.2     Claim 1 considered in the contested decision, after
        introducing the terms "base area" and "maintenance
        area" in its preamble, spells out the following steps:

        -    copying <u>all records</u> from said base area to said
             maintenance area,

        -    <u>directing action of commands</u> intended for said base
             area to said maintenance area;

        -    <u>altering encryption status</u> of said base area;

        -    <u>copying all data records</u> from said maintenance area
             to said base area, <u>wherein all data records being
             copied from the maintenance area to the base are
             encrypted/decrypted</u> in accordance with the altered
             encryption status of the base area;

        -    <u>redirecting action of commands</u> to said base area.

4.3     As a comparison with the first and second paragraphs of
        page 3 and with the paragraph bridging pages 3 and 4 of
        the description shows, the subject-matter of claim 1 on
        which the refusal was based corresponds essentially to
        the summary of the invention given in the application
        as originally filed.

4.4     Claim 1 now on file and the previous claim 1 present,
        *inter alia*, the following differences:

        -    in the present claim 1 not "all records" are copied
             from the base area to the maintenance area and from
             the maintenance area to the base area, but "a
             second set of records" is created in the
             maintenance area when a "first set of records" is
             copied from the base area to the maintenance area,

and a "third set of records" is created in the base
area when the "second set of records" is copied
from the maintenance area to the base area;

- claim 1 on file does not include the step of
  "directing action of commands" or "redirecting
  action of commands";

- according to claim 1 on file, the encryption status
  of the second set of records in the maintenance
  area is modified in response to a user instruction
  to modify data in the first set.

4.5   Hence, contrary to claim 1 considered by the Examining
      Division, claim 1 on file no longer reflects a key
      aspect of the invention which consists in the
      "rerouting of the access" in order to keep the database
      online while the encryption settings in the database
      are altered (see lines 14 to 18 at page 3 of the
      original application).

5.    As to the appellant's argument that the basis for
      referring to the data records as comprising "a first
      set", "a second set" and "a third set" would be self-
      evident to the reader, the Board considers that this
      amendment constitutes a considerable departure from the
      original description of the invention and that, far
      from clarifying the claimed subject-matter, it appears
      to introduce undisclosed features into the claim.

5.1   In fact, claim 1 as originally filed and claim 1
      considered by the Examining Division do not identify
      different sets of records, but specify that *"all
      records"* are copied from the base area to the
      maintenance area and then back to the base area.

6.      Furthermore, the Board fails to see a basis in the
        application for amending the step of "*directing*" to
        "*altering*" "for consistency with the beginning of the
        claim", as submitted by the appellant. In fact,
        *"altering the encryption status of the base area"* and
        *"directing actions of command"* (or *"redirecting actions
        of command"*) are quite distinct steps of the invention
        as originally disclosed and previously claimed.

6.1     According to page 4, lines 4 to 6 of the application as
        originally filed *"data elements [...] are encrypted as
        they are copied to, or from, the maintenance area".*
        Similarly, the detailed embodiment of the invention on
        page 7, lines 16 to 20 specifies that when the step of
        activating encryption means is performed, *"all data
        written to the base column 'password' will now be
        written in encrypted form".*

6.2     For the sake of consistency with the cited passages of
        the description, the step of *"altering the encryption
        status of said second set of records in said
        maintenance area"* should relate to the fact that the
        set of records in the maintenance area is encrypted as
        a result of encryption performed while data elements
        are moved from the base area to the maintenance area.
        However, a combined reading of steps (b), (c) and (d)
        promotes a different understanding of the claimed
        method, according to which the encryption of data is
        performed on the data stored in the maintenance area,
        namely after copying the first set of records from the
        base area and prior to copying the second set of
        records from the maintenance area to the base area.

6.3     From the wording of claim 1, it is also unclear whether
        the modification of data referred to in step (c)
        relates to a modification of the encryption status of

the first set of records or anticipates an unspecified
modification to be performed on the third set of
records in step (e).

6.4     In fact, modifying data records in the base area in the
        sense of altering their encryption status is not
        performed according to the original application as an
        independent step, but is the result of copying data
        with a modified encryption status from the maintenance
        area to the base area.

7.      In summary, the Board finds that claim 1 according to
        the main request does not provide a clear definition of
        the matter for which protection is sought (Article 84
        EPC) and covers subject-matter extending beyond the
        content of the application as originally filed (Article
        123(2) EPC).

*Auxiliary requests*

8.      As pointed out in the statement of grounds of appeal,
        the set of claims of the auxiliary request 1 comprises
        claims 1 to 8 of the main request and the auxiliary
        request 2 comprises only claim 1 of the main request.

8.1     As claims 1 of the auxiliary requests 1 and 2 are
        identical to claim 1 of the main request, the same
        objections under Articles 123(2) and 84 EPC apply.

9.      For the above reasons, the Board comes to the
        conclusion that none of the appellant's requests can
        form a basis for the grant of a patent. Hence, the
        appeal has to be dismissed.

**Order**

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

      The appeal is dismissed.


The Registrar:                              The Chairman:


I. Aperribay                               R. Moufang


Decision electronically authenticated