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**Datasheet for the decision
of 15 February 2018**

Case Number: T 1814/12 - 3.5.07

Application Number: 06720704.3

Publication Number: 1989642

IPC: G06F17/28, H04L12/58, H04L29/06

Language of the proceedings: EN

Title of invention:
Messaging and document management system and method

Applicant:
Epostal Services, Inc.

Headword:
Messaging and document management/EPOSTAL SERVICES

Relevant legal provisions:
EPC Art. 111(1), 117
RPBA Art. 11
EPC R. 103(1) (a), 111(2)

Keyword:

Decision according to the state of the file - reasoned within the meaning of Rule 111(2) EPC (no)

Substantial procedural violation - (yes)

Reimbursement of appeal fee - (yes)

Remittal to the department of first instance - (yes)

Internet disclosures - sufficient degree of certainty (no)

Decisions cited:

T 0583/04, T 0545/08, T 2227/11

Catchword:



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Case Number: T 1814/12 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 15 February 2018

Appellant: Epostal Services, Inc.
(Applicant) 45 Mayapple Road
Stamford, CT 06903 (US)

Representative: Maschio, Antonio
Maschio & Soames IP Limited
30 Carlton Crescent
Southampton SO15 2EW (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 24 February
2012 refusing European patent application No.
06720704.3 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 (appellant) appealed against the decision of the Examining Division refusing European patent application No. 06720704.3, filed on 13 February 2006 as international application PCT/US2006/005052 and published as WO 2007/094772. The application does not claim a priority.

II. In the proceedings leading to the refusal, the first communication issued by the Examining Division referred to the European search opinion, according to which *inter alia* originally filed claim 1 lacked inventive step over the following documents, cited in the European search report, in combination:

D1: WO 2004/084042 A2, published on 30 September 2004;

D2: Visser, Jos et al.: "On ProxyTunnel or How To Give Network Security Administrators a Tremendous Headache", Internet publication, 1 April 2002, pages 1 to 17, retrieved from the Internet on 20 March 2009 using the URL <http://proxytunnel.sourceforge.net/paper.php>.

III. In its letter of reply dated 24 December 2009, the appellant filed a new request *inter alia* comprising a set of replacement claims and submitted the following arguments concerning the publication date of document D2:

"Further to the above, we would also point out that the Examiner has not substantiated the alleged publication date for document D2. The document was retrieved by the Examiner, according to the

International search report [sic], on 20 March 2009, which is after the present application's filing date. Whilst the document bears on its face a date stamp of 1 April 2002, which the Examiner appears to have relied upon, it is to be noted that it also notes that it was updated on 3 March 2008. As such, the following points are not clear:

- Whether the alleged publication date of 1 April 2002 is indeed correct*

- Whether any changes have been made to the document between that date and the filing date of the present application*

- What amendments were made to the document after the International filing date and particularly what amendments were made on 3 March 2008*

- Whether the date claimed for the article of 1 April 2002 was a publication date or merely some other creation date and so whether the document was available to the public on the date of 1 April 2002*

The Examiner is required by a Board of Appeal decision T1134/06 to establish the same facts as would be the case with a prior use or prior oral disclosure, namely when, what and under which circumstances this disclosure was made available to the public. We would submit that there is sufficient doubt even on the data on the face of the document as to when and what was disclosed that D2 should be withdrawn from consideration. At least, the Examiner should justify further why this document is citable."

IV. In its second communication pursuant to Article 94(3) EPC, the Examining Division replied to the appellant's arguments concerning the publication date of document D2 as follows:

"In the letter dated 24.12.2009, on page 4 onwards, the Applicant requested a clarification about the date of document D2. Said document contains an article called "On ProxyTunnel" and, on the first page, a so called "Newflash!" containing an update on the same theme.

The date of the article is clearly indicated under the title, and is the 01.04.2002. The update is clearly contained only in the first lines of the page and has been added on 03.03.2008. It is very clear by the position of said update and by the text of the update that the added part is confined in the lines from the word "Newflash!" to the word "Maniac".

Therefore according to the principle of "free evaluation of evidence" as stated in T482/89 and in T750/94, it is considered that the date of disclosure of the article can be reasonably considered as being the 01.04.2002."

V. In its letter of reply, the appellant again questioned whether document D2 was prior art against the application and reserved its right to elaborate further on this point before the Examining Division or in appeal proceedings.

VI. In a later stage of the proceedings, the Examining Division issued a further communication, together with a summons to oral proceedings pursuant to Rule 115(1) EPC, on 8 July 2011. 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 24 December 2010.

(a) Claim 1 of that request reads as follows:

"A communication system (10) that transmits electronic mail having a message content component and a message data component relating to the message content and/or its transmission, among multiple Sender and Recipient terminals (12, 14) and which both uses and augments the Internet (18), comprising:

a server (20) and server software (24, 24'), links (16) connecting the Sender and Recipient terminals (12, 14) and said server (20) and server software (24, 24') to the Internet (18), and Sender software (22)

(i) operable on at least the Sender terminal (12) and

(ii) operable with conventional electronic mail application software also operating on the Sender terminal (12) to

(iii) selectively provide access by the Sender terminal (12) and said Sender software (22) to said server (20) and server software (24, 24') for managing and processing the electronic mail transmitted from the Sender terminal (12) in order to provide the communication system's (10) premium mail services to the electronic mail, and

(iv) begin processing of said premium mail services to the electronic mail,

characterized by the Sender software being operable to:

(v) facilitate said Sender terminal (12) and Sender software (22) and said server (20) and server software (24, 24') communicating with one

another, at least in part, using direct communications to create a virtual intranet for use by the Sender terminal (12), Recipient terminal (14), and the communication system (10) itself, wherein said direct communications are custom and comprise said Sender (22), Recipient (26), and server (24, 24') software operating on those terminals to open a communication connection for a transmission session using one-time session IDs, establish security on said links (16) with communication system (10) controlled encryption, authenticate the sender, transmit said direct communications message content and/or message data in custom message structures, and close the transmission protocols such as HTTP, SMTP, or other socket protocols."

(b) Communication A contained objections under Article 56 EPC (lack of inventive step) against the then pending claims based on document D1 as closest prior art in combination with document D2 and the assessment of certain features as "standard features of an encrypted communication".

VII. In response to the summons to oral proceedings, the appellant filed with its letter of 16 January 2012 an amended main request replacing the prior main request, a first and a second auxiliary request and detailed arguments.

Claim 1 of the main request reads as follows:

"A communication system (10) that transmits electronic mail having a message content component and a message data component relating to the message content and/or its transmission, among multiple Sender and Recipient

terminals (12, 14) and which both uses and augments the Internet (18), comprising:

a server (20) and server software (24, 24'),
links (16) connecting the Sender and Recipient terminals (12, 14) and said server (20) and server software (24, 24') to the Internet (18), and
Sender software (22)

(i) operable on at least the Sender terminal (12)
and

(ii) operable with conventional electronic mail application software also operating on the Sender terminal (12) to

(iii) selectively provide access by the Sender terminal (12) and said Sender software (22) to said server (20) and server software (24, 24') for managing and processing the electronic mail transmitted from the Sender terminal (12) in order to provide the communication system's (10) premium mail services to the electronic mail, and

(iv) begin processing of said premium mail services to the electronic mail,

characterized by the Sender software being operable to:

(v) facilitate said Sender terminal (12) and Sender software (22) and said server (20) and server software (24, 24') communicating with one another and forming a communications network in which the Sender terminal (12) and the Recipient terminal (14) each communicate with and transmit data directly to the server (20),

at least one of the Sender and Recipient terminals (12, 14) sending a message having a unique message structure to the server (20), the unique message structure including an encrypted data block, a session ID, and a session encryption key, the encrypted data block being encrypted by the session encryption key,

wherein the session ID and the session encryption key are generated by the server (20), and

the server (20) receives the message having the unique message structure, decrypts the encrypted data block, and sends a further message to the at least one of the Sender and Recipient terminals (12, 14)."

Claim 1 of the first auxiliary request replaces the characterising part of claim 1 of the main request as follows:

"characterized by the Sender software being operable to:

(v) facilitate said Sender terminal (12) and Sender software (22) and said server (20) and server software (24, 24') communicating with one another and forming a communications network in which the Sender terminal (12) and the Recipient terminal (14) each communicate with and transmit data directly to the server (20),
the Sender and Recipient terminals (12, 14) utilizing unique message structures in which one of the Sender and Recipient terminals (12, 14) sends a request message to the server (20), and the other of the Sender and Recipient terminals (12, 14) receives a response message from the server (20),

the request and response messages each include an encrypted data block, and the request message further includes a session ID and a session symmetric key, the encrypted data block being encrypted by the session symmetric key, wherein the session ID and the session symmetric key are generated by the server (20), and

the server (20) receives the request message, decrypts and processes the encrypted data block in the request message, and sends the response message to the other of the Sender and Recipient terminals (12, 14)."

Claim 1 of the second auxiliary request replaces the characterising part of claim 1 of the main request as follows:

"characterized by the Sender software being operable to:

(v) facilitate said Sender terminal (12) and Sender software (22) and said server (20) and server software (24, 24') communicating with one another and forming a communications network in which the Sender terminal (12) and the Recipient terminal (14) each communicate with and transmit data directly to the server (20)

through a secure channel using a unique message structure including an encrypted data block, a session ID, and a session encryption key, the encrypted data block being encrypted by the session encryption key,

wherein the system is configured to establish the secure channel for a communication session by the following steps:

the Sender terminal sends a request message to the server, the request message including a public key;

the server generates and stores the session ID and the session encryption key, encrypts these with the public key and sends them back to the Sender in a response message; and

the Sender receives the response message, decrypts the session ID and the session encryption key and stores the session ID and the session encryption key for use in all further data transmissions having the unique message structure to the server in the communication session."

VIII. The first examiner and the appellant's representative held a consultation by telephone before the scheduled date of the oral proceedings. The result of this telephone consultation was communicated to the

appellant with a letter dated 2 February 2012 (hereafter "communication B") and is as follows:

"The Examiner informed the Representative that the new filed sets of claims (main request and 1st and 2nd auxiliary requests) does [sic] not fulfill the requirements of Article 56 EPC over the combination of documents D1 and D2.

In particular in said set of claims explicit reference has been made to different specific features of an encrypted communication.

The Examiner pointed out that document D2 explicitly refers to HTTPS and SSH in the same context of the claimed invention (see page 8 onwards, paragraph "Popping your mail with ProxyTunnel"). Therefore the person skilled in the art would implement all the different features of said protocols, even if not explicitly listed in document D2. For instance HTTPS is implemented using SSL, that anticipates the new features of the filed sets of claims.

Therefore the person skilled in the art would implement said standard features without involving an inventive step in the sense of Article 56 EPC.

Oral Proceeding are maintained as scheduled."

- IX. In a letter dated 13 February 2012, the appellant informed the Examining Division that it would not be attending the oral proceedings scheduled for 16 February 2012 and requested "a decision based on the current state of the file". In reply, the Examining Division cancelled the oral proceedings.

- X. On 24 February 2012, the Examining Division issued a decision "according to the state of the file" on EPO Form 2061. It reads as follows:

"In the communication(s) dated 08.07.2011, 02.02.2012 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 14.02.2012.

The European patent application is therefore refused on the basis of Article 97(2) EPC."

- XI. With the statement of grounds of appeal, the appellant requested that the decision be set aside and that a patent be granted on the basis of one of the main and two auxiliary requests considered in the contested decision. The appellant submitted that it does "not consider that the examiner has addressed the argumentation submitted in support of the main request" and that the skilled person would not consider the combination of documents D1 and D2.
- XII. In a communication of 11 March 2013, the appellant was invited to file a copy of the statement of grounds of appeal duly signed by an authorised person as the statement of grounds was deemed not to be signed.
- XIII. With a letter dated 19 March 2013, the appellant submitted a copy of the statement of grounds of appeal

duly signed by a person authorised to act in the proceedings.

- XIV. In a communication under Rule 100(2) EPC, the Board informed the appellant of its provisional opinion that the decision of the Examining Division was insufficiently reasoned and that the decision was also deficient for other reasons. Consequently, the Board intended to set aside the decision due to a severe procedural violation, to reimburse the appeal fee and to remit the case for further prosecution to the department of first instance. Moreover, the appellant was asked to clarify whether it maintained its request for oral proceedings should the Board remit the case.
- XV. In reply, the appellant submitted that oral proceedings before the Board were not necessary and that the application could be remitted. Moreover, a refund of the appeal fee was requested.

Reasons for the Decision

Admissibility of the appeal

1. As the appellant remedied the deficiency of the missing signature of an authorised person authenticating the statement of grounds of appeal in due time (Rule 50(3), second sentence, EPC), the appeal complies with the provisions referred to in Rule 101 EPC and is therefore admissible.

Deficiencies of the contested decision

2. According to Rule 111(2) EPC 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.
3. The contested decision is a decision on the state of the file. It is 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 (November 2017), C-V, 15.2). 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.
4. 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 risk of uncertainty increases if the claim sets submitted by the applicant change

between the communications referred to. It has therefore been held in several 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 the decisions cited in 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 2017), 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)."

5. The contested decision merely refers for its reasons to the communications dated 8 July 2011 and 2 February 2012, i.e. communications A and B. While communication A is a communication accompanying a summons to attend oral proceedings pursuant to Rule 115(1) EPC, communication B is a summary record of a telephone consultation, which is not *stricto sensu* a communication pursuant to Article 94(3) EPC. According to the established case law of the boards of appeal (see the decisions cited in Case Law of the Boards of Appeal of the EPO, 8th edition 2016, III.K.4.3.4; decision T 0583/04 of 6 June 2006, points 9 to 11 of

the reasons), a decision on the state of the file should be taken on the basis of facts and arguments already on the file in written form, which excludes the minutes of a telephone conversation unless the statements made orally in this telephone conversation were confirmed in a written communication. For this reason alone, the contested decision does not meet the requirements of Rule 111(2) EPC.

6. Moreover, there are further deficiencies in the appealed decision. Between the two communications A and B, the appellant filed a new main request and new first and second auxiliary requests - see above, section VII. All the new requests differed substantially from the sole request with which communication A was concerned. Communication B does not contain a self-sufficient reasoning for any of these new requests; instead, it merely addresses the "new features of the filed sets of claims". This *prima facie* creates doubts as to the extent to 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 relevant facts and the logical chain of reasoning on which the decision is based.

7. The appellant's requests refused with the contested decision are the main request, and the first and second auxiliary requests filed with letter of 16 January 2012. As these requests were filed by the appellant between communications A and B, they were only considered in communication B. Claim 1 of the refused requests differs from claim 1 of the sole request considered in communication A in that the

characterising part of claim 1 has been replaced. For example, the characterising part of claim 1 of the main request refused in the contested decision refers to a "unique message structure including an encrypted data block, a session ID, and a session encryption key, the encrypted data block being encrypted by the session encryption key, wherein the session ID and the session encryption key are generated by the server". This feature is not present in claim 1 of the sole request considered in communication A. It is also not examined in communication A in the context of the examination of the then pending further claims. The Board is aware of the fact that communication A does refer to "additional features" including encryption and the transmission of message data. The Examining Division argued that these additional features, which were not mentioned as part of the identified difference over the system known from D1, were merely "standard features of an encrypted communication", but provided no evidence for this allegation. As the wording of the relevant features has changed substantially in the refused requests, the reasoning given in communication A cannot apply to these refused requests.

Communication B merely summarises the telephone communication. This summary does not contain a detailed examination of the pending requests, nor does it comprise any specific analysis with respect to the unique message structure that is specified in the characterising part of claim 1 of all the refused requests. Communication B explains that document D2 mentions HTTPS (Hypertext Transfer Protocol Secure) and SSL (Secure Sockets Layer) in the same context and that therefore the skilled person "would implement all the different features of said protocols, even if not explicitly listed in document D2. For instance HTTPS is

implemented using SSL, that anticipates the new features of the filed sets of claims". This reasoning neither considers the claimed features in detail nor provides any understandable mapping between the features disclosed in document D2 and the features in the characterising part of the new requests. It also does not explain in detail why the skilled person would arrive without the exercise of inventive skills at "all the different features of said protocols". For example, it neither explains why the new features would be anticipated by SSL nor does it cite any document describing SSL.

In the present case, it is impossible to construct the applicable reasons by mosaicking various arguments from the file, as the parts of the file referenced in the decision do not in any way discuss the amended features of the refused requests in sufficient detail. Consequently, the Examining Division's reasoning lacks a logical chain of reasoning and thus cannot be reviewed by the Board.

8. Moreover, the appellant's detailed arguments in favour of the refused requests submitted with letter dated 16 January 2012 discuss the amended features related to the unique message structure in detail, but were not addressed in communication B (and could not be addressed in communication A). Consequently, the contested decision fails to take into account the relevant arguments put forward by the applicant.
9. Finally, the contested decision relies on document D2 as prior art, but there is no evidence on file for the alleged publication date of document D2. The appellant contested the alleged publication date during the written proceedings, but the decision is silent on this

point, which is crucial for the inventive step reasoning. While it is true that the appellant did not argue on this point in the later stage of the examination proceedings, it at no point agreed to the alleged publication date, so that this highly relevant issue remained contested in the proceedings before the Examining Division. Thus, the contested decision should have provided reasons why the Examining Division nevertheless considered the alleged publication date of document D2 as proven. Hence, there is a further insufficiency in the contested decision's reasoning.

10. As argued by the appellant during the written proceedings (see section III. above), D2 carries not only a date of 1 April 2002, but also a date of 3 March 2008 and indicates that additions to it were made after the filing date of 13 February 2006 of the present application. Hence, an alleged publication date before the filing date is prima facie doubtful for document D2 as a whole, and the appellant had good reason to contest the alleged publication date.

In the written proceedings (see section IV. above), the Examining Division replied by providing reasons concerning the modifications made to document D2 over time, but no evidence for the public availability of the part of document D2 describing the Proxytunnel at the alleged publication date of 1 April 2002 was introduced.

Document D2 contains a description of a program called Proxytunnel and refers in this context to the following information: "Version: 1.2 (Mon Apr 1 10:04:48 CEST 2002)". The document itself does not refer to this information as the publication date of its content related to Proxytunnel. This date could merely indicate

the version of the Proxytunnel program being described, for example. There is no evidence that the relevant content of document D2 was publicly available at the alleged publication date, or in what form. Hence, the Board considers that the alleged publication date of document D2 has not yet been established with a sufficient degree of certainty (see also decision T 2227/11 of 18 February 2016, point 2 of the reasons; decision T 545/08 of 24 March 2017, points 18 and 19 of the reasons).

Consequently, evidence concerning the public availability of the relevant content of document D2 before the effective filing date of the application should be provided if the document is to be used as prior art.

Remittal and reimbursement of the appeal fee

11. In view of the procedural deficiencies mentioned above, the case is to be remitted to the department of first instance for further prosecution (Article 11 RPBA). 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 and so incomplete 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:



I. Aperribay

R. Moufang

Decision electronically authenticated