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**Datasheet for the decision
of 1 October 2021**

Case Number: T 0354/16 - 3.5.04

Application Number: 06709729.5

Publication Number: 1847112

IPC: H04N1/32, G06F17/30, H04N1/00,
H04N1/21

Language of the proceedings: EN

Title of invention:

STORING INFORMATION FOR ACCESS USING A CAPTURED IMAGE

Patent Proprietor:

Mobile Acuity Limited

Opponent:

Cortexica Vision Systems Limited

Headword:

Relevant legal provisions:

EPC 1973 Art. 54(1), 54(2)
RPBA 2020 Art. 13(2), 13(1)

Keyword:

Main request, admittance (yes)

Main request, novelty (no)

First and second auxiliary requests filed at the oral proceedings, admittance (no)

Decisions cited:

Catchword:



Beschwerdekammern

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Case Number: T 0354/16 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 1 October 2021

Appellant: Mobile Acuity Limited
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 14 December
2015 revoking European patent No. 1847112
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chair B. Willems
Members: B. Le Guen
T. Karamanli

Summary of Facts and Submissions

- I. The appeal is against the decision of the opposition division to revoke European patent No. 1 847 112.
- II. The decision cited the following prior-art document:
- D7: WO 2004/038613 A1
- III. The patent was revoked on the following grounds:
- (a) The subject-matter of claims 1, 10 and 17 of the then main request and the then first and second auxiliary requests and claims 1 and 17 of the then sixth auxiliary request lacked novelty over the disclosure of document D7.
 - (b) Claims 10 and 17 of the then fifth and seventh auxiliary requests were not clear and contained subject-matter which extended beyond the content of the application as filed.
 - (c) The subject-matter of claim 10 of the then sixth auxiliary request lacked inventive step over the disclosure of document D7.
 - (d) The third and fourth auxiliary requests filed at the oral proceedings before the opposition division in replacement of the then third and fourth auxiliary requests were not admitted into the opposition proceedings because they were late filed and because their claims *prima facie* did not meet the requirement of clarity.

- IV. The **patent proprietor** ("**appellant**") filed notice of appeal.

With its statement of grounds of appeal, the appellant filed claims 1, 10 and 17 of a main request and of seven auxiliary requests; a copy of *"The Proprietor's observations in response to the Notice of Opposition EP-B-1847112"*; and a copy of the following document:

Richard Hartley et al., *"Multiple View Geometry in Computer Vision"*, Second Edition, Cambridge University Press, 2004, ISBN 0521 54051 8, pp. 10-11, 87-91 and 123-125

The appellant requested that the decision under appeal be set aside and that *"the patent be granted based on the main request or one of the auxiliary requests enclosed"* (see statement of grounds of appeal, page 1, point 1). The heading of the main request read *"Main request - maintain the granted claims"*.

- V. In the reply to the statement of grounds of appeal dated 22 July 2016, the **opponent** ("**respondent**") requested *"oral proceedings under EPC Article 116 in the event that the Appeal Board intends agreeing to any of the proprietor's requests. In particular, ... in the event that the Appeal Board intends issuing any decision whereby the patent is not revoked in its entirety"* (see page 1, point 1).

The respondent also filed a copy of the following document:

"Correspondence problem", Wikipedia, 7 May 2015, retrieved from <https://en.wikipedia.org/wiki/Correspondence_problem>

VI. A summons to oral proceedings was issued on 29 July 2020. In a communication under Article 15(1) of the revised version of the Rules of Procedure of the Boards of Appeal (RPBA 2020, OJ EPO 2021, A35) dated 12 February 2021 ("the board's communication"), the board gave, *inter alia*, the following preliminary opinion:

- (a) The respondent's general reference to its notice of opposition should not be taken into account by the board in accordance with Article 12(4) RPBA 2007.
- (b) The fact that a "correspondence" existed between two entities merely meant that a certain connection existed between these entities, and the fact that two entities "correspond[ed]" with each other merely meant that these entities matched or were similar or equal.
- (c) A proper analysis of novelty and inventive step with respect to claim 1 of the then main request could only be carried out once the following points of interpretation had been clarified:
 - (i) Did the fact that the server associated images with information and decided which information could be accessed by which users limit the interpretation of the "means for definition"?
 - (ii) Did the fact that the captured image corresponded to an image stored on the server limit the function of the camera?

(iii) Did the fact that the server associated the captured image with a stored image limit the interpretation of the "means for using the captured second image to access ... the user-defined information"? It needed to be established whether only the information previously defined by a specific user or information previously defined by any user was accessed.

(iv) Did the means for receiving the accessed user-defined information cover any means for receiving information of any type or format?

(d) The person skilled in the art would have been able to carry out the resemblance analysis disclosed in document D7 without undue burden.

(e) The board tended to share the opposition division's view that the subject-matter of claims 1, 10 and 17 of the main request was not new in view of the disclosure of document D7.

VII. By letter of reply dated 12 April 2021, the appellant filed sets of amended claims according to 19 requests. On page 2 of its letter, the appellant distinguished the sets of claims in the following manner:

(a) *"full sets of claims for the current requests (Main and Auxiliary 1 to 7) labelled 'current request' in clean and mark-up version"*

(b) *"full sets of claims for admittance and consequent conditional replacement of the current second auxiliary request labelled 'conditional new"*

auxiliary request' (A1, A2, A3, B1, B2, B3, C1, C2, C3) in clean and mark-up versions"

(c) "full sets of claims for conditional amendment to the current requests 1 and 3 labelled 'conditional new auxiliary request' in clean and mark-up versions"

The appellant also submitted arguments.

- VIII. In a communication dated 21 April 2021, the board invited the appellant to clarify the ranking of its requests.
- IX. In its reply dated 10 May 2021, the appellant submitted that it did not understand what was unclear about the requests made. The appellant annexed a copy of a PowerPoint presentation displaying the ranking of its requests.
- X. In a letter of reply dated 30 July 2021, the respondent filed further submissions.
- XI. By communication of the Registry dated 27 July 2021, the parties were informed that the oral proceedings appointed for 30 September 2021 would be held as mixed-mode oral proceedings.
- XII. The oral proceedings before the board started on 30 September 2021. As not all relevant issues could be discussed on that day, the parties and the board agreed to adjourn the oral proceedings to 1 October 2021.

On the first day of the oral proceedings, the appellant submitted that auxiliary request A3 filed by letter dated 12 April 2021 became the main request and that

the main request filed by letter dated 12 April 2021 was withdrawn.

On the second day of the oral proceedings, the appellant filed a new first auxiliary request based on auxiliary request C2 filed by letter dated 12 April 2021 and a new second auxiliary request based on auxiliary request A2 filed by letter dated 12 April 2021. The appellant also stated that the auxiliary requests filed by letter dated 12 April 2021 not discussed at the oral proceedings before the board were withdrawn.

XIII. The appellant's final requests were that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the claims of the main request filed by letter dated 12 April 2021 as auxiliary request A3 or, alternatively, on the basis of the claims of the first or second auxiliary request, both filed at the oral proceedings on 1 October 2021.

XIV. The respondent's final request was that the appeal be dismissed.

XV. Claim 1 of the appellant's **main request** reads as follows:

"A system (10) for storing information comprising:

a server (6) for control by a third party comprising:

means for receiving user-defined information from a first user different to the third party (3A, 3B) for access by multiple parties; and

means for associating the received user-defined information and at least a first portion of a first image in a database (8); and

means for providing access by a remote second user (3A 3B) to the user-defined information when a second image, captured by the remote second user, includes a portion corresponding to at least the first portion of the first image;

a first mobile client device controlled by the first user comprising an electronic user device (2A, 28) [sic], the electronic user device (2A, 2B) comprising:

means (16) for definition, by a user of the electronic user device, of user-defined information for access by multiple users via association at a server with at least a first portion of a first image; and

a camera for capturing a second image that includes a portion corresponding to at least the first portion of the first image; and

means (13) for using the captured second image to access, at the server via a network, the user-defined information previously defined by the user of the electronic user device and associated at the server with at least a first portion of a first image and for receiving in reply the accessed user-defined information previously defined by the user of the electronic device; and

a second mobile client device controlled by the second user comprising: an electronic user device (2A, 28) [sic], the electronic user device (2A, 2B) comprising:

means (16) for definition, by a user of the electronic user device, of user-defined information for access by multiple users via association at a server with at least a first portion of a first image; and

a camera for capturing a second image that includes a portion corresponding to at least the first portion of the first image; and

means (13) for using the captured second image to access, at the server via a network, the user-defined information previously defined by the user of the electronic user device and associated at the server with at least a first portion of a first image and for receiving in reply the accessed user-defined information previously defined by the user of the electronic device."

XVI. Claim 1 of the appellant's **first auxiliary request** reads as follows:

"A method of storing user-defined information for future access by multiple parties comprising, at a server (6) controlled by a third party:

receiving from a first originating party (3A, 3B) user-defined information that is defined by the first originating party and is for access by multiple parties;

associating the user-defined information received from the first originating party (3A, 3B) and at least a first portion of a first image in a database (8)) , wherein the user-defined information is added to first information already associated at the server with at

least the first portion of a first image in the database; and

providing access by a second party (3A, 3B) to the user-defined information and the first information, when a second image, captured by the second party, includes a portion corresponding to at least the first portion of the first image; and

providing access by the first originating party (3A, 3B) to the user-defined information and the first information, when a further image, captured by the first originating party, includes a portion corresponding to at least the first portion of the first image, the method further comprising:

extracting interest points from the portion of the second image;

extracting interest points from the first image;

providing access by the second party (3A, 3B) or the first originating party to the user-defined information, when the interest points extracted from the portion of the second image matches the interest points extracted from the first image."

XVII. Claim 1 of the appellant's **second auxiliary request** reads as follows:

"A method of storing user-defined information for future access by multiple parties comprising, at a server (6) controlled by a third party:

receiving from a first originating party (3A, 3B) user-defined information that is defined by the first

originating party and is for access by multiple parties;

associating the user-defined information received from the first originating party (3A, 3B) and at least a first portion of a first image in a database (8); and

providing access by a second party (3A, 3B) to the user-defined information, when a second image, captured by the second party, includes a portion corresponding to at least the first portion of the first image; and

providing access by the first originating party (3A, 3B) to the user-defined information, when a further image, captured by the first originating party, includes a portion corresponding to at least the first portion of the first image."

XVIII. The parties' arguments regarding the **admittance of the appellant's main request** (whose claims correspond to the claims of auxiliary request A3 filed by the appellant with its letter dated 12 April 2021, see point XII. above), in so far as relevant to this decision, may be summarised as follows.

Appellant's arguments

- (a) The requests filed by letter dated 12 April 2021 (which comprised auxiliary request A3) were clearly responsive to issues newly highlighted in the communication of the board and submitted at the earliest possible moment following that communication.
- (b) The main request was a good faith attempt to react to the interpretation of claim 1 of the main

request filed with the statement of grounds of appeal made under point 4.3.1 of the board's communication. The appellant had never been confronted with such a broad interpretation before. Claim 1 of the main request filed with the statement of grounds of appeal was the same as claim 1 of the main request forming the basis of the decision under appeal. The appellant had never understood how the opposition division interpreted the electronic user device defined in claim 1 of that request. The board's interpretation meant that claim 1 of that request defined nothing more than a mobile phone. It was not until reading point 4.3.1 of the board's communication that the appellant realised it only had a chance with a system claim. The main request, filed with reply dated 12 April 2021 as auxiliary request A3, had a single system claim.

- (c) Admitting the main request was not prejudicial to procedural economy because the main request had a single claim corresponding to dependent claim 21 of the main request filed with the statement of grounds of appeal.

Respondent's arguments

- (d) The appellant had failed to provide any reasons, let alone compelling ones, why there were exceptional circumstances. The appellant had not identified any new objection by the appeal board. A preliminary opinion expressed by a board could not constitute an exceptional circumstance justifying the admittance of a request as it was rare that a preliminary opinion of a board did not diverge from the impugned decision in some aspects.

- (e) If the board were to admit the main request, it might have to remit the case to the first-instance department for further prosecution. This would run against the principle of procedural economy, which was the main purpose of Article 13(2) RPBA 2020.
- (f) The appellant had failed to demonstrate that the issues raised by the respondent and the board had been resolved. The appellant had not addressed the comments raised in points 4.3.3 to 4.3.5 of the board's communication on whether the association, at the server, of the captured image with a stored image and the associations of images with information had any limiting effect on claim 1 of requests A1, A2 and A3.

XIX. The parties' arguments regarding the **interpretation of claim 1 of the appellant's main request** may be summarised as follows.

Appellant's arguments

- (a) The means of the server "*for associating the received user-defined information and at least a first portion of a first image in a database (8)*" and the "means (16)" of an electronic user device "*for definition, by a user of the electronic user device, of user-defined information for access by multiple users via association at a server with at least a first portion of a first image*" implied the presence of a software-implemented "man-machine interface" in the "means (16)" that allowed a user to remotely control the association, at the server, of arbitrary user-defined information with a desired image. The "means (16)" necessarily took

into account the format of the message it sent to the server to ensure that the correct association was made.

- (b) The means of the server "*for receiving user-defined information*" and the "means (13)" of a user electronic device necessarily comprised a computer program adapted to execute a handshake protocol.
- (c) Although the camera of an electronic user device could be interpreted as encompassing a standard camera, it would be inconsistent with the concept of the "mind willing to understand" to interpret the "means (16)" and the "means (13)" of the electronic user devices merely as input means and means adapted to transmit an image and receive information. Such an interpretation would amount to striking through sections of the claim.
- (d) The term "portion" in the definition of the means of the server "*for providing access by a remote second user (3A 3B)*" excluded the whole second image.
- (e) Terms used in patent documents should be given their normal meaning in the relevant art, unless the description gave them a special meaning. The appellant had filed evidence as to the normal meaning of "correspondence" in the relevant art. The board seemed to give an illogical, technically meaningless and "acontextual" interpretation of the term "correspondence" which had no justification within any of the documents that formed part of the appeal.

- (f) The Wikipedia article entitled "*Correspondence problem*" - cited during the first-instance proceedings - and the textbook "*Multiple View Geometry in Computer Vision*" - a copy of which had been annexed to the statement of grounds of appeal - provided evidence that the person skilled in the art would have read the expression "portion corresponding" in the definition of the last means of the server to imply that the portions of the first and second images had interest points in the pixel domain based on which a homography between the two images had been estimated.

Respondent's arguments

- (g) The expression "*for access by multiple users via association at a server with at least a first portion of a first image*" in the definition of the "means (16)" did not require any linkage between this means and the server since the association could be made entirely at the server. Moreover, the claim was silent on the structure or format of the messages sent to the server. The "means (16)" was merely a means for inputting user-defined information possibly comprising a means of sending this information to a server.
- (h) What happened at the server in the definition of the "means (13)" of an electronic user device did not limit the "means (13)", which was merely a means of sending messages between the electronic user device and a server.
- (i) The term "portion" did not exclude that the whole second image could be considered.

- (j) The term "*corresponding*" should not be attributed any special meaning in claim 1. The claim did not mention the "correspondence problem".

XX. The parties' arguments regarding the **reproducibility of the content of the disclosure of document D7** can be summarised as follows.

Appellant's arguments

- (a) The subject-matter described in document D7 could not be regarded to form part of the state of the art pursuant to Article 54(1) EPC because the information given in this document was not sufficient to enable the person skilled in the art to carry out a resemblance analysis between two objects. It was not established that the *Viisage* software mentioned in D7 was available to the public at the filing date of document D7. Moreover, document D7 did not explain how to adapt this software for a resemblance analysis.
- (b) Whether different parameters were weighted to different extents was no more than a black box and did not enable reproducibility unless the parameters and their use were identified and the manner of weighting was explained.
- (c) Although principal component analysis ("PCA") was mentioned in the paragraph bridging pages 15 and 16 of document D7, the respondent had not provided any proof that the person skilled in the art would have known how to find corresponding portions of two images using PCA where "portions" excluded the whole images.

Respondent's arguments

- (d) The paragraph bridging pages 15 and 16 of document D7 specified that it was possible to use PCA to perform the resemblance analysis. PCA had been known for many years before the publication date of document D7. The burden was on the appellant to provide evidence that the person skilled in the art would not have known how to perform the resemblance analysis using PCA.

XXI. The parties' arguments regarding **novelty of the subject-matter of claim 1 of the appellant's main request over the disclosure of document D7** can be summarised as follows.

Appellant's arguments

- (a) The third paragraph on page 21 of document D7 (cited under point 2.1.5 of the impugned decision and under point 6.3 of the board's communication) should not be read in isolation. This passage did not directly and unambiguously disclose that facts could be added to the database by the user for download.
- (b) D7 disclosed that owner-defined information could be downloaded from the database and that user-defined information could be uploaded to the factual database. However, D7 did not directly and unambiguously disclose the upload and download of user-defined information by the same person.
- (c) The passage on page 16 of document D7, lines 22 to 28 disclosed the uploading of new facts to the server by a user. However, the document as a whole

did not directly and unambiguously disclose the subsequent downloading of these facts by a user. It was not inevitable that all facts in the factual database were linked and available for download. The passage on page 15, lines 18 to 21 only referred to a linked item. There could be several items linked to an object. Facts could be used for purposes other than downloading. The passage on page 16 of document D7, lines 22 to 28 specified that the user could gain access to additional services in the service server. The passages on page 5, lines 20 to 23, page 8, lines 6 to 21 and page 22, lines 20 to 26 specified user-related data that was uploaded to the server and used for an entirely different purpose than for a subsequent download by a user.

- (d) Document D7 did not disclose multiple mobile client devices.

Respondent's arguments

- (e) Document D7 disclosed a first embodiment on pages 14 and 15 in which a user sent an image of their face to a server and received in return a result message containing the best matching object from an object database stored on the server together with "*information in a linked item in the factual database*" also stored on that server. The passage on page 13, lines 12 to 15 specified that the information could be "*name, sex, age, length, weight, profession, hair colour, eye colour, description of the person, curriculum vitae etc.*". Document D7 did not suggest that only some of the information stored in an item was downloaded to a user. D7 disclosed only one purpose for the

information stored in the factual database, namely downloading to the user. Thus, the person skilled in the art was left with no option but to interpret the *"information in a linked item in the factual database"* on page 15, lines 20 and 21 as referring to all the information comprised in the linked item.

- (f) A second embodiment was described on page 16, lines 22 to 25 and Figure 4, in which the user, after receiving the result of the resemblance analysis, could provide more information to the service server after contacting a WAP server included in the service server. Lines 26 to 28 on page 16 further specified that *"[t]he service handler 202 store[d] the newly supplied information in the factual database 205 and the object database"*. This clearly meant that new facts could be uploaded by a user to the factual database. Since the passage on page 16, lines 8 to 15 specified that the factual database had the same function in the second embodiment as in the first, it was implicit that the newly provided pieces of information stored in the factual database were stored in the item linked to the object the facts related to. Therefore, these facts would be downloaded to a user if that object was found to be the one best matching an object subsequently submitted by a user.
- (g) The passage of document D7 on page 4, lines 12 to 15 disclosed multiple user communication devices transferring data to a common service server.

XXII. The parties' arguments regarding the **admittance of the appellant's first auxiliary request** can be summarised as follows.

Appellant's arguments

- (a) The claims of the first auxiliary request were based on the claims of auxiliary request C2 filed by letter dated 12 April 2021 in reply to the board's communication. The only difference was that claims 1 and 12 had been deleted.
- (b) The claims of auxiliary request C2 filed by letter dated 12 April 2021 themselves corresponded to the claims of the second auxiliary request that had formed the basis of the decision under appeal, with the exception of the following amendments.
 - (i) The claims of auxiliary request C2 clearly specified that user-defined information was uploaded and downloaded by the same user.
 - (ii) The claims of auxiliary request C2 also specified that the second image included a portion corresponding to at least the first portion of the first image if interest points extracted from the portion of the second image matched interest points extracted from the first image.
- (c) There were exceptional circumstances justifying the admittance of the first auxiliary request into the appeal proceedings:
 - (i) The amendments according to the claims of auxiliary request C2 had been added in

reaction to an unforeseeable interpretation made under points 6.5.2 and 6.5.3 of the board's communication. In view of the evidence provided on the interpretation of the term "corresponding", the appellant could not have expected that the board would adhere to the broad interpretation given by the opposition division. The appellant did not understand the opposition division's reasoning.

- (ii) This appeal case was an extremely difficult one, as evidenced by the length of the oral proceedings before the board.

Respondent's arguments

- (d) Not every comment made in a board's communication constituted exceptional circumstances. It was normal that the facts that matter were discussed by the board from a slightly different perspective.
- (e) In view of the board's communication, the appellant was aware of the fact that the interpretation of the term "corresponding" was an issue. The appellant could have filed the first auxiliary request at the beginning of the oral proceedings. There were no exceptional circumstances justifying their filing on the second day of the appeal hearing. The circumstances were entirely of the appellant's own making.
- (f) Regarding requests B1, B2, B3, C1, C2 and C3, the appellant did not provide reasons why the amendments resolved the addressed issues.

XXIII. The parties' arguments regarding the **admittance of the appellant's second auxiliary request** can be summarised as follows.

Appellant's arguments

- (a) The claims of the second auxiliary request were based on the claims of auxiliary request A2 filed by letter dated 12 April 2021 in reply to the board's communication, except that claims 1 and 13 had been deleted.
- (b) There were exceptional circumstances justifying the admittance of the second auxiliary request. The filing of the second auxiliary request was a reaction to the comments made under point 6.5.2 of the board's communication, as well as to discussions that had taken place during the oral proceedings on the interpretation of claim 1 of the main request filed by letter dated 12 April 2021 and claim 1 of the current main request. These comments and discussions introduced new aspects not presented before. The claims of the second auxiliary request clarified that the user-defined information uploaded by a user was downloaded to the same user. The second auxiliary request should be admitted into the appeal proceedings for the same reasons as the main request because the facts were the same.
- (c) The "*means for providing access by a remote second user (3A, 3B) to the user-defined information*" and the "*means for providing access by the first user (3A, 3B) to the user-defined information*" in claim 8 of the second auxiliary request were not intended to be different means.

Respondent's arguments

- (d) There was no exceptional circumstance justifying the admittance of the second auxiliary request. It was unclear which aspects of the discussion at the appeal hearing were new to the appellant. If the appellant considered that point 6.5.2 of the board's communication introduced a surprising new aspect, it should have filed the second auxiliary in reply to this communication rather than on the second day of the oral proceedings.
- (e) In comparison to the server defined in claim 17 of the main request filed with the statement of grounds of appeal, the server defined in claim 8 of the current second auxiliary request comprised additional "*means for providing access by the first user (3A, 3B) to the user-defined information*". It was *prima facie* unclear how this means was different from the "*means for providing access by a remote second user (3A, 3B) to the user-defined information*" specified in claim 17 of the main request filed with the statement of grounds of appeal. Therefore, the appellant had not demonstrated that claim 8 of the second auxiliary request *prima facie* overcame the novelty objection raised under point 2.1.5 of the decision under appeal with respect to claim 17 of the then main request. Under point 6.6 of its communication, the board had confirmed the opposition division's finding.

Reasons for the Decision

1. The appeal is admissible.
2. *Appellant's main request, admittance (Article 13(2) RPBA 2020)*
 - 2.1 The claims of the main request correspond to the claims of auxiliary request A3 filed by the appellant by letter dated 12 April 2021, i.e. after notification of the summons to oral proceedings. Since this notification was issued after the date on which the RPBA 2020 entered into force (i.e. 1 January 2020; see Article 24(1) RPBA 2020), Article 13(2) RPBA 2020 applies to the question of whether to admit the main request into the appeal proceedings (see Article 25(1) and (3) RPBA 2020).
 - 2.2 In accordance with Article 13(2) RPBA 2020, any amendment to a party's appeal case made after notification of a summons to oral proceedings is, in principle, not to be taken into account unless there are exceptional circumstances which have been justified with cogent reasons by the party concerned.
 - 2.3 The board disagrees with the respondent that a preliminary opinion expressed by a board cannot constitute an exceptional circumstance justifying the admittance of a request (see point XVIII.(d) above). The fact that a board's preliminary view expressed in the communication under Article 15(1) RPBA 2020 differs in result from the view expressed in the contested decision does not usually represent an exceptional circumstance within the meaning of Article 13(2) RPBA 2020 (see also T 752/16, point 3.4 of the Reasons). A

preliminary opinion unfavourable to the parties can in principle be expected at any time in the proceedings before the boards of appeal before the decision is announced. However, there may be exceptional circumstances not only when the board raises a new objection but also when the board departs from the impugned decision on a significant aspect that is new and could change the discussion.

- 2.4 In the case in hand, the comments made under point 4.3 of the board's communication raised new questions regarding the proper interpretation of claim 1 of the then main request. In particular, the board noted that claim 1 was directed to an electronic user device and questioned whether the references to the operations carried out at the server specified in that claim had any limiting effect on the interpretation of the electronic user device to which claim 1 was directed (see point VI.(c) above). This question was a significant new aspect that affected the subsequent discussion on novelty (see also point 6.5.2 of the board's communication). Therefore, the board considers that the comments under point 4.3 of its communication under Article 15(1) RPBA 2020 represent an exceptional circumstance within the meaning of Article 13(2) RPBA 2020.
- 2.5 The appellant's main request contains a single claim directed to a system comprising a server and two mobile client devices. Operations carried out at the server clearly have a limiting effect on the interpretation of the system. Thus, this request is a good faith attempt to react to the comments made under point 4.3 of the board's communication (see also the appellant's argument under point XVIII. above, item (b)).

2.6 The board notes that the criterion whether an amendment to a party's case is detrimental to procedural economy is mentioned in Article 13(1) RPBA 2020 but not in Article 13(2) RPBA 2020. In the case of an amendment to a patent, the same applies to the criterion whether the party has demonstrated that such an amendment *prima facie* overcomes the issues raised by the board.

It is further noted that when exercising its discretion under Article 13(2) RPBA 2020, the board *may* also rely on the criteria set out in Article 13(1) RPBA 2020, but it is not required to do so (see, for example, decisions T 954/17, point 3.10 of the Reasons; T 989/15, point 16.2 of the Reasons; T 752/16, point 3.2 of the Reasons; and Document CA/3/19, section VI, Explanatory remarks on Article 13(2), fourth paragraph).

2.7 In the case in hand, the board finds that the presence of exceptional circumstances is a sufficient reason for exercising its discretion under Article 13(2) RPBA 2020 in the appellant's favour. Thus, the board does not need to consider the criteria of Article 13(1) RPBA 2020 (see parties' arguments under items (c), (e) and (f) of point XVIII. above).

2.8 The board, exercising its discretion under Article 13(2) RPBA 2020, decided to admit the appellant's main request into the appeal proceedings.

3. *Appellant's main request, interpretation*

3.1 Claim 1 of the main request specifies a system comprising a server ("server (6)"), a first mobile client device and a second mobile client device. The

two mobile client devices each comprise the same electronic user device.

3.2 In this and the next section, the board refers to the means of the server (6) using the following nomenclature:

- S1 means for receiving user-defined information from a first user different to the third party (3A, 3B) for access by multiple parties
- S2 means for associating the received user-defined information and at least a first portion of a first image in a database (8)
- S3 means for providing access by a remote second user (3A 3B) to the user-defined information when a second image, captured by the remote second user, includes a portion corresponding to at least the first portion of the first image

3.3 The board refers to the means of the electronic user devices using the following nomenclature:

- U1 means (16) for definition, by a user of the electronic user device, of user-defined information for access by multiple users via association at a server with at least a first portion of a first image
- U2 a camera for capturing a second image that includes a portion corresponding to at least the first portion of the first image
- U3 means (13) for using the captured second image to access, at the server via a network, the user-defined information previously defined by the user of the electronic user device and associated at the server with at least a first portion of a first image and for receiving in reply the

accessed user-defined information previously
defined by the user of the electronic device

3.4 The board shares the respondent's view that none of the features put forward by the appellant at the oral proceedings (see point XIX. above, items (a) to (f)) are implied by the wording of claim 1 (see the respondent's arguments under point XIX. above, items (g) to (j)). The reasons are the following.

3.5 *Interpretation of the means U1 and U3*

It is established case law that the concept of the "mind willing to understand" (see appellant's argument under point XIX., item (c)) does not require that a broad term be interpreted more narrowly. It only means that technically illogical interpretations should be excluded (see Case Law of the Boards of Appeal of the European Patent Office, 9th edition 2019 ("Case Law"), II.A.6.1). A non-specific definition in a claim should be given its broadest technically sensible meaning (see Case Law, I.C.4).

An unspecified association between information and (at least a first portion of) a first image may be made at a server without any control from an external device. Thus, the board shares the respondent's view that the definition of the means S2 and U1 does not necessarily imply that the association at the server is remotely controlled by the user electronic device, let alone that the means U1 takes into account specific messaging formats (see the respondent's arguments under point XIX. above, item (g)).

In view of this, the board interprets claim 1 broadly as also encompassing the situation in which the

association between the user-defined information and the (first portion of the) first image is made at the server without any control from the user electronic device.

Additionally, the board notes that communications between two devices can take place without a preliminary handshake between these devices. Thus, the board sees no reason to read claim 1 as implying that the server and the electronic user devices are adapted to carry out a handshake.

3.6 *Interpretation of the term "portion" (means S3)*

The board shares the respondent's view that the term "portion" in the definition of the means S3 does not exclude the whole second image (see point XIX. above, item (i)). Paragraph [0016] of the description of the patent specifies that *"the first portion [of the first image] may be the **whole** or a part of an area associated with the **first image**"* (emphasis by the board). If a portion of the first image may be the whole first image, the board sees no reason to read the expression *"second image ... portion"* as excluding the whole second image. As a matter of fact, according to paragraph [0053] of the patent, in the process for retrieving digital content from the database, *"the whole image rather than a part (the target region) of the captured image is processed to determine the interest points"*. Moreover, according to paragraphs [0064] and [0065], the verification whether a "scene image" and a "mode image" match requires the calculation of a normalised cross correlation measure between these images. The "scene image" is the (whole) image captured by a user (see paragraph [0051]).

In view of this, the board interprets the expression "*second image ... includes a portion correspond to at least the first portion of the first image*" in the definition of the means S3 as encompassing the situation in which the whole second image corresponds to the whole first image.

3.7 *Interpretation of "corresponding" (means S3)*

Although the description of the patent describes an embodiment in which a normalised cross correlation measure between a "model image" and a "scene image" is computed after determining a homography using interest points of a "scene user image key" and a "model user image key" (see Figure 4 and paragraphs [0060] to [0068]), the appellant decided not to include any of these features in claim 1 of the main request. As argued by the respondent (see point XIX. above, item (j)), claim 1 also does not mention the "correspondence problem".

It is established case law that, in proceedings before the EPO, where the patentee has the opportunity to cut down its claims to meet stricter limits in the description, the scope of a claim should not be cut down by implying into it features which appear only in the description as this would deprive the claims of their intended function (see Case Law, II.A.6.3.4).

The board considers it inconsistent with proper claim interpretation to read the expression "*portion corresponding*" as implying that the portions of the first and second images have interest points in the pixel domain based on which a homography between the two images had been estimated.

4. *Reproducibility of the content of the disclosure of document D7*
- 4.1 It is established case law that subject-matter described in a document can only be regarded as having been made available to the public, and therefore as comprised in the state of the art pursuant to Article 54(2) EPC [1973], if the information given to the skilled person is sufficient to enable them, at the relevant date of the document, to practise the technical teaching which is the subject of the document, also taking into account the general knowledge at that time in the field to be expected of them (see also Case Law, I.C.4.11).
- 4.2 Irrespective of whether the *Viisage* software mentioned in D7 was available to the public at the filing date of D7 (see the appellant's argument under point XX. above, item (a)), the board shares the opposition division's view that the person skilled in the art would have been able to carry out the resemblance analysis without undue burden (see point 2.1.5 of the impugned decision, last paragraph).
- 4.3 For the board, the question whether the person skilled in the art would have known how to find corresponding portions of two images using PCA where "portions" excluded the whole images (see the appellant's argument under point XX. above, item (c)) need not be answered because the board interprets the expression "*second image ... includes a portion correspond to at least the first portion of the first image*" in the definition of the means S3 as encompassing the situation in which the whole second image corresponds to the whole first image (see point 3.6 above).

- 4.4 Document D7 explains that "*[i]n order to make the resemblance analysis, it is possible to use the face recognition such as 'Eigenfaces', which is also called PCA (Principal Component Analysis)*" (see page 15, lines 4 to 7). At the oral proceedings before the board, the appellant did not dispute that the person skilled in the art would have known how to obtain the principal components of an image before the priority date of D7. Therefore, the only question to be answered is whether the person skilled in the art would have known how to compare the principal components of two images to obtain a measure of the degree of resemblance between these two images. The board is of the view that the person skilled in the art would have known how to perform this comparison because (i) the set of principal components of an image represents a one-dimensional vector and (ii) the person skilled in the art would have known how to compare two one-dimensional vectors to obtain a measure of the degree of their resemblance. How a comparison between two one-dimensional vectors could be refined by applying weights to different parameters (see the appellant's argument under point XX. above, item (b)) is not relevant to whether the person skilled in the art would have known how to obtain "a" measure of the degree of their resemblance.
- 4.5 In view of the above, the board finds that the subject-matter described in document D7 is to be regarded as part of the state of the art pursuant to Article 54(2) EPC 1973.
5. *Appellant's main request, novelty (Article 54(1) EPC 1973)*

- 5.1 An invention is to be considered new if it does not form part of the state of the art (Article 54(1) EPC 1973).
- 5.2 It is established case law that for an invention to lack novelty, it must be clearly and directly derivable from the state of the art, and all its features - not just the essential ones - must be known from the state of the art. The disclosure of a publication is determined by what knowledge and understanding can and may be expected of the average skilled person in the technical field in question (see Case Law, I.C.4).
- 5.3 Document D7 discloses a system (see Figure 6) for storing information (see Figures 3 and 6: "*Factual database*" and "*Object database*") comprising a server (see Figure 3: "*Service server 100*" and Figure 6: "*Service server 405*") for control by a third party (see page 13, lines 6 and 7: "*owner of the service server*").

As submitted by the respondent (see point XXI. above, item (g)), the passage on page 4, lines 12 to 15 discloses multiple user communication devices transferring data to a common service server.

- 5.4 In a **first embodiment** implemented by the system described in document D7, "[t]he owner of the service server 100, which can be a service provider, can create an item in the object database 104 by entering, for instance, a portrait of a known person. The portrait is entered as an object which is 10 described by a number of parameters. Moreover, a link to an item in the factual database 105 is created, in which data about the known person can be stored. This can be name, sex, age, length, weight, profession, hair colour, eye colour, description of the person, curriculum vitae

etc. The information can be created as an XML document (eXtensible Markup Language) to make facts" (see D7, pages 14, lines 6 to 17).

The general method implemented in the first embodiment is described on page 13, lines 25 to 37 of document D7:

"The user records in step 40 data of a real object using the communication device 1. The communication device 1 transmits in step 41 recorded data to the service server 100. The service server 100 extracts in step 42 a comparison object from the recorded data. The comparison object is represented by a number of predetermined parameters which describe the recorded object. The service server 100 makes a resemblance analysis in step 43 and compares the comparison object with objects previously stored in the service server. The service 35 server transmits in step 44 result data containing information about the resemblance analysis to a result unit 1; 100."

In the detailed description on pages 14 and 15, the "recorded data" transmitted to the service server is a digital image of the user's face (see page 14, lines 7 and 8), and the stored objects describe different faces (see page 15, line 3).

- 5.5 Document D7 discloses **a second embodiment** on page 16 in which the user, after receiving the result of the resemblance analysis, can supply more information to the service server after contacting a WAP server included in the service server (see page 16, lines 22 to 25 and Figure 4). Lines 26 to 28 on page 16 further specify that "[t]he service handler 202 stores the newly supplied information in the factual database 205 and the object database".

The passage on page 16, lines 9 to 13 indicates that in the second embodiment "[t]he message receiver 201, the service handler 202, the object recogniser 203, 10 the object database 204, the factual database 205 and the message transmitter 206 have **the same function as** corresponding components that have been described above in the first embodiment and Fig. 3" (emphasis added by the board). The passage from lines 13 to 15 further specifies that "[t]he method in the second embodiment is **the same as** has been described above in the first embodiment" (emphasis added by the board).

- 5.6 It is common ground between the parties that this sentence means that a user (i.e. not only the owner of the service server) can upload new facts to the factual database (see point XXI. above, items (c) and (f)).
- 5.7 However, the appellant disputed that document D7 directly and unambiguously disclosed the situation in which facts uploaded to the service server by a user were subsequently downloaded to a (for example, the same) user (see point XXI. above, items (a) to (c)).
- 5.8 The board agrees with the respondent that in the second embodiment described on page 16 of document D7, it is implicit that the information uploaded to the server is stored in "the" item linked to the object the facts relate to (see point XXI. above, item (f)). The reasons are the following.

In the first embodiment described in document D7, information stored in the factual database are facts about an object stored in the object database that are included in a single item linked to the object (see D7, page 13, lines 10 to 12: "a link to **an** item in the

factual database 105 is created, in which data about the known person can be stored"; emphasis added by the board).

In the second embodiment, the service handler and the factual database have the same function as in the first embodiment (see point 5.5 above).

In view of this, it is implicit for the board that facts uploaded by the user are also facts about an object stored in the object database that are included in a single item linked to the object, namely the item including the data about that object. This means that if the user-uploaded facts concern an object previously uploaded by the owner of the service server, these facts will be stored together with the owner-defined facts in the item of the factual database linked to that object.

- 5.9 The board also agrees with the respondent that document D7 discloses only one purpose for the information stored in the factual database, namely downloading to the user (see point XXI. above, item (e)). None of the passages cited by the appellant (page 5, lines 20 to 23, page 8, lines 6 to 21 and page 22, lines 20 to 26; see point XXI. above, item (c))) refers to information stored in the factual database. The board cannot identify any passage in document D7 specifying a purpose for the stored facts other than downloading to the user: the passages on page 15, lines 14 to 36, page 18, lines 2 to 6, page 18, lines 17 to 21 and page 19, lines 19 to 24 all describe that information collected from the factual database is sent to the user in a result message.

- 5.10 Therefore, the board concludes that the person skilled in the art is left with no option but to interpret the "*information in a linked item in the factual database*" on page 15, lines 20 and 21 as referring to all the information comprised in the linked item (see also the respondent's argument, point XXI. above, item (e)).
- 5.11 Since under point 5.8 above the board found that it was implicit that the user-uploaded facts were stored together with the owner-defined facts in the item of the factual database linked to an object, it follows from the previous point that the user-uploaded facts will be downloaded to a user when the object to which they relate is found to be the one best matching an object subsequently submitted by the user, as stated by the respondent (see point XXI. above, item (f)). This is true whether or not the user is the same person who uploaded the facts (see point XXI. above, item (b)).
- 5.12 This means that the feature which, in the appellant's view, renders the system of claim 1 new over the system of document D7 (see point 5.7 above) is actually disclosed in document D7.
- 5.13 In light of the above, the board concludes that the subject-matter of claim 1 of the main request is not new in view of the disclosure of document D7.
6. *Appellant's first auxiliary request, admittance (Article 13(2) RPBA 2020)*
- 6.1 The first auxiliary request was filed at the oral proceedings before the board, i.e. after notification of the summons to oral proceedings. Hence, Article 13(2) RPBA 2020 applies to the question of whether to admit this request into the appeal

proceedings (see also point 2.1 above).

- 6.2 The board agrees with the respondent that the preliminary opinion set out under points 6.5.2 to 6.5.3 of the board's communication does not constitute exceptional circumstances within the meaning of Article 13(2) RPBA 2020 (see point XXII. above, item (d)). It was already clear from the proceedings before the opposition division and the reasoning in the decision under appeal that the opposition division interpreted the term "*corresponding*" broadly (see point 2.1.5 of the decision under appeal). The appellant might not have understood the opposition division's exact reasoning. However, the fact that, in the statement of grounds of appeal, the appellant argued that the opposition division did not properly construe "correspondence" (see page 6) and filed evidence about how "correspondence" should, in its view, be interpreted demonstrates that the appellant was aware that the term had been interpreted broadly. Moreover, the comments made by the board under points 6.5.2 and 6.5.3 of its communication did not concern the interpretation of the expression "portion corresponding". Thus, the arguments put forward by the appellant do not justify adding, in reply to the board's communication, features relating to the extraction and matching of interest points from the portion of the second image and from the first image into claim 1 of the second auxiliary request on which the decision was based (see the features identified under point XXII.(b)(ii) above). Furthermore, the board cannot identify any causal link between the length of the oral proceedings before the board and the filing of the current first auxiliary request.

6.3 In view of the above, the board does not consider the reasons put forward by the appellant to be cogent and does not recognise any "exceptional circumstances" within the meaning of Article 13(2) RPBA 2020 which could justify the late submission of the first auxiliary request. Therefore, the board, exercising its discretion under Article 13(2) RPBA 2020, decided not to admit the first auxiliary request into the appeal proceedings.

7. *Appellant's second auxiliary request, admittance (Article 13(2) RPBA 2020)*

7.1 The second auxiliary request was filed at the oral proceedings before the board, i.e. after notification of the summons to oral proceedings. Hence, Article 13(2) RPBA 2020 applies to the question of whether to admit this request into the appeal proceedings (see also point 2.1 above).

7.2 The board agrees with the respondent that if the appellant considered that point 6.5.2 of the board's communication introduced a surprising new aspect, it should have filed the current second auxiliary request promptly in reply to the board's communication rather than on the second day of the oral proceedings before the board (see point XXIII. above, item (d)).

7.3 Moreover, the facts put forward by the appellant are not the same as those taken into consideration when admitting the main request.

The main request had a single claim directed to a system. According to the appellant's submissions, the filing of the main request was a reaction to the board's broad interpretation of the electronic user

device, which, in the appellant's view, meant that claim 1 defined nothing more than a mobile phone. It was not until reading point 4.3.1 of the board's communication that the appellant realised that it only had a chance with a system claim (see point XVIII. above, item (b)).

The second auxiliary request does not have a system claim, it only has server claims and claims for storing information at a server. The two system claims of auxiliary request A2, on which the second auxiliary request was based (see point XXIII. above, item (a)), are no longer in the second auxiliary request.

7.4 Therefore, the appellant's arguments do not convince the board that there are exceptional circumstances justifying the admittance of the second auxiliary request.

7.5 Additionally, when exercising its discretion under Article 13(2) RPBA 2020, the board may rely on the criteria set out in Article 13(1) RPBA 2020 (see point 2.6 above).

In the case of an amendment to a patent, one of the criteria set out in Article 13(1) RPBA 2020 is *"whether the party has demonstrated that any such amendment, prima facie, overcomes the issues raised by another party or by the Board"*.

7.6 In comparison with claim 17 of the main request filed by letter dated 12 April 2021, claim 8 of the current second auxiliary request further specifies *"means for providing access by the first user (3A, 3B) to the user-defined information when a further image, captured*

by the first user, includes a portion corresponding to at least the first portion of the first image".

- 7.7 Claim 17 of the main request filed by letter dated 12 April 2021 corresponds to claim 17 of the main request filed with the statement of grounds of appeal, except for the correction of a typo. Claim 17 of the main request filed with the statement of grounds of appeal corresponds to claim 17 of the main request forming the basis of the decision under appeal.

It follows that the subject-matter of claim 17 of the main request filed by letter dated 12 April 2021 is the same as the subject-matter of claim 17 of the main request on which the decision was based.

- 7.8 The opposition division held that the subject-matter of claim 17 of the then main request was not new in view of the disclosure of document D7 (see point III.(a) above). In its communication, the board had indicated that it tended to share the opposition division's view (see point VI.(e) above).

- 7.9 The board agrees with the respondent that it is *prima facie* unclear how the "*means for providing access by the first user (3A, 3B) to the user-defined information*" in claim 8 of the current second auxiliary request distinguish themselves from the "*means for providing access by a remote second user (3A, 3B) to the user-defined information*" specified in claim 17 of the main request filed with the statement of grounds of appeal. At first glance, the fact that the same means provides access **by the first user** to the user-defined information in addition to providing access **to a remote second user** to that information does not imply any further limitation on the server. In view of this, the

board agrees with the respondent that the appellant has not demonstrated that claim 8 of the second auxiliary request *prima facie* overcomes the novelty objection raised in the decision under appeal with respect to claim 17 of the then main request. The board had confirmed this novelty objection in its communication.

7.10 In view of the above, the board, exercising its discretion under Article 13(2) RPBA 2020, decided not to admit the second auxiliary request into the appeal proceedings.

8. Conclusion

8.1 Since none of the appellant's requests on file is allowable, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



K. Boelicke

B. Willems

Decision electronically authenticated