

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 21 March 2022**

Case Number: T 2483/19 - 3.5.07

Application Number: 05021580.5

Publication Number: 1770550

IPC: G06F17/30

Language of the proceedings: EN

Title of invention:

Method and electronic device for obtaining an evaluation of an electronic document

Applicant:

Sony Ericsson Mobile Communications AB

Headword:

Document evaluation/SONY ERICSSON MOBILE COMMUNICATIONS

Relevant legal provisions:

EPC Art. 56, 84, 113(2)
EPC R. 49, 50(1), 139
RPBA 2020 Art. 13(1), 13(2)

Keyword:

Correction of error - not allowed

Support in the description - main request (yes)

Inventive step - (no) - main request and auxiliary requests I
to III (no)

Amendment after summons - auxiliary request IV (not admitted)

Decisions cited:

T 0003/90, T 1480/12



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 2483/19 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 21 March 2022

Appellant: Sony Ericsson Mobile Communications AB
(Applicant) 221 88 Lund (SE)

Representative: Banzer, Hans-Jörg
Kraus & Weisert
Patentanwälte PartGmbB
Thomas-Wimmer-Ring 15
80539 München (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 1 April 2019
refusing European patent application
No. 05021580.5 pursuant to Article 97(2) EPC**

Composition of the Board:

Chair J. Geschwind
Members: R. de Man
C. Barel-Faucheux

Summary of Facts and Submissions

I. The appellant (applicant) filed an appeal against the decision of the examining division refusing European patent application No. 05021580.5. The application was filed on 3 October 2005 and does not claim the priority of an earlier application.

II. The contested decision cited, *inter alia*, the following documents:

D1: US 2003/0172349 A1, 11 September 2003;

D2: US 6 163 778 A, 19 December 2000;

D3: US 6 847 967 B1, 25 January 2005.

The examining division decided that claims 1 and 7 of the main request and auxiliary requests I, II and III were not supported by the description as required by Article 84 EPC. The subject-matter of claims 1 to 14 of the main request and claims 1 to 13 of auxiliary requests I, II and III lacked inventive step over document D2. Auxiliary request IV was not admitted into the proceedings for being late filed and not clearly allowable.

III. In its statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request or, in the alternative, one of the auxiliary requests I to III considered in the decision under appeal.

It additionally requested that the expression "wherein the reference is once selected of a group comprising"

in claim 1 of all requests be replaced under Rule 139 EPC with the expression "wherein the reference is one selected of [sic] the group comprising".

- IV. In a communication accompanying the summons to oral proceedings, the board pointed out that the appellant was responsible for filing corrected application documents.

It expressed the preliminary view that the objection of lack of support was not justified but that the subject-matter of claim 1 of the main request and of auxiliary requests I to III lacked inventive step over document D2. The board also suggested that the subject-matter of claim 1 of each request lacked inventive step over a notorious general-purpose computer.

- V. In response to the board's communication, the appellant filed a new auxiliary request IV.

- VI. In a subsequent letter, the appellant informed the board that it would not take part in the oral proceedings.

- VII. The board cancelled the oral proceedings.

- VIII. The appellant requests that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request or, in the alternative, of one of auxiliary requests I to IV.

- IX. Claim 1 of the main request as considered in the decision under appeal reads as follows:

"A method for obtaining an evaluation of at least one electronic document, comprising the steps:

acquiring (502) a first electronic document including at least one reference to at least a second electronic document, wherein the reference is once [sic] selected of [sic] a group consisting of a link, a hyperlink, an electronic address and a storage location of the second electronic document,

retrieving (503) the reference to the second electronic document from said first electronic document,

sending (504) to a server (130) a request for an evaluation of the second electronic document associated with the retrieved reference, and

receiving (505) from the server (130) a response including the result of the evaluation."

- X. Claim 1 of auxiliary request I as considered in the decision under appeal differs from claim 1 of the main request in that the following text has been added at the end of the claim:

"wherein the first electronic document and the second electronic document are a web-page or an e-mail."

- XI. Claim 1 of auxiliary request II as considered in the decision under appeal differs from claim 1 of auxiliary request I in that the following text has been inserted after "associated with the retrieved reference":

", the evaluation being based on the contents of the second electronic document".

In addition, "an e-mail" has been replaced with "a e-mail".

- XII. Claim 1 of auxiliary request III as considered in the decision under appeal differs from claim 1 of auxiliary

request I in that the following text has been inserted after "associated with the retrieved reference":

", the request comprising context data comprising data for influencing the evaluation of the second electronic document".

In addition, "an e-mail" has been replaced with "a e-mail".

XIII. Claim 1 of auxiliary request IV reads as follows:

"A method of operating a mobile radio terminal for obtaining an evaluation of at least one electronic document, comprising the steps:

acquiring (502) a first electronic document including at least one reference to at least a second electronic document, wherein the reference is onc [sic] selected from a group consisting of a link, a hyperlink, an electronic address and a storage location of the second electronic document,

retrieving (503) the reference to the second electronic document from said first electronic document,

sending (504) to a server (130) a request for an evaluation of the second electronic document associated with the retrieved reference, the request being sent without having retrieved the second electronic document at the mobile radio terminal, the evaluation being based on the contents of the second electronic document, and

receiving (505) from the server (130) a response including the result of the evaluation,

wherein the first electronic document and the second electronic document are a web-page or a [sic] e-mail."

XIV. The appellant's arguments, where relevant to the decision, are discussed in detail below.

Reasons for the Decision

1. It is well established in the case law of the boards of appeal that the appellant's statement that it would not take part in the oral proceedings is to be understood as a withdrawal of its request for oral proceedings in the absence of any indication to the contrary (see decision T 3/90, OJ EPO 1992, 737, Reasons 1, and Case Law of the Boards of Appeal, 9th edition, 2019, III.C. 4.3.2). The decision can therefore be taken without holding oral proceedings.
2. The application relates to obtaining an evaluation of an electronic document.
3. *The appellant's request for correction*
 - 3.1 In its statement of grounds of appeal, the appellant requested a correction under Rule 139 EPC of claim 1 of the main request and of auxiliary requests I to III. However, it did not file corresponding corrected application documents. Nor did the appellant file such documents in response to the board's communication pointing out that the appellant was responsible for filing them.
 - 3.2 According to Rules 49 and 50(1) EPC, amended application documents are to be presented on separate sheets and to meet certain form requirements. This is essential for further processing of the application and to avoid doubt about what exactly is requested to be granted (see decision T 1480/12, Reasons 5).

The need for such a requirement is especially evident in the present case, where the appellant requested that "wherein the reference is once selected of a group comprising" in claim 1 be corrected to "wherein the reference is one selected of a group comprising", but the actual wording of claim 1 does not use "comprising" but "consisting". Is the corrected version of the claim to state "comprising" or "consisting"?

Since the appellant refrained from filing corrected application documents, the board cannot allow the requested correction.

- 3.3 In its statement of grounds of appeal, the appellant expressly maintained the main request and auxiliary requests I to III considered in the contested decision before "additionally" requesting the correction.

In the specific circumstances of this case the board therefore does not consider the appellant's request for correction to mean that it no longer agrees with the text of the main request and auxiliary requests I to III as considered in the decision under appeal in the event the correction is not allowed. These requests (see sections IX. to XII. above) are thus still to be considered by the board (Article 113(2) EPC).

- 3.4 The board notes that there is no doubt that the phrase "wherein the reference is once selected of a group consisting of ...", present in claim 1 of the main request and auxiliary requests I to III, has to be interpreted as "wherein the reference is one selected from a group consisting of ..." for the purpose of assessing inventive step.

Main request

4. *The invention as defined by claim 1*

4.1 Claim 1 is directed to a method for obtaining an evaluation of an electronic document.

4.2 In an initial step, a first electronic document is acquired. This document includes a reference, such as a (hyper)link, to a second electronic document. The reference is "retrieved", i.e. extracted, from the first electronic document.

4.3 Next, a request for an evaluation of the second electronic document is sent to a server. Presumably, this request includes the reference. A response including the result of the evaluation is then received from the server.

5. *Support in the description - Article 84 EPC*

5.1 The examining division decided that claims 1 and 7 lacked support in the description essentially because the claimed "evaluation of the second electronic document" encompassed any type of evaluation, whereas the description did not disclose even one example of an evaluation.

5.2 The board notes that the term "evaluation" at least has literal support in the description. Moreover, since the claim does not set any requirement on the result of the evaluation, the board has no doubt that the skilled person is able to implement a simple procedure for evaluating an electronic document. Such a procedure could, for example, simply return the number of

characters of the document (thereby evaluating the length of the document).

5.3 It is true that the claim is not limited to such simple ways of evaluating a document and in fact encompasses elaborate evaluation methods which are not specifically disclosed in the application as filed. But this in itself is not a problem of lack of support (nor of insufficiency of disclosure). In fact, it is normal for a claim to define the scope of protection in terms that positively define the essential features of the invention and to encompass embodiments having further characteristics that are neither mentioned in the claim nor disclosed in the application (and could even constitute a patentable further development). For example, a claim to a method which involves transmitting information over a computer network need not be restricted to networking technologies that were available at the effective filing date of the application.

5.4 In the present case, any method falling within the scope of claim 1 includes steps of sending a request for an evaluation to a server and receiving a response including the result of the evaluation from the server. This evaluation may be elaborate but may also be very simple. The significance of these steps is that some evaluation result is requested and received, not that the evaluation of documents is made possible for the first time. If the claimed combination of steps turns out to have inventive merit, there is no reason why the appellant should be denied protection for the application of these steps to an evaluation which was not yet available to the skilled person at the filing date of the application. Hence, since the skilled person would have had no difficulty in implementing

some form of document evaluation, the board considers that the claimed method is supported by the description (and sufficiently disclosed).

- 5.5 In its decision, the examining division referred to the Guidelines for Examination in the EPO, F-IV, 6.2 ("Extent of generalisation"), which states that "an invention which opens up a whole new field is entitled to more generality in the claims than one which is concerned with advances in a known technology". It argued that the evaluation of a document cannot be considered to be a new field of technology in view of documents D1 to D3 and further documents which had been cited by the appellant.

However, this sentence in the Guidelines for Examination cannot be understood as meaning that an invention which does not open up a new field of technology may not be claimed in general terms, and this is confirmed by the cited passage in the Guidelines for Examination when read as a whole.

- 5.6 Hence, the refusal of the main request based on lack of support in the description (Article 84 EPC) is not justified.

6. *Inventive step*

- 6.1 Document D2 relates to determining the "viability" of hypertext links (column 1, lines 6 to 8). The viability of a link is the probability that the link will work (column 1, lines 45 to 48; column 6, lines 51 to 55).
- 6.2 In its statement of grounds of appeal, the appellant did not dispute that link viability information qualified as an evaluation result of the document being

linked to, namely as an evaluation of its accessibility.

The description of the application on page 11, lines 17 to 22, confirms that the evaluation of a document may be based on data other than the contents of the document, such as the number of links to the document. Hence, "evaluation" is to be understood broadly.

6.3 Document D2, in column 8, lines 15 to 19 and 23 to 24, and Figure 6, discloses a process which comprises page loops 602a and link loops 604a for processing each page of a web site stored on a server (e.g. document A stored on server 185a) and, for each page, each link included in the page (e.g. a link to document B on server 185b). For each link, the "link viability" of the link is calculated (column 8, lines 17, to column 9, line 5), and a visual indicator representing the link viability is included in the web page by modifying its HTML code (column 9, lines 6 to 23).

6.4 Hence, this passage discloses acquiring, from the server 185a, a first electronic document A including a reference in the form of a link to a second electronic document B and, implicitly, retrieving the reference from the first electronic document. It further discloses evaluating the second electronic document associated with the retrieved reference by calculating a link viability value.

6.5 The subject-matter of claim 1 differs from this prior art in that evaluating the second electronic document involves sending an evaluation request to another server and receiving a response including the result of the evaluation from that server.

6.6 At the filing date of the application, client-server application architectures in which a computer system acting as a client offloads certain computational tasks to another computer system acting as a server were well-known in the art. In such an architecture, the client submits a computation request to the server and receives a response including the result of the computation from the server.

The distinguishing features represent a straightforward and thus obvious application of such a well-known client-server architecture.

6.7 The appellant argued that the distinguishing features mitigate bandwidth limitations. However, modifying the method of document D2 in accordance with the distinguishing features only increases bandwidth usage, namely for transmitting the request and response.

6.8 The subject-matter of claim 1 of the main request therefore lacks inventive step over document D2 (Article 56 EPC).

Auxiliary request I

7. Claim 1 of auxiliary request I adds that the first and second electronic documents are "a web page or an e-mail".

8. Since the electronic documents in document D2 are web pages, the subject-matter of claim 1 of auxiliary request I also lacks inventive step over document D2 (Article 56 EPC).

Auxiliary request II

9. Claim 1 of auxiliary request II further adds that the evaluation is based on the contents of the second electronic document.

10. Since the evaluation score of a document has no technical significance in the context of the claim, basing the score on the document's content (e.g. its cognitive content) in itself does not achieve any technical effect.

Moreover, the appellant acknowledged that basing the evaluation of a document on the document's content had been known at the filing date of the application (see page 15 of the statement of grounds of appeal).

11. The appellant argued that basing the evaluation on the contents of the document meant that the document had to be retrieved. This feature therefore put more emphasis on the problem of bandwidth usage.

However, downloading a document to the computing entity that evaluates its contents involves bandwidth usage independent of which computing entity carries out the evaluation. If the evaluation is offloaded to a server, it is evident that any bandwidth usage related to the evaluation also moves to the server.

In this context, the board notes that nothing in claim 1 implies any unexpected technical advantage of moving bandwidth usage from the device carrying out the method to the server.

12. The appellant further argued that the "deep inspection" of a web page for an evaluation based on its content

was expensive in terms of the required computational resources. It could not be assumed that the skilled person would have considered offloading such a content-based "deep" evaluation to a server.

However, the claimed evaluation of the content of the document may be as computationally simple as counting the number of characters of the document. Moreover, the point of offloading a computational task to a server is to make use of the server's computational resources.

13. In the letter filed in response to the board's communication, the appellant presented a number of arguments in support of inventive step in connection with both auxiliary request II and the newly filed auxiliary request IV. However, since these arguments are based on the features added to claim 1 of auxiliary request IV, they do not apply to auxiliary request II.
14. Hence, the subject-matter of claim 1 of auxiliary request II lacks inventive step (Article 56 EPC).

Auxiliary request III

15. Claim 1 of auxiliary request III adds to claim 1 of auxiliary request I that the evaluation request comprises context data for influencing the evaluation of the second electronic document.
16. Since the evaluation score of a document has no technical significance in the context of the claim, taking into account contextual factors in the evaluation of the document does not achieve any technical effect. Once the non-technical decision to take into account contextual factors has been taken, it is obvious to implement that decision by including

these factors as "context data" in the evaluation request.

17. The subject-matter of claim 1 of auxiliary request III therefore lacks inventive step (Article 56 EPC).

Auxiliary request IV

18. Claim 1 of auxiliary request IV adds to claim 1 of auxiliary request II that the method operates a "mobile radio terminal" and that the offload request is "sent without having retrieved the second electronic document at the mobile radio terminal".

19. *Admission into the appeal proceedings*

- 19.1 Auxiliary request IV was filed after the notification of the summons to oral proceedings. Its admission into the appeal proceedings is therefore to be assessed under Article 13(1) and (2) RPBA 2020. The latter provision stipulates that any amendment to the appellant's appeal case made after the notification of the 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 appellant.

An example of an exceptional circumstance mentioned in the explanatory remarks with respect to Article 13(2) RPBA 2020 (see Rules of Procedure of the Boards of Appeal, Supplementary publication 2, OJ EPO 2020) is an objection raised for the first time in the board's communication.

- 19.2 The appellant argued that auxiliary request IV had to be admitted because it addressed the fresh issues

raised in points 13 and 19.1 of the board's communication.

- 19.3 In point 19.1 of its communication, the board suggested that the subject-matter of claim 1 of the main request and of auxiliary requests I to III lacked inventive step over a notorious general-purpose computer because these claims appeared to be directed to a method of running, on a notorious general-purpose computer, a computer program making no technical contribution beyond the well-known offloading of a non-technical task to a server.

Since the board does not base its decision on a lack of inventive step over a notorious general-purpose computer, this fresh issue is not a reason for admitting new requests.

- 19.4 In point 13 of the communication the board noted that, since the evaluation score of a document appeared to have no technical significance in the context of claim 1 of auxiliary request II, basing the score on the document's content in itself appeared to achieve no technical effect.

In point II.3.2 of its decision, the examining division, assuming that the evaluation served the purpose of ranking documents, stated that ranking web pages based on their importance was not a technical problem and that the evaluation of documents for that purpose was not technical either. Hence, no new issue was raised in point 13 of the board's communication.

In any event, the board fails to see how the amendments made in auxiliary request IV could address the issue, as claim 1 of auxiliary request IV still does not use

the result of the evaluation for any purpose, let alone a technical purpose.

- 19.5 In the board's view, the amendments made are rather an attempt at addressing the board's argument (in point 14 of its communication) that nothing in claim 1 of auxiliary request II implies an unexpected technical advantage of moving bandwidth usage from the device carrying out the method to the server.

This argument was not made in the contested decision because the appellant argued that the claimed invention reduced bandwidth consumption neither when it filed the second auxiliary request with its submissions in preparation for the oral proceedings before the examining division nor during those oral proceedings.

A difference between the board's and the examining division's reasoning of the same objection, in this case lack of inventive step over document D2, normally does not amount to an exceptional circumstance within the meaning of Article 13(2) EPC. This applies in particular to a "fresh" refutation by the board of an argument newly raised in the statement of grounds of appeal in connection with auxiliary request II.

- 19.6 Since in many of the embodiments described in the application the invention is implemented on a mobile terminal (see also original claims 15 and 16 and claims 12 and 13 of the main request), since the description on page 19, lines 13 to 29, discusses the specific advantages of the invention when implemented on a mobile device, and since this limitation represents a clear distinction from the server-based method disclosed in document D2, the board can only conclude that an independent claim 1 including a

limitation to a mobile terminal could have been filed earlier and that it was a deliberate decision of the appellant to seek broader protection. While seeking broader protection is in no way objectionable, the consequence is that the broader claims are more vulnerable to attack.

- 19.7 As a separate issue, the board notes that the added feature specifying that the offload request is "sent without having retrieved the second electronic document at the mobile radio terminal" does not clearly have a basis in the application as filed.

In its letter, the appellant confirmed that the feature had no literal support in the application as filed but argued that it was directly and unambiguously derivable from the overall description and in particular from paragraphs [0045], [0046] and [0050] of the A1 publication. From the statement in paragraph [0050] that "[i]t will in general be easy to decide whether it is worth following a certain reference to another electronic document located further away from or beyond the initially acquired document" and the fact that this decision was based on the result of the evaluation, it followed that the second electronic document was retrieved (by "following" the reference to it) when the evaluation was already available at the mobile terminal.

In the board's view, the cited paragraphs *prima facie* do not rule out that the second electronic document is retrieved earlier and therefore do not disclose that it is not. Moreover, even if the appellant's reading of these paragraphs were accepted, they would link the non-retrieval of the second electronic document to the moment at which the evaluation is received at the

mobile radio terminal, whereas the feature added to claim 1 links the non-retrieval to the moment at which the offload request is sent to the server.

Hence, auxiliary request IV *prima facie* raises a new issue under Article 123(2) EPC (Article 13(1), fourth paragraph, RPBA 2020).

19.8 In view of the above, auxiliary request IV is not admitted into the appeal proceedings.

20. *Conclusion*

Since none of the requests admitted into the appeal proceedings is allowable, the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



S. Lichtenvort

J. Geschwind

Decision electronically authenticated