

Internal distribution code:

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

**Datasheet for the decision
of 6 July 2022**

Case Number: T 3000/19 - 3.5.07

Application Number: 11741809.5

Publication Number: 2537358

IPC: G06F17/30

Language of the proceedings: EN

Title of invention:

Devices and methods for searching data on data sources
associated with registered applications

Applicant:

BlackBerry Limited

Headword:

Searching data with registered applications/BLACKBERRY

Relevant legal provisions:

EPC Art. 111(1), 127, 128, 131(1)
EPC R. 65, 103(1)(a), 111(2), 143(2), 147
RPBA 2020 Art. 11

Keyword:

Appealed decision - sufficiently reasoned (no)
Remittal to the department of first instance
Remittal - fundamental deficiency in first instance proceedings (yes)
Prior-art evidence - accessibility over time

Decisions cited:

T 0278/00, T 1066/13, T 3071/19, T 0013/20
Council of Europe: "Electronic evidence in civil and administrative proceedings - Guidelines and explanatory memorandum", July 2019

Catchword:

When a video retrieved from the internet is used as prior-art evidence for refusing a patent application, its content, in a form suitable for reviewing the decision, and metadata evidence demonstrating when and how it was made available to the public should be preserved and made accessible over time to interested parties and judicial bodies.



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 3000/19 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 6 July 2022

Appellant: BlackBerry Limited
(Applicant) 2200 University Avenue East
Waterloo, ON N2K 0A7 (CA)

Representative: MERH-IP Matias Erny Reichl Hoffmann
Patentanwälte PartG mbB
Paul-Heyse-Strasse 29
80336 München (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 12 June 2019
refusing European patent application
No. 11741809.5 pursuant to Article 97(2) EPC**

Composition of the Board:

Chair J. Geschwind
Members: P. San-Bento Furtado
M. Jaedicke

Summary of Facts and Submissions

- I. The appeal lies from the decision of the examining division to refuse European patent application No. 11741809.5, which was filed as international application PCT/CA2011/050094, published as WO 2011/097741.
- II. The decision under appeal made *inter alia* reference to the following documents, which were introduced into the proceedings during examination:
- D4 "Mac OS X Leopard Overview: Mac OS X Leopard Dictionary", YouTube, 9 July 2008, retrieved from <https://www.youtube.com/watch?v=JskACcyZbMs>;
 - D5 "Exclude directory from Spotlight index via the command line", 5 November 2009, retrieved from <https://discussions.apple.com/thread/2223487>;
 - D6 "Policy files enabling Applet access to user files", 13 November 2004, retrieved from http://web.archive.org/web/20041113035245/http://www.ccp4.ac.uk/jwc/image_applet/Policy_file_examps_ccp4.html;
 - D7 "Ultra-mobile PC", 29 November 2006, retrieved from <https://en.wikipedia.org/w/index.php?title=Ultramobile.PC&oldid=90824861>.
- III. The examining division decided that the subject-matter of claim 1 of the main request and first to fifth auxiliary requests lacked inventive step over documents D4 and D5 "forming a single piece of prior art disclosing the use of 'Spotlight' on 'Mac OS X'", in combination with common general knowledge and notoriously known features. The examining division

cited documents D6 and D7 and "Google" to illustrate common general knowledge or notoriously known features.

- IV. In its statement of grounds of appeal, the appellant maintained the requests considered in the decision under appeal and filed new sets of claims as sixth to eighth auxiliary requests.

The appellant argued that document D4, an educational video for an end-user, was not an enabling disclosure and was therefore not appropriate as a starting point for assessing inventive step. It reasoned in detail that there were further distinguishing features, also with regard to D4, other than those identified in the decision under appeal. The appellant contested that document D5 was an enabling disclosure, that documents D4 and D5 could be considered a single disclosure in combination, and that document D6 represented common general knowledge. It argued that the need to combine so many documents for the inventive-step objection, including documents D4, D5, D6 and D7, reinforced the appellant's position that the claimed subject-matter was inventive.

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 one of the first to eighth auxiliary requests. In the notice of appeal, the appellant requested oral proceedings if the board intended to dismiss the appeal.

- V. In a telephone conversation, the appellant was informed that the board intended to remit the case to the department of first instance for further prosecution.

VI. In a letter of reply, the appellant informed the board that it agreed to remittal for further prosecution without holding oral proceedings.

Reasons for the Decision

1. The invention concerns a mobile wireless communications device and a method for searching data on data sources associated with registered applications.
2. The grounds for refusal of the decision under appeal are based on lack of inventive step when taking as starting point documents D4 and D5 "forming a single piece of prior art disclosing the use of 'Spotlight' on 'Mac OS X'".

Document D4

3. In the decision under appeal, the prior-art evidence cited by the examining division as "document D4" refers to a video titled "Mac OS X Leopard Overview : Mac OS X Leopard Dictionary", retrieved from the YouTube website and, at the same time, a document including a screenshot of a web browser visiting that YouTube website.
4. The video of D4 was cited for the first time in the examining division's communication of 24 January 2018, which provided the URL for accessing the video on the internet (see section II. above). The document with the screenshot was annexed to the communication and is part of the electronic file. The reproduction of the screenshot is of poor quality, but the first video frame (with time stamp "0:00/1:21") can be seen. The document also shows YouTube information about the video, including the publication date of 9 July 2008

used by the examining division. It does not show any other information relevant to the case.

5. The decision's reasoning refers to video frames at "0:00", "0:56", "1:02" and "1:11" and video frame sequences "0:29-0:52" and "0:59-1:02". However, the web page corresponding to the URL indicated in the citation of document D4 is no longer functioning, so the board cannot assess on its own the relevant parts of the video evidence D4.
6. Essentially the same situation was dealt with in appeal case T 3071/19 against the decision to refuse a parallel application of the same family as the current application. In that case, the decision to refuse the application was based on the same evidence D4 as in this case (D2 in that decision). As the responsible board explained in T 3071/19, Reasons 6, under these circumstances, the board cannot review the correctness of the contested decision's reasoning in so far as it relies on what is shown in the YouTube video evidence. Nor can the board assess the appellant's arguments that this online video is not an enabling disclosure and that there are further distinguishing features other than those recognised in the decision under appeal.
7. The board notes that in the novelty analysis of the impugned decision (point 3.4), in essentially the same way as in the communications since 24 January 2018, the examining division briefly described the content of some of the cited parts of video D4 and quoted one short sentence of the respective audio at "1:02". In its replies and in the grounds of appeal, the appellant provided comments on the video content and a few screenshots. This, however, does not provide sufficient information about the content of the video and does not

allow the board to make its own assessment of the relevant evidence.

Internet disclosure as prior-art evidence

8. An internet disclosure may be regarded as part of the state of the art within the meaning of Article 54(2) EPC. However, examining divisions should make sure that an internet disclosure used as state of the art is reliable in terms of both the publication date (see decision T 1066/13, Reasons 4 to 4.3; see also the Guidelines for Examination in the EPO, G-IV, 7.5.1) and continued accessibility to its content in the version made publicly accessible on that date (see decision T 3071/19, Reasons 5; see also T 0013/20, Reasons 4).

9. Due account should be taken of the rights of third parties and the public to inspect the file under Article 128 EPC. Since the content on the internet changes over time, when "electronic evidence" such as an internet document or a video is used as prior-art disclosure against the patentability of an application, appropriate measures should be taken for collecting, storing and preserving this evidence and making it accessible under suitable conditions for the judiciary, or interested parties, for example, the applicant, an opponent, their respective representatives or a member of the public.

Use of electronic evidence in proceedings

10. In respect of the quite new field of electronic evidence, the Council of Europe has published guidelines on using electronic evidence in civil and administrative proceedings (see "Electronic evidence in civil and administrative proceedings - Guidelines and

explanatory memorandum") adopted by the Committee of Ministers of the Council of Europe on 30 January 2019. Even though these guidelines and the explanatory memorandum are not binding on the EPO or the boards of appeal of the EPO, they provide important practical guidance about handling electronic evidence in the jurisdictions of member states.

- 10.1 The "Guidelines of the Committee of Ministers to member States on electronic evidence in civil and administrative proceedings" ("guidelines on electronic evidence", pages 5 to 11) and the explanatory memorandum (starting on page 13) concern the use of electronic evidence, including data from web pages (page 15, point 11). According to the explanatory memorandum, point 28, "electronic evidence, by its very nature, is fragile and can be altered, damaged or destroyed by improper handling or examination" and for these reasons "special precautions may be taken to properly collect this type of evidence".
- 10.2 It is stated, as a fundamental principle, that electronic evidence should be collected, structured and managed in a manner that facilitates its forwarding to other courts, in particular appellate courts. It "should be collected in an appropriate and secure manner, and submitted to courts using reliable services, such as trust services" and using procedures established by the member states for its secure seizure and collection (guidelines on electronic evidence, points 10, 11 and 14).
- 10.3 Furthermore, electronic evidence should be stored with standardised metadata so that the context of its creation is clear and the integrity of the evidence is preserved. Readability, integrity and accessibility should be guaranteed over time (guidelines on

electronic evidence, points 25 to 27; exploratory memorandum, points 26, 37 and 44 to 46). Courts are advised, through active management, to restrict the electronic evidence to what is strictly required for deciding a case. It is also recommended that electronic data be retained in its original format. A screen printout from a web browser is not considered reliable evidence as it is nothing but a copy of a screen display which can be modified in a very simple manner (exploratory memorandum, points 27, 29 and 35).

Use of online video evidence in the EPO - prior art D4

11. In the current case, document D4 consisting of a screenshot (see point 4 above) included in the file is clearly insufficient for the judicial review of the decision under appeal. Furthermore, it is not apparent from the file whether the video's content has been collected, preserved and/or stored in a manner which guarantees accessibility for members of the judiciary or interested parties.
12. The board could also not find publicly available information about whether and how, in proceedings before the EPO, the content of an internet video used as prior-art evidence in examination should be preserved and made accessible to external parties or the boards of appeal.
 - 12.1 The information about a European patent application or patent is recorded in the European Patent Register which, in accordance with Article 127 EPC, is kept by the EPO and open to inspection by the public. Following Rule 147(1) and (2) EPC, files relating to a European patent application or patent are constituted, maintained and preserved in electronic form, in accordance with the technical and administrative

arrangements determined by the President of the EPO. Any files shall be preserved for at least five years from the end of the year in which the application is refused, deemed withdrawn, or the patent is revoked or lapses (Rule 147(4) EPC). In case appeal or opposition proceedings have taken place, the files will not be destroyed before 25 years after the date of filing (OJ EPO 1990, page 365).

- 12.2 In accordance with Rule 65 EPC, the European search report is to be transmitted to the applicant together with copies of any cited documents. The European Patent Register includes entries for new documents coming to light after the European search report was drawn up (Rule 143(2) EPC, OJ EPO, 2014, A86).
13. The Guidelines for Examination in the EPO (G-IV, 7.5) underline that, for the sake of a valid patent, it is often crucial to cite publications only obtainable from internet websites. With regard to the search report, the Guidelines for Examination (B-X, 11.6) indicate that video and/or audio media fragments available on the internet are converted into a non-patent literature citation, and that the bibliographic data contains the URL of the original location on the internet. At the time the decision under appeal was written, the Guidelines for Examination (November 2018, B-X, 11.6) further indicated that such fragments should be cited as a screenshot of the first page of the internet citation. In the present case, the non-patent literature citation is document D4 with a screenshot of the video. The examining division has thus followed the indications in the Guidelines.

However, a number of screenshots taken from a video, let alone a single screenshot, fail to preserve in its original format the necessary video content to ensure

that the video evidence required for review and public inspection is available later. Consequently, the procedure in accordance with the Guidelines for Examination, B-X, 11.6 is insufficient for preserving video evidence and guaranteeing its accessibility over time as needed for EPO proceedings or for further judicial proceedings before the boards of appeal of the EPO or national courts (Article 131(1) EPC).

The board could not find any other passages of the Guidelines for Examination describing how to preserve the content of multimedia disclosure used as prior art in the proceedings before the EPO and to guarantee its accessibility for external parties or judicial bodies.

Combination of documents D4 and D5

14. Since the board does not have access to the content of the video of D4, it cannot fully assess whether documents D4 and D5 can be considered to form a single disclosure. The board notes however that, as explained in decision T 3071/19, Reasons 7, only in exceptional circumstances can two documents be considered to form a single disclosure. In the decision under appeal, the examining division merely stated that document D5 was considered to form a single disclosure with D4 because "it discloses a core feature of Spotlight". This argument is not sufficient, since it does not explain why a skilled person watching the video of D4 would necessarily have been guided to consult document D5 (or vice versa).

Document D6

15. Document D6 was cited in the decision under appeal to argue that "the skilled person would be aware of commonly known access control functionality to maintain

data security (e.g., as shown in document D6 which discloses the restriction of access to certain local file system locations for certain applications by means of granting access rights associated to these applications, exemplifying common general knowledge)".

15.1 In its grounds of appeal, the appellant contested that document D6 represented common general knowledge. In the appellant's view, document D6 was an enabling disclosure because it described the use of Java classes and indicated the type of content of the files to be used (and where in the directory the file was to be placed). However, the disclosure was directed to enabling Applet access to user files, and little if any detail was given in relation to the policy files. The disclosure was very narrow and specific to this feature. Such a narrow/specialist disclosure did not represent the common general knowledge of the skilled person.

15.2 Document D6 discloses two policy files enabling Applet access to user files that the author has "set up for personal use at home". One file is for Windows XP and "enables read access of files in the folder C:\Documents...\image_applet\data". The other file is for Linux and "enables access of files in all subdirectories of /home/jwc as indicated by the '-'."

The board agrees with the appellant that the disclosure of document D6 is too specialised to be proof of "commonly known access control functionality to maintain data security". This does not mean that "access control functionality to maintain data security" is not commonly known, only that using document D6 does not support such a claim by the examining division.

Substantial procedural violation

16. In accordance with Rule 111(2) EPC, decisions open to appeal have to be reasoned. The decision's reasoning should enable the appellant and, in the event of an appeal, the board to assess whether the decision is correct (see decision T 278/00, Reasons 2).

In the case at hand, the appellant was able to prepare its appeal case because at the time the appeal was filed, it still had access to the video of D4 on which the decision was based. However, the board cannot assess whether the contested decision is correct because that evidence is no longer accessible.

The electronic file only includes a single screenshot printout, comments about the video content by both the examining division and the appellant, a quote from the audio of D4 provided by the examining division, and a few screenshots included in the appellant's written submissions. The board is hence not in a position to make its own assessment of the relevant evidence in its original presentation in an objective and independent manner.

In view of this, the board concludes that the decision under appeal is not sufficiently reasoned and violates Rule 111(2) EPC. This constitutes a substantial procedural violation. The measures recommended by the Guidelines for Examination of November 2018, B-X, 11.6, which were followed by the examining division, did not adequately preserve the relevant electronic evidence to guarantee accessibility over time.

Remittal

17. In view of the substantial procedural violation, special reasons present themselves for remitting the case to the examining division for further prosecution (Article 11 RPBA 2020).

The case is thus to be remitted to the department of first instance under Article 111(1) EPC. Since the procedural violation resulted in the remittal of the case to the examining division without a substantive review of the merits of the decision, reimbursement of the appeal fee in full is equitable under 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 Chair:



G. Nachtigall

J. Geschwind

Decision electronically authenticated