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**Datasheet for the decision
of 26 October 2021**

Case Number: T 3071/19 - 3.5.07

Application Number: 11741807.9

Publication Number: 2537356

IPC: G06F17/30

Language of the proceedings: EN

Title of invention:

Devices and method for searching data on data sources
associated with a category

Applicant:

BlackBerry Limited

Headword:

Searching data/BLACKBERRY

Relevant legal provisions:

EPC Art. 111(1), 128

EPC R. 103(1)(a), 111(2)

Keyword:

Appealed decision - sufficiently reasoned (no)
Remittal to the department of first instance - fundamental
deficiency in first instance proceedings (yes)

Decisions cited:

T 0233/90, T 0278/00, T 2230/12, T 2707/16

Catchword:

A decision open to appeal is not reasoned within the meaning of Rule 111(2) EPC if it does not enable the board of appeal to review its correctness. A decision should therefore not rely on evidence accessible only at a web page which is not guaranteed to remain accessible and unchanged. Rather, it should be ensured that a person inspecting the file can reliably access the cited evidence.



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 3071/19 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 26 October 2021

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 July 2019
refusing European patent application
No. 11741807.9 pursuant to Article 97(2) EPC**

Composition of the Board:

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

Summary of Facts and Submissions

- I. The appellant (applicant) appealed against the decision of the examining division refusing European patent application No. 11741807.9, which was published as international application WO 2011/097739.
- II. The examining division decided that the subject-matter of claim 1 of the main request and of the first to third auxiliary requests lacked inventive step over document D2, which it cited as follows:

D2: "Mac OS X Leopard Overview : Mac OS X Leopard Dictionary", YouTube, 9 July 2008, XP054978034, retrieved from the Internet: URL: <https://www.youtube.com/watch?v=JskACcyZbMs>.

It further made reference to the following documents:

- D4: "Ultra-mobile PC", 29 November 2006, retrieved from https://en.wikipedia.org/w/index.php?title=Ultra-mobile_PC&oldid=90824861;
- D5: "Spotlight (software) - Wikipedia", 21 June 2009, retrieved from [https://en.wikipedia.org/w/index.php?title=Spotlight_\(software\)&oldid=297653666](https://en.wikipedia.org/w/index.php?title=Spotlight_(software)&oldid=297653666);
- D6: "Exclude directory from Spotlight index via the command line", 5 November 2009, retrieved from <https://discussions.apple.com/thread/2223487>;
- D7: "Improve Spotlight Searches with Search Operators in Mac OS X", 6 January 2010, retrieved from <http://osxdaily.com/2010/01/06/improve-your-spotlight-searches-with-search-operators/>.

III. In its statement of grounds of appeal, the appellant maintained the requests considered in the contested decision as its first to fourth auxiliary requests and filed new fifth to seventh auxiliary requests.

The appellant requested that the decision under appeal be set aside and, as its main request, that the case be remitted to the examining division for further prosecution ("main request") or, in the alternative, that a patent be granted on the basis of the claims of one of the first to seventh auxiliary requests. It requested oral proceedings in the event that the board intended to dismiss the appeal.

Reasons for the Decision

1. The application relates to searching data on mobile wireless communications devices.

Appellant's reasons for requesting remittal

2. In support of its request for remittal of the case to the examining division for further prosecution, the appellant submitted that the examining division had introduced document D4 only at the stage of the summons to oral proceedings and documents D5 to D7 less than two weeks before the date of the oral proceedings. The appellant had not had any chance to respond to the introduction of these documents in the first-instance proceedings.

3. The board notes that the appellant reacted to the late introduction of documents D4 to D7 not by requesting postponement of the oral proceedings but by informing the examining division that it would not attend them

and requesting that they be held in its absence. It therefore seems debatable that the request for remittal can be allowed for the reasons indicated by the appellant. However, this point need not be decided because the request for remittal has to be allowed for other reasons, as explained below.

Document D2

4. The decision's inventive-step reasoning relies primarily on document D2.

Document D2 is a screenshot of a web browser visiting the YouTube website. The video pane shows the first video frame (with time stamp "0:00 / 1:21") of a video titled "Mac OS X Leopard Overview : Mac OS X Leopard Dictionary". In the screenshot, the frame is unclear and does not appear to depict anything of relevance.

The decision's reasoning refers to video frames and video frame sequences at "0:06", "1:02" and "1:02-1:04". These frames are not part of document D2.

5. Apparently, the examining division intended the reader to read the decision in conjunction not with document D2 but with a playback of the video at the URL indicated in the decision's citation of document D2, i.e. <https://www.youtube.com/watch?v=JskACcyZbMs>.

Basing a crucial part of the reasoning of a decision on information accessible only at a particular internet web page is normally problematic, since there is no guarantee that the web page will continue to be accessible over time and that its content will remain unchanged after the decision has been taken.

6. In the present case, the web page corresponding to the URL indicated in the citation of document D2 is indeed no longer functioning (showing "Video unavailable"). The board therefore cannot review the correctness of the decision's reasoning in so far as it relies on what is shown in the YouTube video. Nor can it assess the appellant's argument that the video is not an enabling disclosure.

Documents D5, D6 and D7

7. The contested decision in various places also refers to documents D5, D6 and D7, apparently to explain and supplement what is shown in the YouTube video.

In response to the appellant's argument that the video was not an enabling disclosure, the examining division, in point 3.2 of its decision, explained that documents D5, D6 and D7 had been cited for "further exemplification" of how the "Spotlight" software shown in the video worked internally. According to the examining division, these documents formed "a common piece of prior art with D2", as they described the same software.

The board notes that documents D5, D6 and D7 together with either document D2 or the YouTube video evidently do not form a single disclosure. The board also doubts that this is an exceptional case in which a skilled person watching the video would necessarily have been guided to consult documents D5, D6 and D7 in order to understand certain aspects of the video's disclosure (see e.g. decisions T 233/90, Reasons 3.3; T 2230/12, Reasons 8.3), and the contested decision does not contain arguments in support of such an exceptional case anyway.

Perhaps what the examining division had in mind was that the video and the documents could serve as evidence of what was disclosed by the public release of a certain version of the "Spotlight" software. However, the decision should then have carefully argued this position and clearly identified exactly which disclosure was intended to serve as the closest prior art.

In any event, the board does not consider it appropriate, for the first time in these grant proceedings, to investigate itself whether an inventive-step objection could be based on documents D5, D6 and D7 alone.

Substantial procedural violation

8. According to 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, also the board of appeal, to assess whether the decision is correct (see decision T 278/00, Reasons 2).

In the present case, the decision's reliance on evidence that is not available to the board (see points 4. to 6. above) prevents the board from reviewing the correctness of the decision's reasoning. The board is therefore confronted with a decision that contains insufficient reasoning and thus violates Rule 111(2) EPC. This is a substantial procedural violation.

9. The situation is somewhat special in that the evidence was apparently still accessible when the decision was issued and when the appellant prepared its appeal.

Indeed, in its statement of grounds of appeal, the appellant merely pointed out that it would no longer be possible to verify the video's existence and content if it disappeared from the YouTube website.

However, the appellant's remark also shows that the problem was foreseeable. The examining division could have prevented it, for example by using appropriate screenshots as evidence of what was shown in the video or by otherwise ensuring that a person inspecting the file could reliably access the cited evidence. Indeed, the approach taken by the examining division in the present case also appears to be problematic in view of the rights of third parties and the public to inspect the file under Article 128 EPC.

Remittal to the examining division

10. For these reasons, and in accordance with the appellant's main request, the case is to be remitted to the examining division for further prosecution.

Reimbursement of the appeal fee

11. As the board has pointed out in decision T 2707/16 (Reasons 35), the requirement that the procedural deficiency be causal for the necessity to appeal, which in the case law of the boards of appeal is often considered to be a necessary condition for reimbursement of the appeal fee to be equitable (see Case Law of the Boards of Appeal, 9th edition, 2019, V.A.9.7.1), does not take into account all possible circumstances in which reimbursement may be equitable. For example, if as a result of the deficiency the case is remitted to the examining division without any substantial progress having been made on it,

reimbursement of the appeal fee may well be equitable even if the deficiency cannot be directly linked to the filing of the appeal.

12. In the present case, the substantial procedural violation results in the remittal of the case to the examining division without a substantive review of the merits of the decision. Moreover, it cannot be entirely ruled out that the examining division will refuse the application for a second time for similar reasons (but on the basis of less-ephemeral evidence), compelling the appellant to file a further appeal based on essentially identical grounds. The board therefore considers reimbursement of the appeal fee to be equitable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:



B. Brückner

J. Geschwind

Decision electronically authenticated