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**Datasheet for the decision
of 30 August 2023**

Case Number: T 0762/20 - 3.5.07

Application Number: 13782594.9

Publication Number: 2842029

IPC: G06F17/30

Language of the proceedings: EN

Title of invention:
Trusted file indirection

Applicant:
Citrix Systems, Inc.

Headword:
Trusted file indirection/CITRIX SYSTEMS

Relevant legal provisions:
EPC Art. 84, 113(1)
EPC R. 147(1), 103(1)(a)
RPBA 2020 Art. 11, 12(2)

Keyword:

Claims - clarity (yes)

Remittal to the department of first instance - (yes)

Remittal - fundamental deficiency in first instance proceedings (yes)

Right to be heard - substantial procedural violation (yes)

Reimbursement of appeal fee - equitability (no)

Decisions cited:

T 2377/09, T 0545/18



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 0762/20 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 30 August 2023

Appellant: Citrix Systems, Inc.
(Applicant) 851 West Cypress Creek Road
Fort Lauderdale, FL 33309 (US)

Representative: Boulton Wade Tennant LLP
Salisbury Square House
8 Salisbury Square
London EC4Y 8AP (GB)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 14 November
2019 refusing European patent application
No. 13782594.9 pursuant to Article 97(2) EPC**

Composition of the Board:

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

Summary of Facts and Submissions

- I. The appellant (applicant) appealed against the examining division's decision refusing European patent application No. 13782594.9, which was filed as the international application PCT/US2013/037693 (published as WO 2013/163119 A2).

- II. The documents cited in the contested decision included:
D5 Zhao, Xin et al., "Towards Protecting Sensitive Files in a Compromised System", Proceedings of the Third IEEE International Security in Storage Workshop (SISW'05), pp. 21-28, 2005

- III. The examining division decided, among other things, that the subject-matter of independent claims 1 and 8 of the main request and of the first auxiliary request lacked an inventive step over the prior art disclosed in document D5 and that claim 1 of the main request did not comply with Article 84 EPC. The examining division did not admit a second auxiliary request into the proceedings.

- IV. In its statement of grounds of appeal, the appellant requested that the contested decision be set aside and that a patent be granted on the basis of a new main request and new first to third auxiliary requests, all requests submitted with the statement of grounds of appeal. The appellant submitted that the main request and the first and second auxiliary requests were essentially the same as those considered in the decision under appeal.

Furthermore, the appellant submitted that the examining division had incorrectly exercised its discretion in

not admitting the second auxiliary request, specifically that the examining division had introduced document D5 only six days before the oral proceedings, and only via an informal email received from the first examiner, which had no legal force in proceedings under the EPC. In the official communication (board's comment: the appellant actually referred to the minutes of a telephone conversation held with the first examiner) sent on the same day, the examining division had mentioned that "a document at this point has not been provided" and had referred exclusively to document D4.

The appellant argued that consequently no substantiated objections based on D5 had been raised in an official communication from the EPO before the decision under appeal, in which the newly cited document, D5, was used as the closest prior art for refusing the application. The appellant also argued that document D5 could have been communicated to the applicant at an earlier stage of the proceedings. It had been inappropriate for the examining division not to admit the second auxiliary request, which had been filed as soon as possible in response to the new document, D5, sent via an informal email.

V. In a communication under Rule 100(2) EPC, the board informed the appellant of its intention to admit the main request into the appeal proceedings and to remit the case to the examining division for further prosecution on the basis of the admitted main request. Moreover, the board was of the preliminary opinion that the examining division's objections under Article 84 EPC against the main request were not

convincing and that the appeal fee was not to be reimbursed in the event of a remittal on the basis of the main request.

VI. In reply, the appellant agreed with the case being remitted to the examining division on the basis of the main request without holding oral proceedings.

VII. Claim 1 of the main request reads as follows:

"A method of transferring data, comprising:

receiving an indication that modified data is available to a guest domain (511) executing on a hypervisor (402), said modified data including one or more data files in a file system of and originating from a trusted domain executing on the hypervisor (402);

aliasing each of the one or more data files to be accessible through a file system (513) of the guest domain (511); and

sending, to the trusted domain and based on the aliased one or more data files, a file system call for accessing the modified data."

In view of the outcome of the appeal, the text of the other claims of the main request and the lower-ranking claim requests needs not be given.

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

Reasons for the Decision

1. The application relates to transferring files between virtual machines when at least one of these machines is

untrusted (paragraph [02] of the description as published).

Main request

2. *Admissibility under Article 12 RPBA 2020*

The main request filed with the statement of grounds of appeal differed from the main request considered in the contested decision merely in that it corrected the reference sign for the file system of the guest domain from "503" to "513". Consequently, this request corresponded in substance to the main request considered in the contested decision and was in the appeal proceedings under Article 12(2) RPBA 2020.

3. *Clarity and lack of support*

3.1 In its decision, the examining division reasoned its objection under Article 84 EPC against claim 1 of the main request as follows:

"With respect to Article 84 EPC, the subject-matter of claim 1 is not clear with respect to the term 'modified data' and the related claimed features are also not supported by the description. In the general knowledge, all data that is added to a file system will get a 'last modified date'. Therefore, all data in the files of a file system are 'modified data'. However, in the light of the description, paragraphs 69 and 74, modified data may be considered data that is changed because of a system update process such as Windows® Update. However, the claims do not specifically encompass such an update process resulting in 'modified data'. Therefore, even the step of the user opening

a file, touching it or changing an attribute of the file or its contents results in 'modified data', something not intended by the application but encompassed by the subject-matter of claim 1. As a consequence, the claims are not considered clear nor supported by the description under Article 84 EPC."

3.2 The appellant argued that the examining division's objection under Article 84 EPC was incorrect. The objection was based on an incorrect interpretation of the claims and the examining division's untenable conclusion that "all data in the files of a file system are 'modified data'". The skilled person would have understood that the term "modified data" in claim 1 did not mean "all data", contrary to the examining division's allegation. Such an interpretation would have rendered the word "modified" in claim 1 entirely meaningless and was contrary to the disclosure in the application. The skilled person would have immediately ruled out such an interpretation because it completely disregarded a clear limitation to the meaning of the claims. Consequently, the claims were clear and supported by the description.

3.3 The board is not convinced by the examining division's objection under Article 84 EPC, because the skilled person reading claim 1 understands what is meant by "modified data" in the context of claim 1. Claim 1 specifies a method of transferring data, comprising receiving an indication that modified data is available to a guest domain executing on a hypervisor, said modified data including one or more data files in a file system of and originating from a trusted domain executing on the hypervisor. Consequently, claim 1 specifies that the context of the expression "modified

data" is a method of transferring data and that "modified data" includes one or more data files in a file system of and originating from a trusted domain. The skilled person understands that claim 1 relates to transferring modified files from another domain.

In the context of claim 1, it is not convincing to argue that all files would be considered to be modified, even files that were just opened or had any of their file attributes, i.e. their metadata, modified. Instead, the skilled person would understand "modified data" to mean that the file data itself was modified (and file attributes indicating such a modification). Consequently, the appellant correctly argued that the examining division's interpretation of "modified data" was not convincing, and the objection that the expression "modified data" is unclear cannot be upheld.

3.4 Regarding the examining division's objection that claim 1 is not supported by the description, the board considers in the following whether the appellant's right to be heard under Article 113(1) EPC was respected.

3.4.1 The relevant passage of the minutes of the telephone conversation dated 8 October 2019, held on 7 October 2019, i.e. shortly before the scheduled date of the oral proceedings (14 October 2019) in the first-instance proceedings, reads as follows (underlining added by the board):

"1. Addressing the applicant's argument on page 2 of the letter dated 11-09-2019, under section 'Novelty', that the examiner has interpreted

'modified' data to mean any data that is present on the guest domain which has either been stored or accessed.

The examining division submits that what is claimed does not give any clue to the skilled reader about how the data has been modified, by whom or what, and what technical features should be considered behind the term 'modified'. Even the description of the application remains largely silent about the modification and the examining division only found 2 passages which provide some support of the feature (paragraphs 69 and 74), in which it can be understood that 'modified' is intended in the context of a hotfix or system update and the files therein are then made available to a guest domain.

However, this interpretation is not exclusive by only the wording of the claims, and the broader interpretation is applicable without an amendment that encompasses the disclosed definition of the modification in paragraphs 69 and/or 74. Therefore, without such amendment, the examining division upholds its interpretation of 'modified data' and the consequential Article 56 EPC objection, starting with document D4 in combination with common knowledge, as raised in the summons.

2. MAIN REQUEST

As a consequence of the above arguments, the examining division raises a further clarity objection under Article 84 EPC with respect to the term 'modified data' not being clear in addition to the aforementioned Article 56 EPC objection raised in the summons, [...]"

3.4.2 The board notes that, according to the minutes of the telephone conversation, the examining division not only did not raise any objection for lack of support, but even made statements which appeared to recognise some support in paragraphs [69] and [74] of the description for the feature "modified data" in the context of claim 1. Even though the objections against the feature "modified data" were not caused by the amendments filed in response to the summons to oral proceedings before the examining division, in the annex to the summons to oral proceedings the examining division did not raise any objection under Article 84 EPC, and in particular did not raise any objection for lack of support.

Consequently, the examining division substantially changed its view regarding the lack of support by the description for the subject-matter of claim 1 when it finally decided the case (see point 3.1 above). This must have come as a surprise to the appellant, which was not informed of the objection for lack of support in the description before the examining division made its decision. In addition, the reasoning for lack of support in the decision under appeal is insufficient since it does not explain why paragraphs [69] and [74] did not provide the support needed, even though they were previously mentioned as providing some support. Consequently, the board considers that the appellant's right to be heard under Article 113(1) EPC was violated, which is a substantial procedural violation and thus a special reason for remittal under Article 11 RPBA 2020 (see decision T 545/18, points 2.6, 2.7 and 3 of the Reasons, and also the further decisions cited in the Case Law of the Boards of Appeal of the EPO, 10th edition 2022, V.A.9.4.4 a)).

3.4.3 In view of the above, the board considers that it is not possible to perform a complete judicial review of the case and that it is not appropriate for the board itself, in the specific circumstances of the current case, to deal with the objection for lack of support against claim 1 of the main request.

4. *Inventive step - Article 56 EPC*

4.1 In the decision under appeal, the examining division used document D5 as a starting point in its reasoning on the ground for refusal of lack of inventive step.

4.2 Regarding the introduction of document D5 into the first-instance proceedings, as part of the facts and submissions, point 9 of the contested decision states the following:

"An email was sent to the applicant on 08-10-2019, in which the first examiner communicated the feature mapping of the inventive step objection under Article 56 EPC. The Article 56 EPC objection was based on document D5 (XP010914819, 'Towards Protecting Sensitive Files in a Compromised System') a further document found by the examining division which appeared to be a closer prior art document than D4."

4.3 However, the electronic file, which is the sole official file relating to the European patent application (Rule 147(1) EPC) and the record of the first-instance proceedings available for file inspection and used by the board in its judicial review, does not contain the email sent to the appellant on 8 October 2019.

4.4 The minutes of the telephone conversation held on 7 October 2019 were faxed on the same day and comprised

a document as annex which, however, was only later identified as "document D5". The cover page of the minutes of the telephone conversation provides only an XP number of the annexed document, and does not have any bibliographic information or an indication that it corresponds to document D5. The document annexed to the fax is neither labelled with an XP number nor has any clear indication that it is to be designated as "document D5". Moreover, the text of the minutes of the telephone conversation does not mention any new document at all and, as argued by the appellant, instead seems to indicate that no new document is necessary (see point IV. above). The appellant does not contest the receipt of an email referring to an alleged "document D5", but does not describe the content of the email. The board is not in a position to assess either the content or any other details of the email.

4.5 In view of the above, it seems that the email apparently sent on 8 October 2019 was the only occasion on which the examining division may have commented on document D5 and could have given a clear indication that this document would be relevant for the assessment of inventive step before issuing the written decision. The board thus agrees with the appellant's objections (see point IV. above) to the extent that the appellant was not officially informed of an inventive-step objection based on document D5 by the EPO before the notification of the contested decision. Moreover, in the circumstances of the current case, the missing email is the essential piece of evidence for reviewing whether the appellant's right to be heard under Article 113(1) EPC was respected. Since this email is not available to the board, the board cannot review the contested decision in a judicial manner (Article 12(2) RPBA 2020). These circumstances constitute a further

substantial procedural violation and a special reason for remitting the current case to the department of first instance (Article 11 RPBA 2020).

5. In the specific circumstances of the current case, it is not appropriate for the board to comment on the substance of inventive step for the main request.

6. *Reimbursement of the appeal fee*

Even though the first-instance proceedings were tainted by substantial procedural violations, the board considers that a reimbursement of the appeal fee is not equitable under Rule 103(1)(a) EPC since the examining division's objection that claim 1 of the main request considered in the contested decision was unclear was not tainted by a substantial procedural violation. Consequently, the appellant had to file an appeal against the decision on the refused main request in view of this objection for lack of clarity anyway. The fact that the examining division's clarity objection is not convincing does not change the situation regarding the reimbursement (see also decision T 2377/09, point 4 of the Reasons).

7. In view of the above, the contested decision is to be set aside and the current case is to be remitted to the responsible department of first instance for further prosecution on the basis of the current main request and without reimbursement of the appeal fee.

8. The decision can be made without holding oral proceedings since the appellant agreed to a remittal of the case on the basis of the current main request without holding oral proceedings.

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 request for reimbursement of the appeal fee is refused.

The Registrar:

The Chair:



S. Lichtenvort

J. Geschwind

Decision electronically authenticated