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**Datasheet for the decision
of 14 August 2023**

Case Number: T 0390/21 - 3.5.07

Application Number: 14800855.0

Publication Number: 3000049

IPC: G06F15/16, G06F17/30, G06F7/04,
G06F21/62

Language of the proceedings: EN

Title of invention:

System and method to provide document management on a public document system

Applicant:

Altirnao Inc.

Headword:

Document management/ALTIRNAO

Relevant legal provisions:

EPC Art. 56, 111(1)
EPC R. 103(1)(a), 111(2)
RPBA 2020 Art. 11, 12(2), 12(4)

Keyword:

Inventive step - unconvincing reasoning
Substantial procedural violation - appealed decision
sufficiently reasoned (yes)
Remittal - (yes)

Decisions cited:

J 0003/14, T 2467/09, T 1966/16, T 0731/17



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Case Number: T 0390/21 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 14 August 2023

Appellant: Altirnao Inc.
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Wilmington, DE 19808 (US)

Representative: August Debouzy
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 12 November
2020 refusing European patent application
No. 14800855.0 pursuant to Article 97(2) EPC**

Composition of the Board:

Chair M. Jaedicke
Members: R. de Man
E. Mille

Summary of Facts and Submissions

- I. The applicant appealed against the decision of the examining division refusing European patent application No. 14800855.0.
- II. The examining division decided that the subject-matter of claim 1 of the main request and of the first to sixth auxiliary requests lacked an inventive step over known file-sharing systems such as Google Drive.
- III. In its statement of grounds of appeal, the appellant maintained the requests on which the decision was based. It requested 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 the first to sixth auxiliary requests. It also requested reimbursement of the appeal fee.

The appellant requested oral proceedings "in case the Board cannot set aside the examining division's decision based on the written submissions of the parties" and "should any other decision than the setting aside the decision be contemplated by the Board".

- IV. In a communication issued under Rule 100(2) EPC, the board informed the appellant of its intention to set aside the decision under appeal and to remit the case to the examining division for further prosecution. It also expressed the view that the appellant's request for reimbursement of the appeal fee could not be allowed.

V. In response to the board's communication, the appellant withdrew its request for reimbursement of the appeal fee and maintained its other requests.

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

"A file system, comprising:

a file sharing system (1) having a plurality of files stored in the file sharing system, each file being associated with a user;

a document management system (6) coupled to the file sharing system (1), the document management system (6) being a user of the file sharing system (1) for a plurality of managed files stored on the file sharing system (1); and

the document management system (6) controlling access to the managed files stored on the file sharing system (1);

wherein the document management system (6) has a backend (61) having

- a document entry point (501) configured to process requests performed by end users when they use the document management system to interact with the managed files,
- an administration entry point (502) configured to process requests performed by administrators when they manage a configuration of the document management system,
- a security manager (503) configured to filter said requests by verifying that the end users performing the requests have the permission to do so,
- a document manager (504) configured to manage a data model of the system,

and wherein the document management system (6) is configured to perform actions requested in the file

sharing system (1) when the security manager confirms said permission."

- VII. The text of the claims of the first to fifth auxiliary requests is not relevant to this decision.
- VIII. Claim 1 of the sixth auxiliary request differs from claim 1 of the main request in that the text after "a security manager (503) configured to filter said requests by verifying that the end users performing the requests have the permission to do so," has been replaced with the following text:

"a storage (24) configured to store properties associated to managed files stored on the file sharing system (1),
wherein the document management system (6) is configured to perform actions requested in the file sharing system (1) when the security manager confirms said permission
and wherein the backend further comprises a search manager (513) configured to receive search requests inputted by an end user to the document entry point (501) and to return search results to the security manager (503), the security manager being further configured to filter search results returned by the search manager to ensure that the search results list displayed to the end user only shows managed documents that the end user is authorized to see."

Reasons for the Decision

1. The application relates to a document management system which stores the documents it manages in a public file sharing system.

2. *The decision under appeal - main request*

2.1 To come to a decision on the main request, the written decision first deals with claim 1 of the sixth auxiliary request (and of the fourth and fifth auxiliary requests), then with claim 1 of the third auxiliary request, which contains features not present in claim 1 of the sixth auxiliary request, and then concludes that the subject-matter of claim 1 of the main request (and of the first and second auxiliary requests) lacks inventive step because it is broader than the subject-matter of claim 1 of the third auxiliary request.

2.2 The examining division essentially argued that the subject-matter of claim 1 of the sixth auxiliary request amounted to a system comprising a prior-art company-external file sharing system, such as Google Drive, and a duplicate company-internal file sharing system (referred to as "document management system" in claim 1), wherein copies of some or all of the files stored in the company-internal file sharing system were also stored in the company-external file sharing system under a "document management system" account created for the company, which allows the document management system to manage the permissions of the files stored in the company-external file sharing system (see the decision, Reasons 2.3, 2.5 and 2.7).

The examining division further stated that it appeared to be common ground during the oral proceedings that known file sharing systems, such as Google Drive, already included all the "backend" functionality of the claimed document management system (Reasons 2.6).

The decision to arrange the company-external and company-internal file sharing/document management systems in the way claimed was essentially a non-technical, administrative decision whose implementation did not require inventive skill "as implicitly acknowledged by the paucity of technical detail as to the 'document management system' in the application itself and as highlighted by the fact that the implementation require[d] little more than the duplication of a known system" (Reasons 2.7 to 2.12).

2.3 The appellant contested, *inter alia*, that the document management system of claim 1 was a (company-internal) duplicate of the (company-external) file sharing system. It also disputed that known file sharing systems included all the "backend" functionality of the claimed document management system.

2.4 The board agrees with the appellant that the examining division's reasoning is not convincing.

Claim 1 of the sixth auxiliary request relates to a system comprising a file sharing system and a document management system, wherein the document management system uses the file sharing system for storing a set of managed document files. Indeed, claim 1 specifies that the document management system is "a user of the file sharing system for a plurality of managed files stored on the file sharing system" and that it controls "access to the managed files stored on the file sharing system". The backend of the document management system is configured to process requests by end users who "interact with the managed files", i.e. with the files stored on the file sharing system, and it performs "actions requested in the file sharing system".

If the claimed document management system were a "company-internal file sharing system" similar to Google Drive, it would manage access to files stored in that company-internal file sharing system, not to files stored externally. The examining division did not argue that Google Drive can be configured to manage access to files in another file sharing system, let alone provide evidence to support this.

- 2.5 As to the appellant's contestation of the examining division's assertion that known file sharing systems included all the "backend" functionality of the claimed document management system, the board notes that the appellant in principle could have raised this argument regarding alleged facts during the first-instance proceedings in response to the examining division's communication of 2 October 2020 (see point 3.5 below). Nevertheless, since that communication was issued only shortly before the oral proceedings and deviated from the examining division's earlier reasoning in a number of ways, the board considers it appropriate to admit this amendment of the appellant's case into the appeal proceedings (Article 12(4) RPBA 2020).

Since the examining division's reasoning is based on a contested factual assertion which is supported neither by evidence nor by cogent reasons, this is a further reason why the inventive-step reasoning for claim 1 of the sixth auxiliary request cannot stand (see decision T 2467/09, Reasons 8).

- 2.6 Since the inventive-step reasoning for the refusal of the sixth auxiliary request formed the basis for the refusal of the main request, the decision also has to be set aside in respect of the main request.

3. *Alleged substantial procedural violation*

3.1 In support of its request for reimbursement of the appeal fee, which it has now withdrawn, the appellant argued that the written decision was insufficiently reasoned within the meaning of Rule 111(2) EPC. Since, under Rule 103(1) (a) and (6) EPC, the board should consider *ex officio* whether the appeal is to be reimbursed (see decision J 3/14, Reasons 8), it is appropriate to comment on whether the written decision was sufficiently reasoned.

3.2 According to the appellant, the decision's reasoning was obscure. The examining division had not considered the wording of the claims and had failed to properly apply the problem-and-solution approach. The reference to the "paucity" of technical details appeared to be nothing but a value judgment, which did not reflect any of the conditions of the EPC.

3.3 Although the board agrees with the appellant that the decision's reasoning is not convincing, it considers that the decision does present a sufficiently logically coherent chain of reasoning (see the decision, Reasons 2.5 to 2.13, summarised in point 2.2 above, and Reasons 4.3 to 4.5).

Moreover, the written decision deals with the appellant's counter-arguments (Reasons 2.14 to 2.21 and 4.6 to 4.8).

3.4 It is true that the written reasons barely refer to the wording of the claims. However, claim 1 of each request defines a file system comprising a file sharing system and a document management system. There is no dispute that the file sharing system was part of the prior art,

and the decision covers the features which define the backend of the document management system by stating that "it appeared to be common ground during the oral proceedings" that known file sharing systems included the functionality of the claimed backend.

- 3.5 In its statement of grounds of appeal, the appellant denied having acknowledged that the features defining the backend were disclosed by known file sharing systems, and the minutes of the oral proceedings do not confirm that there was such common ground.

However, the examining division's communication of 2 October 2020 contained, in point 5.4, the assertion that "the functionality provided by [the components of the claimed document management system] matches the functionality already provided by file sharing systems such as Google Drive". There is no evidence on file that the appellant specifically contested this assertion during the first-instance proceedings. The board is therefore inclined to read "it appeared to be common ground during the oral proceedings that" as "the appellant did not contest that".

In this context, the board observes that, in its statement of grounds of appeal, the appellant did not point out any feature of the claimed backend which, in the appellant's view, was not disclosed by a file sharing system such as Google Drive. The board does not consider the lack of a contestation to be an acknowledgement that a file sharing system does disclose the relevant features, but it arguably renders it acceptable that the examining division did not back up its factual assertion, which had previously been communicated to the appellant, with documentary evidence.

3.6 As to the examining division's reference to the "paucity of technical detail", these words were used in support of the finding that the skilled person would have been able to implement a system comprising a company-external file sharing system and a duplicate company-internal file sharing server-cum-document management system arranged in accordance with the examining division's interpretation of claim 1 (see the decision, Reasons 2.12).

Essentially, the examining division argued that its position that the skilled person would have been able to implement the functional features of the claim was supported by the absence of further technical detail of those features in the application. This argument therefore served a clear purpose in the context of the decision's reasoning.

3.7 Finally, an alleged failure to properly apply the problem-and-solution approach cannot be equated with a lack of reasoning.

3.8 In sum, the board is not convinced that the deficiencies of the contested decision amount to a substantial procedural violation. There is therefore no basis for ordering reimbursement of the appeal fee under Rule 103(1)(a) EPC.

4. *Remittal for further prosecution*

4.1 In view of point 2. above, the decision to refuse the application cannot be upheld.

4.2 Nevertheless, it still has to be assessed whether the subject-matter of claim 1 of the main request or of any

of the first to sixth auxiliary requests involves an inventive step over the prior art and whether the other requirements of the EPC are met.

- 4.3 Since the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020), in the circumstances of the present case special reasons within the meaning of Article 11 RPBA present themselves for remitting the case for further prosecution (see decisions T 1966/16, Reasons 2.2; and T 731/17, Reasons 7.2 and 7.3).

The case is therefore to be remitted to the examining division for further prosecution on the basis of the main request (Article 111(1) EPC).

- 4.4 Since the appellant's request for oral proceedings is conditional on the board not setting aside the decision under appeal, this decision can be taken 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 examining division for further prosecution.

The Registrar:

The Chair:



S. Lichtenvort

M. Jaedicke

Decision electronically authenticated