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D E C I S I O N
of 28 November 2003

Case Number: T 0449/03 - 3.4.1

Application Number: 00830774.6

Publication Number: 1209638

IPC: G07F 17/16

Language of the proceedings: EN

Title of invention:

System for distributing files containing digital data using a computer network

Applicant:

Caliel S.r.l.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 113(1)

EPC R. 67

Keyword:

"Basis of decision - opportunity to comment (no)"

"Substantial procedural violation (yes)"

"Remittal to first instance (yes)"

"Reimbursement of appeal fee (yes)"

Decisions cited:

T 0161/82, T 0084/82

Catchword:

-



Case Number: T 0449/03 - 3.4.1

D E C I S I O N
of the Technical Board of Appeal 3.4.1
of 28 November 2003

Appellant:

Caliel S.r.l.
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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 15 November 2002
refusing European application No. 00830774.6
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: G. Davies
Members: R. Q. Bekkering
G. Assi

Summary of Facts and Submissions

I. The appellant (applicant) lodged an appeal against the decision of the examining division, dispatched on 15 November 2002, refusing the European patent application No. 00 830 774.6 (EP-A-1 209 638). The notice of appeal was received on 14 January 2003 and the appeal fee paid on the same day. The statement of the grounds of appeal was received on 12 March 2003.

II. After receipt of the European search report the appellant filed with a letter dated 14 January 2002 a replacement set of claims 1 to 19. On 13 May 2002 the examining division issued a first communication pursuant to Article 96(2) EPO, raising objections on the basis of Article 123(2) EPC against claim 1 as amended and on the basis of lack of inventive step, Articles 52(1) and 56 EPO, of the subject-matter of all claims on file having regard to the following prior art:

D1: US-A-5 592 511

Independent claims 1 and 19 filed with the letter dated 14 January 2002, forming the basis of the above communication read as follows:

"1. A system for distributing files containing digital data, by using a telematic network (9, 11, 13, 14) comprising:

- at least one store (4), connected to said telematic network (9, 11, 13, 14) and storing a plurality of said files;
- a plurality of distribution points ($8_1 \dots 8_n$), connected to said telematic network (14) and

comprising each means (24) for receiving one or more files from said at least one store and [sic] and means (26) for recording said one or more files onto a suitable support (16);

- at least one telematic terminal (10, 12), connected to said telematic network (11), for the choice and the booking by a client of one or more files present in said at least one store (4);
- a central processor (2), connected to said telematic network (9, 11, 13, 14), and comprising means for collecting the bookings coming from said at least one telematic terminal (10, 12), and means for transferring said one or more files from said at least one store (4) to at least one of said distribution points (8), characterised in that each of said distribution points ($8_1 \dots 8_n$) comprises a local buffer (22) for storing said files, said local buffer (22) being a cache memory and the time during which a received file remains stored in said cache memory being related with the number of the requests made during that time for that file, whereby the most requested files at a distribution point remain available at the distribution point for longer time."

"19. A method for the choice and the booking, by a client, of files containing digital data by means of a system according to any preceding claim, characterised in that it comprises the following steps:

- access to a central processor (2), through a remote access terminal (10, 12), for the choice and the booking of one or more files;

- choice of the kind of support (16) onto which recording of said files is desired;
- identification, by the central processor (2), of a distribution point (8) that is optimum in respect of the client's location, for recording said files on said support (16);
- evaluation of the time expected for the production;
- preliminary dialogue between the central processor (2) and the distribution point (8), for communicating the list of said one or more files chosen and checking whether file copies are locally available;
- transfer of the files that are missing at the distribution point (8), by taking said missing files from at least one store (4);
- upon complete availability of the whole set of material at the distribution point (8), recording of said files on said support (16) under the control of said central processor (2);
- communication, by the central processor to an authority ($6_1 \dots 6_n$) owning the copyrights for the recorded files, of the fees pertaining to that authority, upon receipt from the distribution point (8) of an acknowledgement of the occurred recording."

III. In response to the above communication, the appellant filed with a letter dated 16 July 2002 a new set of claims 1 to 8 to replace the claims on file.

Claim 1 as amended has the following wording:

"1. A system for distributing files containing digital data, by using a telematic network (9, 11, 13, 14) comprising:

- at least one store (4), connected to said telematic network (9, 11, 13, 14) and storing a plurality of said files;
- a plurality of distribution points ($8_1...8_n$), connected to said telematic network (14) and comprising each means (24) for receiving one or more files from said at least one store and means (26) for recording said one or more files onto a suitable support (16);
- at least one telematic terminal (10, 12), connected to said telematic network (11), for the choice and the booking by a client of one or more files present in said at least one store (4);
- a central processor (2), connected to said telematic network (9, 11, 13, 14), and comprising means for collecting the bookings coming from said at least one telematic terminal (10, 12), means for counting and identifying the booked files, means for debiting the client with the cost associated with the booked files, means for handling the payment of copyright fees to copyright owners ($6_1...6_n$), and means for transferring said one or more files from said at least one store (4) to at least one of said distribution points (8),
characterised in that said distribution points ($8_1...8_n$) are operated under the control of said central processor (2), and comprise each enabling means enabling its operation upon reception of a

unique identification code from said central processor (2) and a local buffer (22) for storing at least the files that are more frequently requested at that distribution point ($8_1 \dots 8_n$), the distribution points ($8_1 \dots 8_n$) being slaved to the central processor (2) also for bookings concerning files already existing in the respective local buffer (22)."

Independent claim 8 corresponds to claim 19 as previously on file.

IV. With its decision dated 15 November 2002, the examining division refused the application on the ground that the subject-matter of independent claims 1 and 8 filed with the letter dated 16 July 2002 did not involve an inventive step (Articles 52(1) and 56 EPC) having regard to document D1 and the skilled person's general knowledge.

V. The appellant requested that the decision under appeal be set aside and a patent be granted based on the following documents:

Claims: No. 1 to 8 filed with the statement of the grounds of appeal received on 12 March 2003;

Description: Pages 1, 1a, 2 filed with the letter dated 16 July 2002;
Pages 3 to 12 as originally filed;

Figures: Sheets 1/3 to 3/3 as originally filed.

Oral proceedings were requested in the event that the above request should not be granted.

VI. In the statement setting out the grounds of appeal the appellant pointed out that the procedure followed by the examining division to arrive at the final decision had been prejudicial to the rights of the appellant, who was not given sufficient possibilities of amending the application documents during examination proceedings. Generally the applicant was entitled to at least two communications before a negative decision on the patentability. There was no justification for the failure to issue a second communication pursuant to Article 96(2) EPC, since there was a clear effort by the appellant to remedy the deficiencies found by the examining division, as clearly shown by the fact that a deeply modified set of claims had been filed in response to the first official communication.

The appellant also regretted that the examining division had not adhered to his request to be heard if the application was deemed to be rejected. However, it was conceded that such a request was not considered by the boards of appeal to be a request for oral proceedings and therefore did not imply a legal obligation for the examining division.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC and is therefore admissible.

2. Having regard to claim 1 forming the basis for the first communication of the examining division pursuant to Article 96(2) EPC, claim 1 on which the decision refusing the application is based contains in substance the following additional features:

(1) means for counting and identifying the booked files, means for debiting the client with the cost associated with the booked files, means for handling the payment of copyright fees to copyright owners;

(2) the distribution points are operated under the control of the central processor;

(3) the distribution points comprise each enabling means enabling its operation upon reception of a unique identification code from the central processor;

(4) the distribution points being slaved to the central processor also for the bookings concerning files already existing in the respective local buffer.

3. Above feature (1) was contained in claim 1 as originally filed. With the amendments filed after receipt of the European search report, the feature was deleted from claim 1, which gave rise to an objection under Article 123(2) EPC by the examining division in the first communication. With the amendments filed by the appellant in reply to the first communication, the feature was reinstated in claim 1. This time the feature was placed in the preamble of claim 1,

acknowledged by the appellant to reflect the prior art provided by document D1 (cf letter of reply dated 16 July 2002, first page).

In the impugned decision (cf paragraph 2.1) this feature was considered to be known from document D1, which in view of the above was already conceded by the appellant.

Feature (3) above was recited in dependent claim 15 as originally filed. In the first communication the appellant was informed that this additional feature was considered to be a well-known option for a person skilled in the art (cf paragraph 3.2).

This corresponds in substance to what was held in the decision under appeal (cf paragraph 2.2).

Accordingly, the grounds held against the appellant in the contested decision with respect to these features were known to the appellant and he has had the opportunity to present comments in accordance with Article 113(1) EPC.

- 4.1 Features (2) and (4) were not dealt with in the first communication. In particular, these features were not contained in claim 1 or any of the remaining claims considered in the first communication.
- In the decision under appeal it was held that feature (2) was known from D1 and in particular clear from column 3, lines 19 to 21 (cf decision, paragraph 2.1). Regarding feature (4) it was held that this feature did not add anything to feature (2) (cf decision, paragraph

2.4). These grounds were not previously communicated to the appellant.

The appellant's allegation that generally the applicant is entitled to receive at least two communications in the examination proceedings before a negative decision on the patentability is unfounded (cf T 84/82, OJ 1983, 451). However, where features are added to a claim in response to an official communication, it is only in exceptional cases that a further communication may be dispensed with (cf T 161/82 OJ 1984, 551): for example where it can be held that the features added to the claim are implicit to the specific part of the prior art document already held against the subject-matter of the claim, so that the objection against patentability communicated to the applicant remains the same.

In the present case, however, the above-mentioned features (2) and (4) of claim 1 cannot be said to be implicit to the system known from D1 held to be prejudicial to the patentability of the subject-matter of claim 1 in the first communication, but rather define further limitations, in particular relating to the specific hierarchical arrangement within the system.

- 4.2 As a matter of fact, the hierarchical arrangement of the system as defined in amended claim 1 would appear to be different from the one disclosed in D1.

The passage of D1 (column 3, lines 19 to 21) cited in the decision under appeal merely states that "the central order/billing computer (8) receives data from the customer at a remote site, which could be a record

store, via an order entry/production computer (9)".
From this passage no conclusions can be drawn on the hierarchy of the computers.

According to D1 (cf column 3, lines 22 to 38; Figure 1), following the reception of this data, which consists of the audio information selected by the customer, requested to be compiled and written to the playback media (CD-ROM/tape), the central order/billing computer (8) forwards the file information to the data base control computer which retrieves the data and queues it for transmission to the remote site. After the data is transmitted to the production computer (9) it is transferred to the CD-Rom or audio tape.

There is no indication of the order entry/production computer (9) at the remote site (distribution points) being operated under the control of the central order/billing computer (8) or the distribution points being slaved to the central processor also for the bookings concerning files already existing in the respective local buffer, as defined in features (2) and (4) of claim 1.

In fact, as argued by the appellant, it would rather appear that the operation of the system of D1 corresponds in substance to a conventional data retrieval from a central database under the control of a computer at a remote site submitting the data request.

4.3 Thus, the objections of the examining division concerning features (2) and (4) of claim 1, raised for the first time in the impugned decision, constitute new

grounds which should have been communicated to the appellant prior to the issuance of a decision in order to provide the appellant with an opportunity to provide comments.

Accordingly, the decision under appeal has been issued in breach of the requirements of Article 113(1) EPC.

The decision under appeal, therefore, has to be set aside.

5. Since the requirement of Article 113(1) represents a fundamental procedural principle ensuring the right of a party to the proceedings to be heard before an adverse decision is issued, its breach amounts to a substantial procedural violation.
6. Merely for the sake of completeness, it is noted that according to established case law of the boards of appeal the appellant's request to be heard if the application is deemed to be rejected, submitted in the examination proceedings (cf letter 16 July 2002), is not considered to be a request for oral proceedings in the sense of Article 116(1) EPC, as already conceded by the appellant.
7. For the above reasons, the Board remits, in accordance with Article 10 RPBA, the case to the department of the first instance under Article 111(1) EPC for further prosecution of the application on the basis of the appellant's request filed with the statement of the grounds of appeal.

8. The appeal fee shall be refunded in accordance with Rule 67 EPC, since the appeal is considered to be allowable to the extent that the decision under appeal is set aside as requested and the refund is equitable by reason of the substantial procedural violation.

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 shall be refunded.

The Registrar:

The Chairman:

R. Schumacher

G Davies