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Datasheet for the decision of 9 April 2008

Case Number: T 0713/05 - 3.5.01

Application Number: 99918353.6

Publication Number: 0996074

IPC: G06F 17/60, G06F 17/30

Language of the proceedings: EN

Title of invention:
Apparatus for data distribution, and terminal for data distribution

Applicant:
Sony Corporation

Opponent:
-

Headword:
Contents distribution/SONY

Relevant legal provisions:
EPC Art. 123(2)

Relevant legal provisions (EPC 1973):
EPC Art. 111(1)

Keyword:
"Remittal on the basis of amended claims"

Decisions cited:
-

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0713/05 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 9 April 2008

Appellant: Sony Corporation
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 30 November 2004 refusing European application No. 99918353.6 pursuant to Article 97(1) EPC 1973.**

Composition of the Board:

Chairman: S. Steinbrener
Members: R. R. K. Zimmermann
G. Weiss

Summary of Facts and Submissions

I. European patent application 99 918 353.6 (publication number EP-A-0 996 074) claims the 11 May 1998 as priority date for an invention concerning the distribution of contents data stored in a contents server via a network to a user terminal.

II. In the examination phase, the applicant (appellant) filed various amendments to the application in response to objections raised by the examining division against the application. The application was in the end refused in oral proceedings held on 13 October 2004 on the basis of amended claims filed with a letter dated 29 July 2004. According to the minutes of the oral proceedings, no formal objections were raised against these claims, leaving the question of inventive step the only relevant point to be decided.

In the oral proceedings, however, the examining division explicitly changed its previous view, consistently upheld in all communications, that document D6 (EP-A-0 715 247, published on 5 June 1996) was the closest prior art and the appropriate starting point for assessing the invention, but maintained the objection under Article 56 EPC 1973, now by referring to a "licence system" using a key as the closest prior art. One such a system was Microsoft's Windows 95® "released well before the priority date of the application".

According to the reasons of the decision posted on 30 November 2004, the only remaining claim features distinguishing the invention from such a licence system

were the encryption with the M key, the storage of the MID and M keys on a single chip, and the use of the C key for accounting purposes. The encryption with the M key was an obvious choice having regard to the prior art known as key escrow system. The single chip feature would not contribute to inventive step since the necessary conditions for achieving the intended effect, namely to increase security of the system, were not in the claim, and also not in the description. The use of the C key for accounting purposes was merely an obvious implementation of an administrative task.

III. The applicant filed an appeal, and paid the appeal fee, on 17 January 2005 and filed a written statement setting out the grounds of appeal together with three sets of amended claims (main request, auxiliary requests I and II) on 4 April 2005. Claim 1 according to the main request reads as follows:

" 1. A terminal apparatus (202A, 202B, 302) for data distribution, comprising:
a storing unit (251, 251A, 251B, 252, 252A, 252B, 351, 352) in which first identification data (MID code) that is particular to said apparatus and second identification data (M key) corresponding to said first identification data have been stored, said storing unit being included in a single chip integrated circuit (221A, 221B, 321);
a data transmitting/receiving unit (225A, 225B, 325) for transmitting distribution request data of contents data together with said first identification data (MID code) read out from said storing unit to a contents server and for receiving contents data which was enciphered by using enciphering data (C key) that

is particular to the requested contents data, then enciphered by using said second identification data (M key) stored on said contents server and transmitted from said contents server, and for receiving the enciphering data (C key) which has been enciphered using said second identification data (M key) and transmitted from said contents server;
a data storing unit (220A, 220B, 320) for storing the data which was enciphered by said contents server on the basis of said second identification data (M key) after being enciphered by using the enciphering data (C key) and received by said data transmitting/ receiving unit and for storing the enciphering data (C key) which has been enciphered using said second identification data (M key);
a first signal processing unit (253, 253A, 253B, 353) for performing a first decoding process on the data and the enciphering data (C key) read out from said data storing unit on the basis of said second identification data (M key) stored in said storing unit and outputting contents data enciphered by the enciphering data (C key) and outputting said enciphering data (C key);
a second signal processing unit (255, 256, 255A, 256A, 255B, 256B, 355, 356) for performing a second decoding process on the data outputted from said first signal processing unit on the basis of the enciphering data (C key) outputted from said first signal processing unit and outputting requested contents data; and
a control unit (224A, 224B, 324) for performing the operation to store the contents data and the enciphering data received by said data transmitting/ receiving unit into said data storing unit and controlling the first decoding processing operation by said first signal processing unit of the contents data

and the enciphering data read out from said data storing unit, and controlling the second decoding processing operation by said second signal processing unit of the data outputted from said first signal processing unit,

wherein said contents server also has stored said first identification data (MID code) and said second identification data (M Key) corresponding to the first identification data (MID code) and has an enciphering data generating unit (118) for generating the enciphering data (C key), and whereby said data transmitted from said contents server and received by said data transmitting/receiving unit comprises: the contents data requested by the distribution request data which has been enciphered by using the enciphering data (C key) and then enciphered by said contents server by using said second identification data (M key) corresponding to said first identification data (MID code) transmitted from said terminal apparatus; and the enciphering data (C key) which has been enciphered using said second identification data (M key),

wherein said control unit (224A, 224B, 324) controls an accounting process on the basis of said enciphering data, such that said control unit (224A, 224B, 324) inhibits an accounting process for the distribution of the requested contents data when the enciphering data (C key) outputted from said first signal processing unit is already stored in said data storing unit, and wherein said terminal apparatus further comprises a third signal processing unit (257, 257A, 257B, 357) for further performing an enciphering process on the data decoded by said first signal processing unit (253, 253A, 253B, 353) on the basis of the first

identification data (MID code) of a destination to which the data is to be moved when the data stored in said data storing unit is moved."

IV. The appellant requested in the statement of grounds (letter dated 4 April 2005) that the decision under appeal be reversed and that a patent be granted according to the claims set out in the main and auxiliary requests filed with the statement of grounds. As a precaution, the appellant requested that oral proceedings be held in the event that the Board contemplated refusing grant of a patent according to the main request. The appellant also indicated that it intended to amend the description once the form of the claims that might be allowed would be known.

V. According to the statement of grounds, claim 1 of the main request was a combination of claim 1 and dependent claim 8 of the version refused by the examining division. Since neither formal objections nor objections regarding novelty were raised against the former claims, such objections should neither be an issue for the present claims.

Regarding inventive step, the appellant submitted that the licence system cited by the examining division as closest prior art was ill defined and did certainly not address security problems which arise when data were moved between user terminals. Neither did the remaining prior art documents cited against the present application relate to any such movement of data, nor did they address any of the security problems associated therewith.

Reasons for the Decision

1. The appeal is admissible.

2. Furthermore, the request for reversal of the decision under appeal is allowable on the basis of the claims as amended according to the present main request. These amendments are admissible and remove the factual basis on which the decision under appeal was taken.

3. More specifically, the amendments consist essentially in the combination of former claim 1 with former dependent claim 8, which was already present as claim 25 in the translation of the application originally filed. The Board is hence satisfied that the amendments do not introduce new subject matter into the application. The claimed teaching is also clearly expressed by the wording of claim 1. Nevertheless, a formal point possibly requiring further consideration in respect of clarity relates to the fact that the terminal apparatus is presently also defined by features of the contents server which however is not part of it (see in particular the last but third paragraph of claim 1).

4. The main request is now directed to the embodiment shown in figure 6 ff. and described in section [0072] ff. of the application as published. This embodiment essentially solves the problem to move contents data from a user terminal forward to another destination without jeopardising the protection of the contents moved.

Prima facie, the prior art cited by the examining division is not pertinent to the embodiment to which present claim 1 now relates. The examining division did not specifically deal during the examination proceedings, and in particular not in the decision under appeal, with this embodiment. Hence, the substantive examination has yet to be made. The Board remits, for this reason, the case back to the examining division for further prosecution on the basis of the present main request (Article 111(1) EPC 1973).

5. Since the Board does not contemplate refusing the grant of a patent according to the main request, the appellant's auxiliary request for oral proceedings to be held need not be taken into account.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance for further prosecution.

The Registrar: The Chairman:

T. Buschek S. Steinbrener