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**Datasheet for the decision  
of 5 June 2009**

**Case Number:** T 0869/06 - 3.5.05

**Application Number:** 96304685.9

**Publication Number:** 0752678

**IPC:** G06F 19/00

**Language of the proceedings:** EN

**Title of invention:**

Apparatus and method for executing game programs having advertisements therein

**Applicant:**

Sony Corporation

**Opponent:**

-

**Headword:**

Game programs having advertisements/SONY

**Relevant legal provisions:**

EPC Art. 52(1)

RPBA Art. 15(2)

**Relevant legal provisions (EPC 1973):**

EPC Art. 54, 56, 106, 107, 108

**Keyword:**

"Inventive step (main request - no, auxiliary request 1 - yes)"

**Decisions cited:**

J 0010/07, T 1102/03, T 1053/06

**Catchword:**

Postponement of oral proceedings - see Reasons point 2.



Case Number: T 0869/06 - 3.5.05

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.05  
of 5 June 2009

**Appellant:** Sony Corporation  
7-35 Kitashinagawa 6-chome  
Shinagawa-ku  
Tokyo 141 (JP)

**Representative:** Cotter, Ivan John  
D Young & Co  
120 Holborn  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 29 December 2005  
refusing European application No. 96304685.9  
pursuant to Article 97(1) EPC 1973.

**Composition of the Board:**

**Chairman:** D. H. Rees  
**Members:** A. Ritzka  
P. Schmitz

## Summary of Facts and Submissions

I. This appeal is against the decision of the examining division dispatched 29 December 2005, refusing European Patent Application No. 96 304 685.9 for the reason that claim 1 of each of the requests did not involve an inventive step having regard to the disclosure of either of

D1: WO 93/22017 A and

D2: GB 2 141 907 A in combination with

D3: WO 93/19427 A.

II. Notice of appeal was submitted on 28 February 2006. The appeal fee was paid on the same day. The notice of appeal was said to be against the decision of the examining division. The statement setting out the grounds of appeal was submitted on 28 April 2006. With the statement setting out the grounds of appeal claims 1 to 26 of a main request, claims 1 to 24 of auxiliary request 1, claims 1 to 22 of auxiliary request 2 and claims 1 to 20 of auxiliary request 3 were filed.

III. The board issued an invitation to oral proceedings scheduled to take place on 12 May 2009 accompanied by a communication. In the communication the board objected to claim 1 of the main request that it did not appear to be novel having regard to the disclosure of D1. If D1 was interpreted in a narrow sense, claim 1 would not appear to involve an inventive step having regard to the disclosure of D1 and D2. Further, the board expressed the view that the subject-matter of the independent claims 1 and 13 of auxiliary request 1 appeared to involve an inventive step.

- IV. With its letter of 12 March 2009, the appellant's representative requested that the date of the oral proceedings be postponed to a date after 18 May 2009, since the representative had already made arrangements for a business trip to the USA from 5 May to 16 May 2009, including pre-booking and paying for flights which could only be changed at considerable expense.
- V. In response to the board's communication of 16 March 2009 objecting to the missing requirements of a request for postponing oral proceedings according to the Notice of the Vice-President of DG3 dated 16 July 2007 concerning oral proceedings before the Boards of Appeal (see Special Edition No. 3 to OJ EPO 2007, 115), the appellant's representative with its letter of 27 March 2009 provided copies of an email and itinerary information dated 25 February 2009 as evidence that the flights were pre-booked. Moreover, he stated that although several other patent attorneys of his law firm could attend the oral proceedings, the appellant would be disadvantaged if the case were transferred at short notice to another representative, since the present undersigned representative had represented the applicant at former stages of the proceedings.
- VI. In its communication of 3 April 2009 the board informed the appellant, that oral proceedings was postponed to 5 June 2009.
- VII. In its letter of 7 April 2009 the appellant's representative announced that he would attend oral proceedings. He further confirmed the request that the decision under appeal be set aside and that the patent

be granted based on the claims of the main request or one of the auxiliary requests on file. The appeal was further based on the further documents on which the decision under appeal is based, i.e. the description pages 1 to 19 and the drawings sheets 1/11 to 11/11 as originally filed.

VIII. At the oral proceedings, which took place as scheduled on 5 June 2009, the appellant filed claims 1 to 24 of auxiliary request 1 replacing auxiliary request 1 on file, withdrew auxiliary requests 2 and 3 and requested that the decision under appeal be set aside and a patent granted on the basis of the main request filed with letter of 28 April 2006, or auxiliary request 1 as filed during the oral proceedings before the board.

At the end of the hearing the board announced its decision.

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

"Apparatus for executing a game program having advertisements therein, comprising:

storage means for storing a game program and advertising data relating to a plurality of advertisements;

means for downloading at predetermined times advertising selection data identifying selected ones of said plurality of advertisements stored in said storage means; and

program execution means for executing said game program stored in said storage means, for selecting one or more of the plurality of advertisements in accordance with the downloaded advertising selection

data and for outputting display data corresponding to the selected advertisements identified in said advertising selection data at respective times within said game program."

Claim 14 is a method claim corresponding to claim 1.

Claim 1 of auxiliary request 1 adds to claim 1 of the main request that said means for downloading is operable to download said game program and said advertising data with said advertising selection data when the apparatus attempts to execute said game program a first time; and said storage means is operable to store the downloaded game program and the advertising data, the advertising selection data being downloaded separately at predetermined times after the game program, the advertising data and the advertising selection data were downloaded when the program was first executed.

Claim 13 of auxiliary request 1 is a method claim corresponding to claim 1.

## **Reason for the Decision**

### **1. *Admissibility***

The appeal complies with the provisions of Articles 106 to 108 EPC 1973, which are applicable according to J 0010/07, point 1 (see Fact and Submissions point II above). Therefore it is admissible.

2. *Request for postponement of oral proceedings*

According to Article 15(2) of the Rules of Procedure of the Boards of Appeal, a change of date for oral proceedings "may exceptionally be allowed in the Board's discretion". Examples of circumstances that may be taken into account when exercising this discretion are given in the Notice of the Vice-President of DG3 dated 16 July 2007 concerning oral proceedings before the Boards of Appeal (see Special Edition No. 3 OJ EPO 2007, 115).

The board accepts on the basis of the representative's statement and the filed supporting evidence, (see Facts and Submissions, points IV, V and VI above), that he had arranged and booked the business trip on the date set for oral proceedings before the notification of the summons and that a business trip arranged in advance of the notification of the summons is a serious substantive reason to request the change of the date for oral proceedings. However, the request does not in fact correspond to any of the circumstances given in the Vice-President's Notice as the present representative could have been substituted by another representative of the same firm.

The board notes that, in accordance with established case law (see e.g. T 1102/03 and T 1053/06), when deciding on a request for postponement of oral proceedings, the discretion should be exercised considering the procedural economy, an optimised use of resources and capacities and the interest of the public.

In the board's view, in such a case as this only an alternative date within a period of about two months from the date of the request is justifiable in view of the balance of interests of the parties and the public. The period of about two months arises from the fact that, except for when the parties consent, new summons have to be issued at least two months in advance of a hearing, so that dates within the two-month period from the date of the request could not be used for other cases. Therefore, the date for oral proceedings was postponed to 5 June 2009.

3. *Main request*

3.1 Interpretation of the claims

Claim 1 refers to storage means for storing a game program and advertising data relating to a plurality of advertisements and to means for downloading at predetermined times advertisement selection data identifying selected ones of said plurality of advertisements stored in said storage means.

The term "at predetermined times" is interpreted as at a time according to a previous definition, i.e. rule, e.g. at the start of the program.

The appellant argued that the term "at predetermined times" had to be interpreted in relation to the "advertisements stored in said storage means" in the sense that the advertising selection data was downloaded after storing the advertisement data. Moreover, the use of the plural form indicated that the downloading took place sequentially.



These arguments do not convince the board. Although claim 1 encompasses the option that the downloading means is operable to download the advertising selection data separately after storing the game program and advertising data in the storage means, as the appellant stated, claim 1 encompasses also the option that the advertising data is downloaded with the advertising selection data, as claimed in claim 7 and admitted by the appellant.

### 3.2 Novelty and inventive step

D1 discloses an apparatus for video games and advertising sequences (see title), thus an apparatus for executing a game program having advertisements therein. The apparatus comprises a program store and a video store containing data which, when addressed by the CPU, is arranged to present one or more advertising sequences of video pictures advertising goods or services (see the figure, page 3, 2nd paragraph and page 4, 2nd paragraph), corresponding to storage means for storing a game program and advertising data relating to a plurality of advertisements.

The advertising sequence or sequences may be downloaded from a central computer, thus being replaceable under control of a manager (see page 6, 2nd paragraph).

The apparatus further comprises a CPU including a memory into which the program of the program store and the advertisement data of the video store are loaded for operation (see page 3, 2nd paragraph to page 4, 2nd paragraph), corresponding to program execution means

for executing said game program stored in said storage means, for selecting one or more of the plurality of advertisements and for outputting display data corresponding to the selected advertisements at respective times within said game program.

The board accepts that D1 does not disclose means for downloading at predetermined times advertising selection data identifying selected ones of said plurality of advertisements stored in said storage means and in selecting the advertisement data to be displayed according to the advertising selection data.

D2 discloses a video game apparatus for playing one or more video games, including means for enabling the display of advertising information (see page 1, lines 32 to 48). The apparatus comprises a read only memory, in which a game program is stored (see page 1, lines 109 to 112), and a video player, on which the advertising material is stored (see page 2, lines 3 to 6). Thus, D2 discloses an apparatus for executing a game program having advertisements therein, comprising storage means for storing a game program and advertising data relating to a plurality of advertisements.

When a game is being played, the control electronics switches to a TV screen to show the output from the game circuitry. When the machine is free, the electronics would switch over the TV screen to the video player in order to display the advertising material. See page 2, lines 6 to 11.

D2 discloses an embodiment which includes a clock/calendar facility and in which it is possible for adverts to be scheduled for different times of the day or different parts of the year (see page 2, lines 45 to 54). When an advert is to be shown, the hardware would select one of the adverts (see page 2, lines 105 and 106). This implies the use of "advertising selection data".

Although D2 at page 2, lines 90 and 91 discloses that, if data are lost when the machine is switched off, adverts can be put onto the machine via a cable link, considering the time when D2 was filed, 1983, this has to be interpreted in the sense of a link to a portable storage device, e.g. a cassette player, rather than to means for downloading as this term would be understood by the skilled addressee of the present application.

The subject-matter of claim 1 differs from the disclosure of D2 by the means for downloading at predetermined times advertising selection data identifying selected ones of said plurality of advertisements stored in said storage means.

Thus, the subject-matter of claim 1 is novel.

D1 is considered to be the most relevant prior art document.

As stated above, the subject-matter of claim 1 differs from the disclosure of D1 by the means for downloading at predetermined times advertising selection data identifying selected ones of said plurality of advertisements stored in said storage means and in

selecting the advertisement data to be displayed according to the advertising selection data. This feature provides a concrete implementation for controlling the replacement of advertising sequences by the manager using the advertising selection data, thereby solving the problem of specifying an implementation for controlling the replacement of advertising sequences by the manager.

The clock/ calendar facility of D2 (see page 2, lines 45 to 54 and 109 to 115) constitutes an embodiment for selecting an advertisement to be shown such that an advertiser can control which of several adverts is shown at any time. Thus, the clock/ calendar facility achieves a similar effect in the technology of D2 as the downloading of the advertising selection data of claim 1. The skilled person would understand that D2 implicitly discloses the use of "advertising selection data", see D2, page 2, lines 45 to 61 and 103 to 115, and that these "advertising selection data" are assigned to the corresponding advertising data.

Moreover, D2 gives an outlook to new technologies as personal computers (see page 2, lines 73 to 82), to which the method may be adapted. The skilled person would thus consult D2 when looking for a solution of the technical problem underlying claim 1.

According to D1 (see page 6, second paragraph), the advertising sequences may be downloaded from a central computer, thus being replaceable under control of a manager. Downloading advertising sequences implies the existence of a data link between the central computer and the game apparatus. Being replaceable under the

control of a manager implies that the control of the manager is effected over the data link.

The skilled person would understand that the advertising selection data implicitly disclosed by D2 may be applied to the system of D1, such that any advertising data are provided with corresponding advertising selection data. The board therefore considers downloading the advertising selection data with the advertising data to be obvious.

The appellant argued that, although it admitted that D2 implicitly disclosed the use of advertising selection data, none of the documents on file disclosed that advertising selection data may be downloaded. In the benefit of doubt it should be assumed that it was not obvious to download advertising selection data.

The board is not convinced by this argument since the established case law of the boards of appeal does not refer to the benefit of doubt with respect to the assessment of inventive step. The present board notes that when assessing inventive step it has to be evaluated whether the skilled person would arrive to the claimed solution starting from the explicit and implicit disclosure of the prior art documents making use of the general common knowledge.

Thus, the subject-matter of claim 1 in the interpretation given in point 3.1 above does not involve an inventive step.

Similar arguments apply to the corresponding method of claim 14.

4. *Auxiliary request 1*

Claim 1 of the auxiliary request 1 differs from claim 1 of the main request in specifying that the game program, the advertising data and the advertising selection data are downloaded when the apparatus first attempts to execute the program, that the game program and the advertising data are stored in the storage means and that the advertising selection data are downloaded separately at predetermined times after the game program, the advertising data and the advertising selection data were downloaded when the program was first executed.

The arguments presented in point 3.2 regarding claim 1 of the main request apply similarly with respect to the identical features.

In addition to the difference presented in point 3.2 above the subject-matter of claim 1 of auxiliary request 1 differs from D1 in downloading the advertising selection data separately at predetermined times after the game program, the advertising data and the advertising selection data were downloaded after the program was first executed. This feature provides the technical effect that, when updating the advertising selection data, the quantity of downloaded data is reduced, solving the problem of providing an apparatus adapted to execute a game program and to display selected ones of the advertisements, keeping the selection up to date with a reasonable use of bandwidth resources.

However, none of the documents on file explicitly disclose the downloading of advertisement selection data and it is not considered to be obvious to download the advertising selection data separately at predetermined times after the game program, the advertising data and the advertising selection data were downloaded when the program was first executed.

Therefore, the subject-matter of claim 1 involves an inventive step.

Similar arguments apply to the corresponding method of claim 13.

## **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 with the order to grant a patent on the basis of the claims of auxiliary request 1 and a description and drawings still to be adapted.

Registrar:

Chairman:

K. Götz

D. H. Rees