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Datasheet for the decision of 20 February 2009

Case Number: T 1726/06 - 3.5.03

Application Number: 01928899.2

Publication Number: 1417792

IPC: H04H 1/02

Language of the proceedings: EN

Title of invention:
System for the delivery of audio recordings

Applicant:
Kochian, Michael C.

Opponent:
-

Headword:
Delivery of audio recordings/KOCHIAN

Relevant legal provisions:
EPC Art. 56, 123(2)

Relevant legal provisions (EPC 1973):
EPC Art.

Keyword:
"Added subject-matter - yes (main request, and first, third and fourth auxiliary requests)"
"Inventive step - no (second auxiliary request)"

Decisions cited:
G 1/93, T 66/85, T 415/91

Catchword:
-

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Case Number: T 1726/06 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 20 February 2009

Appellant: Kochian, Michael C.
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 19 May 2006 refusing European application No. 01928899.2 pursuant to Article 97(1) EPC 1973.**

Composition of the Board:

Chairman: A. S. Clelland
Members: T. Snell
R. Moufang

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division refusing European patent application No. 01928899.2, with international publication number WO-A-02/089372.

The refusal was based on the ground that the subject-matter of the claims of a main request and an auxiliary request did not meet the requirement of inventive step pursuant to Article 52(1) in combination with Article 56 EPC with respect to the disclosure of the following document:

D1: EP-A-0898278

II. The appellant filed a notice of appeal against the above decision. New claim sets of a main request and first and second auxiliary requests were subsequently filed together with a statement of grounds of appeal.

In the statement of grounds, the appellant requested that the decision under appeal be set aside and a patent granted on the basis of one of the aforementioned requests.

Oral proceedings were conditionally requested.

III. In a communication accompanying a summons to oral proceedings the board gave a preliminary opinion in which, *inter alia,* matters concerning Articles 123(2) and 84 EPC, and Article 52(1) in combination with Article 54 or 56 EPC were raised with respect to the claims of the various requests.

IV. In response to the board's communication, the appellant filed a new claim set as a third auxiliary request.

V. Oral proceedings were held on 20 February 2009. At the oral proceedings the appellant submitted claims of a fourth auxiliary request. The appellant requested that the decision under appeal be set aside and a patent granted on the basis of the claims of the main request, or alternatively the claims of one of the first to fourth auxiliary requests.

At the end of the oral proceedings the board announced its decision.

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

"A base unit (77) functioning to interface to and to control an *[sic]* recording device (80) that is capable of making a recording onto standard recording media, wherein said base unit (77) includes:
communications means (14) for communicating over a network with a service center (33) of content material, and for receiving and transmitting data between said service center and said base unit;
processing means (49), for controlling the overall operation of said base unit;
conversion means (45), for converting said data to a form that is suitable for output to said recording device (80);
a control interface means (40), for interfacing said base unit (77) with said recording device (80), and functioning to control said recording device (80);
characterized in that

said processing means is adapted to generate feedback information to said service center indicating the operational readiness of said base unit."

VII. Claim 1 of the **first auxiliary request** reads as follows:

"A base unit (77) functioning to interface to and to control an *[sic]* user-provided recordinig *[sic]* device (80) that is capable of making a recording onto standard recording media, wherein said base unit (77) includes:
- communications means (14) for communicating over a network with a service center (33) of content material, and for receiving and transmitting data between said service center and said base unit;
- processing means (49), for controlling the overall operation of said base unit;
- memory means (70,72,73) electronically interconnected to said processing means, for storing instructions and data as necessary;
- conversion means (45,46), for converting said data to a form at that is suitable for output to said user-provided recording device (80);
- control interface means (40), for interfacing said base unit (77) with said user-provided recording device (80), and fuctioning *[sic]* to control said user-provided recording device;
- input means (44), for accepting input from the user regarding the delivery of said data;
characterized in that
said processing means is adapted to send feedback to said service center containing status information indicating operational readiness."

VIII. Claim 1 of the **second auxiliary request** reads as follows:

"A base unit (77) functioning to interface to and to control an *[sic]* user-provided recordinig *[sic]* device (80) that is capable of making a recording onto standard audio recording media, wherein said base unit (77) includes:
- communications means (14) for communicating over a network with a service center (33) of content material, and for receiving and transmitting data between said service center and said base unit;
- processing means (49), for controlling the overall operation of said base unit;
- non-volatile, read-only memory, electronically interconnected to said processing means, storing instructions that are executable by said processing means;
- a control program, stored in said non-volatile, read-only memory, functioning to contain said executable instructions;
- feedback means, contained as a specialized set of instructions in said control program, functioning to provide information, in the form of a data network message, to said service center (33) pertaining to status information identified and stored in said base unit;
- non-volatile digital memory storage means functioning to store digital audio information transmitted to the base unit from the service center;
- decompression means, electronically interconnected to said processing means, functioning to accept compressed

digital audio information and to convert said information into decompressed digital audio data;
- conversion means (45), for converting said data to a form at *[sic]* that is suitable for output to said user-provided recording device (80);
- a control interface means (40), for interfacing said base unit (77) with said user-provided recording device (80), and fuctioning *[sic]* to control said user-provided recording device;
characterized by
- a user switch (44) having first and second conditions, electronically interconnected to said processing means, permitting a subscriber to activate or deactivate said base unit depending on the respective condition of the switch; and
wherein said processing means is adapted to generate feedback information to said service center indicating the operational readiness of said base unit."

IX. Claim 1 of the **third auxiliary request** reads as follows:

"A base unit (77) functioning to interface to and to control an *[sic]* recording device (80) that is capable of making a recording onto recording media, wherein said base unit (77) includes:
communications means (14) for communicating over a network with a service center (33) of content material, and for receiving and transmitting data between said service center and said base unit;
processing means (49), for controlling the overall operation of said base unit;
conversion means (45), for converting said data to a form that is suitable for output to said recording device (80);

a control interface means (40), for interfacing said base unit (77) with said recording device (80), and functioning to control said independent recording device (80);
characterized in that
said processing means is adapted to generate feedback information to said service center indicating user enablement of a download process."

X. Claim 1 of the **fourth auxiliary request** reads as follows:

"A base unit (77) functioning to interface to and to control an *[sic]* recording device (80) that is capable of making a recording onto recording media, wherein said base unit (77) includes:
communications means (14) for communicating over a network with a service center (33) of content material, and for receiving and transmitting data between said service center and said base unit;
processing means (49), for controlling the overall operation of said base unit;
conversion means (45), for converting said data to a form that is suitable for output to said recording device (80);
a control interface means (40), for interfacing said base unit (77) with said recording device (80), and functioning to control said independent recording device (80);
characterized in that
said processing means is adapted to generate feedback information to said service center indicating readiness to receive a transmission from said service center based on the operational status of the base unit."

Reasons for the Decision

1. *Article 123(2) EPC*

1.1 Article 123(2) EPC states that a European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

1.2 As has been made clear in Decision G 1/93 of the Enlarged Board of Appeal (OJ EPO 1994, 541, point 9) the underlying idea of Article 123(2) EPC is that "an applicant shall not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application". The established criterion is that the subject-matter of an amended application must be **clearly and unambiguously** deducible from the application as filed. This is the criterion adopted by the board in the present case.

1.3 *Main request - claim 1*

1.3.1 The base unit of claim 1 of this request lacks many of the elements present in claim 1 as originally filed. According to the established case law, the requirement of Article 123(2) EPC as applied to the claims means that it is only permissible to delete features from an independent claim if there is a clear and unambiguous basis for a claim lacking these features in the

application as originally filed (cf. Decision T 66/85, OJ EPO 1989, 167).

1.3.2 One of the elements which has been deleted is that the data delivered to the base unit is audio information.

The application as filed consistently refers to the invention as concerning the transmission and recording of audio information (cf. page 1, lines 1-10, page 4, lines 13-15 and original independent claims 1, 15 and 19). All the detailed embodiments also concern the processing of audio information. However, claim 1 now makes no reference to audio but encompasses a base unit able to receive and record any kind of data.

Since no clear and unambiguous basis can be found in the application documents as filed for such a generalisation of the disclosure, the board concludes that subject-matter has been added.

1.3.3 The appellant argued that it was permissible to delete the term "audio" from the independent claims because it was clearly not essential that the data concerned were audio data. Moreover, it was clear from the final paragraph of the description that the invention was not limited to the described embodiments.

1.3.4 The board is not convinced by these arguments. As stated above, the description presents the invention purely in terms of audio transmission and recording. Although the background to the invention at page 3, lines 14-33 mentions control of video cassette recorders (VCR), this is only in the context that such systems "[do] not address the need to control standard

audio recording devices" (cf. page 3, line 18), that "video requirements dictate the complexity of the receiving system" (cf. page 3, line 26) and that "None automatically download audio recordings to standard audio cassette tape" (cf. page 3, lines 31-32), ie these systems do not provide a solution to the problem posed by the invention of downloading, storing, and playback of audio information. Even if it might occur to the skilled person that the invention could be applicable to other types of data, this would be the skilled person's own idea and is not taught by the application as filed (cf. T 415/91, not published, point 2.3 of the reasons for the decision, which the board considers to be an analogous case).

1.3.5 The final paragraph of the description reads as follows:

"While the invention has been described in terms of selected preferred embodiments, it is to be understood that the invention is not limited only to those embodiments. Rather, many modifications and variations will present themselves to those skilled in the art without departure from the scope and spirit of the invention, as defined in the appended claims."

The Guidelines for Examination, C-III, 4.4 require that general statements including the expression "spirit of the invention" be objected to because they imply that the extent of protection may be expanded in some vague and not precisely defined way. With regard to Article 123(2) EPC, the board does not view the above passage as a suitable basis for deleting the term "audio" for the reason that such a vague and imprecise statement can give no clear and unambiguous guidance as to how

the detailed embodiments of the description might be generalised, and certainly no specific hint to the transmission of any other data than audio data.

1.3.6 In view of the above, the board concludes that claim 1 of the main request fails to comply with Article 123(2) EPC.

1.4 *First, third and fourth auxiliary requests - claim 1*

Claim 1 of each of these requests fails to include the term "audio". Hence the above considerations in respect of claim 1 of the main request apply *mutatis mutandis* to claim 1 of the first, third and fourth auxiliary requests. These requests accordingly also fail to comply with Article 123(2) EPC.

2. *Inventive step: second auxiliary request - claim 1*

2.1 Although questions remain as to whether certain claims of the second auxiliary request meet the requirements of Articles 84 EPC as to clarity and/or 123(2) EPC as to added subject-matter, the board is in a position to interpret claim 1 of this request in order to permit an assessment of the claimed subject-matter with respect to inventive step.

2.2 The board considers that D1, the document on which the examining division based its decision, represents the closest prior art.

2.3 D1 discloses an audio server unit adapted to store a library of compressed audio files (paragraph 0025). These files can be downloaded to a download unit

comprising a recording and playback section on request from a user (paragraph 0048). As part of the download process, the compressed audio files are stored directly onto a recording medium of the recording and playback section, whereby in the main embodiment the recording medium is a magneto-optical disc, also called mini disc (paragraphs 0061-0062). However, it is stated in paragraph 0459 that the recording medium need not be a mini disc but can be any other recording medium which allows random accessing.

2.4 Further, according to the embodiment shown in figure 34 and described in paragraphs 0453-0455, the system can be embodied as a "center server" with the functionality of the aforementioned audio server unit, connected to one or more "server terminals" via a communications network. A server terminal is regarded as a base unit within the meaning of the present application, and has a recording and playback section as described above with non-volatile digital memory storage (mini disc) functioning to store digital audio information transmitted to the base unit from the service center.

Implicitly, the server terminal includes conventional features of a data processing unit such as a non-volatile, read only memory and a control program. The server terminal of D1 also comprises feedback means functioning to provide information, in the form of a data network message, to said server center pertaining to status information identified and stored in said base unit (UD STATUS, cf. paragraph 0352), conversion means for converting the data into a form suitable for storage on the mini disc recording medium (*inter alia* Reed Solomon error correction processing, cf. paragraph

0114), and decompression means functioning to accept compressed digital audio information and to convert said information into decompressed digital audio data (cf. paragraph 0073).

2.5 In view of the above, D1 discloses a base unit having all the features of the preamble of claim 1, with the exception that the base unit according to claim 1 functions to interface to and control, by means of a control interface, a user-provided recording device rather than the recording device being included in the base unit itself, and that decompressed digital audio data is provided to the user-provided recording device.

2.6 As mentioned above it is stated in D1, paragraph 0459 that the recording medium need not be a mini disc but can be any other recording medium which allows random accessing. In the view of the board, it is obvious that the skilled person starting out from D1 would contemplate particularly those random access data storage alternatives to mini discs which have the same advantages of small size and portability. An obvious candidate available at the filing date of the application was an mp3 player. Hence the replacement of the built-in mini disc recorder of D1 by an external user-provided recording device does not require inventive skill. An mp3 player, once connected to a base unit (eg a personal computer), is controlled by the base unit via a control interface, eg a USB interface. Thus the provision of a control interface is also obvious.

2.7 Regarding the provision of digital audio data to the storage medium in decompressed form, it is stated on

page 21, lines 11-13 of the description of the present application that "those experienced in the art will recognize that the form of the signal conveyed from the base unit 77 to the recording device 80 depends on the capabilities of the recording device 80. Audio information can be transferred from the base unit 77 to the recording device 80 in compressed form if, due to the nature of the recording device 80, this proves to be a more efficient process". The board considers that recording data on an audio player in decompressed form is merely a less efficient option without any apparent advantage which could provide the basis for an inventive step.

2.8 The characterising part of claim 1 requires

(i) a user switch having first and second conditions, electronically interconnected to said processing means, permitting a subscriber to activate or deactivate said base unit depending on the respective condition of the switch; and that

(ii) said processing is adapted to generate feedback information to said service center indicating the operational readiness of said base unit.

2.9 Regarding (i):

2.9.1 The board considers that the user switch as defined in this claim encompasses a simple power on/off switch or a standby switch conventionally provided in user equipment. A power on/off switch is implicitly electronically interconnected to the processor means to

provide it with power to activate or deactivate the base unit.

2.9.2 In the statement of grounds, in respect of the second auxiliary request, the appellant argued that "The condition of the switch is ... processed by the processing means to function *[sic]* the feedback means to generate a data network message to and on request of the service center containing status information indicating whether the base unit is activated or deactivated ... This information is then used to determine whether delivery of audio information ... is desired or not ... The present invention does provide the subscriber with a simple and convenient means to manage his or her own audio information delivery from the service center in accordance with his or her own time schedule and information ..."

However, the board notes that the wording of the claim does not require that the condition of the switch be processed by the processing means to cause the feedback means to generate such a data network message, nor does the claim require any request from the service center or include any limitation regarding a user's time schedule. It is only required that the switch be interconnected to the processing means, which as already mentioned embraces the function of an on/off power switch. Hence the board is unconvinced by these arguments.

2.10 Regarding (ii):

2.10.1 When data are to be downloaded in the D1 system, the server unit first supplies a SETUP command to the

recording and playback section (paragraph 0351). The recording and playback section responds by transmitting a feedback message UD STATUS to inform the server unit that a setup condition is entered (paragraph 0352). After setup is confirmed, the server unit supplies a download recording command to the recording and playback section, which starts a recording operation on reception of this command (paragraph 0353).

These operations are preceded by a check by the server unit as to whether sufficient space exists on the disc for the amount of data to be downloaded. This is carried out by the server unit requesting that the recording and playback section transfer information concerning the U-TOC sector 0, which has been read upon loading of the disc.

2.10.2 In the board's view, both the UD-STATUS message and the U-TOC sector 0 message are feedback messages confirming that the recording and playback section is operationally ready for data transfer (paragraphs 0266-0267). Hence these are feedback messages indicating the operational readiness of the base unit.

2.10.3 At the oral proceedings, the appellant argued that the feedback messages in D1 did not indicate "operational readiness" of the base unit. "Operational readiness" was to be understood in the sense of the desire of the base unit to receive transmissions. The service center used this information to determine whether or not it should initiate transmission of audio information to the base unit. The feedback messages of D1 merely aided the process of delivery once transmission had been initiated.

The board however considers that the generality of the wording of claim 1 does not allow such a restrictive interpretation of the term "operational readiness". Hence the board is unconvinced by the appellant's argument.

2.10.4 The appellant also argued that the feedback message of the present invention enabled the base unit to receive and record files automatically in unattended fashion, based on the condition of the user switch, whereas in D1 the user had to be involved in the operation.

The board notes however that claim 1 of this request does not require that the audio information be recorded automatically without any user involvement in the process. Hence the board also finds this argument unconvincing.

2.10.5 In consequence, the board concludes that the subject-matter of claim 1 of the second auxiliary request does not involve an inventive step (Articles 52(1) and 56 EPC).

2.10.6 The board has also considered the possibility that claim 1 should be interpreted in the sense that the feedback information indicates the condition of the switch in order to enable data to be downloaded to the base unit "automatically". In this case, the claimed subject-matter in the board's view would still not involve an inventive step for the following reasons.

2.10.7 It was well-known at the filing date of the application to perform automatic updates to a subscriber base unit

such as a personal computer, eg updates of the operating system or a virus checking program. Conventionally in such systems, the user selects automatic updates by ticking a box in the application program displayed on the monitor. Once selected, these updates proceed automatically in the background without further user involvement. Implicitly this process requires that the central server be informed via a network message that the subscriber unit desires to receive such updates. This procedure is analogous to the embodiment described in the present application on page 24, lines 24-29, whereby the server center does not initiate contact but waits for the base unit to send a "trap" to the service center indicating that the base unit is available to receive a transmission message.

2.10.8 It was also well-known at the filing date of the application that a personal computer arranged for receiving data could instead be implemented in the form of a dedicated processing unit (eg a set-top box for digital television reception). In such dedicated units, it is common for certain frequently carried-out operations to be selectable via user switches provided on the case of the unit as an alternative to programming the unit using an on-screen menu. Hence it is obvious that the software-based selection of updates referred to in the previous paragraph could instead be implemented by means of a dedicated user switch.

2.10.9 Therefore the board can recognise no inventive skill either in modifying the system of D1 to enable automatic updates, or in the provision of a user switch

to place the unit into a condition to receive automatic updates.

3. The board therefore concludes that claim 1 of each of the appellant's requests is not allowable. Consequently the requests as a whole are not allowable and, since there is no allowable request, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

D. Magliano A. S. Clelland