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**Datasheet for the decision
of 16 September 2010**

Case Number: T 1458/07 - 3.2.04

Application Number: 02765604.0

Publication Number: 1454664

IPC: A63F 13/12

Language of the proceedings: EN

Title of invention:
On-line game method

Applicant:
Kabushiki Kaisha Eighting

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 56

Relevant legal provisions (EPC 1973):
-

Keyword:
"Inventive step (main, 2nd and 3rd auxiliary request) - no"
"Admissibility late filed requests (1st, 3rd, 5th auxiliary
request) - no"

Decisions cited:
T 0270/90

Catchword:
-



Case Number: T 1458/07 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 16 September 2010

Appellant:

Kabushiki Kaisha Eighting
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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 20 February 2007
refusing European patent application
No. 02765604.0 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: M. Poock
T. Bokor

Summary of Facts and Submissions

I. This is an appeal against the decision of the examining division of 20 February 2007 to refuse European patent application 02 765 604.0 for lack of inventive step having regard to document US-A-6 200 216 (D2).

The applicant lodged the notice of appeal on 19 April 2007 and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was filed on 11 June 2007.

II. Oral proceedings before the board of appeal took place on 16 September 2010.

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

- claims 1 to 4 filed with the grounds of appeal (main request) or in the alternative,
- on the basis of any of the first to fifth auxiliary requests, filed during the oral proceedings.

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

"A method of providing an online game on a mobile terminal, comprising the steps of:

- a) - preparing a product to carry an ID code assigned thereto;
- b) - storing in a data base (311) a number of image characters reflecting features of the product and

correlated to the ID code (18) of the product (12);

- c) - transmitting (308) the ID code (18) of the product to an administration server (230) of a service provider (200) comprising the data base (311);
- d) - searching from the data base (311) an image character correlated to the ID code;
- e) - transmitting the selected image character to a mobile terminal (13); and
- f) - displaying the transmitted image character as an online game character in the online game on the mobile terminal".

In claim 1 of the first auxiliary request, the term "stuffed toy" substitutes the term "product" in the main request.

Claim 1 of the second auxiliary request adds to the end of claim 1 of the main request the feature "so that an illustration mimicking the product is shown on the display".

In claim 1 of the third auxiliary request, "stuffed toy" substitutes the term "product" of the second auxiliary request.

Claim 1 of the fourth auxiliary request adds to the end of claim 1 of the main request the feature "so that a picture of the product is shown".

In claim 1 of the fifth auxiliary request, "stuffed toy" substitutes the term "product" of the fourth auxiliary request.

IV. The appellant essentially argued as follows:

The claimed subject-matter involves technical means and therefore has technical character, is new and involves an inventive step.

The gist of the invention resides in the specific implementation of the method which allows an interaction between a real world product, e.g. a stuffed toy, and the virtual world in order to promote sales of this real world product. The objective technical problem is how to technically implement that a real world product determines what on-line game character appears in an on-line game on a mobile terminal.

In claim 1, the term "product" relates to a tangible object. In contrast, document D2 relates exclusively to an intangible item, ie an electronic trading card.

Moreover, document D2 does not disclose the step of preparing a product with an ID-code, as required by feature a) of claim 1. As a consequence thereof, it does not disclose any of features b), c), and d) in which such ID-code is mentioned. The assignment of an ID-code to the product and the consequences thereof are essential technical features of the invention and, therefore, cannot be disregarded. They have to be considered for the examination of the inventive step in the framework of the problem-solution approach.

D2 does not explicitly mention that a series of game cards is provided with an ID-code, has a rather vague

and unclear disclosure and would not be used by the skilled person as a starting point.

In the oral proceedings before the board it was accepted that the card collecting game described in document D2 may comprise paper trading cards (PTCs) and electronic trading cards (ETCs) as well. Moreover, it was stressed that in the second and third auxiliary requests, "illustration" should read "illustration of the transmitted image character", and in the fourth and fifth auxiliary requests "picture" should read "picture of the transmitted image character".

The first, third and fifth auxiliary requests were filed as a reaction on the discussion in the oral proceedings before the board. It would thus be unfair not to admit these requests into the proceedings. Article 13 of the Rules of Procedure of the Boards of Appeal (RPBA) would provide in such cases the remittal of the case to the first instance.

Reasons for the Decision

1. The appeal is admissible.
2. *Inventive step - main, second and fourth auxiliary requests*
 - 2.1 The second and fourth auxiliary requests are identical to the first and second auxiliary requests filed with the statement of grounds of appeal. Thus, they were filed in appropriate time and are within the procedure.

2.2 Document D2

2.2.1 This document relates to electronic trading cards (in the following "ETCs") to be used in card collecting games. A player attempts to collect a respective complete series of a particular card type by searching a missing card of the series at a co-player (see column 1, lines 33 - 36).

With the invention disclosed in this document, trends in consumer multimedia technology (see column 1, lines 42 - 44 and column 3, lines 38 - 40) are addressed such that the traditional paper card collection game is extended also to on-line collection (see column 7, lines 27, 28).

A player having an incomplete series of a particular type of card at hand (for example, a card printed on paper media as set out in column 5, lines 51 - 57) and having access to a computing device and a network connection, is able to browse remote databases in search of particular ETCs and execute purchases and trades thereof worldwide (see column 7, lines 27 - 68).

After a player has found a missing ETC, it can be downloaded and printed on paper (see column 7, lines 59, 60; column 5, lines 55 - 57 and figure 2).

2.2.2 Therefore, the following features of claim 1 are disclosed in this document:

(a) *Main request*

- (i) According to the Oxford Dictionary of English, an ID-code is a series of letters, numbers, or symbols assigned to something for the purposes of identification.

In the game of D2, a player has to collect a respective complete series of a particular card type (see column 1, lines 33 to 36). Therefore, cards belonging to the respective series have to be identified so that they can be distinguished from other series. If, for instance, the theme of the collecting game relates to farm animals, each card in a series could show a horse. Another series shows pigs and still another one poultry. Within each series, the cards show different kinds of the animal of the series, ie in the horse series: black horse, white horse, pony, zebra. In a pig series: house pig, wild pig, black pig, and so on.

Thus, although not explicitly mentioned in document D2, it results from its explicit disclosure that each series of a particular card type has to be provided with an identification (such as, for example a picture of a horse, pig or poultry). Otherwise, the cards of a series could not be distinguished from cards of another series. Thus, the product (i.e. cards of a series) are prepared to carry an ID-code assigned thereto (feature a).

- (ii) The scope of the card collecting game is that a player must find the series ETCs in a number of disparate locations and bring them together for completing the card series.

Players can search remote databases to find missing ETCs and download them (see column 7, lines 29 - 60). Consequently, missing ETCs must have been stored in remote databases before they can be downloaded.

Each ETC of a respective series has an individual image character attributed thereto. In the example of the horse series card game given above, each ETC has a picture (image character) of a different horse.

Hence, document D2 discloses

- that a number of image characters (different horses) reflecting features of the product (card series of horses) and correlated to the ID-code of the product are stored in a database (feature b),
- that the players connect to an administration server of a service provider comprising the database (part of feature c), and
- that the players search from the database an image character correlated to the ID-code (feature d).

- (iii) Once the player has found a missing ETC on a remote database, it can be downloaded (column 7, lines 58 - 60 in connection with column 7, lines 31 and 32) to his handheld computing device (column 5, lines 43 - 47).

Hence, the found ETC with the selected image character is transmitted to a mobile terminal (feature e).

- (iv) The transmitted ETC with the image character is displayed on the handheld computing device (see column 5, lines 47 to 50). Since this step is performed during the card collecting game in which missing ETCs are downloaded, the transmitted image character is displayed as an on-line game character in the on-line game on the mobile terminal (feature f).

- (v) It is therefore concluded, that a method comprising these features is a method of providing an on-line game on a mobile terminal in the meaning of claim 1.

(b) Second and fourth auxiliary request

- (i) The appellant's submission that the term "illustration" in claim 1 of the second auxiliary request should read "illustration of the transmitted image character" is in line with page 2, line 19 and page 8, lines 19 - 22. Also "picture" in claim 1 of the fourth auxiliary request should read

"picture of the transmitted image character"
for the same reasons.

The additional features of claim 1 of these requests are also known from document D2 because it discloses that the transmitted ETC with the image character (e.g. a black horse) is displayed on the mobile terminal.

2.3 Derivation of the objective technical problem

2.3.1 Document D2 is considered to represent the closest prior art.

2.3.2 The subject-matter of claim 1 of the *main, second and fourth auxiliary requests* is distinguished from the method of D2 by the feature that the ID-code of the product is transmitted to the administration server of a service provider comprising the database. This feature is not explicitly disclosed in this document. Whether it is disclosed implicitly need not be examined because, in any case, its provision does not involve inventive considerations for the following reasons:

2.3.3 According to document D2, players have to browse remote databases, i.e. search through their entire content. With the provision of an ID-code, the area of the database which has to be searched for the missing ETC is reduced so that the search can be accomplished faster.

Therefore the technical problem can be formulated as a method of providing an on-line game on a mobile terminal in which the speed of data retrieval is

increased. This problem is different from the one mentioned by the appellant, i.e. how to make it possible that a real world product determines what on-line game character appears in an on-line game on a mobile terminal. In this wording, the paper trade cards of document D2 determine which ETC appears on the mobile terminal of the player. Thus, the problem as defined by the appellant is already solved with document D2.

2.3.4 Obviousness of the solution

From the above it follows that the skilled person is a programmer or software specialist.

This person knows well database indexing as a data structure for improving the speed of data retrieval operations in a database at the cost of slower writing speeds and increased storage space. Since the index corresponds to the ID-code in claim 1 and in view of the technical problem specified above, it is obvious for the skilled person to use this idea of database indexing in the method known from document D2.

Thus, the board comes to the same conclusion as the examining division in the impugned decision so that the main, second and fourth auxiliary requests cannot be allowed.

3. *Admissibility - first, third and fifth auxiliary requests*

3.1 Under Article 12(1) of the Rules of Procedure of the Boards of Appeal (RPBA), the scope or frame of

discussion in the appeal proceedings is determined by the parties written submissions in the notice of appeal, i.e. the statement of grounds, the reply and any answers to the board's communication filed in accordance with the board's instructions. This provision has also to be read in conjunction with paragraph 2 of the same article which stipulates that the statement of grounds and the reply must contain a party's complete case. Thus the parties' written submissions made at the start the appeal proceedings determine and also limit the scope or frame of discussion.

Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA) stipulates that "Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the boards discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy".

According to Article 13(3) RPBA "Amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings".

- 3.2 Criteria frequently adopted by the boards when exercising their discretion to admit a new request filed in the course of oral proceedings is whether or not good reasons exist for such late filing (which may be the case when amendments are occasioned by

developments in the proceedings) and whether or not a new request appears *prima facie* allowable, that is to say clearly overcomes the objections raised (see, e.g., T 270/90, OJ EPO 1993, 725).

3.2.1 In the present case, the first, third and fifth auxiliary requests were filed during the oral proceedings before the board. They pursue an aspect of the invention (stuffed toy) which was mentioned neither in the statement of grounds of appeal nor in the response to the board's communication. Thus consideration of the patentability of these new auxiliary requests would clearly extend the scope of debate with respect to that determined by the written appeal proceedings.

3.2.2 The appellant, then applicant, was well informed by the examining division of its understanding that document D2 discloses tangible as well intangible trading cards (see decision, page 4, penultimate line, minutes, item 4.5 and summons dated 16 May 2000; item 2.2).

Accordingly, the amendment in the first, third and fifth auxiliary requests can hardly have been occasioned by the discussion in the oral proceedings before the board and, therefore, constitute amendments in the meaning of Article 13(1) RPBA.

3.2.3 This amendment is based only on the description as filed originally. The original dependent claims were not directed to such product. Therefore, the board has no information whether or not this aspect was considered by the first instance when searching the state of the art just before the summons to attend oral

proceedings at the examination division were dispatched. Therefore it would be necessary to give the examining division the opportunity to decide whether an additional search for the claimed subject-matter is necessary or not. This would require adjournment of the oral proceedings.

3.2.4 Moreover, the board has serious doubts, whether the specification of the product as a stuffed toy in the known method of providing an online game required inventive considerations. Hence, the auxiliary requests are not *prima facie* allowable.

3.3 For all these reasons, the board decided not to admit the first, third and fifth auxiliary requests into the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

A. Counillon

M. Ceyte