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**Datasheet for the decision
of 15 May 2012**

Case Number: T 1768/07 - 3.5.01

Application Number: 00957405.4

Publication Number: 1299829

IPC: G06F 17/60

Language of the proceedings: EN

Title of invention:

System and method for digitally providing and displaying
advertisement information to cinemas and theaters

Applicant:

Cinecast, LLC

Headword:

Advertisement information/CINECAST

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Inadmissible amendments - yes (all requests)"



Case Number: T 1768/07 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 15 May 2012

Appellant: Cinecast, LLC
(Applicant) 121 Columbia Street
Cambridge, MA 02138-2731 (US)

Representative: Hammond, Andrew David
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 26 February 2007
refusing European patent application
No. 00957405.4 pursuant to Article 97(1) EPC
1973.

Composition of the Board:

Chairman: R. R. K. Zimmermann
Members: K. Bumés
G. Weiss

Summary of Facts and Submissions

- I. European patent application no. 00957405.4 published as international publication number WO 2001/013301 relates to a system and method for digitally providing advertisement information to cinemas and theatres.
- II. The examining division refused the application in oral proceedings held on 9 January 2007. The decision dealt with a main, a first auxiliary, and a second auxiliary request, each filed with an applicant's letter of 8 December 2006, and a third auxiliary request filed at the oral proceedings. According to the decision issued in writing on 26 February 2007 none of these requests met the requirement of inventive step.
- III. Only few of the claims pursued by the applicant before the examining division are still relevant in the present proceedings. These are independent claim 1 and dependent claim 5 of the main request, dependent claim 4 of the first auxiliary request, dependent claim 3 of the second auxiliary request, all requests as filed with the letter of 8 December 2006, and independent claim 1 of the third auxiliary request filed on 9 January 2007. Claims 1 and 5 of the main request of 8 December 2006 read as follows (numbered brackets ¹<>, ²<> etc. are added for convenience of reference):

"1. A system for communicating with, and providing data representative of advertisement information to, digital presentation equipment (36, 52) in theatres, characterized in said system comprising:

job storage (100, 102) for receiving and storing a plurality of jobs (254), each comprising electronic content and one or more schedule requests (258, 300, 302, 304, 306) regarding conditions in which said electronic content is desired to be presented, wherein said electronic content may include an advertisement (14, 356, 358),
a plurality of digital presentation assemblies (30, 44) coupled to said job storage (100, 102) for receiving data from said job storage (100, 102),
a scheduling daemon (86) arranged to:
read data regarding a showing (270) of a movie in a theatre environment associated with each of said plurality of digital presentation assemblies (30, 44),
read data regarding said one or more schedule requests (258) associated with each said electronic content of each of said plurality of jobs (254),
select jobs from said plurality of jobs (254) through mapping said schedule requests (258) to each said showing (270) of the movie associated with each of said plurality of digital presentation assemblies (30, 44),
for filling a presentation capacity for each said showing (270), ¹<> and
a production daemon (88) arranged to create a presentation of electronic content associated with said selected jobs for each showing, and to provide a presentation for each said showing associated with each of said plurality of digital presentation assemblies (30,44) ²<>."

"5. A system as claimed in any of the preceding claims, ³<wherein if a certain piece of content has previously been transmitted to a first digital presentation assembly (30, 44), said production daemon

is further arranged to not re-transmit said piece of content from the presentation before being transferred to said first digital presentation assembly (30,44)>."

Dependent claim 4 of the first auxiliary request and dependent claim 3 of the second auxiliary request are renumbered versions of dependent claim 5 of the main request. Claim 1 of the third auxiliary request resulted from a combination of above claims 1 and 5 of the main request, essentially through inserting passage ³<...> of claim 5 at position ²<> into claim 1.

- IV. On 23 April 2007, the appellant (applicant) lodged an appeal against the refusal decision of the examining division, paying the appeal fee on the same day. By fax dated and received in the European Patent Office on 26 June 2007, the appellant filed a statement setting out the grounds of appeal, requesting that the decision under appeal be set aside and the case be remitted to the examining division with the order to grant the European patent on the basis of the application documents making up the main and auxiliary requests as heard by the examining division at the oral proceedings of 9 January 2007. Oral proceedings before the board have been requested as an auxiliary measure.

The appellant argued essentially that the examining division had not fully appreciated the technical contribution provided by the invention over the prior art, misapplying the legal practice of the EPO in examining patentability of business-related inventions.

- V. With a communication under Rule 100(2) EPC, the Board issued a provisional opinion concerning allowability of

the appeal, indicating therein that with respect to the main, first auxiliary and second auxiliary requests the examining division was right in the analysis of the technical character of the invention and the technical contribution over the prior art. The Board accepted as undisputed fact that document D1 (L. Vaitzblitz 1995, see International Search Report) was the closest prior art. The system disclosed therein used a cache memory and provided for the packaged delivery of movies with advertisements inserted. Hence, it closely corresponded to the embodiment shown in figure 4 of the present application and thus anticipated the essential aspects of the invention. Regarding the few remaining features distinguishing the claimed invention from the prior art system of document D1, the Board expressly concurred with the examining division that such features resulted in an obvious manner from non-technical considerations.

Having regard to the third auxiliary request, the Board raised as a new issue the objection of added subject matter, stating that the new feature "production daemon ... arranged to not re-transmit ..." in the last paragraph of claim 1 (passage ²<> above) was not derivable from the application as filed in any direct and unambiguous manner. The only possible support for the new feature was found in the second paragraph on page 26, referring to the reuse of content. But this text portion was considered as unclear and inconclusive in respect to this feature. As an additional matter of objection, the Board expressed doubts regarding inventive step since caching and reusing digital data was, at the date of priority, a common technique to reduce traffic load on networks. Applying such a feature to the electronic distribution of multimedia

files between content provider and clients was to be regarded as obvious in the light of the common technical knowledge in the field.

VI. By a letter dated 10 February 2012 filed by the appellant in response to the communication of the Board, all requests then on file were amended to meet the objection of added subject matter. In the third auxiliary request, the last paragraph of claim 1 was amended as follows:

"wherein the production daemon compares content in the presentation to schedules of prior days to determine whether a certain piece of content has previously been transmitted to a first digital presentation assembly (30, 44)."

The exactly same amendment has been made in dependent claim 5 of the main request, dependent claim 4 of the first auxiliary request, and dependent claim 3 of the second auxiliary request.

VII. By letter dated 1 March 2012, the Board summoned the appellant to oral proceedings to be held on 15 May 2012, indicating that the admissibility of the amendments under Article 84 EPC 1973 and Article 123(2) EPC was to be discussed in the oral proceedings.

VIII. By fax received in the EPO on 10 April 2012, the appellant informed the Board that no one would appear at the oral proceedings to represent the appellant.

IX. Oral proceedings were held before the Board as scheduled on 15 May 2012. No one appeared on behalf of the appellant. After closure of the debate and deliberation, the Board closed the oral proceedings with the announcement of the decision.

Reasons for the Decision

1. The appeal, although admissible, is not allowable since the requests pursued by the appellant resulted in amendments of the claims which do not comply with the requirement of Article 123(2) EPC. Pursuant to this provision and the established legal practice of the EPO, an amendment is not admissible if it introduces subject matter ("added subject matter") into the application which is not directly and unambiguously derivable from the application as filed.
2. In the present case, this deficiency of added subject matter results from the new feature "the production daemon compares content in the presentation to schedules of prior days to determine whether a certain piece of content has previously been transmitted to a first digital presentation assembly" (underlining added) that has been introduced into all requests, in claim 5 of the main request, claim 4 of the first auxiliary request, claim 3 of the second auxiliary request, and claim 1 of the third auxiliary request.
3. The only potential support for the function of comparing content to schedules is a detail of the staging process described at page 26, second paragraph,

which passage is part of the description ranging from page 25, line 24 to page 26, line 9 cited by the appellant as the only basis for the amendment. The relevant part of said paragraph reads as follows:

"Presentations are staged for transfer. Schedules are compared to the schedules of the prior days and while duplicates are still registered, the content is not. This step reuses the content that has already been transferred and conserves bandwidth on the WAN. ... "
(underlining added).

This means that "schedules", not the "content" of a presentation, are compared to schedules. "Schedules" are not disclosed as part or component of the "content" of a presentation. On the contrary, they are separate pieces of data. This follows for example from page 15, lines 6 to 8 of the application, which reads: "Among the information stored as part of the job is a requested schedule of showings for the content, the locations of the showings and the content itself". Schedules and content may thus be stored at different locations, in a "jobs and schedules storage 100" and in a "job content storage 102", respectively, as described at page 16, line 18 ff. and shown in figure 6.

A system function comparing content of a presentation with schedules is nowhere disclosed in the application as filed. This is a new feature that results in added subject matter, and this feature is now present in claims of all the four requests (see above) so that none of the requests complies with the requirement of Article 123(2) EPC. Hence, there is no request before

the Board on which basis the decision under appeal could be allowed.

4. In the present case, it does not make a difference that the deficiency of added subject matter could have been remedied easily if the appellant had requested a feasible amendment. Any such amendment would have required the presence of the appellant at the oral proceedings or a further communication issued by the Board on the merits of the case, requiring adjournment of the oral proceedings or, after the oral proceedings, the continuation of the appeal proceedings in writing, all alternative courses of action which would contradict the principle of procedural economy as reflected in Articles 13 to 15 RPBA.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

T. Buschek

R. R. K. Zimmermann