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**Datasheet for the decision  
of 11 January 2013**

**Case Number:** T 1866/08-3.5.06

**Application Number:** 05077253.2

**Publication Number:** 1630641

**IPC:** G06F 1/00, H04L 29/06

**Language of the proceedings:** EN

**Title of invention:**  
Approach for tracking data

**Applicant:**  
Yahoo! Inc.

**Headword:**  
Tracking data/YAHOO

**Relevant legal provisions (EPC 1973):**  
EPC Art. 56

**Keyword:**  
"Technical problem solved - all requests (yes)"  
"Inventive step over cited prior art - main request (yes)"  
"Remittal for further prosecution due to doubts about the completeness of the search"

**Decisions cited**  
T 0034/90, G 0008/91

**Catchword:**  
See points 5-7 and 10.



Case Number: T 1866/08 - 3.5.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.06  
of 11 January 2013

**Appellant:**  
(Applicant)

Yahoo! Inc.  
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**Representative:**

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**Decision under appeal:**

**Decision of the Examining Division of the  
European Patent Office posted 21May2008  
refusing European patent application  
No.05077253.2 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman:** D. H. Rees  
**Members:** M. Müller  
W. Sekretaruk

## Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division, dispatched with written reasons dated 21 May 2008, to refuse the European patent application no. 05077253.2 for lack of an inventive step over D1: WO 98/20672.
- II. An appeal against this decision was received on 22 July 2008, the appeal fee being paid on the same day. A statement of grounds of appeal was received on 11 September 2008, along with five sets of claims according to a main and 1st-4th auxiliary requests.
- III. With summons to oral proceedings, the board informed the appellant of its preliminary opinion that all requests except those of the 3rd auxiliary requests did not conform with Article 84 EPC 1973 and lacked an inventive step, Article 56 EPC 1973. The board also indicated its intention to remit the case for further prosecution on the basis of the 3rd auxiliary request, *inter alia* for the examining division to consider the need for an additional search.
- IV. In response to the summons, the appellant withdrew the pending main and 1st auxiliary requests and filed three sets of claims according to a new main and new 1st and 2nd auxiliary requests based, respectively, on previous 2nd-4th auxiliary requests, with amendments in response to the objections raised by the board. Furthermore, the appellant argued that the board's positive assessment of the previous 3rd auxiliary request also applied to the new 2nd auxiliary request. The appellant objected

however against a further search being performed because it would be neither necessary nor appropriate at this point of the procedure.

- V. The board understands the appellant's requests to be that the decision under appeal be set aside and that a patent be granted based on the following application documents.

claims, numbers

1-20 according to the new main request, or

1-19 according to the new 1st or 2nd auxiliary requests,

all filed with letter of 11 September 2012

description, pages

1, 4-13 as originally filed

2, 3 filed with letter of 06.02.07

drawing, sheets

1/5-5/5 as originally filed

- VI. Independent Claims 1, 17 and 20 according to the new main request read as follows:

"1. A method for operating an intermediary computer to track data requested by a user from a source server over a network, wherein the source server is arranged to communicate with the intermediary computer via a first network communications link, and the intermediary computer is arranged to communicate with the user via a second network communications link, the method comprising the computer-implemented steps of:

receiving (206), at the intermediary computer (104), the requested data from the source server (102); and

supplying (212), via the second network communications link, the requested data from the intermediary computer to the user (106);

characterised in that the method comprises the intermediary computer performing the steps of:

determining (208) whether the requested data includes rights data that indicates an owner of rights to the requested data; and

if the data includes the rights data:

(a) determining whether the source is associated with the owner of rights to the data; and

(b) if the source is not associated with the owner of rights to the requested data, then the intermediary computer not allowing the requested data to be supplied to the user; and

(c) if the source is associated with the owner of rights to the requested data, then the intermediary computer supplying the data to the user and recording (210) that the requested data was supplied.

17. A computer system for tracking data comprising:

one or more processors (504); and

a memory (506, 508) communicatively coupled to the one or more processors and containing one or sequences of one or more instructions which, when executed by the one or more processors, cause the one or more processors to perform the method according to any one of claims 1-16.

20. A computer-readable medium carrying one or more sequences of one or more instructions for tracking data, the one or more sequences of one or more instructions including instructions which when executed by one or more processors, cause the one or more processors to

perform the method according to any one of claims 1-16."

VII. Due to the illness of a board member, the scheduled oral proceedings were cancelled. In an annex to the corresponding notice the board informed the appellant that oral proceedings would be re-appointed, if only to discuss the issue of remittal, should the appellant maintain its opposition to remittal for further prosecution.

VIII. With letter dated 11 December 2012 the appellant withdrew its request for oral proceedings on the condition that the board would remit the case to the first instance for further prosecution. This letter also contained a request to hold oral proceedings should the examining division be minded to refuse the application.

## **Reasons for the Decision**

### *The invention and the prior art*

1. The application is concerned with the problem of locating illegal copies of digital works - such as music, image or video files - in computer networks, especially on the Internet. The invention as claimed refers to the situation in which "data requested by a user from a source server over a network" in transit from the server to the user is intercepted by an "intermediary computer" which determines whether the data indicates "an owner of rights in the requested data" and, if so, whether the source server is "associated with" the rights owner. If and only if this is the case - establishing,

- roughly speaking, that the source server has the "right to send" the data - the data is supplied to the user and this fact is recorded.
2. D1 is the only prior art document referred to during examination. D1 is concerned with the problem of "tra-c[ing] illegal copies of digital content" on the Inter-net (p. 1, lines 18-19). It is proposed that network clients (p. 3, lines 29-31) receiving copyrighted data will not make this data directly available for use (such as display) but only after an ID associated with the device or the user has been imprinted on the data (p. 4, esp. lines 6-7 and 22-24). Due to this regime, copies of a data object can be distinguished from "ori-ginals" by the fact that copies contain an imprinted ID whereas originals do not (p. 9, lines 20-22). According to D1, data with an imprinted user's ID suggest that the user may have illegally distributed the content (p. 9, lines 22-24).

*Article 84 EPC 1973 and claim construction*

3. Insofar as the objections under Article 84 EPC 1973 raised in the summons related to the previous 2nd au-xiliary request, they have been overcome to the board's satisfaction by the amendments in the new main request. Specifically, by explicitly referring to a server com-puter and an intermediary computer rather than an un-specified "source" or "intermediary" and by specifying that the intermediary computer is an internal network node between the server computer, the claims are now considered to be supported by the description as re-quired by Article 84 EPC 1973.

4. The independent claims specify that the data should "include rights data that indicates an owner of rights in the ... data", for instance copyright (see e.g. the description, p. 5, last par.).
  - 4.1 The appellant argues that the term "owner of rights" is a "term of art" which the person skilled in the pertinent field of technology would understand (grounds of appeal, point 3.8), thereby suggesting it to be a term of the technical arts. The appellant further argues that the skilled person would never consider this term to "include a person to whom a content manager has distributed some content".
  - 4.2 The board disagrees. In the board's judgment it is primarily a legal issue what the terms "right", "copyright" and right "ownership" mean and what they possibly exclude or under what conditions. While the board concedes that they are also used by persons skilled in fields of technology, e.g. in the context of what is known as digital rights management, the board rejects the idea that this makes them terms of technical arts with a clear technical meaning. Furthermore, the board notes that rights such as copyright may be transferred - partly or as a whole, and depending on jurisdiction - so that the user requesting and receiving data cannot *a priori* be excluded as "an owner of rights" in the content. For instance, the board deems it typical that the user receiving the content will also receive the right to use (e.g. display) it, possibly under certain limitations, and thus at least temporarily "own" these rights.



4.3 According to the claims it is determined whether the source server is "associated with" the rights owner without specifying how this association is expressed or how it would be determined. The board considers that the skilled person knows ways of practising this feature: In the simplest case, one could require that the source server is explicitly mentioned as the owner so as to be "associated with" it. Alternatively, some data structure such as a table could be employed to express a mapping from rights owners to source servers (or *vice versa*). Or, the data itself might express the association by mentioning both the rights owner and the source server. The board thus accepts this feature as clear, if broad.

4.4 Accordingly, the board construes the independent claims of the main request as follows: Data in transit from a source server to the user may or may not be flagged for delivery control at an intermediary computer - by containing rights data or not -, but if it is, data is supplied to the user if and only if the data contains a direct or indirect reference to the source server. This interpretation had been presented in the summons to oral proceedings (point 10) and was not challenged by the appellant.

*Inventive step*

5. The decision under appeal starts from D1 and makes reference to passages on pages 1, 4 and 9.

5.1 On page 1, D1 introduces the problem of protecting ownership of digital data on the Internet. Within the solution proposed by D1, however, pages 4 and 9 relate

to different specific situations. On page 4 (lines 8-27) it is disclosed that a network client enforces the imprinting of an ID on the requested data before it is made available to the user. The network client is not disclosed as inspecting the data for imprints, let alone to prevent use of the data depending on this inspection. On page 9 (lines 2-3), the description turns to methods for "reading imprinted ID information" as opposed to "methods for imprinting ID information". In this context, "detector" devices are described (lines 4-8) and it is disclosed that a "proxy server" may be equipped with such a detector. This implies the inspection of data in transit through the network.

5.2 Accordingly the board agrees with the appellant, that the appropriate starting point within D1 for the analysis is the disclosure on page 9 (see grounds of appeal, point 3.4): D1 discloses that a proxy server intercepts data in transit from a source to a user and determines whether data contains an imprinted ID. The board agrees with the examining division that the imprinted ID expresses "an owner of rights", at least on a broad interpretation of that term as justified above.

5.3 D1 discloses that the proxy server might detect an illegal action (p. 9, line 11) and suggests that this might be achieved by detecting an imprinted ID (p. 9, lines 8-11 and 22-24). The board agrees with the appellant that the detection of an imprinted ID does not, according to D1, *imply* illegal distribution of content (grounds of appeal, point 3.14; D1, p. 9, lines 22-24: "may have"). Rather, the skilled person would understand D1 as disclosing that the proxy server of D1 merely checks for *likely* illegal actions.

- 5.4 Moreover, D1 does not disclose the proxy server as interrupting the transmission by not supplying the data to the user. Rather, the skilled person would assume from D1 that the proxy server passes on the data as usual even if an imprinted ID was detected. In the board's judgment this is implied by the fact that the proxy server, on the one hand, does not prove a copy to be illegal and, on the other hand, should not block a legal data transmission. Starting from D1 and trying to improve the capability of the system to trace illegal copies, the board considers it obvious to impose the stricter rule that any data with an imprinted ID should be deemed illegal anywhere on the network outside the user device associated with the ID. Data with an imprinted ID detected at the proxy server would thus be illegal by definition. In this case, blocking further transmission of the illegal copy would obviously be an "appropriate measure" which D1 discloses should be taken (p. 9, lines 11-12).
- 5.5 However, the imprinted ID according to D1 does not represent the source server from which data was requested, but the requesting user (p. 4, lines 7-21). D1 thus does not disclose that the detector, e.g. in the proxy server, makes reference to the source server when assessing legality of the intercepted transmission, let alone that it forwards intercepted data or not depending on the source server. In the board's judgment, D1 also does not suggest taking into account the source server to improve its capability of tracing illegal copies or when taking "appropriate measures" if an illegal action is determined.

6. The decision under appeal (reasons 2.2) determines as the difference between more general earlier claim 1 and D1 that "claim 1 determines if the source of the data is associated with the owner and a decision is taken based on that to provide or not the data".
  
7. The decision goes on to state (reasons 2.3-2.4) that this difference "merely" represents "the steps performed by a data tracking and transmission system that implements rules about what to do with the traffic and registers th[ese] activities" and that the "task of tracking data traffic is a mere administrative task". In passing it is argued that these rules and tasks were well-known, for example from the "activity of a librarian registering incoming and outgoing books of the library". The only technical features of claim 1 were merely "data transmission and data recording" and these were known from the prior art. The remaining features did not, so the argument, solve a technical problem but an administrative one, namely to "control the distribution of unauthorised data" which would belong to the non-technical "domain of the administration of property". This difference, especially within the context of D1 which is already adapted to "[implement] rules driven by a detection event" (see again reasons 2.2), would amount to a mere automation of this administrative task, and if its performance were improved by the automation then only to the extent that any computer automation would cause such improvement, without any further technical effect. This difference could thus not establish an inventive step.
  - 7.1 The board takes a difference perspective on the invention. The board concedes that the claimed invention has

administrative aspects but considers that these cannot be stripped from the technical context in which they occur. The claimed invention relates to the "tracking" and delivery control of "data requested by a user from a source server over a network" in view of that source server. The board fails to see how this would be analogous to, let alone known from, the activity of a librarian "registering incoming and outgoing books of the library", or why the skilled person trying to improve the system of D1, would turn to the activities of a librarian for help. The board also considers that the claimed invention goes beyond the mere implementation of a non-technical administrative task without any effect beyond the benefits of any computer automation (see decision under appeal, reasons 2.3, last sentence). Rather, in the board's view, the effect of the invention over D1 is tied to a specifically technical situation, namely the request and download of data by a user over a network from a server, as is now clearly claimed. In this respect, the board agrees with the appellant in considering an automated, network-based mechanism to control and authorize the delivery of data as solving a technical problem (see grounds of appeal, point 3.16).

- 7.2 Therefore, the board concludes that in view of the amended claims the decision under appeal has to be set aside. Moreover, since D1 does not disclose or suggest data delivery depending on the source server (see point 5.5 above), the board concludes that claim 1 is inventive over D1.

*Scope of the search*

8. The application had been filed as a divisional application of European application no. 01991123.9, based on the description and the drawings of the latter, parent application but with a new set of claims 1-53 (see telefax of 4 October 2005, points ii and iv). The European search report however merely refers to claims 1-37. In fact, the European search report issued for the present application is substantially identical to the search report issued for the parent application which contained 37 claims. It would therefore seem possible that the present search relied on the results of the search in the parent application.
  
9. The board's conclusion as to inventive step crucially depends on the finding that the source-sensitive automated delivery control of data across a network solves a technical problem.
  - 9.1 The board notes that the great majority of claims of the parent application, and thus of those which appear to have been searched in the present application, lack the feature of source-sensitive delivery control. Only claims 16, 17, 36 and 37 of the parent application contain this feature. In contrast, all of claims 1-53 originally filed with the present divisional application contain it (esp. independent claims 1, 18 and 37).
  
  - 9.2 The board has its doubts whether the feature of delivery control was exhaustively searched for three reasons:

- Due to the fact that this feature was substantially less prominent in the claims of the parent application than in those of the present divisional application, and that the claims of the parent may have been the basis of the search for the divisional.
  
- because the preamble of all claims - both of the parent and the divisional application - by referring to "tracking data" rather than delivery control may have further detracted from the importance attached to this feature, and
  
- because the examining division considered it to be of no technical relevance anyway (see point 7 above).

9.3 The board has no basis for determining whether these doubts are in fact justified, in which case a further search should be carried out, or not. Therefore, the board is not in a position to order the grant of a patent based on the present main request and thus exercises its discretion under Article 111(1) EPC to remit the case for further prosecution to the examining division.

9.4 In response to the board's indication that it intended to remit the case, the appellant submitted that a further search was neither necessary nor equitable at this point of the procedure (see submission dated 11 September 2012, points 6-6.2). However, when the board decides to remit the case, it is a matter for the examining division to determine whether or not to carry out an further search, a determination in which the board cannot interfere. The appellant's concerns about an

additional search will thus have to be directed to the examining division, too.

*Request for oral proceedings before the examining division*

10. According to the principles developed by the boards of appeal (see, for example, G 8/91, OJ EPO 1993, 346, reasons 7; and T 34/90, OJ EPO 1992, 454, headnotes), the appeal procedure is separate from the examination procedure. It follows that a request for oral proceedings to be held before the examining division cannot validly be made during the appeal proceedings. As a consequence, the appellant will have to file a new request for oral proceedings after the procedure will have been resumed by the examining division.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.

The Registrar:

The Chairman:

B. Atienza Vivancos

D. H. Rees