BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Internal distribution code:
(A) [ ] Publication in OJ
(B) [ ] To Chairmen and Members
(C) [ ] To Chairmen
(D) [X] No distribution

Datasheet for the decision of 9 January 2013

Case Number: T 2090/08 - 3.5.06

Application Number: 05016429.2

Publication Number: 1622060

IPC: G06F 21/00, G06Q 90/00

Language of the proceedings: EN

Title of invention:
Method and system for transferring or returning unused digital rights

Applicant:
LG Electronics, Inc.

Headword:
Unused digital rights/LG

Relevant legal provisions (1973):
EPC Art. 56

Keyword:
"Inventive step - all requests (no)"

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 2090/08 - 3.5.06

D E C I S I O N
of the Technical Board of Appeal 3.5.06
of 9 January 2013

Appellant: (Applicant)
LG Electronics, Inc.
20, Yeouido-dong
Yeongdeungpo-gu
Seoul 150-721 (KR)

Representative:
Katérle, Axel
Wuesthoff & Wuesthoff
Patent- und Rechtsanwälte
Schweigerstrasse 2
D-81541 München (DE)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 23 April 2008 refusing European patent application No. 05016429.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: D. H. Rees
Members: M. Müller
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. The appeal lies against the decision of the examining division, with written reasons dispatched on 23 April 2008, to refuse European patent application 05016429.2 for lack of an inventive step, Article 56 EPC 1973, over, *inter alia*, the document

D1: US 6 009 401 A.

II. Notice of appeal was filed on 18 June 2008, the appeal fee being paid on the same day. A statement of grounds of appeal was filed on 22 August 2008. It was requested that the decision under appeal be set aside and that a patent be granted based on a new set of claims filed with the grounds of appeal.

III. With summons to oral proceedings, the board indicated that, according to its preliminary opinion, the decision as to lack of inventive step over D1 would have to be confirmed. Objections under Article 84 EPC and Rule 29 (4) 1973 EPC were also raised.

IV. In response to the summons, the appellant filed amended claims according to a main and two auxiliary requests, and requested the grant of a patent based on the following documents:

claims, numbers

1-44 according to the main or the 1st auxiliary request, or

1-41 according to the 2nd auxiliary request,

all filed with letter of 29 November 2012

description, pages
2a, 3-5, 16 filed with letter of 29 November 2012
2 filed with letter of 17 September 2007
7, 8, 13 filed with the grounds of appeal, and
1, 6, 9-12, 14, 15 as originally filed

drawings, numbers
5, 6, 8C, 8D, 11 filed with letter of 29 November 2012
1-4B, 7, 8A, 8B, 9, 10 as originally filed

V. Claim 1 according to the main request reads as follows:

"A server (20) for processing access rights to digital contents in a Digital Rights Management, DRM, system, the server adapted to manage at least one rights object related to accessing the digital contents and further adapted to:

analyze a request message received from a first terminal (10), the request message indicating a transfer of the at least one rights object to a second terminal (11) if the request message comprises an identifier of the second terminal (11);

transmit a response message, to the first terminal, containing status information indicating successful processing of the request message so as to enable the first terminal (10) to delete the at least one rights object that the first terminal intends to transfer to the second terminal (11);

transmit the at least one rights object to a second terminal (11) accroding to the indicated transfer,

wherein, when the at least one rights object cannot be successfully transferred to the second terminal (11), the server (20) is adapted to provide

the first terminal (10) with selection options comprising at least two of a refund by cyber cash, re-trying the transfer, obtaining another rights object and getting back of the rights object."

Claim 1 according to the 1st auxiliary request is identical with claim 1 of the main request, except that in its third paragraph, between the words "delete" and "the", the following phrase is inserted:

", directly upon receipt of the response message by the first terminal,"

Claim 1 according to the 2nd auxiliary request differs from claim 1 of the 1st auxiliary request in that the two references to the "server (20)" are replaced by references to the "rights issuer (20)" and in that, at its end, the following text is added:

"wherein, in the operation of providing the first device (10) with selection options:

the rights issuer (20) is adapted to transmit a status message to the first terminal (10), the status message indicating that the transfer failed, so as to enable the first terminal (10) to connect to a presentation server (30) using a URL address of the presentation server included in the status message."

All requests further contain an independent method claim 29 which corresponds closely to the respective independent server or rights issuer of claim 1.

VI. Oral proceedings were held as scheduled on 9 January 2013. At the end of the oral proceedings, the chairman announced the board's decision.

Reasons for the Decision

The invention

1. The application relates to a digital rights management (DRM) system which enables users to transfer unused or partially used rights to different users or, alternatively, to return such rights for a refund or a replacement (see par. 6).

1.1 A DRM system is described and depicted (see fig. 1) in which client devices (fig. 1, items 10 and 11) obtain digital contents from a presentation server (PS, item 30) and the corresponding "rights objects" (RO) from a "rights issuer" (RI, item 20), acting as a "server" for rights.

1.2 The transfer of an unused rights object is initiated by its present owner, the "first device", which communicates its intent, the pertinent rights object, and the target, a "second device", to the rights issuer (see *e.g.* par. 54), and is performed under the control of the rights issuer (see *e.g.* pars. 55-57).

1.3 If the transfer of the rights object to the second device fails - because the second device is powered off or otherwise unreachable, or out of memory (par. 60) - the first device receives a corresponding status message (see original claim 25). This message comprises, *inter alia*, a URL of the presentation server (see ori-

ginal claim 27) and the presentation server, when connected, provides the first device with a choice of alternative actions such as to re-try the transfer, to terminate the transfer and keep the rights object, or to obtain a refund or another rights object instead (par. 61).

The prior art

2. Document D1 discloses a DRM system in which end users can obtain licenses, *i.e.* "rights objects", for the use of "software products" like software programs or other electronic content (col. 3, lines 2-4) at a particular machine. The licenses are maintained by a so-called license clearing house which keeps count of licensed installations of the software product and revokes or authorizes licenses (see col. 3, lines 5-6; col. 4, 47-51 and 55-58; col. 5, lines 7-12), possibly in cooperation with or on request by a "publisher site" and a "merchant site".

2.1 The system of D1 enables end users to transfer a licensed software product from one machine to another one or to return the license and obtain a refund (see abstract, lines 5-10). To this end, the end user's machine must run a dedicated so-called "relicensing manager software utility" which interacts in particular with the licensing clearing house (col. 2, line 63 - col. 3, line 1; see also col. 4, lines 59-61).

2.2 When a user wishes to transfer a piece of software from a first to a second machine, the relicensing manager on the first machine uninstalls the software product and instructs the license clearinghouse to decrement the

license count (col. 4, lines 52-58). Furthermore, the user must store ("capture") the license on, for instance, a floppy disk (col. 4, lines 53-55). Then the user installs on the second machine the captured license and, if not already present, the relicensing manager, which requests from the license clearing house that the transferred license be authorized for the second machine (see col. 4, lines 61-63 and line 66 - col. 5, line 16). Eventually, the license clearing house will increment the license count again (see col. 4, lines 63-65).

2.3 When a user wishes to return a licensed software product for a refund, the relicensing manager on the local machine locks or removes the software and marks the license as revoked and then requests the merchant site to initiate the refund and the license clearinghouse to revoke the license (col. 4, lines 41-51).

2.4 D1 does not disclose that a revoked license is deleted from the end user's machine.

Main request

3. The independent claims of the main request differ from the disclosure of D1 by the following features:

a) The procedure according to D1 requires manual user intervention to store the licence on a floppy disk and to install it on the second device, whereas the transfer procedure according to the claimed invention is automatic and runs under the control of the server. More specifically, the claimed procedure involves a request message from the first terminal

to the server, identifying *inter alia* the second machine to which the rights object is to be transferred, and a response message from the server to the first terminal after succesful transfer of the rights object.

b) The system of D1 does not provide the first device with selection options when the transfer fails.

c) D1 does not disclose that a revoked license, *i.e.* the rights object, is deleted from the first terminal, let alone in response to a response message indicating successful transfer of the license.

This assessment substantially corresponds to the appellant´s analysis according to the letter of 29 November 2012 (p. 7, 2nd par. - p. 8, 2nd bullet point).

4. In the board's judgment, differences a)-c) solve the following problems: Difference a) makes the relicensing procedure of D1 more convenient for the end user by avoiding the need for a manual transfer of the license, difference b) handles the possible failure of the relicensing procedure at the second terminal, and difference c) saves storage on the first machine by deleting a revoked license. The board considers that these problems arise naturally in the context of D1 (see below).

5. According to the appellant, these differences interact with each other for the following reasons.

5.1 During the oral proceedings, the appellant argued that the "early deletion" of the rights object from the first machine - namely in response to an acknowledge-

ment of receipt by the server but independent of whether it was successfully transferred to the second device - incurs the risk that it may have to be recovered later when the transfer to the second device fails. The alternative options offered in this case compensate for this risk by, for instance, enabling the end user to take back the rights object.

5.2 In writing (letter of 29 November 2012, p. 11, 4th par. to p. 12, 1st bullet point), the appellant also argued that the individual alternative options all contribute to the saving of storage: The options "refund" and "re-try" are storage saving, so the argument, because a deleted rights object may remain deleted, the option "get another rights object" is storage saving because it allows the first terminal to store only the rights objects of interest rather than also other, unused rights objects, and the option "get back old rights object" is storage saving "from a dynamic point of view", since the pertinent rights object will at least temporarily not be stored on the first terminal.

5.3 The board disagrees: Firstly, the storage saving effect achieved by deleting an unused rights object from the first terminal is unaffected by the options "refund", "re-try", or "get another"; the unused rights object remains deleted in any case and another rights object requires the same amount of space whether it was obtained directly or in exchange for a returned right. Secondly, it is an elementary consequence of deleting any data object that it may have to be recreated or re-transmitted should it be needed again later on for any reason. The interaction between the storage saving effect and the option for the user to "get back" its

rights object is thus, in the board's judgment, at best a trivial one.

5.4 The board therefore concludes that differences a)-c) may be assessed independently from each other as to their inventive merit.

Difference a) Transfer of rights object under server control

6. In the board's view it is obviously inconvenient for the end user in D1 to transfer the licence manually from the first to the second device. This holds in particular in view of the fact that the software itself is transferred from the publisher to the second device automatically, *i.e.* without the user's intervention. The skilled person seeking to remedy this inconvenience for the end user would be incited to modify D1 so as to automate the transfer of the license, too.

6.1 A major part of the transfer according to D1 is already automatic based on interaction between the end user's machines and the license clearing house, *i.e.* the server (see *e.g.* col. 4, 55-58 and 63-65; col. 5, lines 3-16). Moreover, D1 already provides for the possibility, if only "in an emergency", that the license clearing house reissues a license (see col. 4, lines 2-10). Therefore, the board considers it to be an immediate option for the skilled person to extend the relicensing procedure according to D1 so that the license transfer is also handled by the license clearing house.

6.2 Given this, the board further considers it obvious that the protocol according to which the first end user's machine and the license clearing house, *i.e.* the server,

communicate comprises a "request message" which, *inter alia*, identifies the "second machine" to the license clearing house, and a "response message" which acknowledges this request to the first machine and confirms successful receipt of the license.

Difference b) Alternative actions when transmission fails

7. The board notes that the authorization of the software product for the second machine may fail (col. 4, line 66 - col. 5, line 16). It is further generally known that the transfer of data between devices may fail for a variety of reasons, for example due to communication problems. Handling such situations is a matter of routine for the skilled person. Indeed the most obvious, and commonplace, reactions to a failed transmission are to retry or to terminate the transmission. The board also deems it to be common practice to offer these two options for choice to the user. This also applies to further options which may happen to be available such as a refund; notably, whether or not a refund is offered is an entirely commercial decision, apart from the fact that it is known from D1 (col. 4, lines 41-51). As a matter of necessity, this selection must be offered at the machine the user happens to interact with. To the board, it is an obvious option that the user initiates the transfer at the first machine and stays there during the entire procedure: Thus providing the selection to the first machine is obvious, too. These considerations were put to the appellant in the summons to oral proceedings but were not specifically addressed by the appellant in writing or during oral proceedings.

7.1 During oral proceedings, the appellant referred to D1 as a legacy system and suggested that the age of D1 would discourage the skilled person from modifying D1 towards the invention. Further, in its letter of 29 November 2012 (p. 13, 1st par.), the appellant argued that D1 would provide a number of negative pointers pointing away from the claimed invention. In particular, the alternative options offered in the failure case were impossible to conduct in the system of D1 (letter of 29 November 2012, p. 13, 3rd par. and bullet points). The board disagrees for the following reasons:

7.1.1 According to the appellant, the retry option would be "virtually impossible" and "impractical beyond reason" within D1 due to the necessary handling of the floppy disk this would imply. In the board´s view it may be left open whether this is indeed the case in the context of D1 as it stands, because, as already argued above (point 6), it would be obvious independent of the retry option to do away with the floppy disk in favour of full automation. In a fully automated context however, if the transmission or authorisation of the license on the second machine fails, the board deems it to be a normal course of action for the license clearing house to inform the first machine accordingly and to request indication from the first machine whether the transfer should be retried.

7.1.2 When the transfer fails, possibly several times, it would be an obvious idea to give up the attempt to relicense the software on the second machine and, instead, "relicense" the software on the first machine where it had been installed before ("get back"). D1 provides

immediate support for this operation in the sense that the second machine could be identical to the first one.

7.1.3 If, after a failed transfer, the user happens to find it preferable to return the license and receive a refund or an alternative license, the board cannot see any technical complication which would prohibit that the user inform the license clearing house accordingly and that the due transmissions be triggered ("get refund" or "get another rights object").

7.1.4 The board thus concludes that all the alternative options can easily be incorporated into the system of D1 at least on the assumption that the entire transfer procedure is automatic and under the control of the license clearing house, which the board argued above is an obvious improvement of D1 (points 6 and 6.1). The board also cannot see that D1 would, by any explicit negative pointers or its age, keep the skilled person from modifying D1 in this way.

7.2 The appellant further argued (submission of 29 November 2012, p. 11, 4th par. - p. 12, 1st bullet point) that all the alternative options contribute to the saving of storage on the first machine and/or the entire system, suggesting that the objective technical problem considered by the board ("handling transmission failure", see point 4 above) is the wrong one. As argued above (points 5.2 and 5.3 above), the board disagrees in substance. However, even if a storage saving effect could indeed be ascribed to the alternative options, this would not affect the board's reasoning, because an argument showing that the claimed invention is obvious for the skilled person from the desire to achieve some

of its effects is not invalidated by the presence of further effects.

Difference c) Deleting a revoked rights object

8. The problem to contain, control or reduce storage consumption is one that, in the board's view, a person skilled in software development is always aware of. The board therefore deems obvious the idea that any unused data object - such as, in D1, a revoked license - should, at some point, be deleted from the end user's machine. It is also obvious for the skilled person that the unused data object can be deleted as soon as possible or at later point in time. In order to choose between these alternatives the skilled person would have to assess the circumstances and weigh the requirements against each other, including, *e.g.*, whether storage consumption is critical and whether it is likely that a deleted object may be needed again later (see point 5 above). In the board's view, the skilled person would make this assessment and choice as a matter of routine and without exercising an inventive step.

9. In summary, the board concludes that the subject matter of the independent claims of the main request lack an inventive step over D1, Article 56 EPC 1973.

1st auxiliary request

10. The independent claims of the 1st auxiliary request differ from those of the main request only in requiring that the pertinent rights object is deleted "directly upon receipt of the response message by the first terminal". Disregarding the question whether the feature

of "direct deletion" is clear and supported by the application as originally filed, the board has already expressed above (point 8) its opinion that deletion of a data object "as soon as possible" is an obvious option for the skilled person. Therefore, the above arguments as to lack of inventive step vis-à-vis the main request apply unchanged to the 1st auxiliary request.

2nd auxiliary request

11. The independent claims of the 2nd auxiliary request refer to the "rights issuer" where those of the main and 1st auxiliary request merely refer to a "server". This amendment does not affect the above analysis of the higher ranking requests since the "license clearing house" according to D1 issues the licenses and thus qualifies as a "rights issuer" within D1.

11.1 The independent claims of the 2nd auxiliary request further specify that the rights issuer sends a "status message" to the first terminal which indicates the failed transfer and includes a URL to a presentation server.

11.2 According to the application (*e.g.* par 61 and fig. 7), the first terminal connects to the URL of the presentation server which then provides the selection of alternatives to the end user.

11.3 The board notes that the claim language does not imply how the user at the first terminal uses the transmitted URL nor what happens at the presentation server. This might constitute a lack of clarity or warrant a very broad claim interpretation. However, since the

appellant offered to clarify the claim language in view of the application (*loc. cit.*), the board decided, for the appellant's benefit, to leave these and similar questions open and to interpret the claim language as intended and disclosed in the application.

11.4 The appellant argued that the choice to provide and handle the selection of alternative options at the presentation server avoids the need to provide the corresponding control on the first terminal and therefore reduces the terminal's memory requirements.

11.5 However, D1 teaches that a "relicensing manager" must be installed on each end user's machine before it can obtain a license. Evidently, this requirement is unaffected by the mere fact that additional services are provided to the end user's machine.

11.6 According to D1, a "publisher site" and a "merchant site" cooperate with the license clearinghouse to serve the different user requests. For instance, a user request for a refund is handled by the merchant site (D1, col. 4, lines 41-51 which eventually instructs the license clearing house to revoke the license. By analogy it would be obvious that similar requests such as to license a different product instead of obtaining a refund (*i.e.*, "get another rights object") are handled by the merchant site, too.

11.7 The board considers that the distribution of tasks over different servers in a distributed system in general, and, over the specific servers disclosed in D1 in particular, is a task which the skilled person would address and solve without exercising an inventive step

according to circumstances. Thus it would also be obvious for the skilled person to choose the merchant site of D1 as the claimed "presentation server". Using a URL to identify the relevant server to the user would also have been an obvious option for the skilled person at the priority date of the present application.

11.8 Therefore, the board comes to the conclusion that also the additional features of the independent claims of the 2nd auxiliary request are insufficient to establish an inventive step, Article 56 EPC 1973, even when interpreted according to the appellant's intention on the basis of the description.

Summary

12. There being no allowable request, the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

B. Atienza Vivancos D. H. Rees