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**Datasheet for the decision
of 5 July 2012**

Case Number: T 2305/08 - 3.5.06
Application Number: 02028709.0
Publication Number: 1293872
IPC: G06F 1/00, H04L 12/14,
H04L 29/06
Language of the proceedings: EN

Title of invention:

System for controlling the distribution and use of digital works

Applicant:

ContentGuard Holdings, Inc.

Headword:

Rendering transaction/CONTENTGUARD

Relevant legal provisions (EPC 1973):

EPÜ Art. 56

Keyword:

"Inventive step - after amendment (yes)"
"Remittal for further prosecution"



Case Number: T 2305/08 - 3.5.06

D E C I S I O N
of the Technical Board of Appeal 3.5.06
of 5 July 2012

Appellant: ContentGuard Holdings, Inc.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 11 June 2008
refusing European patent application
No. 02028709.0 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 to refuse the European patent application no. 02028709.0, dispatched on 11 June 2008 as a so-called decision according to the state of the file by reference to the communication dated 6 February 2008 which found the pending claims to lack an inventive step, Article 56 EPC 1973, over the documents

D1: Perritt H., "Knowbots, Permissions Headers & Contract Law", Paper for the Conference on Technological Strategies for Protecting Intellectual Property in the Networked Multimedia Environment, April 2-3, 1993 (with revisions of 30 April 1993), and

D2: US 5 260 999 A.

II. Appeal was filed on 18 August 2008 with the appeal fee being paid on the same day, and on 21 October 2008 a statement of the grounds of appeal was filed. The appellant requested that the decision under appeal be set aside and that a patent be granted based on the documents subject to the decision.

III. With a summons to oral proceedings the board raised several clarity objections, Article 84 EPC 1973, and gave its preliminary opinion that the invention as claimed indeed lacked an inventive step over D1, Article 56 EPC 1973.

IV. In response to the summons, the appellant filed several amended sets of claims to be considered as auxiliary

requests and explained their basis in the application as originally filed.

- V. Oral proceedings took place on 5 July 2012 during which the appellant withdrew all pending requests and filed a new set of claims to form the basis of its sole request, which is to grant a patent based on

description, pages

1, 3-50 as originally filed

2, 2a as received with letter dated 7 November 2007

drawings, sheets

1-13 as originally filed

claims, no.

1-7 as filed during oral proceedings on
5 July 2012,

or to remit the case to the first instance for further prosecution based on these documents.

- VI. The only independent claim 1 reads as follows:

"A system comprising a rendering subsystem and a server repository for storing digital works and controlling the use of digital works in accordance with usage rights (1050; 1450-1457; 1501-1525) associated with said digital works and including a manner of use for a digital work;

said server repository comprising storage means for storing digital works and usage transaction means for:

receiving requests for digital works;

determining whether a request for a digital work should be granted based on usage rights associated with said digital work; and

granting access to said digital work;

said rendering subsystem comprising:

a requestor repository for generating said requests and transmitting said requests to said server repository, said requests specify a manner of use of said digital work; and

means for rendering (403; 412, 413) said digital work; and

wherein said requestor repository is coupled to said means for rendering (403; 412, 413);

wherein

said server repository and said requestor repository are the same device, and the transactions for requesting, determining and granting access are entirely internal in said system;

said usage transaction means for receiving is operative to receive said requests generated by said requestor repository;

said digital work is transmitted from said server repository to said requestor repository as an ephemeral copy of said digital work if the request is granted; and

said ephemeral copy of said digital work is removed after rendering."

VII. At the end of the oral proceedings, the chairman announced the decision of the board.

Reasons for the Decision

New set of claims

1. In the summons to oral proceedings (see point 10) the board of appeal expressed its preliminary opinion that the claimed invention did not imply anything which would "control the usage or distribution of a document in a rendering system" once transferred. This consideration was central for the board's preliminary conclusion as to lack of an inventive step. The newly introduced feature that the digital copy is an ephemeral copy however does express some such control as is argued in more detail below (see point 13) and so constitutes a reasonable response to the board's objections. Therefore, the board exercises its discretion under Article 13 (1) RPBA and admits this new request into the procedure.

The Invention

2. The invention generally concerns a system for controlling the rendering of digital content in accordance with associated usage rights.

- 2.1 The notions of "digital content" and "rendering" are meant to cover, respectively, any work in a digital representation such as audio, video, text or software, and its output in the "desired form", for instance displaying, printing, playing or executing (cf. original description, p. 5, lines 13-16; p. 7, lines 4-7; and figs. 4a and 4b).
- 2.2 The system is based on interactions between so-called "repositories". This term is central to the invention and discussed at some length in the application (cf. p. 6, line 7 ff., and p. 12, line 17 ff.). For instance it is disclosed that "the general instance of a repository ... has two modes, a server mode and a requestor mode", but also that there are "various repository types", amongst which a "rendering repository".
- 2.3 Interaction between repositories is defined in terms of what the application calls "transactions" (see p. 26, penult. par., ff.), in particular "usage transaction" (p. 31, line 16 ff.). During a typical usage transaction a repository in requestor mode ("a requestor repository") will request a digital work from a repository in server mode ("a server repository") and indicate an intended "manner of use". The server repository will establish whether access to the digital work shall be granted based on the usage rights associated with the digital work, and if so will transmit it to the requestor repository. After transmission it is upon the requestor to ensure that the rights associated with the digital work are not exceeded.
- 2.4 The claimed invention concerns a system comprising a server repository and a requestor repository as part of

a rendering subsystem. These three components are tightly coupled in that the two repositories "are the same device" and that the "transactions for requesting, determining and granting access are entirely internal in said system". The claimed invention further specifies that the digital work is transmitted "as an ephemeral copy" and that, "after rendering", "said ephemeral copy ... is removed".

Article 123(2) EPC

3. The decision under appeal did not raise any objections under Article 123(2) EPC against the then pending claims, and the board has no reasons to raise any of its own.
- 3.1 That server and requestor "are the same device", especially for requests to render (e.g. print) a work, is disclosed on page 31, lines 21-23 of the original description.
- 3.2 Page 7 (lines 15-16) of the description discloses that a printing repository may keep an "ephemeral copy" of a digital work until it is printed, already the term "ephemeral" in the board's view implying that the copy will be deleted thereafter. In the context of the usage rights grammar (cf. p. 19, lines 26-29 and fig. 15) it is disclosed that ephemeral copies may be defined for other kinds of rendering, too. As part of the "play" and the "print transactions" it is further explained that works to be rendered are not "retained after the transactions" but that the rendering device, player or printer, "remove the contents from their memory" (p. 38, lines 18-19 and 35-36; p. 39, lines 24-25).

- 3.3 The board is thus satisfied that the amended claims do not go beyond the contents of the application as originally filed and thus conform with Article 123(2) EPC.

Claim construction and Article 84 EPC

4. The board observes that the term "repository" is not an established one in the art with a well-defined technical meaning. Therefore, the board considers that the meaning of the server and requestor repositories in the claims is exclusively determined by the features the claims ascribe to them. The term "repository" *per se* does, in the board's view, not limit the claims but also does not render them unclear.
5. Claim 1 states that the "transactions for requesting, determining and granting access are entirely internal in said system" without defining the term "entirely internal" any further. According to the description (see p. 31, lines 21-24), when server and repository "are the same device" - and thus the usage transactions are "entirely internal" - certain transaction steps need not be performed. This applies in particular to the "registration" step via which the repositories would normally establish a secure channel between them (p. 27, lines 29-33). Thus that the transactions are claimed to be "entirely internal" corresponds to the fact that neither a registration transaction nor a secure channel is claimed, but does not imply any further technical limitation. On this understanding the board has no clarity objections against this term.
6. Claim 1 only mentions "transactions for requesting, determining and granting" but does not refer to a rende-

ring transaction, let alone a specific play or print transaction. Claim 1 also fails to specify that the requests generated by the requestor relate to rendering as a specific "manner of use". As it stands, claim 1 thus does not imply that the removal of the ephemeral copy is part of a transaction involving the server repository and the rendering subsystem set up to control the use of a digital work within its usage rights. Therefore, the board considers claim 1 to be unclear, Article 84 EPC 1973.

However, it is the appellant's clear and express intention that the ephemeral copy and its removal after rendering be understood as a constituent part of a rendering transaction. In view of the board's finding on inventive step (see point 13 below) and in conformance with the appellant's auxiliary request for remittal the board decided to leave the due clarification to be done during further prosecution before the first instance.

The Prior Art

7. Document D1 discloses a digital library system in which digital works (called "information objects") are stored on servers from which they can be retrieved by users at their workstations (D1, p. 2, penult. par.).
- 7.1 Each digital work contains a "permissions header" defining the "terms under which the copyright owner makes the work available" (p. 1, first par.). These terms may define "manners of use", for instance whether and under what restrictions (and at what price) a digital work may be displayed, copied or distributed, or used to create a derivative work (p. 5, 2nd par. ff.).

- 7.2 While it is true that the permissions headers may contain bibliographic and pricing information (see D1, p. 4, 2nd par., and p. 5, 3rd par. from the bottom), the board disagrees with the appellant's statement that this makes the permissions headers "equivalent to" mere "bibliographic record information" (see grounds of appeal, p. 2, 1st par.).
8. Document D2 discloses a system in which an application program upon start-up makes a call to a licence server to check whether usage is permitted or not and act accordingly (e.g. see abstract). Furthermore, D2 states that the licence management program and the application program "may be executing on the same CPU" (col. 10, lines 61-63).

Article 56 EPC 1973

9. It is common ground that D1 constitutes the best starting point for the assessment of inventive step of the claimed invention. In particular, according to D1 it is a precondition for the transmission of documents that a document request and the permission header match, while in D2 the licences do not regulate program transmission but program execution on the client computer.
10. According to the appellant D1 does not disclose the request of an individual digital work but only the request for any document that matches a given search query (grounds of appeal, p. 3, 3rd par.).
- 10.1 The board concedes that the queries according to D1 may not identify an individual document. In the board's judgment however it is entirely obvious that individual

- documents can be identified using such queries, say by ISBN or by a suitable combination of author, title and edition of a book.
- 10.2 In view of established digital library technology (cf. D1, e.g. p. 3, 1st full par.) such queries constitute at least an obvious modification of the system of D1.
11. The appellant also argues that the decision under appeal is wrong not to have "distinguished between the requestor repository and the rendering subsystem" and challenges the finding of the decision (in point 2.1 of the summons to oral proceedings) that the client workstation of D1 contains a requestor repository (grounds of appeal, p.3, last par.).
- 11.1 The board considers it to be implicit that the client workstation according to D1 is equipped with a display and to be at least obvious that it is further equipped with a printer. Both qualify as "means for rendering" as claimed. Likewise, the board considers that the queries issued by the client workstations and their treatment at the servers correspond to the claimed requests, only up to the marginal difference between queries and requests as just discussed (point 10).
- 11.2 Therefore, the board is of the opinion that the client workstations according to D1 comprise a "repository" as claimed, broadly interpreted as argued above (see point 4), which in combination with a rendering means such as its display forms a "rendering subsystem" as claimed.

12. D1 does not disclose that client and servers "are the same device".
 - 12.1 The appellant does not challenge that the licence management system and the application programs according to D2 - acting, respectively, as server and clients for licences - may run on the same CPU and thus on the same computer (D2, *loc. cit.*). It argues however that the different treatment of permissions or licences, in D1 and D2 respectively, namely before transmission or just before execution, either rules out a combination of D1 and D2 altogether, or means that their combination would yield a licence-based system like that of D2 which would not render obvious the claimed invention.
 - 12.2 The board disagrees with this argument, considering that the option to run server and clients on the same CPU is quite independent from the question of how permissions are managed or when. Therefore, the skilled person would obtain as a separate teaching from D2 that client and server could be "the same device" and incorporate it without hesitation into the system of D1.
13. The board agrees with the appellant that D1 does not disclose or suggest anything which would "control the usage or distribution of a document in a rendering system, i.e. client terminal" once transferred (grounds of appeal, p. 2, last par.).
 - 13.1 In contrast, amended claim 1 discloses that digital works are removed after rendering. In the board's view it is clear from claim 1 as a whole that this removal is automatic.

- 13.2 The board accepts that the removal of an ephemeral copy of a digital work after rendering is a measure of making sure that a digital work transmitted for rendering is not used in further, possibly prohibited manners. While this may not be a particularly secure way of enforcing usage rights, it does achieve some security which may be appropriate according to circumstances (cf. in this respect the description, p. 14, 4th par. - p. 16, 1st par. and table 2).
- 13.3 D1 does not disclose that a document transmitted to a client workstation may be automatically removed after rendering. Insofar as a document is requested and transmitted for one-time viewing, say, it would appear obvious that the user may delete it when, after viewing, it can no longer be legally used. However, as the board reads D1, this is entirely within the user's responsibility and no automatic support to do this is disclosed or suggested in D1. The same applies to D2.
- 13.4 So the board concludes that claim 1, under the proviso of the clarity objection raised above (point 6), is non-obvious over D1, even in view of D2, and thus shows an inventive step with regard to these documents in the sense of Article 56 EPC 1973.

Extent of the search

14. The board observes that neither the original claims nor the claims subject to the decision under appeal mentioned or implied that the digital work should be transmitted as an ephemeral copy to be removed after rendering.

- 14.1 Therefore the board cannot establish for sure that this feature was covered by the European search and it would thus be inappropriate to order the grant of a patent.

- 14.2 Therefore, it is necessary that the case be remitted to the department of first instance for further prosecution during which the examining division should clarify whether the pertinent feature was searched and, if not, perform an additional search and proceed from there.

- 14.3 In case that further prosecution does not produce any new pertinent document it is also noted that this application can only proceed to grant when the clarity problem (point 6) has been remedied and the description has been adapted to the new set of claims.

Order

For these reasons it is decided that:

1. The decision is set aside.

2. The case is remitted to the department of first instance for further prosecution on the basis of the sole request before the board, namely

description, pages
1, 3-50 as originally filed
2, 2a as received with letter dated 7 November 2007
drawings, sheets
1-13 as originally filed
claims, no.
1-7 as filed during oral proceedings on
5 July 2012.

The Registrar:

The Chairman:

B. Atienza Vivancos

D. H. Rees