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**Datasheet for the decision
of 4 September 2013**

Case Number: T 0926/09 - 3.5.06

Application Number: 04078194.0

Publication Number: 1515216

IPC: G06F 1/00, G06F 17/60

Language of the proceedings: EN

Title of invention:

Systems and methods for secure transaction management and
electronic rights protection

Applicant:

Intertrust Technologies Corporation

Headword:

Component assemblies/INTERTRUST

Relevant legal provisions:

EPC R. 137(4) in its version in force before 1 April 2010

Relevant legal provisions (EPC 1973):

EPC R. 30(1), 86(1)

Keyword:

"Applicability of Rule 137(4) - no (main request): Amended
claims should have been searched and lack of unity not
established"

"Appellant entitled to rely on communication by the receiving
section indicating that a set of claims filed before receipt
of the European search report was admitted"

Decisions cited:

T 0789/07

Catchword:

see points 1-1.6



Case Number: T 0926/09 - 3.5.06

D E C I S I O N
of the Technical Board of Appeal 3.5.06
of 4 September 2013

Appellant: Intertrust Technologies Corporation
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Representative: Williams, Michael Ian
Cleveland
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 23 December 2008
refusing European patent application
No. 04078194.0 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. 04078194.0. The main request was not allowed pursuant to Rule 137(4) EPC (in its version in force before 1 April 2010) in view of D1 = US 5 343 527; the two auxiliary requests were not admitted under Rule 137(3) EPC.

II. Notice of appeal was filed on 17 February 2009, the appeal fee being paid on the same day. A statement of grounds of appeal was received on 20 April 2009. The appellant requests that the decision be set aside and that the application proceed on the basis of the main request filed with the applicant's letter of 17 October 2008. The final first and second two auxiliary requests filed during oral proceedings before the examining division were maintained and refiled on 9 October 2009. The board thus understands the application documents to be the following ones:

claims, no. 1 and 15 filed on 17 October 2008 (main request), or during oral proceedings on 19 November 2008 (1st and 2nd auxiliary requests, refiled on 9 October 2009), and
2-14 filed on 17 October 2008
description, pages 1-920 as originally filed
drawing, sheets 1-146 as originally filed

III. Claim 1 according to the main request reads as follows.

"A secure component-based operating process which is to be carried out in a protected processing environment (503) that is resistant to tampering by users of the equipment on which the protected processing environment is operated, said process comprising:

- a. retrieving at least one component;
- b. retrieving a record that specifies a component assembly (690);
- c. checking said component and/or said record for validity;
- d. assembling said component assembly (690) in accordance with said record using said component wherein said component assembly provides functions needed for a user to perform a task on an object (300), and the assembly of said component assembly is based at least in part on context parameters relating to the object or user; and
- e. performing a process based at least in part on said component assembly (690), which process includes executing the component in the protected processing environment."

Claim 1 as originally filed reads as follows:

"A secure component-based operating process including:

- (a) retrieving at least one component;
- (b) retrieving a record that specifies a component assembly;
- (c) checking said component and/or said record for validity;

- (d) using said component to form said component assembly in accordance with said record; and
- (e) performing a process based at least in part on said component assembly."

In view of the outcome of this decision, the exact wording of the claims according to the auxiliary requests is not relevant.

Reasons for the Decision

Originally filed claims

1. The request for grant of a European patent for this divisional application was received on 23 November 2004. The request indicated the number of claims as 12, but only 8 claims were filed along with it.
 - 1.1 The receiving section noted this mismatch and, with letter of 28 December 2004, invited the appellant to comment. The appellant explained that it had been its intention to file 12 claims and submitted anew the 12 claims which it believed had been originally filed (see telefax of 5 January 2005).
 - 1.2 The appellant also suggested a possible confusion with another of its applications, European patent application 04078195.7. The latter application was filed on the same day as the present one, also as a divisional application of the same earlier application, and along with 12 claims although the request for grant mentioned 8 claims.

1.3 The receiving section appears to have accepted the appellant's arguments that there had been a confusion and summarized in a letter dated 25 January 2005 as the "situation" that EP04078194.0 has 12 claims and EP04078195.7 has 8 claims. The letter gave no reasons as to why or on what legal basis the new situation was accepted.

1.4 In both cases, search and examination were based on the claims filed on 5 January 2005. Application no. 04078195.7 has meanwhile proceeded to grant.

1.5 In the present case the 12 claims submitted on 5 January 2005 were filed before receipt of the European search report, and hence in breach of the prohibition under Rule 86(1) EPC 1973. Therefore it would seem that, whatever the cause of the confusion, the search and the entire examination procedure was based on a set of claims the admissibility of which was questionable.

1.6 This question may however be left open since the appellant was entitled to rely on the communication by the receiving section according to the generally accepted principle of good faith and the protection of the legitimate expectations of parties before the EPO. Therefore the board treats the 12 claims filed with letter of 5 January 2005 as originally filed.

The invention

2. The application in general relates to computer security in the sense of maintaining the integrity, availability, and confidentiality of the information used (see origi-

- nal application, p. 1, lines 3-12). *Inter alia*, the application is concerned with protecting the rights of content owners based on a "virtual distribution environment" VDE (see p. 4, lines 7-18) and a "rights operating system" ROS (see p. 239, lines 4-15).
- 2.1 It is disclosed that the "ROS VDE functions may be based on segmented, independently loadable executable "component assemblies" which are to perform "operating system or application tasks" (see p. 251, lines 6-8 and 18-20). According to a preferred embodiment, the ROS "assembles component assemblies ... based on" so-called "Permissions Records" PERC which "identif[y] ... the elements [the] ROS is to assemble together to form a component assembly" (p. 258, lines 1-4 and 11-19).
- 2.2 It is further disclosed that assembling the component assemblies may be based on "context parameters (e.g., object, user)" (see page 254, line 13 - page 255, line 2).
- 2.3 The ROS is disclosed to include a "Host Processing Environment" HPE and/or a "Secure Processing Environment" SPE, both of which are jointly referred to as "Protected Processing Environments" (p. 239, lines 11-15). As part of an SPE, a "hardware tamper-resistant barrier" is disclosed (p. 240, lines 6-9), and as part of an HPE a "software-based tamper-resistant barrier" (e.g. p. 242, lines 6-10).
- 2.4 Claim 1 as originally filed relates to a "secure component-based operating process" including, *inter alia*, the retrieval of a "record that specifies a component assembly" and the forming of a "component assembly in

accordance with said record" (steps b and d). Original claims 8 and 9 specify that "at least two of [the] steps" of original claim 1 are performed "within a protected processing environment" or, respectively, "within tamper[-]resistant hardware".

The prior art

3. Throughout examination, D1 was used as a starting point for the assessment of novelty and inventive step. D1 deals with the reuse of software components and discloses in particular a "reuse library" (see fig. 1, no. 103) in which users may locate software components for retrieval and which assures, by way of encryption, that such components were not modified by unauthorized parties (see e.g. abstract and fig. 6; see also col. 15, lines 40-68 and ff.).

The decision under appeal

4. In addition to original claim 1, claim 1 of the main request specifies that
 - the claimed process "is to be carried out in a protected processing environment ... that is resistant to tampering by users of the equipment on which the protected processing environment is operated; that
 - "said component assembly" be "assembl[ed]" - rather than "formed" - "in accordance with said record", and that
 - "said component assembly provides functions needed for a user to perform a task on an object ..., and the assembly of said component assembly is based

at least in part on context parameters relating to the object or user".

5. Rule 137(4) EPC, in its version in force before 1 April 2010, provides that amended claims may not relate to 1.) unsearched subject matter which 2.) does not combine with the originally claimed invention to form a single general inventive concept, *i.e.* which is not unitary with the originally claimed invention.

5.1 Regarding unity (condition 2), it is argued that

- a) original claim 1 is not new over D1 (see reasons 1.1, esp. the feature table); that
- b) the features of original claims 8 and 9, "in particular the feature of claim 9", "constitute a special technical feature" in the sense of Rule 44(1) EPC (reasons 1.1, p. 4, 1st par. below the table); whereas
- c) the special technical feature of the amended claims is "basing the assembly on context parameters" (2nd par. below the table).

It is concluded that "thus" the "special features of both groups are neither the same nor corresponding", so that "non-unity would have been present if claim 1 of the main request had been filed together with the original claims" and that "[h]ence, the subject-matter of claim 1 of the main request does not combine with the originally claimed invention or group of inventions to form a single general inventive concept" (3rd par. below the table).

5.2 Regarding the scope of the search (condition 1), the decision states with reference to the Guidelines but without any explicit argument that the amendment of claim 1 could not have been "reasonably expected" and that, hence, "it must be assumed that claim 1 [of the main request] relates to unsearched subject matter" (reasons 1.1, last par. bridging pp. 4 and 5). According to the minutes (see p. 1, 2nd par.), the examining division had suggested that "the extensive description of over 900 pages did not make it practically possible for the search examiner to extend the search to more than what was strictly needed to interpret the claims".

The board's position

6. The examining division had raised a novelty objection against claim 1 in view of D1 in its first communication dated 21 June 2006. Apparently in reaction to the appellant's response, the examining division changed its analysis of claim 1 in the communication of 13 April 2007, finding (see point 2.2) that claim 1 differed from D1 by

- (b) retrieving a record that specifies a component assembly, and
- (c) said component assembly is formed in accordance with said record.

This finding was maintained in the summons to oral proceedings (also point 2.2).

In the decision however the examination division, referring to their argument dated 21 June 2006, returned

- to its initial analysis and found feature (b) and (c) to be known from D1.
- 6.1 During oral proceedings, the appellant appears to have argued that the "context parameters" specified in more detail the original claimed "component assemblies" and should thus have been admitted even if an additional search might be required (see minutes, p. 4, 4th and 1st pars.).
- 6.2 That the examining division did not accept this argument appears to be due, at least partly, to the fact that it returned to the view that feature (b) and (c) - and especially the "component assemblies" - were known from D1.
7. *Re. Unity:* Where the decision identifies the technical features of original claims 8 and 9 as "a special technical feature" (see p. 4, 1st par.) it does not explicitly refer to any claim or set of claims. Since however the following paragraphs refer to the amended claims and, respectively, the comparison of amended claim 1 and original claim 1, the board takes the decision to identify the features of original claims 8 and 9 as the special technical features of the original set of claims 1-12.
- 7.1 Original claims 8 and 9 specified at least two of the then claimed steps to be performed, respectively, "in a protected processing environment" and "at least in part within tamper resistant hardware". Amended claim 1 specifies the claimed process "to be carried out in a protected processing environment ... that is resistant to tampering by users of the equipment on which the pro-

tected processing environment is operated" and thus requires features which are rather similar to those of original claims 8 and 9. If, as the decision argues, the features of original claims 8 and 9 are special technical features in view of D1 it would appear that the mentioned feature of amended claim 1 had to be considered a special technical feature, too. Moreover, it would also appear that this feature of amended claim 1 would have to be deemed "same or corresponding" to those of original claims 8 and 9 and therefore to establish unity according to Rule 30 EPC 1973 (equivalent to Rule 44(1) EPC) , irrespective of the fact that amended claim 1 also specifies the context parameters. The decision does not address this issue and, in particular, does not give reasons as to why the examining division might have dismissed this consideration.

7.2 Moreover, the decision identifies as special technical features of the original set of claims those of original claims 8 and 9 but does not give any reasons as to why the analysis is restricted to dependent claims 8 and 9. This ignores the possibility that other dependent claims might also contain special technical features of the originally claimed invention which might establish a technical relationship - and thereby unity - between the originally claimed invention according to claims 1-12 and amended claim 1.

7.3 For both reasons the board considers that the reasons given in the decision for lack of unity between the original set of claims and amended claim 1 of the main request are incomplete and therefore insufficient to justify the conclusion.

8. *Re. Scope of the search:* The "component assemblies" are disclosed in the description beginning on page 251, line 4. They are described as components of the ROS which itself is disclosed on pages 239 ff. Even though, as the examining division argues, the application is very large, it would appear that the disclosure relevant for the "component assemblies" is concentrated on pages 239-267 and could have been easily located at the search stage. The board therefore considers that amended claims based on material from this part of the description cannot be dismissed by reference to the size of the description as a whole. Moreover, the board agrees with the appellant that the "context parameters", disclosed on pages 254-255, constitute a reasonable limitation of the claimed "component assemblies" in response to an inventive step objection by the examining division and should therefore have been covered by the search. If the context parameters were, in fact, not searched, the board also agrees with the appellant that an additional search may be required (see also T 789/07, headnote 1).

Auxiliary requests

9. The two auxiliary requests on which the decision is based appear to have been filed during oral proceedings to replace all previously pending auxiliary requests (see decision, facts 8, and minutes, p. 4, penult par.). Neither the decision nor the minutes, however, contain a copy of these two requests. The auxiliary requests presently on file were submitted during appeal on request of the board's registry.

- 9.1 It is the common understanding that the auxiliary requests filed during appeal are meant to be the same as the ones submitted during oral proceedings before the examining division even though it is not clear how this could be established.
- 9.2 This notwithstanding however, the board notes that the appellant maintains the auxiliary requests "[a]s a precaution" but does not challenge or even address the examining division's decision not to admit them under Rule 137(3) EPC as required by Article 12(2) RPBA.
- 9.3 Thus the appeal is not substantiated insofar as it relates to the decision of the examining division not to admit the auxiliary requests and so the board sees no reason to consider them now.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

B. Atienza Vivancos

D. H. Rees