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**Datasheet for the decision
of 30 July 2013**

Case Number: T 1092/09 - 3.4.03

Application Number: 01310568.9

Publication Number: 1217591

IPC: G07F17/16, G07F7/10

Language of the proceedings: EN

Title of invention:

Improvements in and relating to the distribution of content

Applicant:

Nokia Corporation

Headword:

Relevant legal provisions:

EPC 1973 Art. 56

Keyword:

Inventive step - (yes)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1092/09 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 30 July 2013

Appellant: Nokia Corporation
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 15 December 2008 refusing European patent application No. 01310568.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: G. Eliasson
Members: S. Ward
T. Bokor

Summary of Facts and Submissions

I. The appeal is against the decision of the Examining Division dated 15 December 2008 refusing European patent application No. 01 310 568.9 on the ground that the claimed subject-matter does not involve an inventive step within the meaning of Article 56 EPC 1973, having regard to the following prior art:

D1: US 5 862 260 A.

II. The appellant requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of the claims 1-22 filed with the letter dated 17 August 2007.

III. Claim 1 reads:

"A network device (21) for connection in a communication path of a network, the network device including a controller (25) operable to:
detect a predetermined tag within content passing along the path;
in response to said detection, generate a report identifying said detection and identifying a sender and/or recipient of said content; and
address said report to an external monitoring centre (31)".

IV. The appellant's arguments may be briefly summarised as follows:

Two distinct "aspects" of D1 are identified and are referred to as aspects A and B.

Aspect A describes a system for detecting fraudulent calls in a wireless telephone network and corresponds to material found in columns 78 to 87.

Aspect B describes a system for monitoring images etc. printed in magazines or hosted on the world wide web. The Examining Division referred to column 1, lines 22 to 49 in this regard, however, as this falls under the heading "summary of the invention" the skilled person would understand that other specific disclosures will exist in D1 relating to this aspect.

These aspects of D1 represent disclosures which are "completely opposite to one another" and combining them would require modifications which would not be obvious; such a combination would appear to be not even possible.

Furthermore, the combination of these two aspects would still not account for all of the features of claim 1. The missing feature ("[the report] identifying a sender and/or recipient of said content") is not disclosed anywhere in document D1 and would not represent "a good fit" with either aspect A or aspect B.

Reasons for the Decision

1. The appeal is admissible.
2. Inventive Step
 - 2.1 The terms "aspect A" and "aspect B" of the document D1 which were introduced by the appellant and referred to above will be used in the present decision. These terms are preferred to the terms "feature A" and "feature B"

used in the contested decision, as it is not always clear whether features A and B refer to features of claim 1 of the application (see e.g. paragraph 1.1) or to passages of the document D1 in which claimed features are said to be disclosed (see e.g. paragraph 1.4).

It is apparent from a reading of document D1 as a whole that the subject-matter of aspect B occurs not only in column 1, lines 22 to 49, but elsewhere in D1. In particular, in comparing independent claims 1 and 10 of D1 with the subject-matter of column 1, lines 22 to 49 ("summary of the invention"), the Board concludes that the subject-matter of claims 1-18 of D1 should also be regarded as being comprised in aspect B.

Aspect A is considered to be defined by the subject-matter found in "column 78, line 36 to column 87, line 63, and especially column 86, line 65 to column 87, line 63" (see paragraph 1.1A of the decision under appeal).

In the contested decision these passages are regarded as related but ultimately separate technical disclosures ("separate examples of how to implement the technology of D1" - see paragraph 1.1), and the Board is also satisfied that this is the case.

- 2.2 It is not apparent from the contested decision which of these two disclosures is considered by the Examining Division to represent the closest prior art.

In accordance with the established case law of the boards of appeal (Case Law of the Boards of Appeal of the European Patent Office, 6th edition, 2010, I.D.3.1, I.D.3.2) the closest prior art is generally a

disclosure of subject-matter conceived for the same purpose or objective as the invention. The present invention is motivated by the need to monitor the distribution of content over networks for the purpose of countering a loss in revenue to rights holders (see page 1, lines 4-31 of the description). The disclosure of aspect B is therefore the most suitable choice for closest prior art.

2.3 D1 (aspect B) discloses a method in which data is downloaded from computer sites over the internet for screening (column 1, lines 35-40). It is therefore implicit that this data is downloaded onto a device (e.g. a computer) connected to a network (the internet) which may be referred to as a "network device". Hence D1 (aspect B) discloses the following features of claim 1:

- A network device (implicit, see above) for connection [to] a network, the network device including a controller operable to detect a predetermined tag within content (column 1, line 22 to 49; claims 1,10); in response to said detection, [to] generate a report identifying said detection; and [to] address said report to an external monitoring centre (claims 5,14).

The subject-matter of claim 1 differs from aspect B of D1 in comprising the following features (in bold):

- [a] network device for connection **in a communication path of a network;**
- a controller operable to detect a predetermined tag within content **passing along the path;**
- a report...**identifying a sender and/or recipient of said content.**

The Board interprets expressions such as "for connection in a communication path of a network" and "operable to detect..." as defining means which **are adapted** to be used or to function in the claimed manner, rather than merely means which could be thus adapted (T 410/96, reasons 6).

By contrast to claim 1 of the present application, the method of monitoring content proposed in aspect B of D1 is to download data sets from the internet and then to screen them for the relevant steganographically encoded information. Aspect B does not disclose screening data passing along a communications path of the network.

- 2.4 According to the contested decision (paragraph 1.4), the problem solved by claim 1 is "to check copyrighted material being sent in a telephone network". It must therefore be enquired whether this is an appropriate formulation.

Within the context of the problem-solution approach, it is well-established that the objective problem should be based on the technical effect of the features distinguishing the claim from the closest prior art. In the present case, the distinguishing features mentioned above do not include any reference to a telephone network nor is any limitation to a telephone network implied. There is also no reference to a telephone network in the closest prior art (aspect B).

In posing a problem in which a reference to a telephone network is explicitly incorporated, the Examining Division appears to have been unduly influenced by an anticipation of its own subsequent argument which relies on a disclosure relating to a telephone network (aspect A). Tailoring the problem posed to facilitate a

particular combination of prior art disclosures clearly represents an impermissible approach to determining the objective problem.

According to the application (page 4, lines 23-3) the invention aims to solve the problem of providing a system of digital rights management which may be applied to existing technology without the need for modification of terminals (e.g. providing them with dedicated software). Clearly, if this is considered to be the objective problem, then the skilled person would not look for a solution in aspect A, which is concerned not with digital rights management but with fraud prevention in mobile telephony.

This conclusion would not be altered even if the objective problem were defined more generally as, for example, providing improved monitoring of content passed over a network. The closest prior art (aspect B) concerns the distribution of proprietary content on the internet and protecting the rights of the owners of this content, and it is implausible that the skilled person seeking a general improvement in this area would consult a disclosure concerned with the problem of cellular telephone hacking (aspect A).

2.5 In paragraphs 1.2-1.4 of the contested decision it is argued that it would not involve any inventive activity to combine aspects A and B, as the skilled person would understand that, although these aspects are found in different parts of D1, "the techniques A and B are general tools" which can be applied in other situations. The skilled person would therefore find it obvious to combine them to solve the problem posed by the Examining Division (see paragraph 2.4 above).

Moreover, no "surprising or combinatory effect" would result.

The most that this argument could establish is that the general idea of combining aspects A and B would occur to the skilled person. For the reasons explained above, the Board does not believe this to be the case, but even if this assertion were accepted, it would still not constitute a demonstration that the subject-matter of claim 1 is obvious. To establish that would require a convincing argument that in combining these aspects, the skilled person would be led to a network device falling within the ambit of claim 1.

The Board finds that the arguments in the contested decision are not entirely clear in this regard, and can only speculate that a chain of reasoning along something like the following lines is intended: starting from aspect B, rather than downloading files from internet sites for screening for encoded data, the skilled person would locate somewhere in the network the component referred to in aspect A as "cell site 2012" which includes "steganographic decoder 2038" (see figures 38,40); the cell site, when suitably modified to the requirements of aspect B, would comprise (at least most of) the features of the network device defined in claim 1 of the present application.

The "cell site", however, is a component which is disclosed for use in a cellular telephone network, and hence it is implicit that it would be engineered with such an application in mind (see D1, column 80, lines 9-11). For this component to be adapted to be connectable in an internet path and capable of detecting encoded data on internet traffic rather than

on voice data would clearly require a significant re-design.

Moreover, according to aspect A the clear purpose of the cell site is to determine when the appropriate encoded data is **not** present in the content, and then to instigate remedial action, the only concrete example of such remedial action being "interrupting the call" (column 79, lines 28-33). Even if the skilled person were incited to incorporate into aspect B a device corresponding to the cell site, i.e. having the corresponding purpose and functionality, this would lead to aspect B comprising a device for determining when particular encoded data is not present in content passing along a communication path, and for instigating remedial action, which, by analogy to the only disclosed example of such remedial action in aspect A, would presumably be to interrupt the transmission of the data.

Hence, a straightforward combination of aspects A and B would not lead in the direction of claim 1 of the present application.

To move in the direction of the claim, the skilled person would have to perform further adaptations. In particular, the cell site would have to be re-engineered to generate reports (rather than to interrupt transmissions), and this in response to the detection (rather than the non-detection) of encoded data. In short, the cell site would have to be transformed into a device performing the functions described in column 1, lines 40-44 (aspect B), instead of the quite different functions which it is actually disclosed as performing. Such adaptations are beyond

those which could reasonably be described as routine or obvious.

- 2.6 Finally it is also acknowledged in the contested decision that one feature of claim 1 (the report "identifying a sender and/or recipient of said content") is not disclosed at all in D1 (the sole document cited during the examination procedure).

The arguments of the Examining Division that this is an obvious feature (paragraph 1.6 of the contested decision) are not found convincing. They appear to be based on the premise that the task facing the skilled person is to check copyrighted material being sent over a telephone network, which the Board does not regard as the pertinent problem (see paragraph 2.4, above).

The Board does not, therefore, believe that any convincing reason has been advanced for regarding this feature, which is not disclosed in the prior art cited by the Examining Division, as being trivial or obvious.

- 2.7 Hence the skilled person starting from aspect B of D1 would not find it obvious to arrive at the subject-matter of claim 1 of the present application.

- 2.8 For completeness the Board notes that the same conclusion would be reached starting from aspect A. At least one of the above arguments can simply be applied in reverse: no reason can be seen why a skilled person looking to improve fraud prevention in cellular (or other) wireless networks would look to prior art relating to digital rights management on the internet. Once again, the device of claim 1 could only be arrived at by a series of contrived adaptations including, *inter alia*, providing a report "identifying a sender

and/or recipient of said content" which is not disclosed anywhere in D1.

- 2.9 For these reasons the Board judges that the network device of claim 1 involves an inventive step within the meaning of Article 56 EPC 1973.

For the same reasons, *mutatis mutandis*, the method of transmitting a message defined in claim 8, the method of monitoring content defined in claim 14 and the computer program defined in claim 21 involve an inventive step within the meaning of Article 56 EPC 1973.

The Board notes that the description has not yet been adapted in line with amendments made during examination.

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 with the order to grant a patent on the basis of claims 1-22 filed with the letter dated 17 August 2007, Figures 1 to 6 as originally filed and a description to be adapted.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Eliasson

Decision electronically authenticated