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Datasheet for the decision
of 9 July 2014

Case Number:	T 0780/10 - 3.5.06
Application Number:	00986344.0
Publication Number:	1242854
IPC:	G06F1/00
Language of the proceedings:	EN

Title of invention:
INTER-SERVER COMMUNICATION USING REQUEST WITH ENCRYPTED
PARAMETER

Applicant:
MICROSOFT CORPORATION

Headword:
Electronic content distribution using a public key/MICROSOFT

Relevant legal provisions:
EPC Art. 123(2), 56, 84

Keyword:
Amendments - added subject-matter (no)
Remittal to the department of first instance

Decisions cited:

Catchword:

Beschwerdekammern
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European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: **T 0780/10 - 3.5.06**

D E C I S I O N
of Technical Board of Appeal 3.5.06
of 9 July 2014

Appellant: (Applicant)	MICROSOFT CORPORATION One Microsoft Way Redmond, WA 98052 (US)
Representative:	Grünecker, Kinkeldey, Stockmair & Schwanhäusser Leopoldstrasse 4 80802 München (DE)
Decision under appeal:	Decision of the Examining Division of the European Patent Office posted on 9 November 2009 refusing European patent application No. 00986344.0 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman	D. Rees
Members:	S. Krischer
	W. Sekretaruk

Summary of Facts and Submissions

I.   The appeal is directed against the decision of the
        examining division, posted on 9 November 2009, to
        refuse the application 00986344. The reason for the
        refusal was lack of inventive step over the following
        document:

        D1   WO 96 42041 A, 27 December 1996.

II.   A notice of appeal was received on 11 January 2010. The
        fee was received the same day. A statement of the
        grounds of appeal was received on 8 March 2010. Claim
        sets of a main and an auxiliary request were filed.

III.   The board issued a summons to oral proceedings.
        Considering the significant amendments to the claimed
        subject-matter which had been introduced in the course
        of prosecution of the application, including to the
        purpose (from "A method of communicating with a first
        computing device" to "A method for facilitating
        electronic content distribution by a retail computing
        device"), the board concurred that D1 was no longer the
        most appropriate starting point for considering
        inventiveness. Accordingly, the board chose to start
        from another document cited in the international search
        report, but not used in the examination procedure:

        D2   WO 98 58306 A, 23 December 1998.

        The board gave reasons for its preliminary opinion that
        claim 1 of the main request lacked an inventive step
        over D2 (Article 56 EPC). Furthermore, with respect to
        the auxiliary request, the feature of a *public portion
        of a key pair to be included in the encrypted*

information of the HTTP request, which had been added
to claim 1 of the auxiliary request, was objected to as
not being originally disclosed (Article 123(2) EPC).

IV.   In a letter dated 6 June 2014, the appellant filed a
       marked-up version of the auxiliary request highlighting
       the amendments as compared to the main request and
       including references to passages in the original
       application. Description page 2a was also amended to
       acknowledge D2.

V.   Oral proceedings were held on 9 July 2014 during which
       the appellant filed an amended claim set and withdrew
       all other requests. At the end of the oral proceedings,
       the board announced its decision.

VI.   The appellant requests that the decision be set aside
       and a patent be granted on the basis of claims 1-37
       filed during the oral proceedings.
       The further text on file is: description pages 1, 3-63
       as published, pages 2, 2b, 64 filed on 20 April 2005,
       page 2a filed on 6 June 2014; drawing sheets 1-8 as
       published.

VII.   Claim 1 reads as follows:

       "1. A method for facilitating electronic content
            distribution by a retail computing device (71, 72,
            74) configured to provide functionality for a
            retailer of electronic content, said method
            comprising:

            receiving, at the retail computing device from a
            client computing device (90, 92), a purchasing
            order for electronic content;

encrypting, at the retail computing device,
information including at least a set of parameters
relating to the purchased electronic content (10),
the set of parameters comprising at least an
identification of the electronic content, the
encrypted information being destined for a content
computing device (78) configured to provide the
electronic content, the content computing device
being different from the client computing device
and from the retail computing device;

creating, at the retail computing device, an HTTP
request which includes an address of said content
computing device and the encrypted information;
and

transmitting said HTTP request from the retail
computing device to the client computing device
allowing the client computing device to supplement
said HTTP request with a public portion of a key
pair associated with a purchaser of the electronic
content associated with the client computing
device, the key pair having been issued to the
purchaser for use on the client computing device
upon condition of the purchaser tendering
authenticatable credentials and upon further
condition of the key pair not having previously
been issued for use by the purchaser on a number
of devices that exceeds a limit."

Reasons for the Decision

1.   *Overview of the invention*

        The application relates to a server architecture (70 in
        figures 3 and 4) comprising a front-end retail server
        (72 in figures 3, 4; called "retail computing device"
        in the claims) for selling, but not downloading
        (original description page 12, lines 20-23) electronic
        content (such as electronic books, video, audio,
        software executables; see page 6, lines 23-24) to end-
        users and a download server (78 in figures 3, 4; called
        "content computing device") responsible for the
        download of content sold by the retail server (page 12,
        lines 23-25) to end-users' devices. End-users select
        and purchase content (200 and 202 in figure 9) using
        e.g. a browser on a "client computing device" (90, 92
        in figures 3, 4) from the retail server and then
        receive a URL from the retail server for downloading
        the content from the download server (page 37, line 29
        to page 38, line 1). An example of such a URL including
        a download command and a set of encrypted parameters
        related to the purchased content can be found on
        page 14, lines 1-2. A non-exclusive list of parameters
        that can be encrypted can be found in page 23, line 15
        to page 25, line 18. These parameters include in
        particular an identification of the purchased content
        (page 13, line 20; page 23, lines 20-22). The
        encryption is done using a symmetric key which is a
        secret between the retail server and the download
        server (page 22, lines 3-17). The end-user receives a
        receipt in form of a URL on a web page (lines 17-19)
        which, when followed, transmits the encrypted
        parameters to the download server (lines 19-20) where

they are decrypted using the shared symmetric key
(line 20) and a download is initiated upon their proper
decryption. If no other party than the retailer and the
download server knows the symmetric key, a proper
decryption authenticates the URL receipt as having been
generated by a legitimate retailer (page 14, lines
6-10; page 22, line 25 to page 23, line 2). For so-
called "level 5 protected" content the client system
adds an activation certificate to the URL before
accessing the download server, and the public key
contained therein is used to encrypt a decryption key
for the content, so that the client and only the client
can decrypt this key using its activation private key
(page 38, lines 1-13).

2.   *Overview of the decision*

      After the examination as to the admissibility of the
      request and its original disclosure, the board shall
      decide on the appeal. The board may either exercise any
      power within the competence of the examining division
      or remit the case for further prosecution. In the case
      at hand, the board uses its discretion and remits the
      case to the department of first instance for the
      reasons given below.

3.   *Admissibility of the request*

3.1   The claims were filed during the oral proceedings and
      hence according to Article 13(1) of the Rules of
      Procedure of the Boards of Appeal (RPBA) the board has
      discretion whether or not to admit them into the
      proceedings. They are based on the auxiliary request
      filed with the grounds. One effect of their amendments
      in comparison with said auxiliary request is the

deletion of the feature of a *public portion of a key pair to be included in the encrypted information of the HTTP request* which had been objected to by the board in the summons and during oral proceedings as added subject-matter (Article 123(2) EPC). Essentially the amendment is responsive to an objection which the appellant had not understood until there was the opportunity to discuss it in depth at the oral proceedings.

3.2   Moreover, the auxiliary request filed with the grounds of appeal is judged by the board to be a legitimate attempt to overcome the inventive step objection raised by the examining division. Given that the amendment made in the oral proceedings before the board simply successfully overcomes the above mentioned objection with respect to Article 123(2) EPC (see below), the request is admitted into the procedure (Article 13(1) RPBA).

4.   *Original disclosure of the request*

4.1   The examining division did not raise any objections under Article 123(2) EPC in its decision and the board concurs that there was no reason to do so with respect to the claims as refused. Current claim 1 has been significantly rewritten. As to the various amendments, the board finds that they satisfy the requirements of Article 123(2) EPC (added wording in comparison with claim 1 of the refused main request is marked by underlining):

        □   "receiving, at the retail computing device from a client computing device (90, 92), a purchasing order for electronic content": see page 37, lines 26-28 and page 13, lines 26-30;

□ "encrypting, <u>at the retail computing device</u>,
  information including at least a set of parameters
  relating to the purchased electronic content": see
  page 21, line 29 to page 22, line 7, and page 13,
  line 15 to page 14, line 5;

□ "<u>the content computing device being different from
  the client computing device and from the retail
  computing device</u>": see 78, 90/92, 72 in figures 3
  and 4;

□ "creating, <u>at the retail computing device</u>, an HTTP
  request which includes an address of said content
  computing device and the encrypted information":
  see page 22, lines 14-17;

□ "transmitting said HTTP request <u>from the retail
  computing device to the client computing device</u>":
  see page 22, lines 17-20;

□ "allowing the client computing device to
  <u>supplement said HTTP request with a public portion
  of a key pair associated with a purchaser of the
  electronic content associated with the client
  computing device</u>": see page 38, lines 1-4 and
  20-24;

□ "<u>the key pair having been issued to the purchaser
  for use on the client computing device upon
  condition of the purchaser tendering authenti-
  catable credentials and upon further condition of
  the key pair not having previously been issued for
  use by the purchaser on a number of devices that
  exceeds a limit</u>": see page 33, line 22 to page 34,
  line 21 and page 36, line 23 to page 37, line 23.

4.2   As to the amendments of the *description* (page 2a,
      second paragraph), the board also takes the view that
      they satisfy the requirements of Article 123(2) EPC,

since it has simply been amended to indicate background
art D2, as required to satisfy Rule 42(1)(b) EPC.

5.   *Other provisions of the EPC and remittal of the case to
      the department of first instance*

5.1   The independent claim has been significantly rewritten
      compared to the claims as refused. In particular, it
      includes the features of *allowing the client computing
      device to supplement said HTTP request with a public
      portion of a key pair associated with a purchaser of
      the electronic content associated with the client
      computing device, the key pair having been issued to
      the purchaser for use on the client computing device
      upon condition of the purchaser tendering authenti-
      catable credentials and upon further condition of the
      key pair not having previously been issued for use by
      the purchaser on a number of devices that exceeds a
      limit*, disclosed within the framework of the so-called
      "fully individualized" or "level 5" protection in the
      original description (see page 38, lines 5-13; page 4,
      lines 3-8).

5.2   The claims before the examining division (including the
      dependent claims) were not restricted to level 5
      protection, so the present subject-matter was not
      examined in the first instance; it is not known to the
      board even how far it has been searched. The amendments
      that have been made are by no means trivial or unde-
      niably common knowledge. The board judges therefore
      that in the present circumstances it is not appropriate
      for the board alone to decide on inventive step on the
      basis of the prior art at hand.

5.3   Therefore, the board considers it to be appropriate to
        remit the case to the first instance for further
        examination. The board notes that this of course
        extends to all the requirements of the EPC which have
        not directly been touched by this decision. For
        example, it would appear debatable whether the claimed
        subject-matter is clear as to which devices are
        required to be present in order to fall within the
        ambit of the claim, and also whether the claim contains
        all the essential features. It contains no step of
        downloading the ordered content file (in contrast to
        the main request filed with the grounds or the refused
        main request). Furthermore, neither the HTTP request
        nor the public key are used in the claimed method.
        However, it is clear from the description (page 38,
        lines 5-13; page 4, lines 3-8) that they are
        transmitted to the content server where the public key
        is used for encrypting a license containing the
        symmetric content key and embedding it in a licence for
        "fully individualised" (level 5) content items.

Order

For these reasons it is decided that:

1)   The decision under appeal is set aside.

2)   The application is remitted to the department of first
        instance for further prosecution on the basis of claims
        1-37 filed during oral proceedings on 9 July 2014.

The Registrar: The Chairman:

B. Atienza Vivancos   D. Rees

Decision electronically authenticated