

Internal distribution code:

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

**Datasheet for the decision
of 12 January 2015**

Case Number: T 1317/10 - 3.5.06

Application Number: 07753196.0

Publication Number: 2018732

IPC: G06F21/00

Language of the proceedings: EN

Title of invention:

PROTECTING THE INTEGRITY OF ELECTRONICALLY DERIVATIVE WORKS

Applicant:

Adobe Systems Incorporated

Headword:

Digitally signing derived documents / Adobe

Relevant legal provisions:

RPBA Art. 15(3), 15(6), 13(1)
EPC Art. 114(1), 111(1), 78(1), 97(2)
EPC 1973 Art. 54, 84
EPC R. 48(1)(c)
EPC Prot. Interpretation Article 69

Keyword:

Novelty - (no)

Decisions cited:

T 0887/98

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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

Case Number: T 1317/10 - 3.5.06

**D E C I S I O N
of Technical Board of Appeal 3.5.06
of 12 January 2015**

Appellant: Adobe Systems Incorporated
(Applicant) 345 Park Avenue
San Jose, CA 95110 (US)

Representative: Meldrum, David James
D Young & Co LLP
120 Holborn
London EC1N 2DY (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 12 January 2010
refusing European patent application No.
07753196.0 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman W. Sekretaruk
Members: G. Zucka
A. Teale

Summary of Facts and Submissions

I. The appeal is against the decision by the examining division, with reasons dispatched on 12.01.2010, to refuse European patent application 07 753 196.0, on the basis that the subject-matter of independent claim 1 was not inventive, Article 56 EPC 1973. The following document was cited in the appealed decision:

D1: US 2005/0283439 A1.

The following documents were cited during the examination procedure but were not relied upon in the appealed decision:

D2: US 2004/0107348 A1

D3: US 6 748 538 B1

D4: Marc A. Kaplan: "IBM CryptolopesTM, SuperDistribution and Digital Rights Management", Internet citation, [Online] XP002132994, Retrieved from the Internet: URL:<<http://www.research.ibm.com/people/k/kaplan/cryptolope-docs/crypap.html>> [retrieved on 14.03.2000], Page 3, section "Authentication with Digital signatures".

II. A notice of appeal was received on 19.03.2010, the appeal fee being paid on the same day. A statement of grounds of appeal was received on 17.05.2010.

III. The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of claims 1 to 19, description pages 1 to 3, 3a and 4 to 40 and drawing sheets 1 to 11, all filed with the grounds of appeal. The appellant made a conditional request for oral proceedings.

- IV. The board issued a summons to oral proceedings. In an annex to the summons, the board set out its preliminary, negative opinion on the appeal.
- V. On 09.12.2014, the appellant filed three auxiliary requests. Auxiliary request 1 is identical to the main request except for replacement description pages 1 and 20. Auxiliary request 2 is identical to auxiliary request 1 except for a new claim set comprising claims 1 to 19. Auxiliary request 3 is identical to auxiliary request 1 except for a new claim set comprising claims 1 to 19 and replacement description pages 4, 6, 7 and 9.
- VI. The appellant requests that the decision under appeal be set aside and a patent be granted on the basis of the main request or one of the auxiliary requests.

The appellant further requests that the board not rely upon D2 in its reasoning in order not to deprive the appellant of the opportunity to present his arguments regarding D2 to the department of first instance.

- VII. Claim 1 of the main request reads as follows:

"A method comprising:
creating a second document, the second document being derived from the content of a first document;
determining a first message digest for the first document;
computing a second message digest for the second document; and
creating a digital signature for the second document, by encrypting the first message digest, and the second message digest."

- VIII. The claims of auxiliary request 1 are the same as those of the main request.
- IX. Claim 1 of auxiliary request 2 differs from claim 1 of the main request in that the word "derived" on the second line of the claim is replaced by "logically or physically derived".
- X. Claim 1 of auxiliary request 3 differs from claim 1 of the main request in that the word "derived" on the second line of the claim is replaced by "logically derived" and the following passage is added at the end of the third line of the claim: "in that content of the second document comprises an updated or modified version of the first document".
- XI. The appellant's representative announced that he would not attend the oral proceedings, which were held on 12.01.2015 in the absence of the appellant.
- XII. At the end of the oral proceedings, the chairman announced the board's decision.

Reasons for the Decision

1. *The appellant's non-attendance at the oral proceedings*

As announced in advance, the duly summoned appellant did not attend the oral proceedings. In accordance with Article 15(3) RPBA, the board relied for its decision only on the appellant's written submissions. The board was in a position to decide at the conclusion of the oral proceedings, since the case was ready for decision

(Article 15(6) RPBA), and the voluntary absence of the appellant was not a reason for delaying a decision (Article 15(3) RPBA).

2. *The admissibility of the appeal*

In view of the facts set out at points I and II above, the appeal is admissible, since it complies with the EPC formal admissibility requirements.

3. *Admittance of the auxiliary requests*

The board considers that the amendments introduced with the auxiliary requests are not complex but constitute straightforward attempts to overcome the objections raised in its summons to oral proceedings. The auxiliary requests 1-3 are therefore admitted under Art. 13(1) RPBA.

4. *Introduction of D2 into the proceedings*

The board introduces D2 into the proceedings, exercising its power under Article 114(1) EPC 1973 to examine the facts of its own motion.

According to the appellant (page 1 of the reply to the summons), D2 was never substantively relied upon by the department of first instance to raise any objection against the application. The appellant therefore submits that there can be no valid decision to dismiss the present appeal on the basis of any conclusion drawn from D2 and the application should instead be remitted to the examining division for substantive assessment of the merits of the application relative to D2.

The board observes that the appeal system under the European Patent Convention does not provide for a right to have an issue decided by two instances.

Additionally, in the present case, given that the examining division had already concluded that the subject-matter of claim 1 lacks an inventive step in view of another document (*viz.* D1), the introduction of D2 into the discussion before that instance would not change its decision.

The board therefore does not accede to the appellant's request to remit the case.

5. *Interpretation of claim 1 (main request)*

The board considers it appropriate to indicate how it interprets some of the terms used in claim 1 of the main request.

5.1 *the second document being derived from the content of a first document*

5.1.1 In the summons, the board expressed its then preliminary opinion that this feature has no limiting effect on the claim.

5.1.2 The appellant did not agree with this finding (see section 1.1 in the reply to the summons). However, he did not indicate which concrete limitations were imposed on the content of the second document by the fact that it is "derived" from the content of the first document. The description is also not helpful in this respect. According to paragraph [0028] of the description, a derived document is one that "would not exist in the absence of the previous document". The

board observes that this definition also applies to the "history information" in D2. According to the appellant (section 2.3 in the reply), the history information of D2 does not depend on a particular source image but could be used to construct a modified image starting from a different source image. The board notes however, that, if this were done, the resulting image would in general not make much sense. For example, if the brightness change and the cutout mentioned in figure 6 of D2 were applied to a different source image, the resulting image could become, say, a black spot. The derivation in D2 can therefore be said to be at least of the same nature as the critique mentioned under [0029] of the present description. A critique does not necessarily contain any of the text of the original document and could conceivably also refer to a different original document, e.g. if it consisted of general statements such as "The author clearly has not checked his facts".

- 5.1.3 The board therefore finds that the above feature introduces no limitation in the claim.
 - 5.1.4 The board further observes that it makes no difference for the computation of the second message digest or for the creation of the digital signature what exactly is contained in the second document, let alone how that content depends on the content of the first document. Therefore, even if the relationship between the first and second documents were exactly defined in the claim (without however including the steps of the derivation process itself in the claimed subject-matter), this would not introduce a *technical* limitation in the claim.
- 5.2 *message digest*

Given that the claim generally relates to digital signatures, the board takes the view that the skilled person would consider the term "message digest" synonymous with "cryptographic hash value". This finding was not challenged by the appellant.

5.3 *encrypting the first message digest, and the second message digest*

According to the board, the skilled person would either read such an expression as "encrypting the first message digest and encrypting the second message digest" or at least regard this as a possible interpretation. It is observed that this interpretation was used in the reasoning against novelty in section 7 of the summons and that it was not challenged by the appellant.

6. *Novelty (main request); Article 54 EPC 1973*

Regarding claim 1 of the main request, D2 discloses a method comprising:

creating a second document ("history information"; see D2, paragraph [0057];
determining a first message digest ("hash value") for a first document (D2, paragraph [0056]);
computing a second message digest for the second document ("a hash value is generated for the history information"; see D2, paragraph [0057], last sentence); and
creating digital signatures for both the first and the second document by encrypting respectively the first message digest (see D2, paragraph [0056],

second sentence) and the second message digest (D2, paragraph [0057], last sentence).

In D2, as a result of encrypting the first and the second message digest, a digital signature is created for both the first and the second document. *A fortiori*, a digital signature is created for the second document. Hence, the method of D2 falls within the definition of claim 1 of the main request, the subject-matter of which is consequently not novel; Article 54 EPC 1973.

7. *The auxiliary requests*

7.1 Claim 1 of auxiliary request 1 is the same as that of the main request. Its subject-matter is therefore also not novel, Article 54 EPC 1973, for the same reasons.

7.2 In claim 1 of auxiliary request 2 the expression mentioned under 5.1 above is replaced by "the second document being *logically or physically* derived from the content of a first document" [emphasis added by the board]. Given that, according to the appellant (see description paragraph [0028], penultimate sentence), a derivation may be either logical or physical (*tertium non datur*), this amendment does not change the claimed subject-matter, which is therefore also not novel; Article 54 EPC 1973.

7.3 In claim 1 of auxiliary request 3, the expression mentioned under 5.1 above is replaced by "the second document being *logically* derived from the content of a first document *in that content of the second document comprises an updated or modified version of the first document*" [emphasis added]. This amendment contravenes Article 84 EPC 1973, as it contradicts the statement in paragraph [0029] of the description, according to which

such a document should be considered a *physically* derived document.

Even if, in the light of the description, the skilled person were to understand the wording "logically derived" in claim 1 as meaning "physically derived", the auxiliary request 3 would still not be allowable. Indeed, as set out in 5.1.4 above, the specification in the claim of any relationship between the first and the second document introduces in the present case no technical limitation in the claim. The subject-matter of claim 1 of the auxiliary request 3 would therefore not be novel (Article 54 EPC 1973) for the same reasons as claim 1 of the main request.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



B. Atienza Vivancos

W. Sekretaruk

Decision electronically authenticated