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**Datasheet for the decision
of 16 April 2015**

Case Number: T 1399/10 - 3.5.06

Application Number: 06110884.1

Publication Number: 1701257

IPC: G06F9/44

Language of the proceedings: EN

Title of invention:

Systems and methods for an extensive content build pipeline

Applicant:

Microsoft Technology Licensing, LLC

Headword:

Computer game software build/MICROSOFT

Relevant legal provisions:

EPC 1973 Art. 54, 56, 84

EPC R. 137(3)

RPBA Art. 11, 12(4)

Keyword:

Substantial procedural violation - (no)

Novelty - main request (no)

Inventive step - first and third auxiliary requests (no)

Discretionary decision of the examining division confirmed -
second auxiliary request not admitted

Decisions cited:

G 0007/93

Catchword:



**Beschwerdekammern
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Chambres de recours**

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Case Number: T 1399/10 - 3.5.06

**D E C I S I O N
of Technical Board of Appeal 3.5.06
of 16 April 2015**

Appellant: Microsoft Technology Licensing, LLC
(Applicant) One Microsoft Way
Redmond, WA 98052 (US)

Representative: Grünecker Patent- und Rechtsanwälte
PartG mbB
Leopoldstraße 4
80802 München (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 18 February
2010 refusing European patent application No.
06110884.1 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman W. Sekretaruk
Members: G. Zucka
M. Müller

Summary of Facts and Submissions

I. The appeal is against the decision by the examining division, with reasons dispatched on 18.02.2010, to refuse European patent application 06 110 884.1, on the basis that the subject-matter of claims 1, 9 and 13 of the main request and the auxiliary request 1 was not novel, Article 54 EPC 1973, the auxiliary request 2 having not been admitted by the examining division under Rule 137(3) EPC. The reasons for the appealed decision made reference only to the following document:

D1: WO 2004/051396 A2

The following further document, which was cited at the start of the appealed decision but was not used for its reasons, is referred to in the reasons for the present decision:

D5: C. Keith: "From the Ground Up: Creating a Core Technology Group", 01.08.2003, XP002391524, Retrieved from the Internet: URL:http://www.gamasutra.com/features/20030801/keith_pfv.htm [retrieved on 20.07.2006]

II. A notice of appeal was received on 26.04.2010, the appeal fee being paid on the same day. A statement of the grounds of the appeal was received on 10.06.2010.

III. The appellant requested:

- that the decision of the examining division to refuse the application be set aside and a patent be granted on the basis of claims 1-20, labelled "main request", filed with the notice of appeal;

- as auxiliary requests 1 and 2, that the decision of the examining division to refuse the application be set aside and a patent be granted on the basis of claims 1-20, labelled respectively "auxiliary request I" and "auxiliary request II", both filed with the notice of appeal;

- as auxiliary request 3, that the decision of the examining division to refuse the application be set aside and a patent be granted on the basis of claims 1-20, labelled "auxiliary request III", filed with the grounds of appeal;

- conditionally, oral proceedings.

The further text on file is:

description pages

- 1 and 3-17 as originally filed
- 2, 2a and 2b received on 17.08.2007

drawing sheets

- 1-8 as originally filed

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. Claim 1 of the main request reads as follows:

"A method for enabling a software build for content of an interactive multimedia software application comprising:

creating at least one file according to a standardized file format (70 - 74,86 - 100) containing metadata

related to said content, wherein said content is provided in form of various binary content files and wherein said metadata is that which is necessary to perform a software build of said content for a plurality of different interactive multimedia software applications that use the same said content."

- VI. Claim 1 of auxiliary request 1 contains the additional feature that the binary content files have various file formats.

- VII. Claim 1 of auxiliary request 2 distinguishes itself from claim 1 of auxiliary request 1 in that the interactive multimedia software application is a computer game, the content files are produced using various game content editors and tools, each having its own specific native file format, and the metadata is that which is necessary to perform a software build of said content in various formats for a plurality of different computer games that use the same content, the metadata containing the routing, context and reading mechanism for the various binary content files.

- VIII. Compared to auxiliary request 1, claim 1 of auxiliary request 3 contains the additional features that the created at least one file is a XIF file and the method comprises the additional steps of making a plurality of copies of the at least one XIF file and running each copy through a separate content build pipeline corresponding to a particular game engine, wherein each separate content build pipeline includes various transformers such as a merge transformer, a sound transformer, a texture compress transformer, a level of detail transformer, and a XIF to game engine transformer.

- IX. The appellant made no substantive response to the board's arguments. The appellant's representative announced by phone on 18.03.2015 that no-one would attend the oral proceedings on behalf of the appellant. The oral proceedings were held on 16.04.2015, in the absence of the appellant.
- X. At the end of the oral proceedings, the chairman announced the board's decision.

Reasons for the Decision

1. *Alleged procedural violation*
- 1.1 In view of Art 11 RPBA, the board considers it necessary to assess the correctness of the procedure before the first instance, given that the appellant has alleged in the grounds of appeal (section 3.3) that the department of first instance has not exercised its discretion under Rule 137(3) EPC in a proper way.
- 1.2 As a preliminary remark, the board observes that the reasons for not admitting the auxiliary request 2 are not indicated in the decision where they would be expected, *i.e.* under heading II "Reasons for the decision", but under heading III "Further remarks". This possibly reflects an erroneous assumption by the examining division that the non-admittance of a request is not part of the appealable decision.
- 1.3 The appellant submits on pages 8-10 of the grounds of appeal that, by not admitting the auxiliary request 2 into the proceedings under Rule 137(3) EPC, the

examining division did not exercise its discretion in a proper way.

The board points out that, following the principle set out in G 7/93, Reasons 2.6, if an examining division has exercised its discretion under Rule 137(3) EPC against an applicant in a particular case and the applicant files an appeal against the way in which such discretion was exercised, it is not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the first instance department, in order to decide whether or not it would have exercised such discretion in the same way as the first instance department. Rather, a board of appeal should only overrule the way in which a first instance department has exercised its discretion if it comes to the conclusion either that the first instance department in its decision has not exercised its discretion in accordance with the right principles, or that it has exercised its discretion in an unreasonable way, and has thus exceeded the proper limits of its discretion.

In the present case, it is clear that the examining division was of the opinion, rightly or wrongly, that the auxiliary request *prima facie* did not overcome the objections regarding lack of novelty and inventive step but introduced new deficiencies, *viz.* under Articles 123(2) and 84 EPC. Reasons were also given for this opinion in section 7 of the appealed decision and at least for the *prima facie* assessment of clarity the board considers these reasons to be sufficient. It is irrelevant whether the board of appeal considers said reasons to be correct, only whether the examining division was justified, given its opinion, to refuse the requested amendment under Rule 137(3) EPC. The

board holds this to be indeed the case: if an examining division comes to the conclusion that a request is not *prima facie* allowable but introduces new deficiencies, it is justified for the division to refuse the request under Rule 137(3) EPC. The division did not commit a procedural error in doing so, independently of whether the board of appeal would come to the conclusion that it would itself have acted differently in the given circumstances.

The appellant further indicated that it had been clear to him that the request had already been admitted into the proceedings before the oral proceedings took place (grounds for the appeal, page 8, last paragraph and page 10, paragraph 3). In this respect, the board points out that decisions on admissibility or allowability of requests can only be taken by the examining division as a whole. In particular, they can not be taken during a telephone conversation between the applicant and the "primary examiner", *i.e.* the member of the division who is entrusted with the examination under Article 18(2) EPC, second sentence. Moreover, the fact that substantive objections were raised in the telephone conversation does not allow any conclusion about whether that request was considered admissible because also a decision *not* to admit a request based on *prima facie* violation of a substantive requirement requires that substantive objection to be raised.

The appellant also argues that it had not been possible to present any substantive arguments with regard to the alleged deficiencies of the request (grounds of appeal, page 9, paragraph 1). However, the minutes of the oral proceedings before the examining division do not report that the appellant indicated its wish to make such

arguments when specifically asked for further comments by the chairman of the division after the chairman had announced the division's conclusion about admissibility (see p. 4, paragraph 5 of the minutes).

2. *Main request*

2.1 The main request does not satisfy the requirements of Article 54 EPC 1973.

2.2 The principles underlying the invention are well known. The fact that they are well known is better illustrated by a general prior art document, such as D5, rather than by a document such as D1, the latter dealing with a problem in a very specific technical context (adaptation of graphics contents) which is different from the context of the present application (building an interactive multimedia software application).

2.3 Regarding claim 1 of the main request, D5 discloses a method for enabling a software build of an interactive multimedia software application (more specifically a build of a game application; see the section entitled "Data-driven design", first paragraph).

The method of D5 comprises creating at least one file according to a standardised file format containing metadata related to said content (*i.e.* the platform-specific parameters, in the given example PS2-specific parameters, which are saved by the artist; see the section entitled "Tools", fifth paragraph; see also Figure 2 and the corresponding text in D5, where the file is an XML file, which is a standardised file format).

The content in D5 is provided in the form of various binary content files (called "assets" in D5 as is common in the field of computer game development; see the section entitled "Asset pipeline"). From the last sentence in the "Tip" box of the section entitled "Engine design", it is clear that at least some of the "assets" of D5 are files: "Links to new *files* [emphasis added] can be sent and automatically updated".

The metadata in D5 is that which is necessary to perform a software build of said content for a plurality of different interactive multimedia software applications that use the same content (see D5, Figure 2: the platform-specific parameters are used to build a plurality of different interactive multimedia software applications, e.g. for PS2, Xbox or GC hardware, all using the same content).

2.4 D5 therefore discloses in combination the features of claim 1 of the main request, the subject-matter of which is consequently not novel; Article 54 EPC 1973.

3. *Auxiliary request 1*

Compared to the main request, claim 1 of auxiliary request 1 contains the additional feature that the binary content files have various file formats.

D5 does not explicitly state anything about the format of the files making up the "assets" mentioned in that document. The board however considers it obvious that the skilled person will recognise that the files (or "assets") used in game development will normally use different formats according to what they represent, i.e. programming code, audio, video, images etc.

It may be left open whether the use of different formats is implicitly disclosed in D5 and thus whether the feature added to claim 1 of auxiliary request 1 renders the subject-matter of that claim novel, because it does not render it inventive; Article 56 EPC 1973.

4. *Auxiliary request 2*

Under the wording of Article 12(4) RPBA the board has discretion to admit a request even though it was not admitted in the first instance proceedings. This is an exception to the rule expressed in G 7/93 (Reasons 2.6) according to which a discretionary decision should be confirmed unless the first instance has exceeded the limits of its discretion. As argued above (Reasons 1.3), the examining division has not exceeded the limits of its discretion. Since, moreover, the board has no reason to deviate from the rule, it does not admit auxiliary request 2 into the proceedings under Article 12(4) RPBA.

5. *Auxiliary request 3*

- 5.1 Regarding claim 1 of auxiliary request 3, the board considers that the concept of an "XNA Intermediate Format, [referred to as] XIF, file" is not sufficiently precise. The board is not aware of a definition of a "XIF file" which would be more precise than that it is some asset file format used within the "Microsoft XNA Framework". It is noted that the appellant has remained silent with regard to this observation, which had already been made in the board's summons (section 9.1). The claim is therefore unclear; Article 84 EPC 1973.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



B. Atienza Vivancos

W. Sekretaruk

Decision electronically authenticated