

Internal distribution code:

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

**Datasheet for the decision
of 4 March 2015**

Case Number: T 0403/11 - 3.5.03

Application Number: 00903840.7

Publication Number: 1173990

IPC: H04Q7/32

Language of the proceedings: EN

Title of invention:

Method for downloading software

Patent Proprietor:

Roke Manor Research Limited

Opponent:

Vodafone Group Plc

Headword:

Method for downloading software/ROKE

Relevant legal provisions:

EPC Art. 56, 108

RPBA Art. 12(2), 12(4)

Keyword:

Admissibility of appeal - (yes)

Inventive step (main request) - (no)

Admissibility (auxiliary requests) - (no)

Decisions cited:

T 0774/97

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 0403/11 - 3.5.03

**D E C I S I O N
of Technical Board of Appeal 3.5.03
of 4 March 2015**

Appellant: Vodafone Group plc
(Opponent) Vodafone House
The Connection
Newbury, Berkshire RG14 2FN (GB)

Representative: Ferrara, Simone
Vodafone Group Services Limited
Group Legal
Babbage House
The Connection
Newbury, Berkshire RG14 2FN (GB)

Respondent: Roke Manor Research Limited
(Patent Proprietor) Roke Manor,
Old Salisbury Lane
Romsey,
Hampshire SO51 0ZN (GB)

Representative: Ribeiro, James Michael
Withers & Rogers LLP
4 More London Riverside
London
SE1 2AU (GB)

Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 14 December 2010 rejecting the opposition filed against European patent No. 1173990 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman F. van der Voort
Members: T. Snell
R. Cramer

Summary of Facts and Submissions

I. This decision concerns an appeal filed by the opponent against the decision of the opposition division rejecting the opposition filed in respect of European Patent No. EP 1 173 990.

II. Opposition had been filed on the grounds of Article 100(a), (b) and (c) EPC.

The opposition division held that none of these grounds prejudiced the maintenance of the patent.

III. In the statement of grounds of appeal, the appellant (opponent) requested that the decision be set aside and that the patent be revoked in its entirety on the ground, inter alia, that the grounds for opposition pursuant to Article 100(a) and (b) EPC prejudiced the maintenance of the patent.

In the statement of grounds, the appellant referred, inter alia, to the following prior art documents cited in the opposition procedure:

A1: I. Duncumb et al, "MEMO - Multimedia Environment for Mobiles - ACTS - System Function Specification - Security", TF Specification SFS5, 8 December 1998; and

A3: M. Unbehaun, "Multimedia Environment for Mobiles - Terminal technology and Transmission", Proceedings of ACTS Mobile Communication Summit '96, Granada, Spain, Nov 1996, Vol. II, pages 842-849.

IV. In a response to the statement of grounds, the respondent (proprietor) requested that the appeal be declared inadmissible, or, in the alternative, that the

part of the appeal dealing with Article 100(a) EPC be declared inadmissible, due to a lack of a proper substantiation in accordance with Article 108 EPC.

Subsidiarily, the respondent requested that the patent be maintained as granted ("main request"), i.e. that the appeal be dismissed.

Alternatively, the respondent requested that the patent be maintained in accordance with one of five auxiliary requests.

Both parties conditionally requested oral proceedings.

- V. In a communication accompanying a summons to oral proceedings, the board gave a provisional opinion that the appeal was admissible, since at least the ground for opposition pursuant to Article 100(b) EPC was reasoned.

In respect of Article 100(a) EPC, the board stated that it currently agreed with the respondent that there was a lack of a proper substantiation [in the statement of grounds of appeal]. In this respect, although the appellant gave reasons as to why the decision of the opposition division was not agreed with, these reasons alone did not enable the board to determine whether the ground of opposition under Article 100(a) EPC prejudiced the maintenance of the patent such that the patent should be revoked, since the statement of grounds did not substantiate properly any objection based on either lack of novelty or lack of inventive step. Nevertheless, the board noted that "whether or not the board deals substantively with this ground will have to be decided at the oral proceedings in

consideration of the state of the proceedings and the parties' submissions at that time".

The board additionally made preliminary comments on the issues of novelty and inventive step. The board stated inter alia that the disclosures of documents A1 and A3 were "very relevant to novelty and/or inventive step in respect of claim 1 of the main request".

With respect to the first to fifth auxiliary requests, the board noted that the respondent had "given no explanations as to why the subject-matter of claim 1 of each request is considered new and to involve an inventive step".

- VI. In a letter sent in response to the summons, the respondent stated only that it planned not to attend the oral proceedings.

In a telephone call with the board's registrar on the day before the oral proceedings, the appellant informed the board that it would not attend the oral proceedings due to illness.

Neither party responded substantively to the board's communication or made any further requests.

- VII. Oral proceedings were held on 4 March 2015 in the absence of both parties.

From the written submissions, the board inferred the parties' requests to be as follows:

The appellant requested that the decision under appeal be set aside and that the European patent be revoked in its entirety.

The respondent requested that the appeal be declared inadmissible, or, in the alternative, that the part of the appeal requesting revocation of the patent under Article 100(a) EPC be declared inadmissible.

In the event the appeal were held to be admissible, the respondent requested the rejection of the appeal (maintenance of the patent as granted) as a main request, or, in the alternative, that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the claims of one of the first to fifth auxiliary requests, all as filed with the reply to the statement of grounds of appeal.

After due deliberation, the chairman announced the board's decision at the end of the oral proceedings.

VIII. Claim 1 of the main request, i.e. claim 1 of the patent as granted, reads as follows:

"Method for downloading application, service or information software to a mobile telecommunications device said method including the steps of:

- broadcasting application, service or information software via a broadcaster (14) different from a network operator (12) responsible for said broadcasting,
- receiving and downloading said software to said mobile telecommunications device,
- contacting said network operator (12) responsible for said broadcasting, and
- causing said network operator (12) to enable said software such that said software is available for use by a user of said mobile telecommunications device."

IX. In view of the board's decision, it is not necessary to reproduce the text of the auxiliary requests.

Reasons for the Decision

1. Admissibility of the appeal

1.1 The respondent did not dispute that at least the ground for opposition under Article 100(b) EPC was substantiated in the statement of grounds of appeal. In accordance with case law, the substantiation of one ground suffices to render the appeal as a whole admissible, since there is no support in the EPC for the notion of a "partial admissibility" of an appeal in the sense of Article 108 EPC (cf. T 774/97, point 1.1 of the reasons).

Consequently, the respondent's request that the appeal be deemed inadmissible is rejected.

1.2 Subsidiarily, the respondent requested that the part of the appeal concerned with Article 100(a) EPC be deemed inadmissible. In view of the above considerations, it follows that this request must also be rejected.

1.3 Notwithstanding the above, Article 12(2) RPBA states that "The statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on."

Article 12(4) RPBA states that "... everything presented by the parties under (1) shall be taken into

account by the Board if and to the extent it relates to the case under appeal and meets the requirements in (2)."

1.4 It follows that whether, and to what extent, the board shall take the ground for opposition pursuant to Article 100(a) EPC into account is determined by the appellant's case set out in the statement of grounds on this issue.

1.5 In this respect, the appellant gives two reasons why in its view the decision of the opposition division is flawed, namely firstly that the opposition division wrongly assumed that the steps of the method claimed in claim 1 had to be carried out in the order in which they are recited in the claim, rendering the reasoning with respect to prior art documents A1 and A3 invalid, and secondly that the opposition division wrongly interpreted references to the broadcaster and network entities as implicit references to the networks operated by those legal entities.

The board notes that the reasons given by the opposition division with respect to documents A1 and A3 essentially only rely on the order in which the method steps are carried out.

In view of the above, the board determines that it is empowered to consider the issues of novelty and inventive step at least in relation to the disclosures of the documents A1 and A3.

2. *Article 113(1) EPC*

2.1 Main request: The present decision is based on lack of inventive step having regard to the disclosures of the

documents A1 and A3. This issue was mentioned in the communication accompanying the oral proceedings. In particular, the board noted that A3 described a "MEMO" system similar to that described in the patent, and that A1 described security aspects of the MEMO system. Further, the board noted that documents A1 and A3 were highly relevant to the issues of novelty and/or inventive step (cf. point V above). Although the board had given a preliminary, non-binding view that the appellant had not properly reasoned its objections with regard to the issues of novelty and inventive step (which the board now resiles from for the reasons given above), it was indicated that a decision on whether to examine this ground for opposition would be taken at the oral proceedings. It follows that the respondent was aware that the issues of novelty and inventive step with respect to the disclosures of documents A1 and A3 may be discussed. The respondent neither replied substantively to the summons, nor attended the oral proceedings, and thus chose to rely solely on the arguments set out in writing in the letter of reply to the statement of grounds of appeal.

2.2 Auxiliary requests: The present decision is based on non-admissibility of the requests due to a lack of any substantiation. In this respect, the board remarked in the communication accompanying the summons to oral proceedings that the respondent had provided no reasons as to why the subject-matter of claim 1 of each of the auxiliary requests was new and involved an inventive step, thereby presenting the respondent with an opportunity to either provide the necessary reasoning, or disagree with the board's remark. The respondent however chose to remain silent.

2.3 Consequently, the respondent's right to be heard under Article 113(1) EPC has been fully respected with regard to all requests.

3. *Claim 1 - main request - inventive step*

3.1 The present patent relates to a method of downloading and enabling software. In essence, as described in the patent, software provided by a network operator is downloaded to a mobile communications device via a broadcasting platform, which may be a DAB platform (cf. paragraph [0019] of the description. The mobile subscriber contacts the network operator, e.g. via a GSM link, and the network operator then enables the software (cf. paragraph [0020]).

3.2 Claim 1 includes the feature "broadcasting application, service or information software via a broadcaster (14) different from a network operator (12) responsible for said broadcasting".

The board considers the claim to be unclear in respect of the expression "a network operator responsible for said broadcasting", since this does not have a clear meaning in the art in the current context. As clarity is not a ground for opposition, the board will interpret this term in the light of the description. From the description, it is apparent that the network operator is responsible insofar as it provides the software to the broadcaster under a commercial agreement (cf. paragraph [0018]). The board therefore interprets "a network operator responsible for said broadcasting" to mean "a network operator who provides software for said broadcasting".

- 3.3 The board considers that document A3 represents the closest prior art.

Document A3 concerns a system referred to as "MEMO". The basic MEMO system is illustrated in A3, Fig. 2. The MEMO system uses DAB technology for the down-link and GSM for the up-link (cf. page 843, section 2, fourth paragraph, last sentence). It follows that the MEMO system is the same type of system as envisaged in the patent in suit. A3 further describes an "interactive press application" embodiment in which newspaper issues (i.e. "information software") are made available on a server (cf. page 847, first paragraph). A list of available issues is broadcast in a DAB subchannel. Issues can be requested via a user using the GSM connection. In the board's view, this embodiment comes closest to the subject-matter of claim 1.

- 3.4 Using the wording of claim 1, document A3 discloses a method for downloading application, service or information software to a mobile telecommunications device (cf. page 847, "Interactive press application" - information software (daily newspapers) are transferred to the mobile client via the DAB network), said method including the steps of:
- broadcasting application, service or information software via a broadcaster ("DAB network") different from a network operator ("server") responsible for said broadcasting (the operator of the server provides the software to the DAB broadcaster),
 - receiving and downloading said software to said mobile telecommunications device (cf. page 847, left-hand col., lines 13-16), and
 - contacting said network operator responsible for said broadcasting (cf. page 847, left-hand col., lines 11-12).

3.5 The subject-matter of claim 1 differs from the method disclosed in document A3 in the following feature:

"causing said network operator to enable said software such that said software is available for use by a user of said mobile telecommunications device."

3.6 The problem to be solved starting out from document A3 can be seen as how to enhance the known method to enable an operator to charge for a newspaper on a pay-per-view basis. The formulation of this problem does not contribute to inventive step, since newspaper editions in the real world are usually provided on a payment-per-edition basis.

3.7 In seeking a solution to this problem, the skilled person would consult document A1, which is concerned with security aspects of MEMO systems, designed in particular to "enforce payment for services with valued content" (cf. page 3, line 12). In order to provide "Conditional Access" (cf. section 4.4), i.e. to restrict access to a service transmitted via DAB, the service provider transmits "Entitlement Management messages" (EMM) which enable individual receivers or groups of receivers to access the service (cf. page 20, last paragraph). "Entitlement Management Messages" contain entitlements or secret keys. They can be sent in the DAB multiplex signal or delivered by other media, e.g. smart cards. If the skilled person were to apply this teaching to the interactive press application of A3, a method would result in which the EMMs would either be sent together with the encrypted newspaper on the DAB link, or separately in the form of a smart card. In either case, enabling of the software

(delivery of the EMM) occurs in response to contacting the software provider when ordering an issue of the newspaper.

Consequently, the skilled person would arrive at the subject-matter of claim 1 without inventive skill.

3.8 The respondent essentially submitted the following arguments:

(i) Broadcasting the software via a broadcaster different from the network operator enables a large amount of data to be transmitted simultaneously to multiple devices without placing load on the network operator, and optionally at no cost to the users of the devices.

(ii) Contacting the network operator and causing the network operator to enable the software *after* the broadcast enables a user to select a particular service for use on his mobile device, and provides a mechanism for the network operator to bill the user or control which users are able to use the service.

(iii) The combination of (i) and (ii) was not obvious at the priority date because it brings together two communication modes which do not normally operate together: broadcast mode on the one hand by a broadcaster different from the network operator; and contacting a network operator on the other hand (typically via a point-to-point mode) in order to enable the software that has been downloaded.

3.9 Re (i): A3 discloses a different broadcaster (DAB operator) to the network operator providing the software. The quantity of data which can be transmitted

as well as the load on the network operator is not relevant to the claimed subject-matter, but, in any case, the MEMO system of A3 also allows a large amount of data to be transmitted simultaneously to multiple devices optionally at no cost.

Re (ii): Claim 1 is not limited to a specific order of method steps. Method steps merely define functions which can be performed at any time, unless in the context of the claimed subject-matter, this were technically implausible. In the present case, the board can see no reason why all the steps as formulated in claim 1 have to be performed in the order recited in the claim. In this respect, the step of contacting the network operator in claim 1, which could potentially provide a mechanism for the network operator to bill the user (although claim 1 is not limited in this respect) could occur before or after downloading the software.

Furthermore, even if for the sake of argument it were assumed that the steps were performed in the order recited in claim 1, in the board's view there would still be no inventive step. The board notes that in A1, the EMMs may be transmitted via a smart card. In the board's view, one obvious situation where it would be necessary to contact the network operator (server) *after* receiving the software download is if a replacement smart card containing the EMM were required e.g. because the original smart card were lost or defective.

Re (iii): The board notes that A3 also brings together the communications mode of broadcasting and contacting the network operator via a point-to-point link (GSM). When combined with A1, enabling of the software by

contacting the provider via the point-to-point link thus becomes obvious.

Consequently, the board finds the respondent's arguments unconvincing.

3.10 For the above reasons, the subject-matter of claim 1 of the main request does not involve an inventive step (Articles 52(1) and 56 EPC). The main request is therefore not allowable.

4. *First to fifth auxiliary requests - admissibility*

4.1 The five auxiliary requests were submitted with the response to the statement of grounds of appeal. However, the response did not include any arguments explaining how the requests overcame the grounds for opposition, in particular with respect to novelty and inventive step. This was noted by the board in its communication accompanying the summons to oral proceedings.

4.2 As was noted in point 1.3 above, the board is required to take everything into account presented by the parties only to the extent that there is a statement setting out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, specifying expressly all the facts arguments and evidence relied on (cf. Article 12(2) and (4) RPBA). As there is no such statement in respect of the auxiliary requests, despite this being brought to the respondent's attention, the respondent is in effect relying on the board to make its own investigations. This would however be contrary to the board's duty to remain impartial in inter partes proceedings.

4.3 Consequently, the first to fifth auxiliary requests are held to be inadmissible (Articles 12(2) and 12(4) RPBA).

5. *Conclusion*

As the main request is not allowable and none of the auxiliary requests are admissible, it follows that the patent must be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



G. Rauh

F. van der Voort

Decision electronically authenticated