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Datasheet for the decision of 5 February 2018

Case Number: T 0987/12 - 3.5.07

Application Number: 08250054.7

Publication Number: 1942424

IPC: G06F17/30

Language of the proceedings: EN

Title of invention:
Background data transmission between media device and host device

Applicant:
Apple Inc.

Headword:
Data transfer between media and host devices/APPLE

Relevant legal provisions:
EPC Art. 56
EPC R. 103(1)(a)

Keyword:
Inventive step - after amendment - (yes)
Reimbursement of appeal fee - (no)

Decisions cited:

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 0987/12 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 5 February 2018

Appellant: (Applicant)	Apple Inc. 1 Infinite Loop Cupertino, CA 95014 (US)
Representative:	Barton, Russell Glen Withers & Rogers LLP 4 More London Riverside London SE1 2AU (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 2 December 2011 refusing European patent application No. 08250054.7 pursuant to Article 97(2) EPC**

Composition of the Board:

Chairman	R. Moufang
Members:	P. San-Bento Furtado
	M. Jaedicke

Summary of Facts and Submissions

I. The appeal lies from the decision of the Examining Division to refuse European patent application No. 08250054.7 for lack of inventive step (Articles 52(1) and 56 EPC) of the subject-matter of independent claims 1 and 11 of the then main request and the then first and second auxiliary requests over the following prior-art document D5 in combination with common general knowledge:
D5: US 2006/0047775 A1, published on 2 March 2006.

The decision also cites the following documents to illustrate common general knowledge:
D2: US 2004/0216108 A1, published on 28 October 2004;
D4: US 7 024 485 B2, published on 4 April 2006;
D6: WO 2005/078623 A1, published on 25 August 2005.

In *obiter dicta* the Examining Division expressed its opinion that the subject-matter of dependent claims 2 to 10 and 12 to 17 of each of the three requests was not inventive either.

II. In the statement of grounds of appeal, the appellant requested that the decision be set aside and that a patent be granted on the basis of a main request or of one of two auxiliary requests, all three requests having been filed with the grounds of appeal.

The appellant also requested reimbursement of the appeal fee because the contested decision relied on "documents D2, D4 and D6 as exemplifying the common general knowledge even though those documents are patent documents rather than extracts from an encyclopedia, a basic text, or the like".

III. In a communication accompanying the summons to oral proceedings, the Board expressed its preliminary opinion that the subject-matter of claim 1 of the main request and of the first auxiliary request was not inventive over the disclosure of document D5. Claim 1 of the second auxiliary request was unclear and seemed to add subject-matter to the application as originally filed. As far as the claim could be understood, the subject-matter of claim 1 of the second auxiliary request also appeared to lack inventive step.

The Board explained that since none of the substantive requests on file seemed to be allowable and the deficiencies in the contested decision did not seem to amount to a substantial procedural violation, it was of the non-binding opinion that the request for reimbursement of the appeal fee had to be refused.

IV. With a letter of reply the appellant filed an amended second auxiliary request and a new third auxiliary request. In a subsequent letter the appellant informed the Board that it would not be represented at the oral proceedings.

V. Oral proceedings were held on 26 October 2017 in the absence of the appellant. At the end of the oral proceedings, the chairman announced that the decision would be given in writing.

VI. The appellant's final requests were that the contested decision be set aside and that a patent be granted on the basis of

- the main request or first auxiliary request, both submitted with the grounds of appeal, or
- the second or third auxiliary request submitted under cover of letter dated 26 September 2017.

Additionally, the appellant requested reimbursement of the appeal fee.

VII. Claim 1 of the main request reads as follows

"A method for transferring media assets between a host computer (1302) and a client device (1304), the client device capable of connecting with a computer network (1320) as well as with the host computer, the client device including a media database (1318) and a data storage device (1316), said method comprising:

determining (1114) a set of media assets on the host computer that are to be copied to the client device;

monitoring (1120) whether the client device is busy with tasks other than media assets transfer with the host computer;

initiating (1126-1132) copying of the media assets in the set of media assets from the host computer to the data storage device of the client device; and

pausing (1122) said copying while said monitoring indicates that the client device is busy with other tasks;

the method being characterised by further comprising:

creating (1118) entries in the media database for the media assets in the set of media assets prior to initiating copying of the media assets of said set to the data storage device of the client device such that once an entry for a media asset is placed in the media database, the client device is able to select that media asset for playback, said initiating being subsequent to said creating, wherein, if said copying of that media asset to the data storage device of the client device has not been completed at the time of selection of that media asset, then a streaming connection for that media asset is opened; and

updating (1134) the entries in the media database as the media assets are stored to the data storage device of the client device after copying one or more of the media assets of said set to the client device from the host computer."

In view of the outcome of the appeal proceedings, the claims of the other requests are not relevant for the present decision.

VIII. The appellant's arguments relevant to this decision are discussed in detail below.

Reasons for the Decision

1. The appeal complies with the provisions referred to in Rule 101 EPC and is therefore admissible.

The invention

2. The application relates to synchronisation, backup or management of media data on media devices, where the media data pertains to media assets transferred between a host computer and media (client) devices in a computer network. The transfer of media assets can take into consideration potentially more important or time-sensitive tasks that the media device is performing (see paragraphs [0001] and [0004] to [0006] of the published application).

The media assets (e.g. music, audiobooks, podcasts, images, photos, or video files such as movies, music videos or TV shows) may be stored in the client media device (paragraphs [0058] and [0067]). Media devices may include portable or mobile devices, e.g. "media playback devices (including portable media players,

portable digital assistants, mobile telephones), set-top boxes, etc" (paragraph [0048]).

3. The claims of the main request are directed to "a method for transferring media assets" corresponding to the processes described with reference to Figures 13A and 13B for
- copying media assets from the host computer to the client device (paragraphs [0148] to [0152]), and
- playing media assets at the client device (paragraphs [0152] to [0156]).

3.1 The client device stores a media database with entries for the media assets. That database includes metadata for media assets to be copied, e.g. the remote location of a media asset, so that a user can select such a media asset for playback. Copying a set of media assets from the host computer to the client device can be done at a lower priority than other operations such as playback. In such a case, copying is temporarily suspended when the client device is busy with other tasks (paragraph [0152]).

3.2 When a user selects a media asset to be played back, the media-asset playback process at the client device first determines whether the media-asset file is available locally (paragraph [0155]). If that media-asset file is available locally, it is retrieved from the local file and played (paragraph [0152] to [0155]). Otherwise, the network address stored in the media database is used to open a streaming connection to stream the media data pertaining to the media asset (paragraphs [0152] and [0156]).

Prior art - document D5

4. Document D5 discloses a video-on-demand (VOD) client system that includes a content acquisition system for automatically downloading internet content and a content storage system for storing the downloaded content. The content is downloaded at a time and from a source chosen according to content-viewer-defined selections and content-provider-defined resource-availability criteria (paragraphs [0011] and [0025], Figure 2).

Document D5 also discloses a method for managing download of content to the client device, so that the download process is optimised for bandwidth usage (abstract, paragraph [0003]). The method uses a "Work List" of pending and scheduled downloads in the form of a table, each entry including an indication of the resource locator from which the content is to be downloaded, a download priority, and information about where the content is to be stored locally and about the state of completion of the download (paragraph [0043], Figure 3). New download requests are added to the Work List by the requesting entity, e.g. another software module (paragraph [0044]). Upon completion of a successful download, the corresponding content item is removed from the Work List (paragraph [0060]).

Downloads to the client device are scheduled according to the download priorities stored in the Work List. The priority scheme is used to ensure efficient management of content downloads and to avoid resource contention. The priority for a download item can be assigned, e.g. by the content viewer or the network operator, and can be based on several factors, including e.g. cost of bandwidth, availability of high-speed connection,

network quality assessment from errors and bandwidth encountered in a previous download from this location. A pre-emptive priority may also be assigned to a download, in which case the item is downloaded as soon as any current pending requests for content download have been "fulfilled" (paragraphs [0045] to [0047]).

Inventive step

5. In the contested decision, document D5 was considered to be the closest prior art.

Compared to the claims considered in the contested decision, which already defined opening a streaming connection if copying of the media asset has not been completed, claim 1 of the main request further specifies that the streaming connection is opened if copying of the media asset has not been completed at the time of selection of the media asset.

5.1 In the grounds of appeal, the appellant disputed that document D5 was a suitable starting point for the inventive-step assessment because it related to a different problem to that of the claimed invention. The disclosure of document D5 related to downloading media content at a convenient time, whereas the claimed invention was directed to transferring media assets to a client device and, while those media assets were being transferred, allowing the user to playback the media assets.

5.2 In its communication, the Board took document D5 as the starting point for assessing inventive step.

In its reply to the Board's communication, the appellant additionally argued that, starting from

document D5, it was not obvious to allow playback to be selected of a media asset which had not yet been downloaded. Document D5 did not disclose streaming. It was generally concerned with making "smart decisions about ... when to get it" (e.g paragraph [0015]) in contrast to the "real time" VOD systems mentioned in paragraph [0009] and the problems they were said to cause. Even the "Get it Now" feature of paragraph [0061] merely changed the prioritisation and waited for the outstanding download requests to be completed before commencing download in accordance with adaptable bandwidth usage mechanisms. It was not an attempt to be "real time". Furthermore, there was no suggestion in document D5 that the Work List was in any way related to selection for playback. The Work List was instead a download queue, which was constantly updated, with entries being deleted regularly.

5.3 The Board essentially agrees with the appellant's arguments. With regard to the background of the invention, document D5 explains that in a VOD system a content viewer is able to start a VOD session by "electronically browsing through a catalog of available content, selecting a program for viewing and receiving the selected content for viewing almost instantly over the network to the client device" (paragraph [0007]). In paragraph [0061] document D5 discloses that the pre-emption of a lower priority download "midway through its piece-by-piece download if a higher priority download enters the Work List during that time" allows the inclusion of a "Get it Now" feature for the user "wherein download of content begins as soon as any outstanding download request from a client device to the network is completed". These passages suggest that content is obtained as soon as possible, but they do

not disclose streaming the content or selecting remotely stored content for streaming.

In the Board's opinion, the VOD system of document D5 is based on the concept of fully downloading the content before playback. Download of content is scheduled so as to avoid resource contention caused by content downloads and to optimise bandwidth usage. Streaming is contrary to those purposes as a streaming-based system "lends itself to expensive network and server equipment" which is "underutilized most of the time" (paragraph [0009] of document D5).

If a skilled person were to consider further speeding-up the availability of some content for playback in the framework of document D5, he would try to refine the downloading approach by increasing the priority of that content.

Furthermore, document D5 does not disclose letting the user select a content item for playback before download is completed, and especially not selecting a content item during download. Even if the skilled person were to consider adding that selection possibility to the system of document D5, he would nevertheless choose to perform the download with high priority and complete the full download before playback.

Nor is it plausible that a skilled person facing the problem of enabling immediate viewing in the system of document D5 of media available on the server would first start a download of that media to the client local database. Instead, the skilled person would consider supporting immediate streaming of a media item upon selection of the item on the host computer.

Even though document D5 is not without relevance, it does not disclose opening a streaming connection for a media item during downloading of that media item, or even letting the user select a media item for viewing during a download process.

For the reasons given above, the Board is not convinced that it would be obvious to modify the system or method of document D5 to support selection for immediate playback of content items during download by opening a connection for streaming such a selected content item during its download.

5.4 The subject-matter of claim 1 of the main request is therefore inventive over the method of document D5, when that document is taken as the starting point.

Further procedure

6. The Board cannot uphold the single ground for refusal given in the decision under appeal, namely lack of inventive step over the method of document D5 as closest prior art. Since that was the only line of reasoning reviewed and discussed in the appeal proceedings, the decision is to be set aside. The Board notes however that further prior art, including common general knowledge regarding real-time VOD systems, has been cited or discussed in the European search report and in the proceedings thus far. The Board therefore considers it appropriate to set aside the decision and remit the case to the Examining Division for further prosecution.

Request for reimbursement of the appeal fee

7. The appellant requested that the appeal fee be reimbursed because the Examining Division relied on documents D2, D4 and D6 as exemplifying the common general knowledge. According to the case law, however, only as an exception could common general knowledge include information contained in patent specifications.

The Board agrees with the appellant that technical information from patent documents does not necessarily correspond to common general knowledge. For the reasons given below, the Board nonetheless finds that the Examining Division was not obliged to rely in the written decision on any documents to support its assertion that the two alternative ways to play media content were common general knowledge.

7.1 In the contested decision, the Examining Division first stated that the skilled person was aware from his common general knowledge of the two alternative ways to play media content from a network, i.e. downloading/ playing and streaming playback, and knew their advantages and disadvantages. It then cited passages of documents D2, D4 and D6 to support that assertion with regard to common general knowledge.

7.2 The decision under appeal does not explain why the cited passages of documents D2, D4 and D6 support its statement regarding common general knowledge. Even though the Board agrees that such an explanation should be given for clarity and completeness, it notes that an Examining Division may invoke common general knowledge without citing documents as support. Evidence needs to be provided only if the assertion as to common general knowledge is challenged.

In the present case, the Examining Division first made its statement regarding common general knowledge in its communication of 13 April 2011. While in its reply the applicant discussed each of documents D2, D4 and D6, in the examination proceedings the applicant did not contest that the two alternative ways to play media content from network were common general knowledge.

Under those circumstances, there was no need for the Examining Division to backup its assertion with further evidence in the written decision.

The Board therefore concludes that even though it may not be sufficient to cite patent documents to prove common general knowledge, in this case there was no causal link between that defect in the decision and the need to file an appeal. Since the appellant had not contested the alleged common general knowledge, that defect in the written decision was not decisive and hence not fundamental.

8. Reimbursement of the appeal fee could be equitable by reason of other severe deficiencies in the contested decision. However, for the reasons given in the Board's preliminary opinion, none of the deficiencies in the contested decision identified by the Board amounts to a substantial procedural violation. Following the Board's communication, the appellant did not contest the Board's opinion with regard to those deficiencies and did not argue that any other procedural violation had occurred.

9. Since no ground for ordering reimbursement of the appeal fee in accordance with Rule 103(1)(a) EPC, in particular no substantial procedural violation, could

be established, the request for reimbursement of the appeal fee is to be refused.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution.

3. The request for reimbursement of the appeal fee is refused.

The Registrar: The Chairman:

I. Aperribay R. Moufang

Decision electronically authenticated