

Internal distribution code:

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

**Datasheet for the decision
of 23 March 2017**

Case Number: T 1525/12 - 3.5.07

Application Number: 04772199.8

Publication Number: 1583098

IPC: G11B27/00, G11B27/10, G11B20/10

Language of the proceedings: EN

Title of invention:
Reproduction device, reproduction method, reproduction
program, and recording medium

Applicant:
Sony Corporation

Headword:
Reproduction device/SONY

Relevant legal provisions:
EPC Art. 54(1), 54(2), 84, 87(1), 87(4), 111(2), 113(2),
123(2)
EPC R. 111(2)

Keyword:

Amendments - allowable (yes)

Novelty (yes)

Priority - validity of priority date - first application

Substantial procedural violation - reimbursement of appeal fee
(no)

Remittal to the department of first instance (yes)

Decisions cited:

G 0002/98, G 0002/10

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 1525/12 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 23 March 2017

Appellant: Sony Corporation
(Applicant) 7-35, Kitashinagawa 6-chome
Shinagawa-ku
Tokyo 141-0001 (JP)

Representative: 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 16 February
2012 refusing European patent application No.
04772199.8 pursuant to Article 97(2) EPC.

Composition of the Board:

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

Summary of Facts and Submissions

I. The applicant (appellant) appealed against the decision of the Examining Division to refuse the European patent application no. 04772199.8, which was originally filed as international application PCT/JP2004/012243 on 19 August 2004 (priority claimed: JP 2003399546 of 28 November 2013) and published in accordance with Article 158(3) EPC 1973 (publication no. EP 1 583 098 A1).

II. In the decision under appeal, the Examining Division came, *inter alia*, to the following conclusions:

- independent claims 1 and 12 of the main request filed in electronic form on 15 November 2011 lacked clarity (Article 84 EPC);
- claim 1 of the auxiliary request (AR) filed in electronic form on 15 November 2011 comprised all the features of claim 1 of the main request and thus also did not comply with Article 84 EPC; the same applied to claim 11;
- an auxiliary request filed at 13:55 (AR') during the oral proceedings before the Examining Division was not admitted because it did not comply with Articles 84 and 123(2) EPC;
- an auxiliary request filed at 15:30 (AR'') during the oral proceedings was not admitted because it did not comply with Article 123(2) EPC.

Under the heading "Further remarks not being part of the decision", the Examining Division considered that the subject-matter of claim 1 according to the main

request was not new with respect to the following document:

D1: WO-A-2004/049710 (published on 10 June 2004).

For the content of D1, which is in Japanese, the Examining Division apparently referred to US 2005/0105888 (published on 19 May 2005).

III. With the statement of grounds of appeal, the appellant filed new claims 1 to 6 of a second auxiliary request and requested that the decision under appeal be set aside and a patent be granted on the following basis:

- (a) main request - as defined as main request in the contested decision;
- (b) first auxiliary request - as defined as auxiliary request (AR) in the contested decision;
- (c) second auxiliary request - as filed with the statement of grounds.

Furthermore, the appellant referred to shortcomings in the first instance proceedings which, in its view, potentially represented a serious procedural violation.

IV. Following the summons to oral proceedings, the Board expressed its preliminary opinion in a communication pursuant to Article 15(1) RPBA dated 18 November 2016.

According to the Board's communication, it appeared that the meaning of the terms objected to by the Examining Division and their functionalities could be understood in the context of claim 1 of the main request. The Board, however, questioned whether the subject-matter of claim 1 found full support in the description (Article 84 EPC).

As to the novelty objection raised in the context of "further remarks" in the decision, the Board noted that the Examining Division appeared to have assumed that the priority claim of the present application was not valid, since the claimed invention had already been disclosed in the earlier application D1. The Board raised the question whether it should assess the validity of the priority, and if so, to which extent and on which basis.

Noting that the issue of inventive step had not been addressed in the contested decision, the Board informed the appellant that it did not intend to examine the appellant's requests under Article 56 EPC, but would remit the case to the department of first instance for further prosecution in case the outstanding objections were overcome.

- V. In response to the Board's communication, the appellant, with letter dated 22 December 2016, filed a revised main request, a revised first auxiliary request and a revised second auxiliary request to replace all requests on file on condition that the new requests were admitted into the proceedings.

Furthermore, the appellant invited the Board to inform the representative if it was minded to allow any of the submitted requests so as to avoid the cost of holding oral proceedings.

- VI. By fax dated 9 January 2017, the Board informed the appellant that the new main request and the new first and second auxiliary requests could be admitted into the proceedings, and that it intended to remit the case

to the department of first instance for further examination on the basis of the main request.

As to the procedural shortcomings referred to in the statement of grounds of appeal, the Board was of the opinion that they did not amount to a substantial procedural violation. Thus, it did not intend to order the reimbursement of the appeal fee.

Should the appellant withdraw its request for oral proceedings under the condition that the Board decided as set out above, the oral proceedings would be cancelled.

- VII. By fax dated 9 January 2017, the appellant withdrew the request for oral proceedings conditional on the Board proceeding as set out in its last communication.
- VIII. With fax dated 10 January 2017, the appellant was informed that the oral proceedings scheduled for 11 January 2017 had been cancelled.
- IX. In summary, the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the main request or, alternatively, of one of the first and second auxiliary requests, all requests having been filed with the letter dated 22 December 2016.
- X. Claim 1 according to the main request reads as follows:

"A reproducing apparatus for reproducing content data hierarchically recorded on a disc-shaped recording medium, comprising:

a player object (30) defined by a java class for controlling a reproduction process for content data

hierarchically recorded on the disc-shaped recording medium and for generating an event (312) corresponding to a predetermined change;

user input means for receiving a user input and informing said player object of the user input, wherein the predetermined change is based on an input to said user input means; and

a java program object (31) formed above said player object, wherein the java program object is a superordinate program with respect to the player object and controls the player object through an application programming interface (32),

wherein the java program object is configured to prepare programs that are executed when the java program object is informed of the occurrence of events,

wherein a program performs a process corresponding to the event that takes place; and

wherein said player object is configured to inform the java program object of the occurrence of said event, and to control the reproduction process for content data hierarchically recorded on the disc-shaped recording medium with said process corresponding to the event."

XI. Claim 12 according to the main request reads as follows:

"A reproducing method of reproducing content data hierarchically recorded on a disc-shaped recording medium, comprising the steps of:

a user input means receiving a user input and informing a player object of the user input;

the player object defined by a java class and controlling a reproduction process for content data hierarchically recorded on the disc-shaped recording medium and generating an event corresponding to a

predetermined change, wherein the predetermined change is based on said user input to the user input means;

said player object informing a java program object formed above said player object of the occurrence of said event, wherein the java program object is a superordinate program with respect to the player object and controls the player object through an application programming interface;

the java program object preparing programs that are executed when the java program object is informed of the occurrence of events;

wherein a program performs a process corresponding to the event; and

said player object informing the java program object of the occurrence of said event, and controlling the reproduction process for content data hierarchically recorded on the disc-shaped recording medium with said process corresponding to the event."

Claim 1 according to the first auxiliary request differs from claim 1 of the main request in that it further comprises the following feature:

"wherein said java program object is configured to register a process corresponding to the event that takes place to said player object, and said player object is configured to execute said process corresponding to the event that takes place".

Claim 1 according to the second auxiliary request differs from claim 1 of the first auxiliary request in that the last four "wherein" clauses of the latter have been replaced by the following:

"wherein said java program object is reproduced from the recording medium;

wherein the java program object is configured to register an event listener to an event, wherein the event listener executes a corresponding method when the java program object is informed of the occurrence of a corresponding event;

wherein said player object is configured to inform the java program object of the occurrence of said event, and to control the reproduction process for content data hierarchically recorded on the disc-shaped recording medium with said corresponding method; and

wherein when said java program object registers the event listener to said player object, said player object causes the corresponding method of the event listener to be executed when the corresponding event takes place."

XII. The appellant's arguments relevant to the outcome of the appeal are summarised in the reasons below.

Reasons for the Decision

1. The appeal is admissible.

The invention

2. The present application relates, *inter alia*, to a reproducing apparatus that allows the user to interactively operate a program recorded on a large capacity type recording medium such as the Blu-ray Disc (see paragraph [0001] of the application as published in accordance with Article 158(3) EPC 1973 = EP 1 583 098 A1).

2.1 As explained in paragraph [0029], the reproduction-only recording medium referred to in the application is

named BD-ROM (Blu-ray Disc Read Only Memory) and is a derivative of the Blu-ray Disc standard. The BD-ROM standard prescribes HD movie mode that provides interactive functions similar to those of the DVD video.

2.2 The application is in particular concerned with the so-called "full profile" of the BD-ROM standard which has a higher degree of freedom and expansibility than the HD mode (see paragraph [0041]). The corresponding player model is provided, according to the present invention, with a Java virtual machine (Java VM) and executes a Java application to accomplish the "full profile" (paragraph [0042]).

2.3 In particular, the player model according to the application has a layer structure. As shown in Figure 4 and explained in paragraphs [0037], [0038] and [0043], an API (Application Programming Interface) is defined between the Blu-ray Disc (BD) presentation engine, which handles play lists and clips, decodes an AV stream and reproduces picture and sound data, and a Java application. Like the navigation engine 201 in the HD movie mode of the BD-ROM (see Figure 4), the Java application exists above the BD presentation engine through a Java Virtual Machine (Java VM).

2.4 As described in paragraph [0045], when the BD presentation engine is operated with the Java application, *"it can be thought that the player that reproduces a play list is a virtual player on the software, commands for playback, stop, stream selection, and so forth are sent to the player, and the player is operated with the commands. The player needs to inform the player of the current status of the player as to which play list the player is reproducing*

and what times various operations such as stream selections and user inputs will change".

Furthermore, *"these functions of the player are considered as abstractive objects on the Java application 203. The abstractive objects of the functions of the player are referred to as the BD basic player"*.

A schematic representation of a BD basic player is shown in Figure 5.

- 2.5 In other words, higher-level control of the BD basic player 30 by the Java program 31 via the API 32 is converted to low-level control by the operating system (OS) and the hardware 33 (see paragraphs [0049] and [0054]).
- 2.6 Finally, as pointed out in paragraph [0050], the BD basic player needs not only to be controlled by a superordinate program, namely a Java program, through the API, but also needs to inform this program about player status changes.

Admission of the new requests

3. Claim 1 according to the main request submitted with the letter dated 22 December 2016 relates to "[a] *reproducing apparatus for reproducing content data hierarchically recorded on a disc-shaped recording medium*". The claimed apparatus comprises the following features itemised by the Board (differences with respect to the main request according to the statement of grounds, which was refused by the contested decision, are shown in italics (additions) or in strikethrough (deletions)):

- (a) a player object *defined by a java class*
 - (i) for controlling a reproduction process for content data hierarchically recorded on the disc-shaped recording medium and
 - (ii) for generating an event corresponding to a predetermined change,
 - (iii) ~~said event representing a change in status of the player object;~~

- (b) user input means
 - (i) for receiving a user input and informing said player object of the user input,
 - (ii) wherein the predetermined change is based on an input to said user input means; and

- (c) a *java program object* formed above said player object, wherein the *java program object*
 - (i) is a superordinate program with respect to the player object and
 - (ii) controls the player object through an application programming interface;

- (d) wherein the *java program object* is configured
 - (i) to prepare programs that are executed ~~by the player object~~ when the *java program object* is informed of the occurrence of events,
 - (ii) wherein a program performs a process corresponding to the event that takes place; and

- (e) wherein said player object is configured
 - (i) to inform the *java program object* of the occurrence of said event, and

(ii) to control the reproduction process for content data hierarchically recorded on the disc-shaped recording medium with said process corresponding to the event.

4. As pointed out by the appellant, claim 1 has been amended to specify that a player object is defined by a java class and that the program object is a java program object.

The Board is satisfied that these amendments find support in paragraphs [0062], [0048] and [0054], as indicated by the appellant.

4.1 As to the two deletions, the appellant has submitted that both the text "*said event representing a change in status of the player object*" and the text "*by the player object*" had been added during prosecution of the application before the Examining Division and that their removal did not add subject-matter. On the contrary, in the appellant's view, the amended claim text more closely corresponded with the text in the description that provided basis for the claim feature d)ii) (paragraph [0053]).

4.1.1 In fact, the two removed passages are part of extensive amendments filed with letter dated 15 November 2011. At that time, the applicant did not provide any specific reason for their addition. The Board agrees with the appellant that their removal does not violate Article 123(2) EPC.

4.1.2 As to the added features, the Board is satisfied that they reflect the actual embodiment of the invention as described in the application and, by specifying that the player object is defined by a java class and that

the program object is a java program object, further separate the claimed invention from the apparatus disclosed in document D1.

- 4.1.3 Corresponding amendments have been made to the method claim 12.
- 4.1.4 In summary, the Board considers that the new main request should be admitted into the proceedings.
- 4.2 As the appellant has requested that all previously filed requests be replaced by the new requests submitted with letter dated 22 December 2016, the Board has also considered the admissibility of the new first and second auxiliary requests.
 - 4.2.1 As pointed out by the appellant, the new first auxiliary request is based on the corresponding request according to the statement of grounds of appeal and incorporates the same amendments made to the main request. For the reasons given above, the Board has no objection against the admission of this request into the appeal proceedings.
 - 4.2.2 The new second auxiliary request is based on the new first auxiliary request and includes the additional feature "*wherein said java program object is reproduced from the recording medium*" which, as pointed out by the appellant, is based, for example, on claim 2 of the original application.

A further substantial difference is the reference to an "*event listener*" which is registered to an event and executes a corresponding method when the java program object is informed of the occurrence of the corresponding event. Features relating to an event

handling program corresponding to an event listener according to the present claim 1 were also recited in claim 1 of the second auxiliary request filed with the statement of grounds. Consequently, the second auxiliary request is essentially based on subject-matter already covered by a previous request and, in fact, can be regarded as a legitimate attempt to overcome objections addressed in the contested decision and to clarify the claimed invention in the light of the Board's comments. Hence, the Board considers that also the second auxiliary request can be admitted into the proceedings.

- 4.3 In summary, the appellant's request to replace the requests filed with the statements of grounds with the new requests filed with letter dated 22 December 2016 is allowed.

Main request

5. The Examining Division considered that claim 1 of the main request then on file made use of several expressions which, taken alone, constituted undefined labels with no limiting effect on the scope of the claim. The Examining Division's objections under Article 84 EPC may be summarised essentially as follows:
- the term "object", as in "player object" and "program object", had a particular meaning in the application which was related to object and script oriented programming languages and should be reflected in the claims;
 - it was not clear what programs were and how they related to the "program object" and the "player object"; it was furthermore not clear what was the

difference between the program ("program object") and the programs which were prepared by said program;

- it was not clear in the claim how the program related to the process and whether the processes should be understood as merely being activities or as being software processes;
- the definition of the "player object" and the "program object" was also unclear as well as their interaction; in particular, the terms "formed above", "superordinate" and the expression "the program object ... controls the player object" did not clearly define the interaction between both "objects".

5.1 The clarity objections raised by the Examining Division relate to features similar to features present in claim 1 of the new main request and thus could also possibly apply to this request.

6. In the statement of grounds of appeal the appellant argued essentially as follows:

- The Examining Division rejected claim 1 of the Main Request because, in its opinion, it did not meet "*the requirements of clarity*". As there was no basis in Article 84 EPC for the multiple criteria referred to in the decision, the Examining Division appeared to have based its decision on some unknown, unspecified and unfounded legal criteria. On this basis alone the decision should be set aside.
- According to the contested decision, claim 1 did not comply with Article 84 EPC, *inter alia*, because some expressions used in claim 1 constituted

undefined labels which had no limiting effect on the claim. However, if a term was held to have no limiting effect on the scope of the claim, this did not represent a lack of clarity under Article 84 EPC. In any case, the skilled person was readily available to give a technical meaning to the relevant expressions used in claim 1.

- The Examining Division expressed the opinion that the term "object" had a special meaning in the application and that this should be reflected in the claims. This aspect of the decision did not represent a "reasoned statement" under Rule 111(2) EPC, since a mere statement of "opinion" in the absence of any supporting evidence could hardly be considered as "reasoned".
- The decision was mistaken to focus on the isolated word "object" since this was not used in this manner in claim 1. Rather, the question was whether the terms "player object" and "program object", which were used in the claim, were clear to the skilled person. As claim 1 provided detailed definitions of these terms, the use of "player object" and "program object" satisfied the requirement of Article 84 EPC.
- According to the Examining Division's decision, it was not clear what the "programs" mentioned in claim 1 were and how they related to the program object and the player object. In fact, they were programs in accordance with well-known and standard terminology and their functionality was also clear from the claim. The apparatus generated events corresponding to user inputs, and a program performed a process corresponding to a particular

event, such as starting playback of the content, pausing playback of the content and so on.

- The "program object" was a program like the other "programs". However, in terms of functionality, the "program object" was a program that prepared the other "programs", which then performed processes corresponding to user input events. Claim 1 clearly defined the difference between the "program object" and the "program", in that the task of the former was to prepare the latter, while the task of the latter was to perform a process corresponding to a user input event.
- As to the term "process", it was clear that a "process" was performed by a "program", whereby the process corresponded to a machine-implemented method or sequence of actions.
- As to the clarity of the interaction between the program object and the player object, the skilled person would understand from the claim wording that the "program object" was above and controlled the "player object". In fact, the claim wording simply described a common type of hierarchical arrangement that would be readily understood by the skilled person.
- As to the expression, "the program object ... controls the player object", the "meaning" of the control was in conformity with the standard definition of "control", while the "extent" or "implications" of the control were not relevant to defining the matter for which protection was sought.

Interpretation of claim 1 of the main request

7. The terms "player object" and/or "program object" occur in the introductory part of the application as published (paragraphs [0016] to [0022]), in connection with the second embodiment of the invention (see section 2-4 "About movie player object 300", paragraph [0224]) and in the originally filed claims. Furthermore, the movie player 300 shown in Figures 30 and 31 is called either "movie player object" or "movie player" in the description of the second embodiment.

7.1 According to paragraph [0046], a Blu-ray Disc (BD) basic player *"reproduces data from a disc-shaped recording medium defined in the first embodiment of the present invention. The BD basic player 30 is an object such as a personal computer on the computer environment. The computer environment is not limited to a general purpose personal computer. For example, the computer environment includes a software environment implemented in a dedicated reproducing apparatus and/or a recording and reproducing apparatus that reproduces data from a disc-shaped recording medium defined in the first embodiment of the present invention" (underlining added).*

7.1.1 Furthermore, it is specified in paragraph [0047] that *"[t]he BD basic player 30 is an abstractive object on the software. Below the BD basic player 30, an OS (Operating System) and hardware 33 exist. As a superordinate program of the BD basic player 30, there is a Java program 31 through an API 32"*.

7.1.2 Thus, the term "player object" in claim 1 refers to software which implements a virtual disc player and

whose functions are controlled by a higher level program, such as a Java program.

- 7.2 According to feature (b) of the claim itemisation (see point 3 above), an input to user input means causes a "predetermined change", namely a change in status of the player. For instance, a user input may relate to different operations of the player such as start, stop, fast forward etc. (see Figure 14C).
- 7.2.1 According to feature (a)(ii), in response to the "predetermined change" the player object generates an "event" and informs a java program object of the occurrence of this event (see feature (e)(i)).
- 7.2.2 According to feature (c), a java program object controls the player object by means of an API and programs which are prepared by the java program object and executed in response to the java program object being informed of the occurrence of an event (feature (d)(i)), so that the player object performs a process corresponding to the event caused by the user input (feature (d)(ii) and (e)(ii)).
- 7.2.3 In summary, a virtual player (the player object) responsible for the reproduction of a disc-shaped medium is controlled by a user interface and by a higher level program (the Java program object). The user input defines the operation to be performed by the virtual player. This event is sent by the virtual player to the higher level program which generates a series of commands for the virtual player.
- 7.3 Paragraphs [0048] to [0050] give a description of the apparatus shown in Figure 5 which is consistent with the above interpretation of claim 1.

- 7.3.1 *"The BD basic player 30 has two statuses A and B. In status A, a play list and graphics can be reproduced. In status B, their reproduction is stopped. Status A includes a plurality of operations such as variable speed reproductions for example high speed reproduction and reverse reproduction and jump reproduction that reproduces data from any time point on the disc. In addition, the BD basic player 30 contains variables that hold statuses [sic] of the player (common parameters 34). The common parameters 34 are composed of registers and so forth on the computer environment. When an application (Java program 31) on the upper layer accesses the common parameters 34 through a method of Java, the application can perform a process corresponding to the status of the BD basic player 30" (paragraph [0048]).*
- 7.3.2 *"The BD basic player 30 is an abstractive object on the software. The BD basic player 30 finally converts control by the Java program 31 through the API 32 to control by the OS and the hardware 33 that exist in the lower level. (paragraph [0049] - underlining added)"*
- 7.3.3 *"The BD basic player 30 needs to be controlled by a superordinate program (Java program 31) through the API 32. In addition, the BD basic player 30 needs to inform the superordinate program that the status of the BD basic player 30 changes. In other words, when the BD basic player 30 performs a plurality of operations that successively reproduces one play list and then another play list, the superordinate program needs to have known the status of the BD basic player 30. According to the first embodiment of the present invention, as a mechanism that informs the upper layer of the status of the player, event models are used" (paragraph [0050]).*

- 7.4 Feature (a)(ii) of claim 1 specifies that an event corresponds to a "*predetermined change*" based on an input to the user input means (see feature (b)(ii)).
- 7.4.1 According to the description (paragraph [0078], column 15, lines 28 to 33) of the published application, events can be categorised as events that take place in a content that is being reproduced, as an event that takes place as an interrupt by the user, and as events that take place corresponding to status changes of the player. These three types of events are further described in paragraphs [0078] to [0082]. In particular, as specified in column 15, lines 55 to 58, status changes of the player may be events that take place in a content that is being reproduced, and an event that takes place as an interrupt by the user. Events corresponding to key inputs are shown in Figure 14C.
- 7.5 In summary, the Board considers that the meaning of the terms objected to by Examining Division and their functionalities can be readily understood in the context of claim 1.
- 7.6 The Board is thus satisfied that claim 1 is clear and supported by the description within the meaning of Article 84 EPC.
- 7.6.1 The same applies to claim 12 which relates to a method comprising steps which essentially correspond to the features recited in claim 1.

Novelty with respect to document D1

8. The Examining Division refused the then main request solely on the basis of Article 84 EPC. However, in the section "Further remarks not being part of the decision", it also came to the conclusion that the subject-matter of claim 1 of that request was not new in view of the disclosure in document D1 (Article 54(1) and (2) EPC). The Examining Division listed all the features recited in this claim and indicated passages and figures of document D1 which would either explicitly or implicitly disclose the claim features.
- 8.1 Document D1 (= WO2004/049710) is the publication of international application PCT/JP2003/014511 which was filed on 14 November 2003 [since document D1 is in Japanese, the Examining Division relied, for its content, on the translation provided in document US 2005/0105888; the Board does the same]. The publication date of document D1 is 10 June 2004, which lies between the priority date (28 November 2003) and the filing date (19 August 2004) of the present application.
- 8.2 The question of the validity of the claimed priority was not addressed in the contested decision which, in its part "Facts and submissions" only briefly referred to the first communication dated 9 February 2011 as *"raising doubts on the validity of the claimed priority of the application"*.
- 8.3 In paragraph 2 of the first communication the Examining Division had pointed out the following: *"The filing date of the "first application" must be claimed as a priority, i.e. the application disclosing for the first time any or all of the subject-matter of the European application. It has been found that the application to*

*which the priority claim is directed is in fact not the first application in this sense, but the subject-matter of claims 1-26 was disclosed in the still earlier application WO 2004/049710 (D1) filed by the same applicant; therefore, the priority claim is invalid insofar as the subject-matter was already disclosed in the still earlier application [...]. To the extent the priority claim of the present application is **invalid**, the effective date of the European application is the date of its filing."*

- 8.4 It can therefore be assumed that the Examining Division regarded document D1 as prior art for the reason that the application from which the present application claims priority was not the first application with respect to the claimed subject-matter, which was already disclosed in the earlier application D1, and that the priority claim was therefore not valid.
9. In its grounds of appeal the appellant, with respect to the then main request, brought forward arguments why the Examining Division's analysis of the disclosure of document D1 and its comparison with the claimed subject-matter was incorrect. According to the appellant there were several differences so that D1 did neither anticipate the claimed subject-matter nor qualify as the "first application" pursuant to Article 87(4) EPC.
- 9.1 In its letter dated 22 December 2016 the appellant furthermore argued that, in view of the additional features introduced into the independent claims of the new main request, referring now to the player object being defined by a java class as well as referring to a java program object, the claims were directed towards a completely different invention not disclosed in D1 nor

in any of D1's priority documents, which appeared to be subsets of the information disclosed in D1. In addition, the appellant emphasised that document D1 could not qualify as first application because not all of the applicants of D1 were applicants of the present application.

10. It is common ground that, pursuant to Article 87(1) and (4) EPC, only the first application filed in a state party to the Paris Convention or a member of the World Trade Organization can form the basis of a priority right for the respective subject-matter (see Case Law of the Boards of Appeal of the EPO, 8th edition 2016, II.D.4.). The same follows for international applications from Article 4(A) and (C) Paris Convention in connection with Article 8(2)(a) PCT. Since the filing date of the application published as document D1 (14 November 2003) predates the filing date of the priority application of the application in suit (28 November 2013), the application published as D1 may itself theoretically qualify as first application for the purposes of Article 87(1) and (4) EPC and Article 4(C) Paris Convention. However, this presupposes *inter alia* that the invention as claimed is directly and unambiguously disclosed in document D1. The yardstick to be applied in this context is the same as for the assessment of novelty (see opinion G 2/98, OJ EPO 2001, 413, reasons 9; decision G 2/10, OJ EPO 2012, 376, reasons 4.6). Thus, if the Board came to the conclusion that no such direct and unambiguous disclosure was to be found in document D1, the content of this document could not be novelty-destroying for the claimed invention and the application as published in this document could not qualify as first application for priority purposes.

11. As correctly pointed out by the appellant, the claims according to the main request now on file refer to a "*java program object*" and to the player object being "*defined by a java class*". These features find support in the document from which the present application claims priority (see paragraph [0060] and paragraphs [0046] and [0052] of the English translation of document JP 2003399546), but are not disclosed in document D1. This document can therefore not be novelty-destroying for the subject-matter of the claims of the main request. Equally and for the same reasons, the application as published in D1 does not constitute, with respect to the now claimed subject-matter, the first application for priority purposes.

12. In view of the above conclusion, there is no need for the Board to assess the pertinence of the further arguments brought forward by the appellant in its grounds of appeal and in its letter dated 22 December 2016. There is also no need to investigate whether any of the three priority documents of D1 contains more information than document D1 itself, since the Examining Division neither relied on these priority documents with respect to the issue of "first application" nor ascertained whether they had been published before the relevant date of the present application.

Alleged procedural violation

13. With the statement of grounds of appeal (paragraphs 2 and 2.2), the appellant raised some procedural objections against the decision of the Examining Division and appeared to allege that the first instance proceedings had been tainted by a substantial procedural violation. Furthermore, in paragraph 3.2 the

appellant stated that the Examining Division had failed to comply with Article 113(2) EPC when deciding on the then auxiliary request and that this potentially represented a serious procedural violation.

13.1 In particular, the appellant has pointed out (see above point 6) that the Examining Division rejected the main request because claim 1 did not meet the requirementss of clarity (Article 84 EPC), thereby basing its decision "*on some unspecified and unfounded legal criteria*", and that it failed to provide any basis for its opinion that the particular meaning given to the term "object" in the application should be reflected in the claims, so that this aspect of the decision did not represent a "reasoned statement" under Rule 111(2) EPC.

13.2 As to the then auxiliary request, the appellant submitted that the Examining Division based its lack of clarity objection simply on the fact that the auxiliary request comprised the same undefined terms as the main request. However, it did not provide any evidence or indication of even considering the additional wording/features recited in claim 1 of the then auxiliary request.

13.3 In summary, the appellant has essentially argued that the first instance decision failed to provide a reasoned statement under Rule 111(2) EPC, and that the Examining Division did not decide upon the then auxiliary request in the text submitted to it by the applicant (Article 113(2) EPC).

14. As to the first objection raised by the appellant, it is evident, in the Board's opinion, that the Examining Division could only have meant "clarity" when referring to the "requirements" of Article 84 EPC and thus did

not base its decision on any unspecified and unfounded legal requirements.

- 14.1 As to the objection that the refusal of the main request was not based on a "reasoned statement", the Board notes that in section 1.1.1 the Examining Division identified some terms which in its opinion were as such not sufficiently clear to define the claimed subject-matter. In particular, the Examining Division held that the technical implications of such terms could only be deduced from a detailed study of the description. In the same section of the decision, the Examining Division identified these terms and briefly explained why, in its opinion, they were not sufficiently clear.
- 14.2 Although the Examining Division's reasoning as to the lack of clarity of the subject-matter of claim 1 of the then main request may indeed appear succinct and schematic, this is not to be regarded as a procedural violation, since it provides sufficient information to understand the Examining Division's opinion and to enable the appellant and the Board to examine whether the decision was justified.

In conclusion, the Board finds that, in the present case, the reasons which led to the refusal of claim 1 of the then main request can be easily understood. Thus, Rule 111(2) EPC is not infringed.

- 14.2.1 As to claim 1 of the then auxiliary request, it is clear from the contested decision that, in the Examining Division's view, the intrinsic lack of clarity of some terms used in claim 1 of the then main request and in claim 1 of the then auxiliary request could not be removed by the additional features recited

in the latter. In other words, the Board finds that the Examining Division did not arrive at its conclusion because it neglected to consider the text of the then auxiliary request as submitted by the applicant, but because it was of the opinion that the additional features did not clarify terms which, in its view, were intrinsically unclear.

- 14.3 Hence, the Board considers that in the first instance proceedings the Examining Division did not commit a substantial procedural violation justifying the reimbursement of the appeal fee.
15. Since the Examining Division did not consider the issue of inventive step, the Board finds it appropriate to make use of its powers under Article 111(1) EPC and to remit the case to the department of first instance for further prosecution on the basis of the main request.
- 15.1 Under these circumstances, there is no need to consider the appellant's auxiliary requests.

Order

For these reasons it is decided that:

1. The decision under the appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution on the basis of the main request.

The Registrar:

The Chairman:



N. Maslin

R. Moufang

Decision electronically authenticated