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Datasheet for the decision
of 14 July 2015

Case Number: T 1929/12 - 3.5.06

Application Number: 04796800.3

Publication Number: 1682980

IPC: G06F9/445, H04L29/08

Language of the proceedings: EN

Title of invention:
SYSTEM, METHOD, AND COMPUTER PROGRAM PRODUCT FOR REMOTELY
DETERMINING THE CONFIGURATION OF A MULTI-MEDIA CONTENT USER

Applicant:
Sony Corporation

Headword:
Remotely determining a computer configuration/SONY

Relevant legal provisions:
EPC 1973 Art. 56, 84
EPC R. 101(2)
RPBA Art. 11

Keyword:
Claims - clarity of distinguishing features (no) -
 effects of distinguishing features over prior art established
 (no)
Inventive step - (no)
Decision under appeal - non-
compliance with Article 123(2) insufficiently reasoned
Remittal to the department of first instance - special reasons
for not remitting the case

Decisions cited:

Catchword:

Beschwerdekammern
Boards of Appeal
Chambres de recours

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Case Number: **T 1929/12 - 3.5.06**

D E C I S I O N
of Technical Board of Appeal 3.5.06
of 14 July 2015

Appellant: (Applicant)	Sony Corporation 1-7-1 Konan Minato-ku Tokyo 108-0075 (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 19 April 2012 refusing European patent application No. 04796800.3 pursuant to Article 97(2) EPC.

Composition of the Board:

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

Summary of Facts and Submissions

I.   The appeal lies against the decision of the examining
        division, with reasons dated 19 April 2012, to refuse
        European patent application No. 04 796 800.3 for non-
        compliance with Article 123(2) EPC. In a section en-
        titled "Additional comments", the examining division
        further noted that the "gist" of the invention appeared
        to be known from document

        D1:   US2003/093507 A1.

II.   A notice of appeal was filed on 8 June 2012, the appeal
        fee being paid on the same day. On 28 August 2012, a
        statement of grounds of appeal was received, in which
        it was requested that the decision under appeal be set
        aside because it was not reasoned within the meaning of
        Rule 111(2) EPC and because the objection under
        Article 123(2) could not be sustained.

III.   In a communication dated 1 March 2013, the board infor-
        med the appellant of its preliminary opinion that, cer-
        tain deficiencies in the decision notwithstanding, the
        case should not be remitted to the first instance for
        further prosecution but that the case should be heard
        in substance, and invited the appellant to provide its
        observations on this question. With a letter dated
        3 April 2013, the appellant agreed to the board's
        proposal to proceed with the appeal proceedings in
        order to hear the matters of substance. The board
        informed the appellant that it was exercising its
        discretion not to remit the case.

IV.   With a summons to oral proceedings, the board then in-
        formed the appellant of its preliminary opinion that it
        was indeed doubtful whether the subject matter of claim

1 was disclosed in the application as originally filed
and, hence, whether it complied with Article 123(2)
EPC. With this proviso, the board expressed its
preliminary view that the claimed invention lacked an
inventive step, Article 56 EPC 1973.

V.   In response to the summons, the appellant filed amended
       claims 1-3 according to a main request and claims 1-2
       according to two auxiliary requests, and requested the
       grant of a patent on this basis.

VI.   Oral proceedings were held on 14 July 2015. During the
       oral proceedings, the appellant filed an amended claim
       1 as the basis for a further, third auxiliary request.

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

       "A method for remotely determining the configuration of
       a user's computer (110) of a multimedia content user,
       said method being performed server-side and comprising:
           sending (320) player detection code (120) to the
       user's computer, wherein said player detection code
       performs player detection at the user's computer and
       stores configuration information in cookies;
           receiving an HTTP request (371) from the user's
       computer including said cookies;
           determining (372) whether the HTTP request contains
       sufficient configuration information, and if so sending
       (374) from the server a minimal HTTP response to the
       user's computer;
           if the HTTP request is determined not to contain
       sufficient configuration information, sending (373) an
       HTTP response to the user's computer containing code to
       send the user's computer to a Detection URL;
           receiving (375) a Detection URL HTTP request from
       the user's computer and analyzing (376) the HTTP header

of the request to determine the (1) OS version; (2) web
browser version; (3) hardware platform; and (4) user
interface language type for the user's computer;

sending a modified information header instruction
(382) and unique client ID (383) to the user's
computer, wherein said instruction requests the user's
computer to send different information than the user's
computer has already sent; and

receiving a modified header from the user's
computer, the modified header including configuration
information (135) regarding the user's computer and
said client ID."

VIII. Claim 1 of the first auxiliary request reads as
       follows:

"A method for remotely determining the configuration of
a user's computer (110) of a multimedia content user,
said method being performed server-side and comprising:
    receiving an HTTP request (371) from a user's
computer including said cookies;
    determining (372) whether the HTTP request contains
Delivery Management cookies, and if so sending (374)
from the server an empty HTTP response to the user's
computer;
    if the HTTP request is determined not to contain
cookies, sending (373) an HTTP response to the user's
computer containing code to send the user's computer to
a Detection URL;
    receiving (375) a Detection URL HTTP request from
the user's computer and analyzing (376) the HTTP header
of the request to determine the (1) OS version; (2) web
browser version; (3) hardware platform; and (4) user
interface language type for the user's computer;
    sending a modified information header instruction
(382) and unique client ID (383) to the user's

computer, wherein said instruction requests the user's
computer to send different information than the user's
computer has already sent; and

receiving a modified header from the user's
computer, the modified header including configuration
information (135) regarding the user's computer and
said client ID."

IX.   Claim 1 of the second auxiliary request differs from
        claim 1 of the first auxiliary request in that the
        "sending" step now reads as follows (emphasis by the
        board):

        "[...] sending a modified information header
        instruction (382) and unique client ID (383) to the
        user's computer, wherein said instruction requests the
        user's computer to send different information <u>than the
        user's computer understood was desired by the server,
        wherein the different information excludes information
        that has already [been] sent</u> [...]".

X.   Claim 1 of the third auxiliary request differs from
        claim 1 of the main request in that the "sending" step
        reads as follows (emphasis by the board):

        "[...] sending a modified information header
        instruction (382) and unique client ID (383) to the
        user's computer, wherein said instruction requests the
        user's computer to send different <u>configuration</u>
        information than the user's computer has already sent,
        <u>which is necessary for the server to service a request
        for media from the user's computer</u>; [...]",

        and that at the end the following phrase has been
        added:

"[...] and the different configuration information
being used by the server in order to determine at least
one of: a file format, bit rate, communication
protocol, physical medium, compression algorithm,
digital rights management information for storing media
to the user's computer."

XI. At the end of the oral proceedings, the chairman
announced the decision of the board.

Reasons for the Decision

The alleged procedural violations, Article 11 RPBA

1. According to Article 11 RPBA, the board shall remit a
case to the department of first instance if fundamental
deficiencies are apparent in the first instance procee-
dings, unless special reasons present themselves for
doing otherwise.

2. The appellant argued that the decision had to be set
aside because it was not reasoned and thus did not com-
ply with Rule 111(2) EPC. In particular, the appellant
argued as follows.

2.1 Section II of the material annexed to the decision was
entitled "Provisional Opinion of the Examining
Division" which, by definition of "provisional", could
not contain the reasons for the decision. Section III,
entitled "Additional Comments", did not relate to Ar-
ticle 123(2) EPC under which the application was re-
fused, and thus could not represent the reasons for the
decision either. Since, therefore, the decision did not
provide reasons for refusing the application, the

decision had to be overturned (see the grounds of
appeal, points 2 to 2.2).

2.2   The "Provisional Opinion of the Examining Division" did
        not refer "to the actual wording (and hence subject-
        matter) of the claims" and thus failed to "identify *any*
        particular claim wording that is considered to
        represent added subject matter" (see the grounds of
        appeal, points 3.2 and 3.3; appellant's emphasis).

2.3   The decision made it "extremely difficult for the
        Applicant to properly respond to the objection"
        because, so the argument, "it is not realistic [...]
        for the Applicant to detail support for *every* one of
        the very large number of combinations of [added] claim
        features" (see the grounds of appeal, points 3.4 and
        3.5; appellant's emphasis).

3.   It was further noted that section I, entitled "Summary
        of Facts and Submissions", made no mention of the oral
        proceedings, and that section II of the decision did
        not explicitly address the applicant's submissions.

4.   The board takes the following position on the circum-
        stances referred to.

4.1   While the material annexed to the decision does not
        mention the oral proceedings, the summons to oral
        proceedings and the applicant's reply to the summons
        are mentioned (see section I, points 9 and 10), and the
        oral proceedings themselves are referred to on the
        front sheet of the decision (Form 2007).

4.2   That the decision contains a section entitled "Provi-
        sional Opinion" rather than one entitled, say,
        "Reasons" appears to suggest that the examining

division based its final decision on text copied from
its summons to oral proceedings ("cut and paste") and
failed to edit the copied text sufficiently. The board
disagrees with the appellant who argued that copying
and pasting from the provisional opinion is in itself
to be criticised in that it prejudged any argument made
at the oral proceedings (letter of 8 June 2015, section
3, point 6). Moreover, the board considers that the
wrong section title, undesirable as it may be, does not
imply that the decision can - let alone must - be
considered to contain no reasons at all. Rather, in the
context of the decision as a whole and the procedural
context in which it was issued it is evident that the
examining division meant the "Provisional Opinion" to
contain the reasons for the decision.

4.3   While the decision does not explicitly address and re-
        fute the appellant's arguments in the decision under
        appeal, it is further evident from the minutes that
        these arguments were heard, understood and exhaustively
        discussed during the oral proceedings. This establishes
        to the board's satisfaction that the examining division
        took its decision in knowledge and appreciation of the
        appellant's arguments.

4.4   The board agrees with the appellant that an objection
        under Article 123(2) EPC requires an indication of
        which particular feature or combination of features of
        the claim in question goes beyond the content of the
        application as originally filed.

4.4.1   The decision under appeal accepts that "all features
        defined in claim 1 seem to have a basis in the applica-
        tion as originally filed" but states that "their
        combination goes [...] beyond the application as
        originally filed" (p. 5, 3rd para.). It then explains

why it was found "hard to determine what is the sequence of method steps defined in Figures 3A-3D" and that hence "clear and unambiguous basis for the amendments of claim 1" was lacking (see p. 5, 4th para. to p. 6, 4th para.). Moreover, it is stated that "[c]laim 1 seems to combine features from [two different] embodiments" disclosed in the application and thus seemed to "creat[e] a completely new embodiment" which was "not directly and unambiguously disclosed in the present application" (p. 6, 5th para.).

4.4.2   The board notes that even if it were indeed difficult or even impossible to establish in complete detail how the methods depicted in figures 3A to 3D interacted with each other, that is insufficient to warrant the finding that the specific claims on file did not comply with Article 123(2) EPC. The failure of a description to disclose a particular combination of features such as a sequence of steps is only relevant for the claims at stake if such a combination of features was actually claimed.

4.4.3   The decision under appeal does not identify specific features of then claim 1 which were considered, individually or in combination, to go beyond the application as originally filed. In this regard, the board therefore agrees with the appellant that the decision is insufficiently reasoned, Rule 111(2) EPC. This constitutes a fundamental deficiency within the meaning of Article 11 RPBA.

5.   However, it is clear from the minutes (points 1.2.1 and 1.2.2) that the applicant argued that the amended claim found basis in the combined features of the methods depicted in figures 3A to 3D and that it identified, in

combining these methods, step 331 in figure 3A with step 371 in figure 3B.

5.1   In the decision under appeal the examining division argues why, in its opinion, the original application did not disclose that, and how, the methods of figure 3A and figures 3B to 3D were to be combined and makes clear that the objection under Article 123(2) EPC rests on the combination of features from figure 3A and figures 3C to 3D, respectively (see p. 6, 5th para.). While no particular features were mentioned the board accepts as evident that then claim 1 constitutes such a combination, for instance the step of "sending a player detection code" relating to figure 3A, the step of "send[ing ...] the user's computer to a Detection URL" to figure 3B and the remaining steps to figure 3D. Again, this corresponds to the minuted indication of original disclosure given by the applicant (see minutes, point 1.2.1).

5.2   Although the board agrees with the appellant that the minutes reporting the discussion of contentious points between the examining division and the applicant cannot replace the decision (see appellant's letter of 8 June 2015, section 3, point 7), the minutes enabled the board to understand the reasons for the decision sufficiently well for it to deal with it.

5.3   The board also disagrees with the appellant's allegation that the deficiencies in the reasons given in the decision were "prejudicial to its ability to contest the decision under appeal in an effective manner during the appeal procedure" (see grounds of appeal, point 3.5). Firstly, the appellant, when drafting its appeal, had at its disposal the minutes which contain a detailed exposition of the arguments

exchanged before the decision was taken during the oral
proceedings. And secondly, the onus of proof that
amendments conform with Article 123(2) EPC is on the
applicant. Therefore it must be required of the
applicant - and cannot be considered unrealistic - to
provide a basis in the application as originally filed
for the amended claims as a whole. The board also
cannot see a combinatorial problem here: starting from
the minuted basis for the amendments (see minutes,
point 1.2.1), all that is required of the appellant
appears to be an indication why and in what way the
methods depicted in figures 3A-3D combine with each
other to provide disclosure for the sequence of method
steps according to then claim 1.

6.   In summary, even though the board agrees with the
        appellant that the decision under appeal suffers from a
        fundamental deficiency within the meaning of Article 11
        RPBA, no purpose would be served by remitting the case
        to the examining division, which would most likely have
        stood by its opinion and eventually issued another,
        better reasoned decision to the same effect. This con-
        sideration, combined with the fact that both the board
        and the appellant were able to deal with the decision
        under appeal in view of the minutes, constituted, in
        the board's view, special reasons for not remitting the
        case under Article 11 RPBA.

The invention

7.   The application relates to the distribution of multi-
        media content to users. As users may have different de-
        vices or device configurations they will need the con-
        tent in different formats. It was known that content
        providers pre-formatted the content according to
        several common user configurations and that users were

required to make their selection manually. Accordingly,
it could happen that the format desired by a user had
not been made available by the provider or that the
user did not know enough technical details to make the
required choice. The invention is thus meant to
minimise the necessary user input and to relieve the
content provider from having to anticipate all possible
(or all supported) configurations (see p. 2, last para.
to p. 3, 2nd para.).

7.1   As a solution, support is proposed to determine the
        user's computer configuration automatically (see *e.g.*
        p. 3, last para.).

7.2   In response to a user's request to have a piece of con-
        tent delivered, the proposed solution works broadly as
        follows: A "delivery management server" (p. 9, last
        para.) sends the user a number of scripts which (try
        to) determine the relevant user configuration automati-
        cally and return this information so that the content
        can be formatted accordingly. If the information is in-
        sufficient (*i.e.* incomplete or possibly outdated; see
        p. 10, 2nd para.), a "preferences page" may open in
        which the user has to enter the missing information
        manually. This is referred to as "indirect querying"
        (see *e.g.* p. 24, last para.; fig. 1, steps 332 to 334).
        It is disclosed that, in an embodiment, "the
        preferences page includes a mechanism through which the
        connection speed of the user's computer can be deter-
        mined" (p. 10, 3rd. para.; p. 16, last para. to p. 17,
        1st para).

7.3   It is further disclosed that "direct reporting" (or
        "direct query[ing]") "of client capabilities is gene-
        rally easier and more efficient than indirect query-
        ing" (see p. 23, 2nd para. to p. 25, 1st para.). In

this context it is disclosed that the server sends a
request to the client asking "for different information
than the client either already has sent or is prepared
to send based on a standard or previous request" (see
p. 23, 3rd para.). In response, the client will return
"information that was not included in information pre-
viously received or that the client understood was
desired by the server" (p. 23, lines 2 to 4 from the
bottom). It is stated that this "permits the server to
get all of the information desired" (p. 23, last line)
and "can reduce the amount of data being sent,
particularly when some of the data is not desired for
processing at the server" (p. 24, lines 1 to 4).

7.4   Figure 3A discloses the overall procedure and, in par-
        ticular, the "indirect querying" method for obtaining
        missing information (steps 332 to 334). The "direct
        querying" method is depicted in figure 3D which
        branches off the flow chart according to figure 3C.

Article 123(2) EPC

8.   Claim 1 as subject to the contested decision and claim
        1 of the present main request combine steps which are
        disclosed, respectively, in figures 3A to 3D.
        Specifically, figure 3A discloses the steps of "sending
        player detection code" (no. 320), "receiving an HTTP
        request" (implicitly between steps 330 and 331), and
        "determining" sufficiency (step 331), figure 3B
        discloses the step of conditionally "sending [of] the
        user's computer to a Detection URL" (step 313), figure
        3C discloses the step of "receiving a Detection HTTP
        request" (steps 375 and 376) and figure 3D discloses
        the steps of "sending" and "receiving" modified header
        information (steps 382 to 386). The steps of claim 1 of
        the 1st and 2nd auxiliary requests are disclosed in

figures 3B-3D. The features depicted in figure 3A were deleted (step 320) or modified, so that in their amended version they are originally disclosed in figure 3B (steps 371 and 372 rather than steps 330 and 331).

9.   The decision under appeal argued that it was not clear from the application how the methods according to the flow charts in figures 3A to 3D interacted with each other and concluded that the claimed feature combination constituted a new method which was not directly and unambiguously disclosed in the application as originally filed (see decision, p. 6, last para.).

9.1   In the summons to oral proceedings the board said it tended to agree with the examining division that the precise interaction between the flow charts - especially between that of figure 3A with those of figures 3B to 3D - was not clearly disclosed.

9.2   The board has no such doubts regarding claim 1 according to the 1st or 2nd auxiliary request.

9.3   In view of this and the fact that claim 1 according to all requests shares another deficiency (see below), the board decided to leave open the question whether claim 1 of the main request complies with Article 123(2) EPC.

The prior art

10.   D1, by the same applicant and inventor, discloses the general idea underlying the present application, namely the semi-automatic determination of the user's computer configuration via detection scripts or the "preferences page". In other words, it discloses what the present application refers to as the "indirect querying" method (see paras. 13 to 15 and 54 to 58; figs. 1 and 3). D1

also discloses that eventually the requested content is
formatted in view of the configuration information
obtained (see para. 13).

11.   Over D1, the present application is meant to contribute
        the idea of "direct querying", *i.e.* requesting missing
        information from the client computer directly rather
        than having the user input it manually.
Article 84 EPC 1973

12.   Claim 1 of all requests specifies that the server sends
        an "instruction" requesting the user's computer to send
        "different information" and that the user's computer
        returns "modified" configuration information.

12.1   The board considers this language to be unclear for the
        following reasons:

        a)   The claims do not specify what the client does in
                response to the received instruction and in order
                to produce the modified information, and, in par-
                ticular, does not imply that the client operation
                is fully automatic.

        b)   The claims do not specify in what way the
                requested information is "different" from the
                information which the "user has already sent".

        Both issues are relevant in order to assess the effect
        and the inventive merit of the present invention in
        view of and over the "indirect querying" method known
        from D1 (see fig. 3).

12.2   The appellant argues as follows:

a)   The claimed method has to be construed as a fully
     automatic procedure because it refers to an "in-
     struction" sent to the "user's computer" and
     therefore "does not require input from the user"
     (see letter of 8 June 2015, point 14.4., last
     para.), because it is referred to as the "direct
     querying" method according to which the client
     software "directly reports th[e] information", and
     because it is disclosed as being "easier and more
     efficient than indirect querying" based on the
     provision of a preferences page to the user (p.
     24, last para. to p. 25, 1st para.).

b)   The "different information" referred to any infor-
     mation the user's computer may not have sent be-
     fore, for instance because it was "not [...] un-
     derstood to be desired" or because "the client
     [was not] prepared to send" it before (p. 23, 2nd
     and 3rd paras.). Typically, according to the
     appellant, different information related to a
     specific parameter of the client computer (say its
     operating system or its browser) about which the
     server had no information yet.

As to the effects of the "indirect querying" method,
the appellant argued that an *automated* querying avoided
the need for user input, and the delayed request for
"different information" allowed the user to send less
information initially, which helped to reduce the
bandwidth requirement and to enhance privacy (see p.
24, 1st para.).

12.3   The board is not convinced by these arguments.

a)   The fact that the server sends an instruction and
     the client, in response, produces "modified infor-

mation" does not exclude the possibility that the
client involves the user in the process. Also nei-
ther the qualification of the querying as "direct"
nor the statement that the "direct reporting" is
"easier and more efficient than indirect querying"
implies that the retrieval of "modified" informa-
tion is a fully automated procedure (apart from
the fact that neither is contained in the claim
language).

b)   The term "different information than the user's
computer has already sent" (main and 1st auxiliary
request) does not allow any conclusion to be drawn
as to the amount of information the user may have
sent (in absolute terms or relative to what is re-
quired), why the user may have not sent this in-
formation before, or why the server may need it at
the specified point. As the appellant points out,
the server may simply lack certain information,
but it is also conceivable that the server needs
"different information" because an attempt to for-
mat the requested content based on the available
information failed, or because the server requests
as "different information" the client's confirma-
tion that it has installed a player which the
server might prefer, for technical or commercial
reasons, as formatting target. The term used in
the 2nd auxiliary request, "different information
than the user's computer understood was desired by
the server", does not clarify this point, as
nothing is claimed about the server's "desire".
And the phrase added in the 3rd auxiliary request
"which is necessary for the server to service a
request for media from the user's computer" or
what it is used for (see point X above) does not
clarify the point either, because the servicing of

a media request by formatting the requested
content is the common ultimate purpose of all
configuration information referred to in the
claims (and the application as a whole).

Hence, the claim language allows no conclusion to be
drawn as to whether the pertinent features contribute,
in view of D1, to reducing the amount of user inter-
action, to reducing the bandwidth requirement or to
increasing privacy.

13.   In summary, the board was unable establish that the
        alleged effects of "direct querying" could be
        attributed to the claimed features. To the extent that
        the appellant argued these effects to be constitutive
        for the matter for which protection is sought, this
        renders claim 1 of all requests unclear, Article 84 EPC
        1973.

Article 56 EPC 1973

14.   The appellant argued that, in general terms, the
        present application was meant to improve the method
        according to D1 by incorporating what the application
        refers to as "direct querying".

14.1   However, as argued above, the effects which the
        appellant alleged were achieved by direct querying
        cannot be attributed to the claimed features in the
        context of claim 1 according to any of the requests. No
        further effects than those discussed were put forward
        by the appellant, and nor are any apparent to the
        board.

14.2   Therefore, the appellant's argument as to why the
        claimed matter might show an inventive step over D1
        also fails.

14.3   The board concludes that the claimed matter according
        to all requests lacks an inventive step over D1,
        Article 56 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