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Datasheet for the decision
of 29 May 2018

Case Number: T 2342/13 - 3.5.07

Application Number: 10000250.0

Publication Number: 2182518

IPC: G11B27/32, G11B27/34,
                          G11B27/36, H04N5/85, G11B20/00,
                          G11B20/10, G11B27/10

Language of the proceedings: EN

Title of invention:
A reproducing apparatus, a system, a reproducing method, a
control program and a computer-readable recording medium
storing the software for content authentication

Applicant:
Sharp Kabushiki Kaisha

Headword:
Reproducing apparatus IV/SHARP

Relevant legal provisions:
EPC Art. 76(1)
RPBA Art. 12(4)

Keyword:

Late-filed request - second and third auxiliary requests - admission (yes)
Amendments - main and first and second auxiliary requests - added subject-matter (yes)
Remittal to the department of first instance - third auxiliary request - (yes)

Decisions cited:

G 0007/93, T 1816/11, T 2330/12

Case Number: **T 2342/13 - 3.5.07**

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 29 May 2018

Appellant:
(Applicant)

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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 17 June 2013
refusing European patent application No.
10000250.0 pursuant to Article 97(2) EPC

Composition of the Board:

Chairman   R. Moufang
Members: R. de Man
               M. Jaedicke

Summary of Facts and Submissions

I.   The applicant (appellant) appealed against the decision
        of the Examining Division refusing European patent
        application No. 10000250.0.

II.   The application was filed in English as a divisional
        application of European patent application
        No. 04792222.4 (the parent application), which had been
        filed as international application PCT/JP2004/014954
        and published in Japanese as WO 2005/036544 and in
        English as EP 1 679 706 A1.

III.   After holding oral proceedings, the Examining Division
        issued a communication under Rule 71(3) EPC, expressing
        the intention to grant a patent on the basis of a third
        auxiliary request. The applicant subsequently
        disapproved of the proposed text, maintained its main
        and first auxiliary requests and filed an amended
        second auxiliary request.

IV.   The Examining Division then resumed the examination
        proceedings and finally refused the application. It
        decided that the subject-matter of claim 1 of both the
        main request and the first auxiliary request was not
        new in view of the following document:

        D1: EP 0 751 515 A2, published on 2 January 1997.

        It refused to admit the second auxiliary request into
        the proceedings under Rule 137(3) EPC. The decision
        makes no mention of a third auxiliary request.

V.   Along with the statement of grounds of appeal, the
        appellant resubmitted the main and first and second
        auxiliary requests and filed a third auxiliary request

corresponding to the text proposed in the Examining
Division's communication under Rule 71(3) EPC.

VI.   In a communication accompanying a summons to oral
        proceedings, the Board introduced the following
        document:

        D5: Peinado M.: "Digital Rights Management in a
            Multimedia Environment", SMPTE Journal, April 2002,
            pp. 159-163.

        It *inter alia* expressed the preliminary opinion that
        the subject-matter of claim 1 of all requests lacked
        inventive step and raised questions concerning
        Article 76(1) EPC, in particular inviting the appellant
        to indicate a basis in the parent application for the
        subject-matter of its requests. It also noted that the
        description appeared to contain matter extending beyond
        the content of the parent application as filed and
        suggested that that objection could be overcome by
        deleting the text on page 94, line 22, to page 95,
        line 11.

VII.   In its written submissions in preparation for the oral
        proceedings, the appellant agreed to the Board's
        suggestion to delete the text on page 94, line 22, to
        page 95, line 11, of the description and commented on
        the substantive points raised in the Board's
        communication.

VIII.   By letter of 20 February 2018, the appellant informed
        the Board that it would not attend the oral
        proceedings.

IX.   Oral proceedings were held in the appellant's absence
        on 6 March 2018. At the end of the oral proceedings,

the chairman announced that the decision would be
issued in writing.

X.   The appellant requests that the decision under appeal
       be set aside and that a patent be granted on the basis
       of the main request or, in the alternative, on the
       basis of one of the first to third auxiliary requests.

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

       "A reproducing apparatus, comprising:
           data acquiring means (50) for acquiring video
       data, a program for reproducing the video data, a play
       list indicating (i) the video data to be reproduced by
       the program and (ii) an order in which the video data
       is to be reproduced, and program management information
       for controlling execution of the program;
           decoding means (20) for decoding the video data;
       and
           program executing means (70) for executing the
       program,
           characterized in that the reproducing apparatus
       further comprises general control means (80') for
       permitting, with reference to the program management
       information, the program executed by the program
       executing means (70) to reproduce the video data with
       reference to the play list."

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

       "A reproducing apparatus, comprising:
           data acquiring means (50) for acquiring video
       data, a program for reproducing the video data, and
       program management information for controlling
       execution of the program;

decoding means (20) for decoding the video data; and

program executing means (70) for executing the program,

characterized in that the program management information includes content data specifying information for specifying video data items to be reproduced by the program and an order in which the video data items are to be reproduced,

the reproducing apparatus further comprises general control means (80') for determining, in accordance with the content data specifying information, that the program executed by the program executing means (70) is permitted to reproduce the video data items specified by the content data specifying information included in the program management information for the program in the order specified by the content data specifying information, and

the general control means (80') prohibits the program controlled by the program management information acquired by the data acquiring means from reproducing video data not specified by the content data specifying information being included in the program management information for the program."

XIII. Claim 1 of the second auxiliary request differs from claim 1 of the main request in that the characterising part has been replaced with:

"the program executing means (70) executes the program in accordance with a program specifying information item (*program_file_name*) included in the program management information, the program is acquired via a network,

the video data is acquired from an optical disk, and

the reproducing apparatus further comprises general control means (80') for permitting, with reference to the program management information, the program being executed by the program executing means (70) to reproduce the video data with reference to the play list."

XIV.   Claim 1 of the third auxiliary request reads as follows:

"A reproducing apparatus, comprising:
data acquiring means (50) for acquiring video data, a program for reproducing the video data and program management information for controlling execution of the program, the program management information comprising certificate data;
a video reproducing section (20) for reproducing the video data; and
program executing means (70) for executing the program,
wherein upon an interruption carried out by the video reproducing section (20) a general control means (80') acquires video data information indicating the video data to be reproduced and public key data, and verifies if the program is allowed to reproduce the video data, using the video data information, the public key data and the certificate data."

XV.   The appellant's arguments where relevant to the 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.

2.   *The invention*

2.1   The application relates to an apparatus for reproducing
          content, including video data and computer programs.
          The content is acquired from a content-recording medium
          such as an optical disk by means of a "data acquiring
          means". The apparatus includes a "decoding means" for
          decoding video data and a "program executing means" for
          executing programs.

2.2   The independent claims of all requests are directed to
          verifying whether the reproduction of video data
          associated with a program is allowed.

3.   *The description*

          The Board is aware that the passage on page 94,
          line 22, to page 95, line 11, of the application as
          filed ("In cases where ... irrelevant to the program.")
          may contain a mistranslation of the original PCT
          application (see decision T 2330/12 of 15 January 2018,
          reasons 3.1, which deals with another divisional
          application of the same parent application). Since the
          appellant has agreed to delete this passage from the
          description of the application at issue, this potential
          violation of Article 76(1) EPC has now been removed.

Main request

4.   *Added subject-matter - Article 76(1) EPC*

4.1   Claim 1 of the main request relates to a reproducing
          apparatus which includes data-acquiring means for
          acquiring "video data, a program for reproducing the
          video data, a play list indicating (i) the video data
          to be reproduced by the program and (ii) an order in
          which the video data is to be reproduced, and program
          management information for controlling execution of the
          program".

4.2   The reproducing apparatus of claim 1 of the main
          request includes "general control means for permitting,
          with reference to the program management information,
          the program executed by the program executing means to
          reproduce the video data with reference to the play
          list".

          In the Board's view, the skilled person understands
          this as meaning that the control means makes decisions
          about permitting reproduction of the video data
          indicated in the playlist on the basis of information
          included in the program-management information.

4.3   According to the appellant, the feature specifying the
          functionality of the general control means finds a
          basis in paragraphs [0267] to [0273], [0275], [0277]
          and [0300] of the parent application.

4.3.1   Paragraphs [0267] to [0273] are preceded by paragraph
          [0266], which explains that a "verifying process" will
          be explained next. This verifying process is said to be
          a process "for checking whether or not the reproduction
          of the video data corresponding to the program

currently being executed is approved by the copyright
holder of the video data".

The verifying process is then explained with reference
to Figure 33. First, a CPU obtains the filename of the
"target video data" and extracts a public key from the
video data (paragraph [0268]; step S101). Next, the CPU
searches, using the video-data filename as a key, for a
relevant "video_info()" entry in the program-management
information. If no such entry is found, or if an entry
is found but contains no certificate, video
reproduction is not approved and program execution is
terminated (paragraphs [0269] and [0270]; steps S102
and S103). If a relevant entry containing a certificate
is found, the CPU verifies, on the basis of the
certificate, the public key and a hash value of the
currently executed program, whether video reproduction
is approved and, if not, terminates program execution
(paragraphs [0271] to [0273]).

4.3.2   The parent application then explains, in paragraphs
        [0275] to [0277], that the verifying process can also
        function without using the public-key encryption
        method. In that case, "the disapproved use of the video
        data can be checked by merely checking the static
        information *video_file_name* that is not contained in
        the program". It is apparent from Figure 30 and its
        description in paragraphs [0246] to [0251] that
        "video_file_name" refers to a field of the
        "video_info()" data structure.

4.3.3   Paragraph [0300] discloses that, as a variation of the
        embodiments described earlier in the application, the
        reproducing apparatus may make a reference to "play
        list information indicating an order in which the video

data is reproduced". It does not relate to determining whether video reproduction is allowed.

4.4   Hence, the disclosed verifying process, both in the version described in paragraphs [0267] to [0273] and in the variation discussed in paragraphs [0275] to [0277], specifically checks whether the filename of the video data to be reproduced is present in a "video_info()" entry contained in the program-management information. In the Board's view, the skilled person reading the parent application would not directly and unambiguously recognise this step as being merely optional, as it forms the basis of the verifying process. Paragraph [0300] does not change this, since it does not relate to verifying video-reproduction permission.

Claim 1, on the other hand, does not include a feature specifying that the general control means checks whether the filename of the video data to be reproduced is listed in the program-management information.

The subject-matter of claim 1 cannot therefore be directly and unambiguously derived from the passages cited by the appellant.

4.5   The parent application contains a number of further passages relating to "verifying" whether video-data reproduction is permitted. But none of these passages provides a basis for the subject-matter of claim 1.

In particular, paragraphs [0022] to [0025] and [0391] to [0394] and original claims 20 and 37 disclose verifying whether a content data item to be reproduced is a content data item specified in the program-management information. This corresponds to the step of checking whether the filename of the video data to be

reproduced is present in an entry of the program-
management information - a feature missing from
claim 1.

Paragraphs [0026] to [0028] and [0395] to [0398] and
original claims 21, 22, 38 and 41 relate to verifying
authorisation information included in the program-
management information with the help of "verification-
use" information. The "permitting" operation of claim 1
lacks these details.

4.6   The subject-matter of claim 1 of the main request
        therefore extends beyond the content of the parent
        application as filed, contrary to Article 76(1) EPC.

First auxiliary request

5.   *Added subject-matter – Article 76(1) EPC*

5.1   Claim 1 of the first auxiliary request specifies that
        the program-management information "includes content
        data specifying information for specifying video data
        items to be reproduced by the program and an order in
        which the video data items are to be reproduced". It
        also recites general control means for "determining, in
        accordance with the content data specifying
        information, that the program executed by the program
        executing means is permitted to reproduce the video
        data items specified by the content data specifying
        information included in the program management
        information for the program in the order specified by
        the content data specifying information".

5.2   The parent application, in paragraphs [0269] and [0277]
        to [0279], discloses content-data specifying
        information included in the program-management

information in the form of the "video_file_name" field
of a "video_info()" entry, which is used to verify
whether permission exists to reproduce video data (see
the discussion in points 4.3.1 and 4.3.2 above).

The parent application, in paragraph [0280], also
discloses that a program may correspond to "a plurality
of video data to be reproduced". This also follows from
Figure 30, which shows that the program-management
information for a program includes a number of
video_info() entries, each entry including a
video_file_name field.

5.3   The parent application does not, however, disclose that
        "content data specifying information" which is used for
        determining whether reproduction of the corresponding
        video-data items is permitted determines "an order in
        which the video data items are to be reproduced". The
        only passages in the parent application referring to
        the order in which video-data items are to be
        reproduced are paragraphs [0220] and [0300].

        Paragraph [0300] states that the reproducing apparatus
        may make a reference to "play list information
        indicating an order in which the video data is
        reproduced", but it makes no connection between the
        playlist information and the video_info() entries
        contained in the program-management information.

        Paragraph [0220] discloses that the video_file_name
        field of the program-management information of "the
        present embodiment" can specify a plurality of
        filenames in an order corresponding to the order in
        which the video data is to be reproduced. But this
        passage is part of "Embodiment 4", described in
        paragraphs [0146] to [0226], which focuses on the

program-management-information data structure shown in
Figure 22. That data structure includes no video_info()
entries but an optional single video_file_name field,
which is used to inform the reproducing apparatus which
video-data file to reproduce concurrently with the
execution of the program (see e.g. paragraph [0182]).
Hence, even if the skilled person reading the parent
application were to combine the embodiment to which
paragraph [0220] refers with one of the embodiments
described in paragraphs [0269] and [0277] to [0279], he
would not identify the optional single video_file_name
field of Figure 22 with the fields of the same name
included in the video_info() entries of Figure 30.

5.4   The other passages in the parent application relating
        to verifying whether video-data reproduction is
        permitted, discussed in point 4.5 above, do not provide
        a basis for the subject-matter of claim 1 either, as
        they also make no reference to the order in which the
        content data items are to be reproduced.

5.5   The first auxiliary request therefore does not comply
        with Article 76(1) EPC.

Second auxiliary request

6.   *Admission – Article 12(4) RPBA*

6.1   The Examining Division refused to admit the second
        auxiliary request into the first-instance proceedings
        under Rule 137(3) EPC in view of the time of its filing
        and because it *prima facie* did not meet the
        requirements of Articles 52(1) and 56 EPC.

6.2   Since the request was filed only after the completion
        of oral proceedings in which the examination

proceedings had essentially been brought to a conclusion, in the absence of special circumstances the Examining Division's refusal to admit a newly filed request introducing new features does not amount to an abuse of discretion. Hence, the admission of the second auxiliary request into the proceedings is now at the Board's discretion under Article 12(4) RPBA.

6.3   Although the Board does not find fault with the Examining Division's discretionary decision not to admit the request, it also considers that the non-admission is in itself no reason to treat the second auxiliary request, in respect of its admission under Article 12(4) RPBA, more strictly than if it had been filed for the first time with the statement of grounds of appeal. It would run counter to procedural efficiency if an applicant could increase its chances of having a new request admitted by delaying the filing of that request until after the application has been refused.

6.4   The question then arises whether the non-acceptance by the appellant of the text proposed by the Examining Division is a factor weighing against admission of the new request. In this respect, the Board notes first that the appellant was fully entitled to maintain its higher-ranking requests and thus to disapprove of the text proposed in the communication under Rule 137(3) EPC. And it cannot be held against the appellant that, in the course of the first-instance proceedings, it submitted, as an auxiliary request, a text that was found to meet the requirements of the EPC. If it had not filed that text, the Examining Division would have refused the application at the oral proceedings, and it would have been open to the appellant - within the

normal limits of Article 12(4) RPBA - to submit, on appeal, amended requests in reaction to the refusal.

6.5   In decision G 7/93 (OJ EPO 1994, 775), the Enlarged Board of Appeal held that a board of appeal, in the circumstances of the case it had before it, should overrule the discretionary decision of the department of first instance only if the latter had exercised its discretion in an unreasonable way or in accordance with the wrong principles. In that case, the examining division had refused to give consent to an amendment of the claims it had proposed for grant. The question before the referring board then was, essentially, whether to overrule the examining division's discretionary decision and give consent to the amendment or to confirm the examining division's decision and, presumably, allow the applicant to revert to the originally proposed text.

6.6   The situation before the Board now is therefore fundamentally different from that considered in decision G 7/93, provided that the filing of the second auxiliary request is to be regarded as a reaction to the negative opinion expressed by the Examining Division on one of the higher-ranking requests considered in the oral proceedings rather than as an amendment of the claims that had been found allowable at the end of those oral proceedings. This is indeed the case: the second auxiliary request corresponds to the then main request with amendments that seek to overcome the Examining Division's novelty objection.

6.7   As to the Examining Division's second reason for non-admission of the second auxiliary request, namely a *prima facie* lack of inventive step, the Board considers that a question relating directly to the compliance of

a request with a provision of substantive patent law is
to be assessed by the Board itself and that on such a
point there is no latitude for deferring to the view of
the department of first instance (cf. decision
T 1816/11 of 22 November 2016, reasons 2.6).

6.8   Since the amendments made in the second auxiliary
        request do not present the Board with any difficulty,
        it exercises its discretion under Article 12(4) RPBA
        and admits the second auxiliary request into the
        proceedings.

7.   *Added subject-matter – Article 76(1) EPC*

7.1   Claim 1 of the second auxiliary request adds a number
        of features to claim 1 of the main request:

        -    the program-executing means executes the program
             "in accordance with a program specifying
             information item (*program_file_name*) included in
             the program management information";
        -    the program is acquired via a network; and
        -    the video data is acquired from an optical disk.

7.2   Since these added features do not affect the objection
        under Article 76(1) EPC raised above against claim 1 of
        the main request, the subject-matter of claim 1 of the
        second auxiliary request likewise infringes
        Article 76(1) EPC.

Third auxiliary request

8.   *Admission – Article 12(4) RPBA*

8.1   The third auxiliary request corresponds to the text
        proposed for grant in the Examining Division's

communication under Rule 71(3) EPC. In response to this communication, the appellant expressed its disapproval of the proposed text, maintained its main and first auxiliary requests and submitted an amended second auxiliary request. The Examining Division then resumed the examination proceedings and refused the application. In its decision, it made no mention of the third auxiliary request.

8.2   The appellant's letters filed after the communication under Rule 71(3) EPC contain no clear indication that the appellant maintained its third auxiliary request. The Examining Division apparently assumed that it had been withdrawn; otherwise, it should have referred to the request in its later communication and decision and have mentioned that the applicant had failed to give its approval to it, in accordance with the procedure set out in the Guidelines for Examination in the EPO (the current version of November 2017 explains this procedure in point E-X, 2.9).

8.3   Nevertheless, in the circumstances of the present case the Board accepts that the appellant never had the intention to withdraw the request. It therefore admits the third auxiliary request into the proceedings.

9.   *Remittal*

9.1   The communication under Rule 71(3) EPC, expressing the Examining Division's intention to grant a patent on the basis of the third auxiliary request, does not constitute a decision and is therefore not binding on the EPO. In its communication, the Board expressed a number of reservations about the allowability of the request. In particular, it questioned the clarity of claim 1 and suggested that the claim's subject-matter

lacked inventive step over a video player as known from document D1 in combination with the well-known use of public-key and certificate data for verifying whether a computing entity is allowed to reproduce particular content data, as exemplified by document D5.

9.2   The Board's concerns about the clarity of claim 1 related to the feature "wherein upon an interruption carried out by the video reproducing section a general control means acquires video data information indicating the video data to be reproduced and public key data, and verifies if the program is allowed to reproduce the video data, using the video data information, the public key data and the certificate". In particular, the Board had questions about the role of the "interruption", the acquisition of the "video data information" and "public key data", and how the "video data information" was to be used in the process of verification.

9.3   On reconsideration, although the Board is not yet convinced that the claim is clear, any problems of clarity for claim 1 appear to be a matter of wording rather than being of a fundamental nature. In particular, paragraph [0243] of the application explains that when reproduction of video data starts, the video reproducing section extracts public-key data from the video data and notifies the general control section, by way of an interrupt, of the extracted public-key data and the filename of the video data to be reproduced. And paragraphs [0268] to [0273] disclose that the general control section uses the filename to retrieve certificate data corresponding to the video data to be reproduced from the program-management information and then verifies whether the program is allowed to reproduce the video data on the basis of the

public-key data, the certificate data and a hash value
of the program.

9.4   As to the potential objection of lack of inventive
        step, the Board notes the following. Although document
        D1 on page 2, line 58, to page 3, line 19, discloses a
        video player for reproducing the content of a recording
        medium which contains "software capable of the
        interactive reproduction (e.g. the educational
        software, the game software)", the Board now agrees
        with the appellant's argument that document D1 does not
        directly and unambiguously disclose a "program" and
        "program executing means" as claimed. In fact, the
        passage on page 7, line 6, to page 8, line 47,
        discloses, with reference to Figures 4 and 5A to 5D,
        that educational software consists of a number of
        blocks of multiplexed stream data together with
        "reproduction permission codes". When reproduced, a
        block displays a question in response to which the user
        inputs an answer. Depending on the answer given by the
        user, a "correct" or "incorrect" answer block is
        displayed. The reproduction permission codes
        essentially encode which answer blocks must have been
        displayed before another question block may be
        reproduced. An actual program and corresponding
        program-executing means are therefore not implied. In
        this context, the Board notes that document D1 also
        refers to a movie as "software" (see page 2, lines 24
        to 47).

        In addition, the verification process of claim 1 as
        explained in point 9.3 includes details going beyond
        the general principle of using public-key and
        certificate data to verify access rights.

9.5   In these circumstances, the Board considers it
        appropriate to exercise its discretion under
        Article 111(2) EPC and to remit the case to the
        Examining Division for further prosecution on the basis
        of the third auxiliary request. The Examining Division
        should, in particular, examine whether claim 1 is clear
        or still requires clarification.

9.6   In addition, the description still needs to be adapted
        in view of point 3 above.

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.

The Registrar: The Chairman:

I. Aperribay   R. Moufang

Decision electronically authenticated