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**Datasheet for the decision
of 24 March 2017**

Case Number: T 0228/14 - 3.5.06

Application Number: 03008711.8

Publication Number: 1338942

IPC: G06F1/00

Language of the proceedings: EN

Title of invention:

System and method for controlling the distribution and use of digital works

Patent Proprietor:

ContentGuard Holdings, Inc.

Opponent:

Vodafone Group Services Limited (opposition withdrawn on 8 March 2013)

Headword:

Distribution and use of digital works/CONTENTGUARD

Relevant legal provisions:

EPC Art. 101(2), 101(3)(b)
EPC 1973 Art. 100, 111(1), 113(2)
EPC R. 60(2)

Keyword:

Remittal to the department of first instance - (yes)
Grounds for opposition - extension of subject-matter (no)

Decisions cited:

T 0197/88, T 1866/13

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 0228/14 - 3.5.06

D E C I S I O N
of Technical Board of Appeal 3.5.06
of 24 March 2017

Appellant: ContentGuard Holdings, Inc.
(Patent Proprietor) 6900 N. Dallas Parkway, Suite 850
Plano TX 75024 (US)

Representative: Grünecker Patent- und Rechtsanwälte
PartG mbB
Leopoldstraße 4
80802 München (DE)

Respondent: Vodafone Group Services Limited
(Opponent) Vodafone House
The Connection
Newbury
Berkshire RG14 2FN (GB)

Representative: Boulton Wade Tennant
Verulam Gardens
70 Gray's Inn Road
London WC1X 8BT (GB)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted on 1 July 2013
revoking European patent No. 1338942 pursuant to
Article 101(3) (b) EPC.

Composition of the Board:

Chairman W. Sekretaruk
Members: Martin Müller
 A. Teale

Summary of Facts and Submissions

- I. The appeal lies against the decision of the opposition division, with reasons dispatched on 1 July 2013, to revoke European patent No. 1338942, which had been filed as a divisional application based on the earlier European patent application No. 95308420.9. The opposition division found that the subject-matter of claim 1 according to the main request received on 6 February 2012 extended beyond the content of the earlier application as filed (Article 100(c) EPC). Auxiliary requests 1 to 10 were not admitted into the procedure because the extension objection also applied to claim 1 of these requests, so that they did not "prima facie" overcome the ground for opposition under Article 100(c) EPC. To justify the non-admittance of the auxiliary requests, reference was made to Rule 80 EPC. The grounds for opposition under Articles 100(a) and (b) EPC, which had also been raised in the notice of opposition, were not addressed in the decision.
- II. On 8 March 2013, i.e. after the decision was delivered in oral proceedings before the examining division, the only (remaining) opponent withdrew its opposition.
- III. On 11 September 2013 the proprietor filed a notice of appeal against the decision and paid the appeal fee. A statement of grounds of appeal was received on 11 November 2013. The appellant/proprietor requests that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1-87 as filed on 6 February 2012 and upon which the decision was based. Furthermore, it maintains the ten auxiliary requests not admitted by the opposition division, also

filed on 6 February 2012 and each comprising claims 1-87.

IV. Claims 1 and 45 according to the main request read as follows:

"1. A system for the distribution and use of digital works, the system comprising:

a plurality of repositories (201-204; 402-404; 411,415) for storing and/or exchanging digital works;

a communication medium for coupling repositories to enable exchange of repository transaction messages and/or distribution of digital works, said repositories comprising an external interface for removably coupling to said medium;

means for providing usage rights associated with digital works, each of said usage rights specifying how a digital work may be used or distributed, said usage right being stored together with the corresponding digital work in a repository;

characterized in that

each of said repositories further comprising:

a usage transaction processing means having a requester mode of operation for generating usage repository transaction messages to request access to digital works stored in another repository, said usage repository transaction message specifying a purpose corresponding to a specific usage right representing how the requesting repository desires to use said digital work, and/or said usage

transaction processing means having a server mode of operation for determining if a request for access to a digital work stored in a storage means of said repository may be granted, said request being granted only if the usage right specified in said request is associated with said digital work; and

said system comprising:

a first repository (404; 415) comprising a usage transaction processing means having a server mode of operation, said first repository (404; 415) storing a specific digital work;

a second repository (402; 411) comprising a usage transaction processing means having a server mode of operation and a requester mode of operation, said second repository (402; 411) being adapted to request said specific digital work from said first repository (404; 415),

said specific digital work being transferred to said second repository (402; 411), if said request from said second repository (402; 411) specifies a usage right that is associated with said specific digital work and said usage right specifying that said specific digital work may be transferred in the requested manner; and

a rendering system (401; 410) comprising said second repository (402; 411) and a device or execution engine (403; 412, 413) adapted to render a digital work into its desired form; whereby rendering of said specific digital work into its desired form is granted, if a usage right is

associated with said specific digital work that specifies that the specific digital work may be rendered in the requested manner."

"45. A method for the distribution and use of digital works, said method comprising the steps of:

providing a set of usage rights associated with a digital work, each of said usage rights specifying how a digital work may be distributed or used;

storing said digital work and its associated usage rights in a first repository (404; 415);

a second repository (402; 411) initiating a request to transmit said digital work in said first repository (404; 415) to said second repository (402; 411);

said first repository (404; 415) permitting transmission of said digital work if a usage right is associated with said digital work that specifies that the digital work may be transmitted to said second repository (402; 411);

said second repository (402; 411) determining if a specific usage right is associated with said digital work that specifies that the specific digital work may be rendered in a requested manner by a device or execution engine (403; 412, 413) adapted to render a digital work into its desired form; whereby said device or execution engine (403; 412, 413) and said second repository

(402; 411) are comprised in a rendering system
(401; 410);

said second repository (402; 411) denying access
to said digital work is said specific usage right
is not associated with said digital work;

if said specific usage right is associated with
said digital work, said second repository (402;
411) determining if conditions specified by said
usage right are satisfied;

if said conditions are not satisfied, said second
repository (402; 411) denying access to said
digital work;

if said conditions are satisfied,

said second repository (402; 411) permitting
rendering of said digital work for purposes
corresponding to a specific usage right."

- V. In a letter dated 9 December 2016, the board referred to the closely related case T 1866/13 and informed the appellant of its inclination to decide the present case along the lines of the former. More specifically, the board expressed its inclination to set aside the decision and to remit the case to the opposition division for further prosecution. The appellant did not respond to this letter.

Reasons for the Decision

The following reasons are substantially identical to those on which the board's earlier decision T 1866/13 are based.

1. The appeal is admissible.

The invention

2. The invention in general relates to a digital rights management system based on digital works with associated usage rights and transactions between trusted devices called "repositories".
 - 2.1 In what follows reference will be made to the application documents of the present application as filed. The drawings and description of the earlier application are identical to the drawings and pages 1-46 of the description of the present application. The claims originally filed with the earlier application are included as "aspect[s] of the present invention" in the present application on pages 47 to 50.
 - 2.2 The basic operation of the invention is illustrated in figure 1 and the corresponding description (paragraph bridging pages 5 and 6). A creator deposits a digital work in repository 1 from which it may be requested by repository 2 for a particular purpose. If the usage rights associated with the digital work allow the requested purpose, repository 1 transmits the digital work to repository 2. The basic operation of the invention was the subject of method claim 23 of the present application as filed but also of claim 6 of the earlier application as filed (see also the present

description, page 48, last 14 lines, to page 49, line 10).

- 2.3 The description specifies on page 3 (paragraph 3) that: "A repository has two primary operating modes, a server mode and a requester mode. When operating in a server mode, the repository is responding to requests to access digital works. When operating in requester mode, the repository is requesting access to a digital work." Furthermore, with reference to figure 2, a repository 201 is disclosed as "represent[ing] the general instance of a repository" which "has two modes of operation: a server mode and a requester mode" (see page 6, lines 10 to 12). Repository 201 is said to be "general in that its primary purpose is as an exchange medium for digital works" (see page 6, lines 14-15).
- 2.4 It is further disclosed that "the repository 201 may communicate with a plurality of other repositories", especially a "rendering repository 203" (page 6, lines 15-17). Rendering repositories are described on page 7, line 3 *et seq.*, and illustrated in figures 4a and 4b. Rendering repositories (see no. 402 or 411) receive digital works, store them as ephemeral copies and pass them on to rendering devices such as a printer, a display, or an execution engine for what is called "rendering". In the section on rendering systems, reference is also made to "external" repositories 404 and 415 in which the requested digital works are stored.

Article 100(c) EPC 1973

3. The decision under appeal turns on the finding of the opposition division that the existence of repositories which have a server mode only is not unambiguously

derivable from the earlier application as filed (see the decision, esp. page 6, 4th paragraph from the bottom). The opposition division found specifically that the description on page 5, lines 23-28, did "not allow to derive that such first repository does not have a requester mode", that neither the "document server" nor the "digital work server" described on page 11, lines 5-12, "appear[ed] to be a repository" and that it could also not be derived that the "document server" referred to on page 23, lines 28-30 (actually: lines 26-28), could "be equated to a repository and [did] not permit to derive any information about the actual possibilities of the document server (the presence or absence of a requester mode)" (see the decision, page 6, 2nd and 3rd paragraphs from the bottom).

4. The appellant challenges this decision, arguing that the description as a whole left no room for any other interpretation than that the "digital work server" is a repository itself (see grounds of appeal, page 3, paragraph 1; esp. lines 1-2 and 16-21). The appellant also refers to the disclosure on page 23, lines 26-30, in which "a repository and a document server" are jointly referred to as "both repositories" (see grounds of appeal, page 3, paragraph 2). The appellant thus concludes that the description unambiguously contemplated "a repository that only processes requests from other repositories" (see page 4, paragraph 1). The definition on page 6, lines 10-12, according to which the "general instance" of a repository has both a server and a requester mode did not allow the conclusion that all repositories had to be able to both request access to digital works *and* to process such requests (see page 4, paragraph 3).

5. The board agrees with the decision under appeal in that the description does not disclose expressly that the servers mentioned in the description do not have a requester mode, thus leaving open the question of the presence or absence of the requester mode.
- 5.1 However, the claimed alternative to a repository having a server mode does not expressly require a repository which has *only* a server mode. What is claimed is a repository which must have a server mode, but which may or may not have a requester mode. For this feature to be originally disclosed, therefore, it is not necessary that a repository be disclosed which *does not* have a requester mode. It is sufficient that a repository be disclosed which *may or may not* have a requester mode.
- 5.2 The disclosed servers satisfy this requirement. In combination with the fact that the cited section on page 23 directly and unambiguously refers to a document server as a repository, the board is satisfied that the existence of a repository which has a server mode, but which may or may not have a requester mode is disclosed in the present and the earlier application as originally filed.
- 5.3 A similar argument applies to the description of the "basic operation of the present invention" on page 5, last paragraph, *et seq.*, with reference to figure 1. Repository 1 in this context is required to operate as a server. Whether it can, in a different situation, also act as a requester is left open. In the board's view, this too discloses a repository which has a server mode, but which may or may not have a requester mode.

- 5.4 Repositories 404 and 415 depicted in figures 4a and 4b and described on page 7, last two paragraphs, are also only required to have a server mode, but may or may not have a requester mode.
- 5.5 As regards the cited section on page 6 (lines 10-14) defining "repository 201 [to have] a server mode and a requester mode", the board agrees with the appellant that what is defined here is only the "general instance of a repository". It is also defined that "[r]epository 201 is general in the sense that its primary purpose is as an exchange medium for digital works". In the board's view this does not contradict the existence of special purpose repositories, such as rendering repositories or servers, which may not operate as an exchange medium and thus may not need both modes.
- 5.6 Only the cited section on page 3, lines 17-18, appears to make the existence of both "a server mode and a requester mode" obligatory for all repositories. If taken literally, this would apply to rendering repositories and to server repositories as well. However, in the board's judgment, the skilled person would, in view of the application as a whole and the cited passages in particular, understand that passage to be analogous to the passage on page 6 in defining only the general case, too.
6. The board therefore comes to the conclusion that the ground of opposition under Article 100(c) EPC 1973 does not prejudice the maintenance of the patent as granted for the reason that claim 1 refers to a repository which has a server mode, but which may or may not have a requester mode.

7. For this reason, the decision under appeal has to be set aside.

Continuation of the opposition procedure after the decision has been set aside

8. According to Rule 60(2) EPC 1973, the opposition proceedings may be continued by the European Patent Office of its own motion when, as in the present case, the opposition is withdrawn.
 - 8.1 If the opposition proceedings were terminated after the decision had been set aside, the patent would stand as granted. In the present case, the proprietor requests maintenance of the patent only in amended form and thus no longer approves the text of the patent as granted. A decision to terminate the proceedings would therefore be contrary to the principle of party disposition as codified in Article 113(2) EPC 1973.
 - 8.2 Moreover, the board notes that the opposition division gave in the annex to the summons to oral proceedings its preliminary opinion that the subject-matter of the granted claims lacked inventive step and that, consequently, also this ground for opposition prejudiced the maintenance of the European patent, Article 101(2) EPC (see also T 0197/88, headnote 1, reasons 3.2 and 3.3). The same objection, if maintained, would also prejudice the maintenance of the patent in amended form according to the main request, Article 101(3) (b) EPC.
 - 8.3 For both reasons, the opposition proceedings are to be continued.

Remittal to the first instance for further prosecution

9. The opposition was based on all grounds for opposition under Article 100(a)-(c) EPC 1973. The decision however was limited to the ground for opposition under Article 100(c) EPC 1973. The board thus exercises its discretion under Article 111(1) EPC 1973 and remits the case to the opposition division for further prosecution.

Auxiliary requests

10. The opposition division did not admit the auxiliary requests into the proceedings because it considered that they suffered from the same extension problem as the main request and were thus "prima facie" not allowable. Since the board does not share the finding of the opposition division as regards the original disclosure of the main request, this reason also does not justify the decision not to admit the auxiliary requests.
11. The board also notes the following:
 - 11.1 The opposition division referred to Rule 80 EPC to justify its decision not to admit the auxiliary requests because they did "not prima facie overcome the grounds of opposition under Article 100(c)".
 - 11.2 The finding that a request does not *overcome* a ground for opposition is however distinct from the finding that an amendment is *occasioned* by a ground for opposition. For instance, if a proprietor filed a number of requests trying to overcome an inventive step objection, these requests would typically be accepted as occasioned by the ground for opposition under

Article 100(a) EPC 1973, even if eventually the opposition division found that none of them overcame the objection and revoked the patent.

- 11.3 Therefore in this case Rule 80 EPC - or Rule 57a EPC 1973 which applies to the present case - does not give the opposition division the discretion to decide not to admit an auxiliary request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



B. Atienza Vivancos

W. Sekretaruk

Decision electronically authenticated