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Datasheet for the decision of 24 April 2017

Case Number: T 1040/14 - 3.5.06

Application Number: 10196044.1

Publication Number: 2333662

IPC: G06F9/445, H05K5/02

Language of the proceedings: EN

Title of invention:
USB autorun device

Applicant:
Arkeytyp IP Limited

Headword:
USB autorun device II/ARKEYTYP

Relevant legal provisions:
EPC Art. 14(1), 56, 84

Keyword:
Inventive step - both requests (no)

Decisions cited:
T 0286/10, T 1711/11

Catchword:

Europäisches Patentamt
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Office européen des brevets

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Case Number: T 1040/14 - 3.5.06

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

Appellant: (Applicant)	Arkeytyp IP Limited 25 Bank Place Mellow, Co. Cork (IE)
Representative:	Langley, Peter James Origin Limited Twisden Works Twisden Road London NW5 1DN (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 4 November 2013 refusing European patent application No. 10196044.1 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 dispatched on 4 November 2013, to refuse European patent application No. 10 196 044.1. Reference was made *inter alia* to the documents:

D1: Anon, "The Internet Webkey is Quick n'Easy", iNETready Communications Inc., 2006, retrieved from http://web.archive.org/web/20061018060807/http://www.internetwebkey.com/pdf/usb-webkey-datasheet.pdf (on 15 February 2008),
D3: WO 2005/066923 A1,
D4: US 2004/259423 A1, and
D5: DE 10 2004 039201 A1,

and it was argued that the claimed invention lacked inventive step over D4 in combination with D1 and D3.

II. A notice of appeal and a statement of grounds of appeal were filed and the appeal fee was paid on 6 January 2014. The appellant requested that the decision be set aside and that a patent be granted on the basis of pending main and auxiliary requests, i.e. apparently on the basis of the following application documents:

Main request

claims 1-25 filed on 11 September 2012
description pages
1-5, 7-74 filed on 16 December 2011
6 filed on 11 September 2012
drawings, sheets
1/33-33/33 as originally filed.

Auxiliary request

claims 1-18 filed on 21 December 2012
description pages
1-5, 12-74 filed on 16 November 2012
6-10 filed on 20 September 2013
(page 11 being deleted)
drawings, sheets
1/33-33/33 as originally filed.

The appellant also requested that the appeal fee be reimbursed pursuant to Rule 103(1)(a) EPC because the examining division had shown impermissible "national bias" in choosing to base its objection on the English D4 instead of the earlier French family member, which the appellant referred to as

D7: WO 03/027946 A1.

III. In an annex to summons to oral proceedings, the board introduced an additional document, namely

D8: US 2006 142236 A1 (published 29 June 2006),

and informed the appellant of its preliminary opinion that no fundamental deficiency or substantial procedural violation was apparent in the first-instance proceedings and that the claimed invention *inter alia* lacked clarity (Article 84 EPC) and inventive step over D1 in view of D4 (or D5) and D8 (Article 56 EPC).

IV. In response to the summons, the appellant did not file any amendments or arguments. With letter of 21 April 2017, it informed the board that it would not be making written submissions or attending the oral proceedings.

Accordingly, the oral proceedings were held on 24 April 2017 in the appellant's absence.

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

"A portable USB autorun device operable to communicate with a computer terminal, the device including a USB microcontroller; and in which the autorun device is adapted to be detachable from a surrounding support by an end-user to enable a USB interface plug on the autorun device to be inserted into a female USB receptacle in the computer terminal, and wherein the support is detachably connected to sections of the edge of the autorun device and the edge thickness of those sections of the device is substantially the same as the edge thickness of adjacent portions of the surrounding support and wherein the device is operable to cause the computer terminal to auto-connect to a web site."

Claim 1 of the auxiliary request reads as follows:

"A portable USB autorun device assembly comprising a USB autorun device and a surrounding support, the USB autorun device including a USB interface plug, wherein the USB autorun device is operable to communicate with a computer terminal, the USB autorun device including a USB microcontroller, wherein the USB autorun device is a portable, application-specific USB autorun device that, following connection to the computer terminal, automatically initialises or presents itself as a known type of device and then automatically sends to the terminal a sequence of data, the data complying with a standard protocol, that sequence of data automatically causing content to be accessed or a task to be initiated;

wherein the device (i) includes a standardised USB module that includes the USB microcontroller, the standardised module being designed to be attached to or embedded in multiple types of different, application specific packages but (ii) excludes mass memory storage for applications or end-user data;

wherein the surrounding support is a leaflet, a flyer or a promotional card,

and in which the USB autorun device is adapted to be detachable from the surrounding support by an end-user to enable the USB interface plug on the autorun device to be inserted into a female USB receptacle in the computer terminal, and wherein the surrounding support is detachably connected to sections of an edge of the USB autorun device and the edge thickness of those sections of the device is substantially the same as the edge thickness of adjacent portions of the surrounding support and wherein the USB autorun device is operable to cause the computer terminal to auto-connect to a web site."

VI. At the end of the oral proceedings, the chairman announced the board's decision.

Reasons for the Decision

Decision in the appellant's absence

1. According to Article 15(3) RPBA the board is not obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned. Therefore, and also in accordance with Article 15(3) RPBA, the board is treating the appellant as relying only on its

written case. The following reasons rely substantially on the board's preliminary opinion as communicated to the appellant with the summons to oral proceedings.

Alleged substantial procedural violation
Article 11 RPBA and Rule 103(1)a) EPC

2. The appellant argues *inter alia* that the skilled person would not have combined D4 and D1 because the application context of D4, computer security, is incompatible with the business aim of D1 (see e.g. grounds of appeal, page 5, paragraph 1, page 7, paragraph 2, and page 8, paragraph 4).

2.1 In the appellant's view, the examining division misinterpreted the security context of D4 by interpreting the term "dongle" too broadly, based on the reference to a corresponding wikipedia entry (which the decision referred to as D6).

2.2 D4 is an English family member of a PCT application that was originally filed in French (D7, see grounds of appeal, page 3, paragraph 3 *et seq.*). In the appellant's view, the term "dongle" in the title of D4 had to be construed as equivalent to the corresponding term "clé électronique" in the title of D7, of which it apparently was the translation. More specifically, the term "clé électronique" implied a computer security context, whereas the term "dongle" *per se* might not, or not to the same extent (see the grounds of appeal, page 5, paragraph 1). In the appellant's view, the examining division had come to the wrong conclusion because it had referred to D4 instead of D7 as it should have.

2.3 The appellant further argues that the examining division committed a substantial procedural violation

by referring to D4 rather than the "authoritative source" D7 and thus impermissibly preferring the English language over the original French, thereby infringing Article 14(1) EPC (see the grounds of appeal, page 10).

3. The board agrees with the appellant that, for the question of inventive step, the meaning which D4 gives to the term "dongle" cannot be called into question by the mere fact that it had been used with a broader meaning elsewhere (D6), and that the security context of D4 had to be taken into account when determining the disclosure of D4. To the extent that the examining division may not have done this, its reasoning may be incorrect in substance. Whether this was actually the case is immaterial for this decision. At any rate, however, this would not constitute a *procedural* error. The board accepts that using the English document D4 may have influenced the examining division in this regard, but notes that D4 is a piece of prior art in its own right. There is no basis for the appellant's assertion that the examining division is obliged to refer to prior-art documents in their original language. In particular, Article 14(1) EPC is no such basis. The board therefore concluded that the examining division's use of D4 rather than D7 was not a fundamental deficiency, and did not immediately remit the case to the examining division under Article 11 RPBA. The board also considers that no substantial procedural violation occurred. Moreover, reimbursement of the appeal fee under Rule 103(1)(a) EPC is not possible, because the appeal is not being allowed.

The invention

4. The invention relates to what has been called a "webkey", i.e. a small "autorun" USB device which, when plugged into a terminal computer, automatically connects the user to a predetermined website (see the description, e.g. on page 11, first and last paragraphs). It does this by producing a stream of key codes like those that would have been created by keystrokes on a USB keyboard compliant with the "Device Class Definition for Human Interface Devices" (HIDs) of the USB standard (see page 1, penultimate paragraph, and page 3, paragraph 3). The device is meant to be cheap so that it can be used e.g. as a promotional give-away (see figures 3-20). The price of known USB devices, especially of memory sticks, being dominated by the cost of the memory, the invention is expressly not intended as a "memory product" (see page 11, paragraph 3). It is indicated that the webkey may be manufactured and distributed as the detachable part of a card (see e.g. figures 7, 12 and 19). The application refers to USB autorun devices as being known (see page 1, paragraph 2; page 3, paragraphs 3 and 4).

The prior art

5. D1 discloses a webkey which offers the same functionality as the claimed device (see page 3, paragraph 2), namely automatically connecting the user to a predetermined website when the webkey is plugged into the computer. The user is thus freed from having to memorise and type in a URL of interest. D1 also discloses the promotional context and several application scenarios (see page 2, lower half). The amount of memory on the webkey is not disclosed.

6. D3 discloses a USB memory device integrated into a card, a product label or similar (see figures 1-4), so that it can be connected to a computer in order to make promotional product information available to customers. For connection with the computer, an adaptor is required (see figure 6A), because the USB connector is not "detachable" from its support.

7. D4 discloses a USB "dongle" which is detachably connected to a card (see figures 1 and 5; par. 17) and can be connected to a computer, possibly via a suitable adaptor (see figure 2). The dongle functionality is not discussed at length (see paragraphs 3 and 4) but it is understood that a dongle is a piece of hardware, the presence and validity of which must be ascertained to give a user access to certain services. D4 itself is exclusively concerned with shaping dongles so that they can be manufactured cheaply (see paragraphs 14 and 46).

8. D5 is concerned with the cheap manufacture of USB memory devices ("Datenträger"; see e.g. paragraph 5). Technically, the solution is similar to that disclosed in D4 (see D5, figures 1 and 5).

9. D8 discloses a USB device (see figures 1 and 2) which behaves like a (second) USB (HID) keyboard (see paragraphs 19 and 37) by outputting key codes corresponding to those generated by strokes at a keyboard. A central idea of D8 is that these key codes are generated in response to an acoustic stimulus detected by an integrated microphone (see paragraph 20). This enables the user for instance to trigger the opening of the Windows start menu with a clap of his hands. This disclosure is independent of other functions the USB device might also have. In

particular, it does not appear to disclose that the USB device also is a USB "mass" memory device.

D1 is prior art, Article 54(2) EPC

10. The board notes that the appellant did not challenge the examining division's implicit understanding that D1 was available to the public before the priority date of the present application, as established by the fact that it had been archived by the Web Archive before that date, and therefore forms part of the state of the art for the case to hand. The board has no objections to this assumption either (thereby following recent jurisprudence of the boards of appeal, see e.g. T 286/10, reasons 4.2, and T 1711/11, reasons 2.2).

Clarity, Article 84 EPC, and claim construction

11. Claim 1 of the auxiliary request specifies that the device is "application-specific" and includes a "standardised [...] USB module [...] designed to be attached to or embedded in multiple types of different, application specific packages".

11.1 The board notes that the term "standardised" has, in itself, no technical meaning. Accepting a feature of some component as a standard does not change the feature itself; it merely assures developers and users that compliant components of the same type share that feature.

11.2 Also the indication that the device is "application-specific" and the USB module "designed" for use by "multiple types of different, application specific packages" has no clear technical implication. A single component may be used by any application package that

conforms to its interface specification, whether or not the component is standardised and without that component being specifically "designed" for such use.

12. Claim 1 of the auxiliary request further specifies that the USB module "excludes mass memory storage for applications or end-user data". The board considers that it is unclear what type or amount of memory is hereby excluded and, therefore, what technical effect this exclusion might have.

Inventive step

13. The board considers that the claims, notwithstanding the above objections under Article 84 EPC, are clear enough to allow an assessment of inventive step.

14. The board considers the most suitable starting point for that to be document D1.

Main request

15. The webkey of D1 being "stick-shaped" (see the figure on page 1 of D1), claim 1 of the main request differs from D1 only in the claimed "surrounding support" of the claimed USB device.

15.1 The problem solved by this difference is to provide a cheap way of manufacturing the webkey.

15.2 The skilled person addressing this problem would, in the board's view, be aware that this question was substantially independent of the functionality provided by the device in question and would therefore search

the prior art for solutions beyond the application domain of D1.

15.3 D4 and D5 disclose USB devices manufactured with the claimed type of surrounding support. The board takes the view that the skilled person would understand that the cost advantage of manufacturing USB devices detachably connected to cards is compatible with the functionality of the USB device of D1, and would therefore not hesitate to manufacture the device of D1 as disclosed in D4 or D5.

15.4 The board thus concludes that claim 1 of the main request lacks inventive step over D1 in combination with either D4 or D5, Article 56 EPC.

Auxiliary request

16. Claim 1 of the auxiliary request specifies the surrounding support as being a "leaflet, a flyer or a promotional card". The board considers that being "promotional" is not a technical feature of the cited card. For instance, printing promotional content on any card would make it "promotional", irrespective of its primary technical functionality. A card might also be used as a "promotional" item as it stands, i.e. without any physical change, if it was given away free.

17. As explained above, the board takes the view that the requirement that the device is "application-specific" or "standardised" does not imply any limitation on the device and thus cannot constitute a difference.

18. In view of this, the board considers that claim 1 of the auxiliary request differs from D1 in that

(a) the surrounding support is a card,
(b) the USB device presents itself as a "fake HID keyboard", and
(c) "mass memory storage" is "excluded" from the device.

18.1 The board agrees with the decision under appeal that these differences solve two unrelated problems. Specifically, both features (a) and (c) address the problem of cheap manufacture of the webkey of D1, while feature (b) relates to the implementation of its functionality.

18.2 As regards feature (b), the board notes that D1 leaves open how its functionality of bringing customers "to a pre-programmed web page location" is implemented (page 3, paragraph 2). In other words, in the board's view D1 neither discloses nor excludes either one of the autorun devices mentioned in the application (page 3, lines 14-29). The board considers that the express goal of sparing users from the risk of "typing incorrect URL's" (see D1, page 1, sentence 1, and page 3, paragraph 3) suggests that the webkey should "do the typing" for them. Trying to implement this idea, the skilled person would find in D8 that a suitable "fake HID keyboard" has been implemented and would not hesitate to use it to solve this problem.

18.3 Feature (a) has already been discussed above with regard to the main request.

18.4 As regards feature (c), the board considers it an obvious matter of cost-effectiveness to exclude expensive memory if it is not needed.

19. In summary, the board finds that claim 1 of the auxiliary request specifies an obvious implementation of the device of D1 using software technology known from D8 and manufacturing technology known from D4 or D5, and therefore lacks inventive step too, Article 56 EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

B. Atienza Vivancos W. Sekretaruk

Decision electronically authenticated