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**Datasheet for the decision
of 8 January 2018**

Case Number: T 2275/15 - 3.5.06

Application Number: 11180761.6

Publication Number: 2474907

IPC: G06F9/445

Language of the proceedings: EN

Title of invention:

Communication system, information processing apparatus,
communication program, and communication method

Applicant:

Nintendo Co., Ltd.

Headword:

Software update between terminals/NINTENDO

Relevant legal provisions:

EPC R. 111(2), 103(1)(a)
RPBA Art. 11

Keyword:

Substantial procedural violation - decision not reasoned
Remittal to the department of first instance
Reimbursement of appeal fee

Decisions cited:

Catchword:



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Case Number: T 2275/15 - 3.5.06

D E C I S I O N
of Technical Board of Appeal 3.5.06
of 8 January 2018

Appellant: Nintendo Co., Ltd.
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Representative: Lang, Johannes
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 6 July 2015
refusing European patent application No.
11180761.6 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 6 July 2015, to refuse European patent application No. 11 180 761.6 for lack of inventive step over

D1: WO 02/25438 A1.

II. A notice of appeal was filed on 3 September 2015, the appeal fee being paid on the same day. A statement of grounds of appeal was received on 16 November 2015. The appellant requested that the decision be set aside and that a patent be granted on the basis of claims 1-14 of a main request or claims 1-13 of one of auxiliary requests I-III, all as (re-)filed with the grounds of appeal.

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

"A communication system including at least a first information processing terminal (10a) and a second information processing terminal (10b) that are communicable with each other,

the first information processing terminal comprising:

obtaining means for obtaining, from outside, a multiplayer program which allows a multiplayer between the first information processing terminal and the second information processing terminal and a basic software update program for updating basic software in the second information processing terminal such that the multiplayer program is executable on the second information processing terminal;

program storage means (35a, 44a) for storing the multiplay program and the basic software update program that have been obtained by the obtaining means;

first transmission means (311, S74, S87) for transmitting the multiplay program or the basic software update program which is stored in the program storage means, to the second information processing terminal in accordance with a request from the second information processing terminal; and

first multiplay process means for executing the multiplay with the second information processing terminal, and

the second information processing terminal comprising:

first reception means (311, S49) for receiving the basic software update program from the first information processing terminal;

first basic software update means (311, S50) for updating basic software of the second information processing terminal by using the basic software update program received by the first reception means;

second reception means (311, S35) for receiving the multiplay program from the first information processing terminal; and

second multiplay process means (311, S37) for executing the multiplay with the first information processing terminal based on the multiplay program received by the second reception means."

The wording of the other independent claims of the main request or those of the auxiliary request is immaterial for this decision.

Reasons for the Decision

The invention

1. The application addresses the problem of updating the software in a game device (see figure 1), preferably what is called a "multiplay" program (see page 17, paragraph 2), when an Internet connection or a suitable storage medium is not available (page 1, penultimate paragraph). The proposed solution is essentially to enable the game devices to exchange the required software directly with each other (see e.g. page 14, paragraph 3), be it with the game program itself (see e.g. page 17, paragraph 2), other application programs (page 31, paragraph 2) or "basic software" such as firmware (see page 1, penultimate paragraph; page 19, penultimate paragraph *et seq.*; page 26, paragraph 3 *et seq.*; page 33, paragraph 2).

The prior art

2. D1 relates to a system for installing software updates (or "patches") on computer terminals across a network with reduced demands on a human administrator (see page 4, lines 19-23, of the application as originally filed). The patches to be installed are stored on "package computers", the computers on which they are to be installed are referred to as "target computers". An "update server" is provided to mediate between the target and package computers (page 5, lines 4-6, and figure 2, no. 220), which may not be able to communicate directly with each other, e.g. due to a firewall (see page 5, lines 1-4, and figure 2, nos. 200 and 230; but see page 6, lines 11-17). On the target computers, the patch is controlled by a so-called

update agent, which communicates with the update server and/or the package computers (see page 6, lines 11-21, and the paragraph bridging pages 12 and 13).

The issues to be decided

3. The decision under appeal found claim 1 of the main request to differ from D1 essentially by the fact that the claimed terminals were capable of updating and executing "multiplay" programs (see reasons 10). The application of D1 to a different kind of program being obvious (reasons 16), and the execution of any kind of program being well-known (reasons 17), it was concluded that the claimed invention was obvious over D1 (reasons 19).
4. The appellant argued that the decision "misse[d] the fundamental distinguishing point" between the claimed invention and D1, namely "that the updating process [was] directly and automatically performed between communication terminals", whereas D1 related to updating software "across a remote network in a client-server system" (see the grounds of appeal, page 4, paragraphs 1 and 2 after the bullet points, and page 5, penultimate paragraph).
5. This argument had been raised before and was dismissed in the decision under appeal with the following words (see reasons 18):

"The applicant's arguments in favour of inventive step based on the difference between a client-server (as in D1) and a master-slave (allegedly as in claim 1) arrangement can not be agreed upon, because D1

discloses that the update already happens between terminals."

6. The appellant considered this to be a mere "assertion [...] without any substantiation" (see the grounds of appeal, page 5, paragraph 4), the decision thus being unfounded (page 5, penultimate paragraph).

The board's position

7. The description is explicit about the central idea of the invention being that two terminal devices should be able to exchange software directly between them (see e.g. figure 5). Moreover, the applicant insisted several times during examination that this was the main difference from D1 (see the submission of 9 January 2013, page 2, paragraph 6; of 8 July 2013, point II; and of 21 May 2015, page 3, paragraph 1). The examining division did not address this point (see the communications of 27 February 2013 and 23 December 2014) until the decision, which, however, contains merely the cited passage.
8. The board agrees with the appellant that the sentence is an unsubstantiated allegation.
 - 8.1 In the decision, the examining division did not refer to any specific passage in D1 which would have disclosed "that the update already happens between terminals" (see reasons 18, but also reasons 14).
 - 8.2 It reproduced the applicant's argument that D1 disclosed a client-server arrangement whereas the invention relied upon a master-slave architecture. At the same time, by suggesting that the "master-slave

[...] arrangement" was only "allegedly as in claim 1" (still reasons 18), the examining division suggested that the applicant might have misconstrued the claimed invention, without explaining what, in its opinion, the claimed invention actually specified.

8.3 It also did not explain why the devices in D1 could be read on the claimed "terminals", properly construed, in such a way that D1 might have been considered as disclosing direct communication between terminals.

8.4 In other words, the examining division failed to explain in its decision whether it dismissed the applicant's argument that D1 did not disclose direct communication between terminals because it relied on a misinterpretation of D1 or of the claimed invention, i.e. because D1 disclosed a "master-slave [...] arrangement" between terminals and where it was to be found, or because the claimed invention did not actually require a "master-slave [...] arrangement" so that the client-server architecture fell within the scope of the claimed invention.

9. As a consequence, the reasons for the decision do not carry the conclusion that the claimed invention lacks inventive step over D1. In other words, the decision under appeal is not reasoned within the meaning of Rule 111(2) EPC.

*Remittal and reimbursement of the appeal fee
Article 11 RPBA and Rule 103(1)a) EPC*

10. Lack of compliance with Rule 111(2) EPC is a fundamental deficiency, which, according to Article 11 RPBA, should lead to an immediate remittal of the case

to the examining division, unless special reasons present themselves for doing otherwise.

- 10.1 In the present case, the board is not aware of any such special reasons.
- 10.2 The board thus concludes that the decision under appeal must be set aside and the case be remitted to the examining division for further prosecution.
11. Lack of compliance with Rule 111(2) EPC is also a substantial procedure violation, which makes reimbursement of the appeal fee equitable. Since, as stated above, the appeal is also allowable, the appeal fee must be reimbursed, see Rule 103(1)(a) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:



B. Atienza Vivancos

W. Sekretaruk

Decision electronically authenticated