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**Datasheet for the decision  
of 14 March 2018**

**Case Number:** T 0591/17 - 3.5.06

**Application Number:** 03012069.5

**Publication Number:** 1357457

**IPC:** G06F1/00

**Language of the proceedings:** EN

**Title of invention:**

System and method for digital rights management using a standard rendering engine

**Applicant:**

ContentGuard Holdings, Inc.

**Headword:**

Digital rights management/CONTENTGUARD

**Relevant legal provisions:**

RPBA Art. 11

EPC R. 103(1) (a), 111(2)

**Keyword:**

"Decision according to the state of the file"  
Substantial procedural violation - appealed decision  
sufficiently reasoned (no)  
Remittal to the department of first instance  
Reimbursement of appeal fee

**Decisions cited:**

T 0278/00, T 0963/02, T 0897/03

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 0591/17 - 3.5.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.06**  
**of 14 March 2018**

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

**Representative:** Grünecker Patent- und Rechtsanwälte  
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Leopoldstraße 4  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 10 October 2016  
refusing European patent application No.  
03012069.5 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** W. Sekretaruk  
**Members:** M. Müller  
A. Teale

## **Summary of Facts and Submissions**

- I. This appeal is against the decision of the examining division dated 10 October 2016 to refuse European patent application No. 03 012 069. The following grounds for the decision were given:

*"In the communication(s) dated 04.03.2016 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein. The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 11.07.2016."*

- II. The relevant file history is as follows:

In a communication dated 22 March 2005, the examining division stated that the then claims lacked inventive step over D1 and D2. Amended claims were filed on 4 October 2005, and the appellant gave arguments why the amended claims showed the required inventive step over D1 and D2.

In a letter dated 16 February 2006, the EPO informed the appellant that examination proceedings were stayed until the Enlarged Board of Appeal had decided in case G 1/05 about questions concerning the validity of a divisional application. The decision in case G 1/05 was taken on 28 June 2007.

On 27 July 2015, the primary examiner conducted a telephone conversation with the appellant, in which - according to the corresponding minutes of 3 August 2015 - a number of clarity objections were raised and seve-

ral statements on inventive step were made, *inter alia* that the "single well disclosed implementation" in the description was known from D1 and D2 (see the minutes, page 1, paragraph 4). In response to the telephone conversation, with a letter of 14 December 2015, the appellant filed further amended claims 1-29.

Then, in the communication of 4 March 2016 referred to in the decision under appeal, the examining division reproduced claim 1 (point 2.1) and gave the following reasons:

*"2.2 The first examiner maintains the opinion that the subject-matter defined is not inventive in view of the teachings in D1 and D2 and with reasoning similar to the one in the communication of 22.03.2005 (points 6.1 - 6.4) and in the telephone conversation of 27.07.2015; furthermore document D9 is now introduced as a further example of prior art that render the subject-matter defined in claims not inventive (Article 56 EPC).*

*2.3 Document D9 is introduced to give a further example of browser and helper application able to process protected content with a standard rendering engine (see D9 figure 10 and pages 96-98 "Overview", "Application Installation", "Secure Container Processor"); D9 appears to disclose all the "security" features of claim 1 while D9 does not explicitly disclose the features:*

*"identifying a user interface description;  
building a specific user interface based on the user interface description; replacing the standard user interface of an application program used to*

*render the content with the specific user interface"*

*However D9 suggests the possibility of defining said specific user interface since "alternate layouts" are possible based e.g. on requirements from a Content Provider (see D9 page 102 lines 3-5) and the person skilled in the art would consider this possibility as implementation choice; as a conclusion the subject-matter defined in claim 1 is not inventive. With reference to the arguments in applicant's letter of 14.12.2015 it can be concluded that D9 enforce associated rights while at the same time suggesting the possibility of "tailoring" websites".*

## **Reasons for the Decision**

1. Rule 111(2) EPC provides that decisions of the EPO which are open to appeal shall be reasoned. The decision must contain, in logical sequence, those arguments which justify the tenor. All facts, evidence and arguments which are essential to the decision must be discussed in detail (see, for instance, T 278/00, point 2 of the reasons, and T 897/03, points 2 and 3 of the reasons).
2. For its reasons, the decision under appeal refers to the communication dated 4 March 2016. It is established jurisprudence of the boards of appeal that such decisions are in principle accepted, but that a decision "by reference" is only reasoned within the meaning of Rule 111(2) EPC if the communication

referred to itself contains the required reasons (see, for instance, T 963/02, point 2.1 of the reasons).

3. The communication referred to states that the then claims lacked inventive step both in view of D1 and D2 and in view of D9.
  - 3.1 As regards D1 and D2, the communication itself refers to the communication of 22 March 2005 and the telephone conversation of 27 July 2015. In each of these instances, a different set of claims was before the examining division. It is, thus, not clear to what extent the reasons in the earlier communication and telephone conversation still applied to the claims on file when the decision was taken and to what extent they were overcome by the appellant's arguments put forward in the meantime. The examining division appears to concede this by stating in the communication of 4 March 2016 that only "similar" reasoning applied to the claims pending at the time, without however explaining to what extent the earlier reasoning still applied and to what extent it had to be adapted.
  - 3.2 As regards D9, the communication refers to three entire pages and a complete figure of D9 to show that all the "security" features of claim 1 were known from that document. The communication does not, however, define the security features or, as a consequence, state which features the examining division considered to be disclosed in D9. In other words, the communication leaves open whether the feature said not to be explicitly disclosed in D9 is the only difference between claim 1 and D9, and thus whether showing a lack of inventive step of that feature would be sufficient to show a lack of inventive step of claim 1 as a whole. Also the broad brush reference to large parts of D9 is

an obstacle to determining which features of claim 1 the examining division considered to be known from D9 and why. Moreover, in the reasons given as to why the difference feature was considered obvious over D9, the examining division seems to suggest that the interpretation of D9 depended, in an undefined way, on arguments given by the applicant.

- 3.3 In summary, the board considers that neither the reasons referring to D1 and D2 nor those referring to D9 show, in logical sequences, all the facts and arguments that justify the finding that claim 1 lacks inventive step, and that therefore the reference to the communication of 4 March 2016 is insufficient to provide the reasons required under Rule 111(2) EPC.

*Article 11 RPBA and Rule 103(1)(a) EPC*

4. An insufficiently reasoned decision constitutes a fundamental deficiency of the first instance proceedings, Article 11 RPBA, and a substantial procedural violation, Rule 103(1)(a) EPC.
- 4.1 According to Article 11 RPBA, the board shall remit the case to the department of first instance, unless special reasons present themselves for doing otherwise. The board has considered whether the age of the present application constitutes such a special reason. In this regard, the board notes that it took the examining division almost ten years to react to the appellant's letter of 4 October 2005, only a small part of which was due to the staying of examination proceedings.
- 4.2 However, taking into account that the appellant did not once, between 2005 and 2015, even enquire about the progress of examination proceedings, and did not



address the overall length of the proceedings in its grounds of appeal, the board has decided that the age of the case does not constitute a special reason for not remitting the case.

- 4.3 However, when a decision is set aside and the case remitted to the examining division, without an assessment of the merits of the appeal, due to a substantial procedural violation, reimbursement of the appeal fee under Rule 103(1)(a) EPC is normally equitable. In the present case, the board has no reason to deviate from this practise.

## Order

### **For these reasons it is decided that:**

1. The decision 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