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**Datasheet for the decision
of 24 November 2022**

Case Number: T 2745/18 - 3.5.01

Application Number: 12711497.3

Publication Number: 2673742

IPC: G06Q30/00, H04L29/08

Language of the proceedings: EN

Title of invention:

INTELLIGENT DELIVERY AND ACQUISITION OF DIGITAL ASSETS

Applicant:

Apple Inc.

Headword:

Providing a digital asset to two user devices/APPLE

Relevant legal provisions:

EPC Art. 56

RPBA Art. 12(4)

Keyword:

Inventive step - providing an asset bought in an online store to a purchasing user device and a further user device (no - business method; obvious implementation)

Decisions cited:

T 0641/00, T 2423/10



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Case Number: T 2745/18 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 24 November 2022

Appellant: Apple Inc.
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Representative: Barton, Russell Glen
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 19 June 2018
refusing European patent application No.
12711497.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman M. Höhn
Members: W. Zubrzycki
E. Mille

Summary of Facts and Submissions

- I. This is an appeal against the decision of the examining division to refuse the European patent application No. 12711497.3 for lack of inventive step (Article 56 EPC).
- II. The contested decision held that the subject-matter of claim 1 of the main request and first auxiliary request did not involve an inventive step over D1 (WO 2009/032805 A2), especially considering the disclosures of D2 (WO 2004/061608 A2) and/or D6 (US 2010/057884 A1) and/or D8 (US 2006/173974 A1). The decision mentioned that the subject-matter of dependent claim 8 of the main request was obvious over D1 in view of the disclosures of D4 (US 2007/174888 A1) and D7 (US 2007/150550 A1).
- III. In the statement setting out the grounds of appeal, the appellant requested that the decision be set aside and a patent be granted on the basis of the main request or first to second auxiliary requests filed therewith. The main request and the first auxiliary request corresponded to the refused requests. The second auxiliary request was new.
- IV. In the communication accompanying the summons to oral proceedings, the Board expressed its preliminary view that all the requests lacked an inventive step.
- V. By letter dated 7 November 2022 and received on 23 November 2022, the appellant announced that nobody would be attending the oral proceedings.

VI. Oral proceedings were held by videoconference on 24 November 2022 in absentia. After due consideration of the appellant's written requests and arguments the chairman announced the decision.

VII. Claim 1 of the main request reads:

"An electronic system for delivering a digital asset from an online store server to an electronic device via a network, comprising:

means for detecting that a first digital asset has been acquired from an online store server by an acquisition device associated with a first user account;

means for arranging delivery of the first digital asset in a first format to the acquiring device, wherein the first format is determined based on the acquisition device;

means for determining, by the online store server, that the first digital asset should be automatically delivered to a second electronic device based on a previous indication by the second electronic device to the online store server for automatically receiving acquired digital assets, other than the acquisition device, that is also associated with the first user account; and

means for arranging delivery of the first digital asset in a second format, different than the first format, to the second electronic device, wherein the second format is determined based on the second electronic device."

VIII. Claim 1 of the first auxiliary request adds at the end of the penultimate feature after "account" the following wording:

"wherein the determination is based at least in part on

the asset type".

- IX. Claim 1 of the second auxiliary request adds at the end of claim 1 of the main request the following wording:

"wherein the means for arranging delivery to the second electronic device comprises:

means for queuing the first digital asset in a delivery queue for delivery to the second electronic device; and means for sending to the second electronic device a push notification indicative of the first digital asset being available for download from an online repository; wherein the means for queuing the digital asset comprises:

means for prioritizing contents of the delivery queue associated with the second electronic device such that digital content explicitly requested by the first user account would be delivered to the second electronic device before the digital asset acquired via the acquisition device."

- X. The appellant essentially argued as follows.

In addition to the distinguishing features indicated in the contested decision, claim 1 differed from D1 in that a purchased asset was delivered to an acquisition device, i.e. the device used for the purchase, and to a second device. By contrast, Figure 2 of D1 clearly showed that the asset was provided either to the acquisition device or to another device, but not to both. Thus, D2 taught away from the claimed solution (grounds of appeal, page 3, second paragraph and page 7 second paragraph).

The distinguishing features interacted synergistically because, firstly, they were linked by using the second

device and, secondly, they collectively solved the overarching problem of synchronising the claimed devices with respect to the digital asset (page 4, paragraphs 3 to 5).

Providing the same content in two different formats was not disclosed in the prior art and therefore not obvious (page 5, first paragraph). Using the second device to indicate that it should receive the asset was not obvious in view of D1 at paragraph [40] which disclosed that the user specified download destinations using the acquisition device and, therefore, taught away from this feature (page 6). Since the indication to receive the asset was based on the capabilities of the second device, it was advantageous to receive it directly from this device rather than from another device (page 3, seventh paragraph).

The prior art did not disclose the queue prioritising scheme claimed by the second auxiliary request and this feature was therefore not obvious (page 9, second paragraph).

Reasons for the Decision

1. The invention
 - 1.1 Claim 1 of the main request concerns an online store system providing a purchased digital asset to multiple user devices (published international application, paragraph [5]). While not claimed, the asset might include a song, movie or textual content ([27]).
 - 1.2 Looking at Figure 1, the system comprises a server 102, hosting the online store, and multiple user devices to

which the digital assets are downloaded, such as a portable electronic device 106 and a desktop computer 110 ([27]). These user devices are associated with the user's account at the online store ([38], last sentence).

When the user accesses the online store and purchases an asset using one of those devices ("*an acquisition device*" in claim 1), the asset is provided to this device and to a second electronic device based "*on a previous indication by the second electronic device to the online store*" (cf. third claimed feature). While not claimed, but disclosed in the application, the indication might for instance specify that the second electronic device should receive only certain media types ([56]).

The server delivers the asset to the second device and the acquisition device in different formats, based on the devices. The description does not provide any examples of formats used and does not explain how and based on what criteria it is determined which format should be used for each of the devices ([30] and [49]).

2. Main request

2.1 Claim 1, Article 56 EPC

2.1.1 It is common ground that document D1 is the closest prior art. Like the claimed invention, it concerns an online store server providing purchased digital assets, such as songs, to multiple registered user devices (see paragraphs [20], [21] and [43]).

D1 discloses that when the user purchases an asset using one of the registered devices, the online store

server provides this asset to either this device or to one or more other devices, corresponding to a second device in claim 1 ([27] to [30] and Figure 2). The latter occurs for example if a purchased asset, such as full-length movie, is found to be too large to be downloaded to the portable device from which it was purchased; such an item is instead downloaded to the desktop device and possibly further suitable devices ([22] and [30]).

D1 discloses that the indication of which asset types should be downloaded to which user device is part of delivery preferences set prior to the purchase (see [39], first sentence). These delivery preferences correspond to the "*previous indication by the second electronic device to the online store server for automatically receiving acquired digital assets*", as defined in claim 1.

2.1.2 Using the lettering at point 2.1.1, the contested decision held that claim 1 differed from D1 in that:

- a) The formats in which the asset is delivered to the acquisition device and to the second device are different and determined based on the devices, whereas D1 does not mention using formats at all.
- b) The indication to the online store server for automatically receiving acquired digital assets is provided by the second electronic device.

2.1.3 However, the Board agrees with the appellant (see section X. above) and judges that claim 1 additionally differs from D1 in that:

- c) The asset is provided to the acquisition device and to the second user device, whereas in D1 the asset is

provided to either the acquisition device or to one or more second user devices.

- 2.1.4 The Board disagrees with the appellant that the distinguishing features interact synergistically. The appellant's arguments in this respect are not convincing.

Firstly, the mere fact that the distinguishing features relate, or as the appellant put it are linked, to the second device is not a synergetic effect.

Secondly, synchronising devices with respect to a digital asset cannot constitute a synergistic technical effect, because it is not derivable based on a comparison between the claimed invention and D1. The system of D1 already provides the same asset to more than one registered user device, albeit not to the acquisition device and a further device (cf. decision, page 10, second paragraph). Accordingly, the actual effect of feature (c) lies in the alternative choice of the receiving devices. The Board cannot see that features (a) and (b) interact synergistically with this choice.

- 2.2 Concerning feature (a), the Board judges that, at the level of generality at which it is specified, this feature does not contribute to any (further) technical effect. As set out above, the description says that the "digital asset" includes textual content (cf. [27], line 6) and, when used with respect to texts, formatting covers using different fonts or text styles. This, however, relates to presentation of information and lacks technical character. The claimed formulation "based on the device" does not necessarily imply that any technical criteria are applied for selecting

formats.

- 2.3 Incidentally, the Board judges that feature (a) is obvious even if it is narrowly interpreted as meaning that songs are provided to the claimed devices in different audio formats selected based on those devices' rendering capabilities. The Board considers that the skilled person faced with the problem of ensuring that the devices can optimally render and store received audio assets would have readily considered using different audio formats, such as WAV and MP3. The obviousness of this solution is even more evident in view of document D2 cited in the decision, which discloses providing audio content in a format supported by a receiving device, see page 32, lines 18 to 27.
- 2.4 Concerning feature (b), the Board starts the assessment of inventive step from the embodiment set out at paragraph [39], first sentence of D1. The appellant argued that in D1 the asset delivery preferences were always set by the acquisition device. However, Figure 5 and paragraph [42], on which this argument relies relate to a different embodiment, whereas the paragraph [39] embodiment leaves open which devices are used for setting the delivery preferences, as essentially acknowledged in the grounds of appeal (page 3, sixth paragraph).
- 2.5 The Board judges that, starting from this embodiment it is obvious to specify the asset types to be accepted by the second device, such as the desktop computer, on the device itself. Interpreted in line with the appellant's argument as meaning that the indication from the second device is based on the capabilities of this device (which is not claimed), the feature is even more

obvious. The easiest way of indicating the second device's capabilities to the server is to upload this device's settings to the server.

- 2.6 Turning to feature (c), the Board judges that providing the asset to the acquisition device and a second device, follows from a business requirement.

In an ancillary line of reasoning the contested decision referred to decision T 2423/10 which concerned an online store, essentially identical to the claimed one, which provided a purchased asset to one device chosen from multiple suitable devices. T 2423/10 stated at point 6 of the reasons that *"the range of devices suitable for receiving the "digital asset" is broad, but there are commercial reasons for limiting delivery to one device. The seller might, for example, want to charge the customer a fee for each device to which the "digital asset" is sent"*.

The Board takes the view that this finding applies equally to the claimed choice of receiving devices. More particularly, the Board considers that, like the choice discussed in T 2423/10, the claimed choice is also based on business considerations, presumably on the applied fee scheme, and lacks technical character. Hence, applying the COMVIK approach, the business requirement to deliver the asset to the acquisition device and the second device is given to the technically skilled person within the framework of the technical problem.

- 2.7 Contrary to the appellant's view, the technically skilled person is constrained by this requirement specification and would implement it, even if this runs

against D1's teaching.

2.8 The Board judges that adapting the system of D1 to provide the asset to the claimed choice of receiving devices does not pose any technical difficulty. As stated in the contested decision (see point 2.1.1, penultimate paragraph), D1 discloses all the necessary means for providing an asset to any subset of available devices (see paragraphs [21] and [40]).

2.9 Hence, claim 1 lacks an inventive step (Article 56 EPC).

3. First auxiliary request

3.1 Claim 1 of the first auxiliary request adds to claim 1 of the main request that the determination whether the digital asset should be automatically delivered to the second device is "based at least in part on the asset type".

3.2 The Board agrees with the contested decision that this feature is disclosed in D1 at paragraph [21]. Incidentally, claim 20 of D1 also discloses this feature, almost literally.

3.3 Hence, claim 1 of the first auxiliary request does not add any distinguishing features to claim 1 of the main request and lacks an inventive step for the above reasons.

4. Second auxiliary request

4.1 Admittance

The Board admits the second auxiliary request into the

proceedings under Article 12(4) RPBA 2007. The reason is that the subject-matter of claim 1 of this request does not present the Board with any new issues. This claim combines claim 1 of the main request with dependent claim 8 which was discussed in the contested decision at points 2.1.5.2 and 2.1.5.3.

4.2 Article 56 EPC, claim 1

4.2.1 However, the Board judges that claim 1 of the second auxiliary request does not add anything inventive.

4.2.2 Claim 1 adds the following features to claim 1 of the main request:

d) *Means for queuing the first digital asset in a delivery queue for delivery to the second electronic device;*

e) *Means for sending to the second electronic device a push notification indicative of the first digital asset being available for download from an online repository;*

f) *Means for prioritizing contents of the delivery queue associated with the second electronic device such that digital content explicitly requested by the first user account would be delivered to the second electronic device before the digital asset acquired via the acquisition device.*

4.2.3 Concerning feature (d), the Board agrees with the contested decision that D1 discloses it at paragraphs [36] and [37] (decision, point 2.1.5.2).

4.2.4 Features (e) and (f) are novel over D1.

4.2.5 As regards feature (e), the Board agrees with the contested decision that sending a notification

informing the second device that an asset is available for download is obvious in view of D7, see Figure 2 (decision, point 2.1.5.2).

- 4.2.6 Concerning feature (f), the Board notices that "*the digital asset acquired via the acquisition device*" is "*explicitly requested by the first user account*" with which this device is associated (cf. first claim feature). Accordingly, feature (f) covers a queue containing only items acquired via the acquisition device whose order need not be altered in any way. It follows that the claimed means for prioritising the queue do not produce any technical effect.
- 4.2.7 Incidentally, even if it is generously interpreted as meaning that digital assets purchased directly using the second user device are prioritised higher and delivered sooner than assets purchased using other devices, feature (f) still lacks an inventive step. In the Board's judgment, it is then an obvious implementation of the business requirement that a digital asset ordered from a certain address, e.g. from home, should be delivered at this address before digital assets ordered from other addresses, such as the office.
- 4.2.8 Hence, claim 1 of the second auxiliary request lacks an inventive step (Article 56 EPC).
5. Accordingly, none of the requests fulfils the requirements of the EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



T. Buschek

M. Höhn

Decision electronically authenticated