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**Datasheet for the decision
of 25 May 2023**

Case Number: T 1622/21 - 3.4.02

Application Number: 12005999.3

Publication Number: 2587466

IPC: G09B7/00

Language of the proceedings: EN

Title of invention:

Variation and control of sensory work playback

Applicant:

Sony Computer Entertainment America Inc.

Headword:

Relevant legal provisions:

EPC Art. 56, 111(1)
EPC R. 103(1) (a), 111(2)
RPBA 2020 Art. 11

Keyword:

Substantial procedural violation - (yes) - appealed decision
reasoned (no) - reimbursement of appeal fee (yes)
Remittal - (yes)

Decisions cited:

Catchword:



Beschwerdekammern

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Case Number: T 1622/21 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 25 May 2023

Appellant: Sony Computer Entertainment America Inc.
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 3 May 2021
refusing European patent application No.
12005999.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman R. Bekkering
Members: A. Hornung
B. Müller

Summary of Facts and Submissions

I. The applicant appealed against the decision of the examining division refusing European patent application No. 12005999.3 on the basis of Article 97(2) EPC because the requirements of Article 56 EPC were not fulfilled.

II. The applicant requested that the decision under appeal be set aside and a patent be granted on the basis of the claims in accordance with a main request or one of auxiliary requests 1 to 9', all requests filed with the statement setting out the grounds of appeal. The sets of claims of the main request and of auxiliary request 1 are identical to those of the main request and of auxiliary request 1 underlying the appealed decision, respectively.

III. The present communication refers to the following documents dealt with in the proceedings before the examining division:

D1: US 2004/0268384 A1,

D2: US 2003/0014768 A1.

IV. Claim 1 of the main request reads as follows (the features of claim 1 of the main request will be referred to as **F1** to **F7** added by the board):

F1 "A method for inserting advertising content during content playback in a media player, the method comprising:

F2 receiving sensory work;

F3 receiving advertising content;

F4 receiving a playback control record, the playback control record defining an advertising content insertion event;

F5 in response to the defined advertising content insertion event, varying the playback of the received sensory work by inserting the advertising content as additional information into the received sensory work,

F6 providing in the playback control record separate identifiers for different sources of the sensory work; and

F7 taking into account the separate identifiers in accordance with the source of the sensory work when varying the playback of the sensory work".

Reasons for the Decision

1. Substantial procedural violation

1.1 An appealable decision must be reasoned

According to Rule 111(2) EPC, appealable decisions must be reasoned. As stated in the Case Law of the Boards of Appeal, 10th edition, III.K.3.4.1, this general principle of law "is intended to ensure fairness between the EPO and parties to proceedings and enable the decision to be reviewed on appeal". This requirement has been interpreted consistently by the boards of appeal as meaning that "all decisive considerations in respect of the factual and legal aspects of the case must be discussed in detail in the decision" and that a decision "has to contain the logical chain of reasoning which led to the relevant conclusion" (Case Law of the Boards of Appeal, 10th edition, III.K.3.4.3).

1.2 Appealed decision

The grounds for the decision concerning the lack of inventive step of the subject-matter of claim 1 of the main request are divided into three chapters having the titles "1 Preliminary Remarks", "2 Main Request" and "3 The Arguments of the Applicant", respectively.

1.2.1 In the first chapter "1 Preliminary Remarks", the examining division sets out its general view that "the subject-matter of the application concerns 'playback of sensory work', which is tantamount to the display on *[sic]* information within the meaning of Article 52(2) EPC" (grounds for the decision, point 1.1). In point 1.2 of the grounds for the decision, the examining division states that "those features which do lie in a field of technology and do relate to what is being displayed are a given to the skilled man". In point 1.3 of the grounds for the decision, it is stated that "[t]he independent claim (...) all relate to what information is presented to whom at what time. This is inherently non-technical, and may therefore be considered to be a requirement specification for a skilled man to implement. That skilled man would then implement these *[sic]*, using well-known features (cf. also documents D1 and D2) of media players". All these statements of the examining division in points 1.1 to 1.3 of the grounds for the decision may be considered to be generally valid. However, the board is unable to see any concrete link between these general statements and the features of claim 1 of the main request.

The examining division further explains that a "suitable MPEG coding scheme" is disclosed in D1 (point 1.3.1 of the grounds for the decision). The relevance of this brief statement of the examining division to the present claim

1, without further explanations, is not self-evident, because claim 1 does not mention any "MPEG coding scheme".

Therefore, as suggested in its title, the first chapter "1 Preliminary Remarks" does not comprise a reasoning for refusing the main request.

- 1.2.2 The third chapter "3 The Arguments of the Applicant" sets out the applicant's arguments in favour of inventive step of the subject-matter of claim 1 and the examining division's reasons why the applicant's arguments were not found convincing. The purpose of this part of the decision is to demonstrate that the requirement of the applicant's right to be heard has been respected, in the sense that the applicant has had the opportunity to present its arguments in favour of granting a patent and to hear the examining division's reasoning as to why its arguments were not convincing. In this chapter, the examining division explains why certain specific arguments of the applicant were not found convincing. Yet no logical chain of reasoning can be found to show that the subject-matter of the claim lacks inventive step.

Therefore, the third chapter "3 The Arguments of the Applicant" cannot be regarded as self-contained reasoning of the examining division for denying that the subject-matter of claim 1 involves an inventive step.

- 1.2.3 In the second chapter titled "2 Main Request", the entire reasoning as to why the subject-matter of claim 1 lacks an inventive step is limited to the two following paragraphs:

"What is claimed is a server with a database in a network like the Internet. That much is held to be notorious at the date of priority of the present application, which, in the opinion of the Division,

cannot reasonably be disputed - in particular since it is also depicted in figure 1 of D1.

The Division therefore assesses that the driving force behind the subject-matter of claim 1 is the display of information (which cannot contribute to the technical character of the claim) and the implementation thereof being within the reach of the skilled man."

The first paragraph refers to a server that should be claimed and points out that "a server with a database in a network like the Internet" is notorious. However, claim 1 of the main request does not comprise any server. Therefore, these general findings cannot be regarded as a reasoning of lack of inventive step.

The second paragraph contains only assertions without providing any explanation or evidence to support these assertions.

None of the actual features of claim 1 are even mentioned in the examining division's reasoning. For instance, even though the exact meaning of the features "separate identifiers", "taking into account the separate identifiers" and "the source of the sensory work", defined in features **F6** and **F7**, would appear to be unclear (Article 84 EPC), features **F6** and **F7** seem to be technical features, whose possible contribution to inventive step would have had to be examined in detail.

1.2.4 In conclusion, neither are "all decisive considerations in respect of the factual and legal aspects of the case discussed in detail in the decision", nor does the appealed decision "contain the logical chain of reasoning which led" to the finding of the subject-matter of claim 1 lacking an inventive step.

- 1.3 Failure to state adequate reasons for the examining division's decision of lack of inventive step is considered a substantial procedural violation (Case Law of the Boards of Appeal, 10th edition, V.A.11.6.9).
2. Insufficient reasoning in the appealed decision prevents the board from following the line of argument having led to the examining division's finding of lack of inventive step. Therefore, the appealed decision must be set aside and the case be remitted to the first instance for further prosecution in accordance with Article 111(1) EPC and Article 11 RPBA.
3. The substantial procedural violation justifies the reimbursement for reasons of equity of the appeal fee (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 department of first instance for further prosecution.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:



L. Gabor

R. Bekkering

Decision electronically authenticated