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

**Case Number:** T 1623/21 - 3.4.02

**Application Number:** 12006000.9

**Publication Number:** 2587467

**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, 84, 76(1), 111(1), 123(2)  
RPBA 2020 Art. 11

**Keyword:**

Inventive step - identification of technical and non-technical  
features - problem-solution approach  
Remittal - fundamental deficiency in first-instance  
proceedings (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**

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**Case Number: T 1623/21 - 3.4.02**

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

**Appellant:**  
(Applicant)

Sony Computer Entertainment America Inc.  
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**Representative:**

Eisenführ Speiser  
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**Decision under appeal:**

**Decision of the Examining Division of the  
European Patent Office posted on 30 April 2021  
refusing European patent application No.  
12006000.9 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. 12006000.9 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 7', 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 **F10** added by the board):
- F1** "A playback method for use in a network media player being part of a network of a plurality of network media players, the method comprising:
- F2** receiving a sensory work;

**F3** receiving a user-generated playback control record generated by a user of one of the plurality of network media players,

**F4** the user-generated playback control record corresponding to the received sensory work,

**F5** the playback control record defining overlay information to be overlaid onto the received sensory work,

**F6** wherein the user-generated playback control record identifies a source of the overlay information;

**F7** receiving from the source the overlay information identified by the user-generated playback control record; and

**F8** varying playback of the received sensory work according to the user-generated playback control record such that the overlay information is overlaid during the playback of the sensory work,

**F9** wherein a frame of reference is created in time by identifying an epoch time (t0) and

**F10** associating this time with the playback of the sensory work such that the overlay defined by the user-generated playback control record is applied at a defined instance relative to the epoch time (t0)".

## **Reasons for the Decision**

1. Main request

1.1 Appealed decision

According to the appealed decision, point 2.8 of the grounds for the decision, "the subject-matter of the claims are devoid of inventive merit, and obvious within the meaning of Article 56 EPC".

1.1.1 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). In point 2.2 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 and 2.2 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 actual features of claim 1 of the main request.

1.1.2 Points 2.3 to 2.7 of the grounds for the decision set 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. In these points, although the examining division explains why certain specific arguments of the applicant were not found convincing, no logical and self-contained chain of reasoning can be found to show that the subject-matter of claim 1 lacks inventive step.

1.1.3 Contrary to the examining division's view expressed in point 2.3 of the grounds for the appealed decision, overlaying information onto a received sensory work at a specific instance relative to the epoch time amounts to a technical task. Indeed, as explained by the applicant (statement of grounds of appeal, point II.1, pages 2 to 4), the technical task underlying the playback method of claim 1 includes identifying a source of the overlay information (feature **F6**), controlling the communication of the network media player with the identified source of the overlay information (feature **F7**), controlling the subsequent playback carried out by the network media player (feature **F8**) and defining a point in time at which the overlay is overlaid onto the sensory work (features **F9** and **F10**).

1.1.4 In points 2.4, 2.4.1 and 2.4.2 of the grounds for the decision, the examining division mentions an "original version" of data and an "amended version" of data when altering data, asserts that present claim 1 relates to "non-technical display of information or [to] the notorious functionality of rewinding" and refers to D1, [0019], to show that "the skilled person is very much aware of how this technology works and how it is standardised".

The board is unable to follow the examining division's reasoning as there is no clear link to the actual wording of claim 1. In particular, claim 1 does not define a functionality of rewinding. Moreover, in view of the

method steps referred to in point 1.1.3 above, the board is not convinced that claim 1 only defines "non-technical display of information". Finally, to convincingly argue lack of inventive step, it is not sufficient to assert that the skilled person is aware of the underlying technology. It must also be shown that the skilled person had a clear incentive to apply the presumably known technology in a particular way, namely to arrive at the claimed subject-matter.

- 1.1.5 In points 2.5 and 2.5.1 of the appealed decision, the examining division explains why, in its view, it is difficult to assess whether an efficiency gain is actually achieved by the features of claim 1, because it was not clear in the applicant's argumentation "what should be efficient".

The board is not convinced by the examining division's argumentation. Indeed, as persuasively explained by the applicant (statement of grounds of appeal, page 3, lines 17 to 20), by applying the playback method of claim 1 "bandwidth requirements for sharing tailored versions of sensory works between many users" are significantly reduced. This amounts to an efficiency gain.

- 1.1.6 It follows that the reasons of the appealed decision for showing that the subject-matter of claim 1 lacks an inventive step are not found convincing by the board.

At least some of the method steps of claim 1 are technical features having a technical content going beyond the mere display of information. Therefore, the technical content of these features may not be ignored when assessing the inventive step of the subject-matter of claim 1. Rather, the assessment of inventive step should, in principle, have been carried out on the basis of the problem-solution



approach, including the definition of an objective technical problem solved by the distinguishing technical features of claim 1. If the problem-solution approach was not used, the examining division should have explained the reasons for not using it.

## 1.2 Clarity

It is doubtful whether claim 1 complies with the requirements of Article 84 EPC.

For example, it is doubtful whether feature **F6** is clear because neither the characteristics of the source of the overlay information nor its relationship to the network of a plurality of network media players of claim 1 are defined.

## 1.3 Amendments

It is doubtful whether claim 1 complies with the requirements of Articles 76(1) and/or 123(2) EPC.

For example, it is doubtful whether there is a clear and unambiguous basis in the application documents as originally filed of the parent application for (i) a source of the overlay information and (ii) an identification of this source of the overlay information by the playback control record.

Moreover, present claim 1 comprises a certain number of features allegedly taken from the description which therefore in principle raise the question of unallowable intermediate generalisation.

## 2. Further prosecution - remittal

- 2.1 The reasons given in the appealed decision for showing that the subject-matter of claim 1 lacks an inventive step are deficient and hardly comprehensible by the board.

In particular, the examining division did not clearly determine which features of claim 1 are technical features and which are non-technical features. Furthermore, no detailed reasons were given as to why some features of claim 1 are non-technical. Still further, the examining division's finding that the subject-matter of claim 1 lacked an inventive step was not based on applying the problem-solution approach, comprising the steps of identifying the distinguishing features of claim 1 over the disclosure of the closest prior art, determining which distinguishing features are technical features and which are non-technical features, determining the technical effect of the distinguishing features which are technical, deducing therefrom the objective technical problem solved by the distinguishing features, looking for an incentive for the skilled person to solve the objective technical problem and analysing whether the solution as claimed was obvious in view of the available prior art.

While the use of the problem-solution approach is not mandatory because it is not always reasonably applicable, if it is not used, the examining division should have explained the reasons for not using it.

Despite the serious deficiencies in the examining division's reasoning mentioned above, in the board's view the decision cannot be considered as not reasoned for the purposes of Rule 111(2) EPC. The applicant did not rely on a lack of sufficient reasoning either.

- 2.2 As explained in point 2.1 above, the appealed decision is seriously flawed because the examining division neither

made a clear division of the features of claim 1 into technical and non-technical features nor properly applied the problem-solution approach.

Therefore, the appealed decision must be set aside.

- 2.3 In order to determine the further course of action, the following aspects have to be considered:

Re-examination of the patentability of claim 1 on a different basis is necessary, including the consideration of the technical character of certain features of claim 1 and the correct application of the problem-solution approach (if no reasons for not applying this approach are provided).

Furthermore, the examining division might have to take into account that the compliance of claim 1 with the requirements of Articles 76(1), 84 and/or 123(2) EPC seems to be doubtful.

Due to these aspects, the board is confronted with a fresh case, the examination of which is not compatible with the primary object of the appeal proceedings to review the decision under appeal in a judicial manner.

In view of these considerations, the board decides to make use of its discretion under Article 111(1) EPC and Article 11 RPBA 2020 in remitting the case to the examining division for further prosecution.

## **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.

The Registrar:

The Chairman:



L. Gabor

R. Bekkering

Decision electronically authenticated