Datasheet for the decision
of 29 May 2018

Case Number: T 2342/13 - 3.5.07
Application Number: 10000250.0
Publication Number: 2182518

IPC: G11B27/32, G11B27/34,
     G11B27/36, H04N5/85, G11B20/00,
     G11B20/10, G11B27/10

Language of the proceedings: EN

Title of invention:
A reproducing apparatus, a system, a reproducing method, a control program and a computer-readable recording medium storing the software for content authentication

Applicant:
Sharp Kabushiki Kaisha

Headword:
Reproducing apparatus IV/SHARP

Relevant legal provisions:
EPC Art. 76(1)
RPBA Art. 12(4)
Keyword:
Late-filed request - second and third auxiliary requests - admission (yes)
Amendments - main and first and second auxiliary requests - added subject-matter (yes)
Remittal to the department of first instance - third auxiliary request - (yes)

Decisions cited:
G 0007/93, T 1816/11, T 2330/12
Case Number: T 2342/13 - 3.5.07

DECISION
of Technical Board of Appeal 3.5.07
of 29 May 2018

Appellant: Sharp Kabushiki Kaisha
(Applicant)
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Decision under appeal: Decision of the Examining Division of the European Patent Office posted on 17 June 2013 refusing European patent application No. 10000250.0 pursuant to Article 97(2) EPC

Composition of the Board:
Chairman R. Moufang
Members: R. de Man
M. Jaedicke
**Summary of Facts and Submissions**

I. The applicant (appellant) appealed against the decision of the Examining Division refusing European patent application No. 10000250.0.

II. The application was filed in English as a divisional application of European patent application No. 04792222.4 (the parent application), which had been filed as international application PCT/JP2004/014954 and published in Japanese as WO 2005/036544 and in English as EP 1 679 706 A1.

III. After holding oral proceedings, the Examining Division issued a communication under Rule 71(3) EPC, expressing the intention to grant a patent on the basis of a third auxiliary request. The applicant subsequently disapproved of the proposed text, maintained its main and first auxiliary requests and filed an amended second auxiliary request.

IV. The Examining Division then resumed the examination proceedings and finally refused the application. It decided that the subject-matter of claim 1 of both the main request and the first auxiliary request was not new in view of the following document:


It refused to admit the second auxiliary request into the proceedings under Rule 137(3) EPC. The decision makes no mention of a third auxiliary request.

V. Along with the statement of grounds of appeal, the appellant resubmitted the main and first and second auxiliary requests and filed a third auxiliary request.
corresponding to the text proposed in the Examining Division's communication under Rule 71(3) EPC.

VI. In a communication accompanying a summons to oral proceedings, the Board introduced the following document:


It inter alia expressed the preliminary opinion that the subject-matter of claim 1 of all requests lacked inventive step and raised questions concerning Article 76(1) EPC, in particular inviting the appellant to indicate a basis in the parent application for the subject-matter of its requests. It also noted that the description appeared to contain matter extending beyond the content of the parent application as filed and suggested that that objection could be overcome by deleting the text on page 94, line 22, to page 95, line 11.

VII. In its written submissions in preparation for the oral proceedings, the appellant agreed to the Board's suggestion to delete the text on page 94, line 22, to page 95, line 11, of the description and commented on the substantive points raised in the Board's communication.

VIII. By letter of 20 February 2018, the appellant informed the Board that it would not attend the oral proceedings.

IX. Oral proceedings were held in the appellant's absence on 6 March 2018. At the end of the oral proceedings,
the chairman announced that the decision would be issued in writing.

X. The appellant requests that the decision under appeal be set aside and that a patent be granted on the basis of the main request or, in the alternative, on the basis of one of the first to third auxiliary requests.

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

"A reproducing apparatus, comprising:
   data acquiring means (50) for acquiring video data, a program for reproducing the video data, a play list indicating (i) the video data to be reproduced by the program and (ii) an order in which the video data is to be reproduced, and program management information for controlling execution of the program;
   decoding means (20) for decoding the video data;
   and
   program executing means (70) for executing the program,
   characterized in that the reproducing apparatus further comprises general control means (80') for permitting, with reference to the program management information, the program executed by the program executing means (70) to reproduce the video data with reference to the play list."

XII. Claim 1 of the first auxiliary request reads as follows:

"A reproducing apparatus, comprising:
   data acquiring means (50) for acquiring video data, a program for reproducing the video data, and program management information for controlling execution of the program;
decoding means (20) for decoding the video data; and
program executing means (70) for executing the program,
characterized in that the program management information includes content data specifying information for specifying video data items to be reproduced by the program and an order in which the video data items are to be reproduced,
the reproducing apparatus further comprises general control means (80') for determining, in accordance with the content data specifying information, that the program executed by the program executing means (70) is permitted to reproduce the video data items specified by the content data specifying information included in the program management information for the program in the order specified by the content data specifying information, and
the general control means (80') prohibits the program controlled by the program management information acquired by the data acquiring means from reproducing video data not specified by the content data specifying information being included in the program management information for the program."

XIII. Claim 1 of the second auxiliary request differs from claim 1 of the main request in that the characterising part has been replaced with:

"the program executing means (70) executes the program in accordance with a program specifying information item (program_file_name) included in the program management information,
the program is acquired via a network,"
the video data is acquired from an optical disk, and
the reproducing apparatus further comprises general control means (80') for permitting, with reference to the program management information, the program being executed by the program executing means (70) to reproduce the video data with reference to the play list."

XIV. Claim 1 of the third auxiliary request reads as follows:

"A reproducing apparatus, comprising:
    data acquiring means (50) for acquiring video data, a program for reproducing the video data and program management information for controlling execution of the program, the program management information comprising certificate data;
    a video reproducing section (20) for reproducing the video data; and
    program executing means (70) for executing the program,
    wherein upon an interruption carried out by the video reproducing section (20) a general control means (80') acquires video data information indicating the video data to be reproduced and public key data, and verifies if the program is allowed to reproduce the video data, using the video data information, the public key data and the certificate data."

XV. The appellant's arguments where relevant to the decision are discussed in detail below.
Reasons for the Decision

1. The appeal complies with the provisions referred to in Rule 101 EPC and is therefore admissible.

2. The invention

2.1 The application relates to an apparatus for reproducing content, including video data and computer programs. The content is acquired from a content-recording medium such as an optical disk by means of a "data acquiring means". The apparatus includes a "decoding means" for decoding video data and a "program executing means" for executing programs.

2.2 The independent claims of all requests are directed to verifying whether the reproduction of video data associated with a program is allowed.

3. The description

The Board is aware that the passage on page 94, line 22, to page 95, line 11, of the application as filed ("In cases where ... irrelevant to the program.") may contain a mistranslation of the original PCT application (see decision T 2330/12 of 15 January 2018, reasons 3.1, which deals with another divisional application of the same parent application). Since the appellant has agreed to delete this passage from the description of the application at issue, this potential violation of Article 76(1) EPC has now been removed.
Main request

4. Added subject-matter - Article 76(1) EPC

4.1 Claim 1 of the main request relates to a reproducing apparatus which includes data-acquiring means for acquiring "video data, a program for reproducing the video data, a play list indicating (i) the video data to be reproduced by the program and (ii) an order in which the video data is to be reproduced, and program management information for controlling execution of the program".

4.2 The reproducing apparatus of claim 1 of the main request includes "general control means for permitting, with reference to the program management information, the program executed by the program executing means to reproduce the video data with reference to the play list".

In the Board's view, the skilled person understands this as meaning that the control means makes decisions about permitting reproduction of the video data indicated in the playlist on the basis of information included in the program-management information.

4.3 According to the appellant, the feature specifying the functionality of the general control means finds a basis in paragraphs [0267] to [0273], [0275], [0277] and [0300] of the parent application.

4.3.1 Paragraphs [0267] to [0273] are preceded by paragraph [0266], which explains that a "verifying process" will be explained next. This verifying process is said to be a process "for checking whether or not the reproduction of the video data corresponding to the program
currently being executed is approved by the copyright holder of the video data".

The verifying process is then explained with reference to Figure 33. First, a CPU obtains the filename of the "target video data" and extracts a public key from the video data (paragraph [0268]; step S101). Next, the CPU searches, using the video-data filename as a key, for a relevant "video_info()" entry in the program-management information. If no such entry is found, or if an entry is found but contains no certificate, video reproduction is not approved and program execution is terminated (paragraphs [0269] and [0270]; steps S102 and S103). If a relevant entry containing a certificate is found, the CPU verifies, on the basis of the certificate, the public key and a hash value of the currently executed program, whether video reproduction is approved and, if not, terminates program execution (paragraphs [0271] to [0273]).

4.3.2 The parent application then explains, in paragraphs [0275] to [0277], that the verifying process can also function without using the public-key encryption method. In that case, "the disapproved use of the video data can be checked by merely checking the static information video_file_name that is not contained in the program". It is apparent from Figure 30 and its description in paragraphs [0246] to [0251] that "video_file_name" refers to a field of the "video_info()" data structure.

4.3.3 Paragraph [0300] discloses that, as a variation of the embodiments described earlier in the application, the reproducing apparatus may make a reference to "play list information indicating an order in which the video
data is reproduced". It does not relate to determining whether video reproduction is allowed.

4.4 Hence, the disclosed verifying process, both in the version described in paragraphs [0267] to [0273] and in the variation discussed in paragraphs [0275] to [0277], specifically checks whether the filename of the video data to be reproduced is present in a "video_info()" entry contained in the program-management information. In the Board's view, the skilled person reading the parent application would not directly and unambiguously recognise this step as being merely optional, as it forms the basis of the verifying process. Paragraph [0300] does not change this, since it does not relate to verifying video-reproduction permission.

Claim 1, on the other hand, does not include a feature specifying that the general control means checks whether the filename of the video data to be reproduced is listed in the program-management information.

The subject-matter of claim 1 cannot therefore be directly and unambiguously derived from the passages cited by the appellant.

4.5 The parent application contains a number of further passages relating to "verifying" whether video-data reproduction is permitted. But none of these passages provides a basis for the subject-matter of claim 1.

In particular, paragraphs [0022] to [0025] and [0391] to [0394] and original claims 20 and 37 disclose verifying whether a content data item to be reproduced is a content data item specified in the program-management information. This corresponds to the step of checking whether the filename of the video data to be
reproduced is present in an entry of the program-
management information - a feature missing from
claim 1.

Paragraphs [0026] to [0028] and [0395] to [0398] and
original claims 21, 22, 38 and 41 relate to verifying
authorisation information included in the program-
management information with the help of "verification-
use" information. The "permitting" operation of claim 1
lacks these details.

4.6 The subject-matter of claim 1 of the main request
therefore extends beyond the content of the parent
application as filed, contrary to Article 76(1) EPC.

First auxiliary request

5. Added subject-matter - Article 76(1) EPC

5.1 Claim 1 of the first auxiliary request specifies that
the program-management information "includes content
data specifying information for specifying video data
items to be reproduced by the program and an order in
which the video data items are to be reproduced". It
also recites general control means for "determining, in
accordance with the content data specifying
information, that the program executed by the program
executing means is permitted to reproduce the video
data items specified by the content data specifying
information included in the program management
information for the program in the order specified by
the content data specifying information".

5.2 The parent application, in paragraphs [0269] and [0277]
to [0279], discloses content-data specifying
information included in the program-management
information in the form of the "video_file_name" field of a "video_info()" entry, which is used to verify whether permission exists to reproduce video data (see the discussion in points 4.3.1 and 4.3.2 above).

The parent application, in paragraph [0280], also discloses that a program may correspond to "a plurality of video data to be reproduced". This also follows from Figure 30, which shows that the program-management information for a program includes a number of video_info() entries, each entry including a video_file_name field.

5.3 The parent application does not, however, disclose that "content data specifying information" which is used for determining whether reproduction of the corresponding video-data items is permitted determines "an order in which the video data items are to be reproduced". The only passages in the parent application referring to the order in which video-data items are to be reproduced are paragraphs [0220] and [0300].

Paragraph [0300] states that the reproducing apparatus may make a reference to "play list information indicating an order in which the video data is reproduced", but it makes no connection between the playlist information and the video_info() entries contained in the program-management information.

Paragraph [0220] discloses that the video_file_name field of the program-management information of "the present embodiment" can specify a plurality of filenames in an order corresponding to the order in which the video data is to be reproduced. But this passage is part of "Embodiment 4", described in paragraphs [0146] to [0226], which focuses on the
program-management-information data structure shown in Figure 22. That data structure includes no video_info() entries but an optional single video_file_name field, which is used to inform the reproducing apparatus which video-data file to reproduce concurrently with the execution of the program (see e.g. paragraph [0182]). Hence, even if the skilled person reading the parent application were to combine the embodiment to which paragraph [0220] refers with one of the embodiments described in paragraphs [0269] and [0277] to [0279], he would not identify the optional single video_file_name field of Figure 22 with the fields of the same name included in the video_info() entries of Figure 30.

5.4 The other passages in the parent application relating to verifying whether video-data reproduction is permitted, discussed in point 4.5 above, do not provide a basis for the subject-matter of claim 1 either, as they also make no reference to the order in which the content data items are to be reproduced.

5.5 The first auxiliary request therefore does not comply with Article 76(1) EPC.

Second auxiliary request

6. Admission - Article 12(4) RPBA

6.1 The Examining Division refused to admit the second auxiliary request into the first-instance proceedings under Rule 137(3) EPC in view of the time of its filing and because it prima facie did not meet the requirements of Articles 52(1) and 56 EPC.

6.2 Since the request was filed only after the completion of oral proceedings in which the examination
proceedings had essentially been brought to a conclusion, in the absence of special circumstances the Examining Division's refusal to admit a newly filed request introducing new features does not amount to an abuse of discretion. Hence, the admission of the second auxiliary request into the proceedings is now at the Board's discretion under Article 12(4) RPBA.

6.3 Although the Board does not find fault with the Examining Division's discretionary decision not to admit the request, it also considers that the non-admission is in itself no reason to treat the second auxiliary request, in respect of its admission under Article 12(4) RPBA, more strictly than if it had been filed for the first time with the statement of grounds of appeal. It would run counter to procedural efficiency if an applicant could increase its chances of having a new request admitted by delaying the filing of that request until after the application has been refused.

6.4 The question then arises whether the non-acceptance by the appellant of the text proposed by the Examining Division is a factor weighing against admission of the new request. In this respect, the Board notes first that the appellant was fully entitled to maintain its higher-ranking requests and thus to disapprove of the text proposed in the communication under Rule 137(3) EPC. And it cannot be held against the appellant that, in the course of the first-instance proceedings, it submitted, as an auxiliary request, a text that was found to meet the requirements of the EPC. If it had not filed that text, the Examining Division would have refused the application at the oral proceedings, and it would have been open to the appellant - within the
normal limits of Article 12(4) RPBA - to submit, on appeal, amended requests in reaction to the refusal.

6.5 In decision G 7/93 (OJ EPO 1994, 775), the Enlarged Board of Appeal held that a board of appeal, in the circumstances of the case it had before it, should overrule the discretionary decision of the department of first instance only if the latter had exercised its discretion in an unreasonable way or in accordance with the wrong principles. In that case, the examining division had refused to give consent to an amendment of the claims it had proposed for grant. The question before the referring board then was, essentially, whether to overrule the examining division's discretionary decision and give consent to the amendment or to confirm the examining division's decision and, presumably, allow the applicant to revert to the originally proposed text.

6.6 The situation before the Board now is therefore fundamentally different from that considered in decision G 7/93, provided that the filing of the second auxiliary request is to be regarded as a reaction to the negative opinion expressed by the Examining Division on one of the higher-ranking requests considered in the oral proceedings rather than as an amendment of the claims that had been found allowable at the end of those oral proceedings. This is indeed the case: the second auxiliary request corresponds to the then main request with amendments that seek to overcome the Examining Division's novelty objection.

6.7 As to the Examining Division's second reason for non-admission of the second auxiliary request, namely a prima facie lack of inventive step, the Board considers that a question relating directly to the compliance of
a request with a provision of substantive patent law is to be assessed by the Board itself and that on such a point there is no latitude for deferring to the view of the department of first instance (cf. decision T 1816/11 of 22 November 2016, reasons 2.6).

6.8 Since the amendments made in the second auxiliary request do not present the Board with any difficulty, it exercises its discretion under Article 12(4) RPBA and admits the second auxiliary request into the proceedings.

7. Added subject-matter - Article 76(1) EPC

7.1 Claim 1 of the second auxiliary request adds a number of features to claim 1 of the main request:

- the program-executing means executes the program "in accordance with a program specifying information item (program_file_name) included in the program management information";
- the program is acquired via a network; and
- the video data is acquired from an optical disk.

7.2 Since these added features do not affect the objection under Article 76(1) EPC raised above against claim 1 of the main request, the subject-matter of claim 1 of the second auxiliary request likewise infringes Article 76(1) EPC.

Third auxiliary request

8. Admission - Article 12(4) RPBA

8.1 The third auxiliary request corresponds to the text proposed for grant in the Examining Division's
communication under Rule 71(3) EPC. In response to this communication, the appellant expressed its disapproval of the proposed text, maintained its main and first auxiliary requests and submitted an amended second auxiliary request. The Examining Division then resumed the examination proceedings and refused the application. In its decision, it made no mention of the third auxiliary request.

8.2 The appellant's letters filed after the communication under Rule 71(3) EPC contain no clear indication that the appellant maintained its third auxiliary request. The Examining Division apparently assumed that it had been withdrawn; otherwise, it should have referred to the request in its later communication and decision and have mentioned that the applicant had failed to give its approval to it, in accordance with the procedure set out in the Guidelines for Examination in the EPO (the current version of November 2017 explains this procedure in point E-X, 2.9).

8.3 Nevertheless, in the circumstances of the present case the Board accepts that the appellant never had the intention to withdraw the request. It therefore admits the third auxiliary request into the proceedings.

9. Remittal

9.1 The communication under Rule 71(3) EPC, expressing the Examining Division's intention to grant a patent on the basis of the third auxiliary request, does not constitute a decision and is therefore not binding on the EPO. In its communication, the Board expressed a number of reservations about the allowability of the request. In particular, it questioned the clarity of claim 1 and suggested that the claim's subject-matter
lacked inventive step over a video player as known from document D1 in combination with the well-known use of public-key and certificate data for verifying whether a computing entity is allowed to reproduce particular content data, as exemplified by document D5.

9.2 The Board's concerns about the clarity of claim 1 related to the feature "wherein upon an interruption carried out by the video reproducing section a general control means acquires video data information indicating the video data to be reproduced and public key data, and verifies if the program is allowed to reproduce the video data, using the video data information, the public key data and the certificate". In particular, the Board had questions about the role of the "interruption", the acquisition of the "video data information" and "public key data", and how the "video data information" was to be used in the process of verification.

9.3 On reconsideration, although the Board is not yet convinced that the claim is clear, any problems of clarity for claim 1 appear to be a matter of wording rather than being of a fundamental nature. In particular, paragraph [0243] of the application explains that when reproduction of video data starts, the video reproducing section extracts public-key data from the video data and notifies the general control section, by way of an interrupt, of the extracted public-key data and the filename of the video data to be reproduced. And paragraphs [0268] to [0273] disclose that the general control section uses the filename to retrieve certificate data corresponding to the video data to be reproduced from the program-management information and then verifies whether the program is allowed to reproduce the video data on the basis of the
public-key data, the certificate data and a hash value of the program.

9.4 As to the potential objection of lack of inventive step, the Board notes the following. Although document D1 on page 2, line 58, to page 3, line 19, discloses a video player for reproducing the content of a recording medium which contains "software capable of the interactive reproduction (e.g. the educational software, the game software)" , the Board now agrees with the appellant's argument that document D1 does not directly and unambiguously disclose a "program" and "program executing means" as claimed. In fact, the passage on page 7, line 6, to page 8, line 47, discloses, with reference to Figures 4 and 5A to 5D, that educational software consists of a number of blocks of multiplexed stream data together with "reproduction permission codes". When reproduced, a block displays a question in response to which the user inputs an answer. Depending on the answer given by the user, a "correct" or "incorrect" answer block is displayed. The reproduction permission codes essentially encode which answer blocks must have been displayed before another question block may be reproduced. An actual program and corresponding program-executing means are therefore not implied. In this context, the Board notes that document D1 also refers to a movie as "software" (see page 2, lines 24 to 47).

In addition, the verification process of claim 1 as explained in point 9.3 includes details going beyond the general principle of using public-key and certificate data to verify access rights.
9.5 In these circumstances, the Board considers it appropriate to exercise its discretion under Article 111(2) EPC and to remit the case to the Examining Division for further prosecution on the basis of the third auxiliary request. The Examining Division should, in particular, examine whether claim 1 is clear or still requires clarification.

9.6 In addition, the description still needs to be adapted in view of point 3 above.

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:

I. Aperribay R. Moufang

Decision electronically authenticated