

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of 17 October 2007**

Case Number: T 0953/04 - 3.5.01

Application Number: 01302368.4

Publication Number: 1191420

IPC: G06F 1/00, G06F 17/60

Language of the proceedings: EN

Title of invention:
Method of distributing software

Applicant:
FUJITSU LIMITED

Opponent:
-

Headword:
Software distribution/FUJITSU

Relevant legal provisions:
-

Relevant legal provisions (EPC 1973):
EPC Art. 56
EPC R. 67, 86(4)

Keyword:
"Inventive step - no"
"Procedural violation - no"
"Lack of cooperation in clarifying facts"

Decisions cited:
T 0027/97, T 0258/97, T 0708/00

Catchword:
See points 3.3 and 3.4 of the Reasons



Case Number: T 0953/04 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 17 October 2007

Appellant:

FUJITSU LIMITED
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Kanagawa 211-8588 (JP)

Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 17 March 2004
refusing European application No. 01302368.4
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. Steinbrener
Members: R. R. K. Zimmermann
A. Pignatelli

Summary of Facts and Submissions

- I. European patent application number 01 302 368.4 claiming a priority date from 20 September 2000 concerns a method of distributing software.
- II. The examining division cited the documents D1: EP-A-0 704 785 (published in 1996) and D2: US-A-5 680 453 (published in 1997), and raised an objection regarding inventive step. The application was refused in oral proceedings, essentially for this reason. In addition, the examining division did not allow the first auxiliary request for claiming unsearched subject matter. The decision in writing was notified by letter dated 17 March 2004.
- III. The applicant (appellant) filed an appeal against the refusal of the application on 5 April 2004, paid the appeal fee on 12 May 2004, and filed a statement setting out the grounds of appeal on 21 June 2004. Together with the statement of grounds, the appellant inter alia filed three sets of claims as main request, first auxiliary request, and second auxiliary request. The respective claims 1 of these requests read as follows:
- Main request:
- "1. A method of supplying software that can be used for secret communication between a first user and a second user, the method being carried out by an electronic processing apparatus and comprising the steps of:
- supplying the first user with software for secret communication; and
- supplying the second user with software for secret communication with the first user,

characterised by:

supplying the first user with a retrieval code together with the software, the retrieval code being a code for disclosure by the first user to the second user, and which identifies the software supplied to the first user;

receiving the retrieval code from the second user;
and

supplying the second user with software for secret communication with the first user based on the retrieval code."

First auxiliary request:

"1. [the first part of the claim as the main request] characterised by:

supplying the first user with a retrieval code together with the software, the retrieval code being a code for disclosure by the first user to the second user, and which identifies the software supplied to the first user;

receiving the retrieval code from the second user;
certifying the second user by determining whether

the retrieval code has previously been used; and

supplying the second user with dedicated software for secret communication with the first user based on the retrieval code."

Second auxiliary request:

"1. [the first part of the claim as the main request] characterised by:

supplying the first user with a retrieval code together with the software, the retrieval code being a code for disclosure by the first user to

the second user, and which identifies the software supplied to the first user;
receiving the retrieval code from the second user;
and
supplying the second user with software for secret communication with the first user based on the retrieval code,
wherein said code is used to make a secret key for cipher communications."

IV. In a communication of 3 July 2007, annexed to summons to oral proceedings requested by the appellant as an auxiliary measure, the Board did not raise any formal objections against the amended claims filed with the present requests, but voiced serious doubts about the allowability of the appeal. The communication indicated in particular:

"6. [...] The invention is in the field of electronic software distribution and, accordingly, involves various aspects of legal, commercial, and technical nature. In particular, the overall process structure defined in the method and apparatus claims seems to result from mainly commercial and legal considerations regarding the promotion and distribution of software. The technical features in the present claims appear to have rather secondary character and seem not to define anything which goes beyond what is notorious in e-commerce and digital rights management. Patentability of an invention, however, requires the technical contribution to be novel and non-obvious over the prior art.

7. An important issue of the forthcoming oral proceedings is thus to identify and assess the technical features and aspects of the claimed invention. Commercial and legal concepts and models of distributing products to consumer and managing digital rights, be it conventionally or via Internet, do prima facie not solve any technical problem, and if they do not, they must be ignored in assessing inventive step even if they involve novel and creative ideas.
 8. Regarding the refund of the appeal fee, the Board has doubts whether any of the circumstances submitted by the appellant on the issue qualifies as a substantial procedural violation in terms of Rule 67 EPC. In addition, the appeal must be allowable before refund can be ordered."
- V. In a reply letter dated 28 August 2007, the appellant indicated that no representative of the appellant would attend the oral proceedings. No other comments or submissions were made.
- VI. Oral proceedings were held on 17 October 2007, as scheduled and indeed without the participation of the appellant. At the end of the oral proceedings the decision on the appeal was given.
- VII. The appellant's written requests to be considered by the Board at the oral proceedings were as follows:
The appellant requested the decision under appeal be set aside in its entirety and a patent be granted on either one of the sets of claims filed as main and auxiliary requests together with the statement of appeal grounds dated 16 June 2004. Moreover, a refund

of the appeal fee was requested for reasons of substantial procedural violations.

VIII. According to the appellant's written submissions, the examining division was wrong in its assessment of inventive step. It was not disputed that the subject-matter defined in the preamble of the respective claims was known from document D1, and that this document could be considered to form the closest prior art. However, neither starting from document D1 nor using the general technical knowledge, the skilled person would arrive at the claimed invention. The examining division was wrong not to produce any documentary material or evidence of disclosure for its allegation that the claimed distinction over the prior art of document D1 was part of the common general knowledge. Neither was any evidence produced for the existence of any ground or inducement to combine the alleged general technical knowledge with the teaching of document D1. However, even if the skilled person were to combine the features which allegedly constitute common general knowledge with the teaching of document D1, he would not arrive at the claimed invention.

The examining division was also wrong to cite document D2 against the second auxiliary request. This document did not disclose the inventive idea to generate keys for cipher communications from a software identifier; it rather disclosed ciphering the software itself using the ID or title of the software.

The examining division was finally wrong to refuse the amended claims according to the then first auxiliary request under Rule 86(4) EPC; the amendments had all been disclosed properly in the original application and

were allowable in the light of decision T 708/00 - Transmission frame/ALCATEL (OJ EPO 2004, 160).

The appellant submitted various reasons for the alleged procedural violations. First, the chairman of the examining division had made a link between admitting the second auxiliary request and the withdrawal of the then main request and first auxiliary request. Furthermore, the examining division had misapplied Rule 86(4) EPC and wrongly refused to carry out an additional search. Since the additional search as requested was denied without giving reasons the decision was not fully reasoned.

Reasons for the Decision

1. The appeal is admissible.
2. The procedural violations alleged by the appellant do not justify reversal of the decision under appeal from the outset.

As apparent from the minutes of the oral proceedings before the examining division, to which the appellant did not raise any objections, all requests submitted were dealt with by the examining division in accordance with the normal procedural practice. A circumstance which amounts to the breach of a fundamental procedural right is not apparent, neither from the file nor from the submissions made by the appellant to this end. Also the other points raised by the appellant (misapplication of Rule 86(4) EPC and unreasoned refusal to carry out an additional search), even if they were confirmed by the Board, do not prima facie amount to a substantial procedural violation since they

would basically relate to an error of judgement and its consequences.

3. The appeal, moreover, is not allowable on the merits since the claims, in particular the respective claims 1 in all requests, do not meet the requirement of inventive step.

3.1 The presence of inventive step requires that the invention as claimed provides a technical contribution to the "closest prior art". According to the case law of the boards of appeal, any non-technical aspects of the invention, which do not contribute to the solution of a technical problem, have to be ignored. The present claims raise doubts regarding the technical contribution of the invention for the following reasons:

3.2 The appellant and the examining division apparently agreed on document D1 as the closest prior art. It is also undisputed that this document fully anticipates the preamble of the respective claims 1.

The Board agrees with these conclusions. Document D1 is indeed an appropriate starting point for assessing inventive step. It discloses (using the terms of the present claims) a method for supplying software that can be used for a secret communication between a first user and a second user (the "copyright management program P" given to the "primary user" and "secondary user" of the database system 1 for encrypting and decrypting data, see col. 5, line 46 to 58 and col. 6, lines 22 to 31).

The characterising parts of the method claims, considered to distinguish the invention from the closest prior art, define schemes for supplying the users with a retrieval code (claim 1 of the main request) and additional method steps either of

certifying the second user, namely by determining whether the retrieval code has previously been used (claim 1 of the first auxiliary request), or of using the retrieval code to make a secret key for cipher communications (claim 1 of the second auxiliary request).

Providing retrieval codes, certifying users, and making secret keys for cipher communications are as such common functions notorious in e-commerce and digital rights management. An inventive contribution to the prior art may only reside in a specific combination of such features for solving a technical problem.

- 3.3 The use of cryptographic methods in the technical context of electronic data processing and communication has certainly technical character. But a scheme how and to whom distribute cipher keys and software, or retrieval codes, or which method to use for making a cipher key may result from a pure business concept for licensing software or other purely non-technical considerations. Such an understanding of the invention is supported by statements in the application, for example, in section [0007] f., which indicate that "[...] a corporation that provides encrypting software cannot earn any income except where users purchase the software. [...] An aim of the invention is to enable software to be distributed safely, to enable a corporation to earn a reward for the service ensuring the safety of the use of the software, and to provide a method for promoting the spread of the software among a large number of customers".

In the statement of grounds, the appellant identifies various problems in the prior art which the invention intends to overcome and discusses the differences

between the claimed invention and the prior art of documents D1 and D2. However, even if these submissions were accepted, they still leave room for doubts to which extent this contribution over the prior art solves a technical problem; they do not convince the Board that the technical contribution is more than the straightforward implementation of a business concept for licensing software.

- 3.4 For such reasons, the Board took up the issue in its communication of 3 July 2007 and invited the appellant to clarify the question in the oral proceedings. Neither did the appellant attend the oral proceedings nor did it make any further observations on this question.

As follows from decision T 258/97 - Multi-address call/CANON (not published in OJ EPO), point 7 f. of the reasons, it is, however, incumbent on the appellant to cooperate in the determination of the relevant technical features of an invention in the event of doubt. If not, these features are to be ignored in assessing inventive step if the doubts regarding their technical character cannot be resolved (see also decision T 27/97 - Cryptographie à clés publiques/FRANCE TELECOM, not published in OJ EPO, point 4.4 of the reasons).

Against the background of continuing doubts regarding the technical content of the present invention (see point 3.3 supra) and lacking cooperation of the appellant in clarifying the issue, the Board considers itself barred from arriving at a positive judgement on inventive step so that the appeal cannot be allowed.

4. Since allowability of the appeal is a requisite for reimbursement of the appeal fee under Rule 67 EPC, the

request for reimbursement must be refused, irrespective of whether or not substantial procedural violations occurred in first instance proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

T. Buschek

S. Steinbrener