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**Datasheet for the decision  
of 14 January 2011**

**Case Number:** T 1658/06 - 3.5.06

**Application Number:** 04001954.9

**Publication Number:** 1457860

**IPC:** G06F 1/00

**Language of the proceedings:** EN

**Title of invention:**

Publishing digital content within a defined universe such as an organization in accordance with a digital rights management (DRM) system

**Applicant:**

MICROSOFT CORPORATION

**Headword:**

Digital rights management/MICROSOFT

**Relevant legal provisions:**

EPC Art. 52(2),(3)

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Subject-matter excluded under Art. 52(2) and (3) EPC (no)"

"Obvious on the basis of notorious prior art (no)"

"Remittal for further prosecution (yes)"

**Decisions cited:**

G 0010/93, G 0003/08, T 0641/00, T 0258/03, T 0424/03

**Catchword:**

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Case Number: T 1658/06 - 3.5.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.06  
of 14 January 2011

**Appellant:**

MICROSOFT CORPORATION  
One Microsoft Way  
Redmond  
WA 98052 (US)

**Representative:**

Grünecker, Kinkeldey  
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**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 4 April 2006  
refusing European patent application  
No. 04001954.9 pursuant to Article 97(1) EPC  
1973.

**Composition of the Board:**

**Chairman:** D. H. Rees  
**Members:** M. Müller  
M-B. Tardo-Dino

## Summary of Facts and Submissions

- I. The appeal is against the refusal of application number 04 001 954.9 in oral proceedings which took place on 27 January 2006, with written reasons dispatched on 04 April 2006. The application was refused on the ground that claim 1 of the main and first auxiliary requests was limited to subject-matter excluded from the concept of an invention in the sense of Article 52(1) EPC 1973 by Article 52(2) EPC 1973 and therefore constituted excluded subject-matter as such (Article 52(3) EPC 1973). A second auxiliary request was not admitted into the procedure (Rule 86(3) EPC 1973).
- II. Notice of appeal was filed on 14 June 2006 and the appeal fee paid on the same day. A statement setting out the grounds of the appeal was submitted on 14 August 2006. The three requests were maintained and reasons for setting aside the decision were given.
- III. The board issued a summons to oral proceedings. In the accompanying communication it provisionally agreed with the appellant that the claimed subject-matter was not excluded from patentability by Articles 52(2) and (3) EPC. However it appeared that the subject-matter of the independent claims of all the requests did not evince an inventive step over the notorious prior art of computer networks. The board further indicated that if this objection were overcome, it would be necessary to remit the case to the examining division for further prosecution since there had been as yet no search of prior art.

IV. In preparation for the oral proceedings the appellant submitted two further auxiliary request claim sets and in the oral proceedings it amended one of these claim sets in response to points made by the board. Finally it requested that the decision under appeal be set aside and that the application be remitted to the department of first instance for further prosecution on the basis of the set of claims 1 to 10 submitted during the oral proceedings. It withdrew all other requests.

The further text on file is:

description pages

3, 5 to 41 and 51 to 54 as originally filed,  
1, 2, 4 and 42 to 45 received on 24 May 2005 with  
letter dated 23 May 2005 (note: there are no  
description pages 46 to 50);

drawing sheets 1 to 16 as originally filed.

V. Claim 1 of the sole request reads as follows:

"A method for controlling rendering of encrypted digital content in a digital rights management system (10) comprising a license issuing computing device (1210) and a requesting computing device, the method comprising:

receiving, at the license issuing computing device a user's request for rendering the digital content (12) corresponding to the encrypted digital content from the requesting computing device, the request including rights data associated with the digital content, the rights data listing at least one identifier and a set of rights associated therewith;

selecting, by the license issuing computing device, an alternate set of rights based on the identifier;  
substituting, by the license issuing computing device, the alternate set of rights for the set of rights from the rights data;  
issuing a digital license (1208) to a trusted component (18) of the requesting computing device, the digital license comprising the alternate set of rights and a decryption key for decrypting the encrypted digital content, whereby the alternate set of rights in the issued license sets forth terms and conditions that the requesting user must adhere to in connection with rendering the corresponding content and the trusted component is trusted in the digital rights management system;  
determining, by the trusted component, whether the requesting user satisfies the terms and conditions set forth in the alternate set of rights, and if so,  
obtaining the decryption key from the digital license, decrypting the encrypted digital content by applying the decryption key to the encrypted digital content, and rendering the digital content by the requesting computing device."

Claim 10 reads as follows:

"A computer-readable medium having stored thereon computer-executable instructions which when executed direct a digital rights management system comprising a license issuing computing device and a requesting computing device to perform a method according to one of claims 1 to 9."

VI. At the end of the oral proceedings the chairman announced the board's decision.

### **Reasons for the Decision**

1. The appeal is admissible since it complies with the applicable requirements of the EPC (see I and II above).
2. The examining division did not raise any objections under Article 123(2) EPC 1973 during examination and the board does not see any reasons for doing so. The amendments made in appeal do not add subject-matter to the application, being disclosed in particular by original description page 16 line 17 to page 17 line 22.
3. It is the established case law of the Boards of Appeal (see G 3/08 (to be published) 10.13) that claimed subject-matter specifying at least one feature not falling within the ambit of Article 52(2) EPC is not excluded from patentability by the provisions of Articles 52(2) and (3) EPC. In this case claims 1 to 9 are all method claims which specify that the method is carried out by "computing devices". Claim 10 is a claim to a "computer-readable medium". Neither of these two features fall under the exclusions of Article 52(2) EPC and hence the claimed subject-matter of the present request is not excluded from patentability by the provisions of Articles 52(2) and (3) EPC (see T 258/03, Hitachi (OJ EPO 2004, 575) and T 424/03, Microsoft).

The examining division took a position which is now quite clearly incompatible with the case law of the Boards of Appeal. However its actions were not in

contradiction to the Guidelines for Examination of the time and it is arguable that T 258/03, which had been decided and which was repeatedly referred to by the appellant during the examination procedure, was not entirely established case law at the time of the refusal.

4. Since the only ground explicitly relied on for refusal of the application has been successfully refuted, the board could remit the case for further prosecution on this basis alone. However it appears expedient for the board to investigate whether there are any other grounds for refusing the application as it presently stands, in application of Article 111(1) EPC, taking into account the considerations discussed in G 10/93 (OJ 1995, 172), particularly point 5.

5. Clarity and interpretation

5.1 The claims use some terms more familiar in a contractual or intellectual property setting, in particular "license" and "terms and conditions". However in the full context of the claimed subject-matter the board considers that these terms clearly refer to technical matters - the "license" is a set of control data sent from one computer to another and the "terms and conditions" refer to the state of the device associated with the user, said user either being identified with the device or (in the case of a multi-user device) with identification data within said device.

5.2 The claims refer to a "trusted component" of the requesting computing device. "Trusted component" is certainly a term of the art known to the skilled person, but the board considers that it has little limiting effect. The application states that "The trusted component 18 typically has a license evaluator ..., the license evaluator 20 is trusted in the DRM system 10 to carry out ... the rules and requirements in the license 16, and the user should not be able to easily alter such trusted element for any purpose, nefarious or otherwise," (description page 16 line 28 to page 17 line 4). However, the degree of trust clearly depends on the ease with which the element may be altered in fact, which in turn depends on the effort and expenditure which the designer is prepared to put in. The board considers that in the context of the present claims "trusted" merely means that the component carries out the actions defined in the claims, i.e. rendering content according to the licence, and by implication not allowing rendering when the licence conditions are not satisfied, and not allowing rendering of a type not allowed by the licence.

6. Novelty and inventive step

6.1 The claimed subject-matter concerns the control of a computer - a user requests an action and the action either takes place or does not according to the state of the user's device and to a set of control data obtained from another device (the data being called a "license" in the application). One computer controlling another computer is a technical effect going beyond the effects observed when any computer program is run and therefore all the claimed means involved in achieving



that effect have to be taken into account when assessing the novelty and inventive step of the claimed invention (T 641/00, COMVIK (OJ EPO 2003, 352), Headnote I).

- 6.2 The board considers that the combination of features claimed - *inter alia* the user's request to render some digital content triggering a communication with another system, the communication containing certain control data which is replaced by other control data and returned - cannot be dismissed as common knowledge of such notoriety that it cannot be challenged (in contrast to earlier requests in appeal which could be seen as lacking an inventive step with respect to the notorious prior art of computer networks). The extent to which page 15 line 16 to page 17 line 22 describes prior art acknowledged by the appellant has not been established (see the minutes of the oral proceedings before the examining division at point 24, last paragraph). Neither has there been any search of the prior art carried out in the procedure which led to the present appeal. Thus the board has no basis on which to make a judgement of the novelty and inventive step of the claimed subject-matter and therefore finds it appropriate to remit the case for further prosecution in accordance with the appellant's request.

**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 on the basis of claims 1 to 10 of the sole request filed during the oral proceedings.

The Registrar

The Chairman

B. Atienza Vivancos

D. H. Rees