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**Datasheet for the decision
of 20 November 2015**

Case Number: T 2385/10 - 3.5.07

Application Number: 01909242.8

Publication Number: 1257921

IPC: G06F17/30, G06F13/00,
G06F15/16, H04L9/00

Language of the proceedings: EN

Title of invention:

Watermark encoder and decoder enabled software and devices

Applicant:

Digimarc Corporation

Headword:

Watermark-enabled software/DIGIMARC

Relevant legal provisions:

EPC Art. 111(1), 123(2)

EPC R. 103(1)(a)

RPBA Art. 11

Keyword:

Right to be heard - substantial procedural violation (yes)

Remittal to the department of first instance - (no)

Amendments - all requests (not allowable)

Reimbursement of appeal fee - (no)

Decisions cited:

T 0190/03

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2385/10 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 20 November 2015

Appellant: Digimarc Corporation
(Applicant) 9405 S.W. Gemini Drive
Beaverton, OR 97008 (US)

Representative: Sessford, Russell
Forresters
Skygarden
Erika-Mann-Strasse 11
80636 München (DE)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 15 July 2010 refusing European patent application No. 01909242.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman R. Moufang
Members: R. de Man
M. Rognoni

Summary of Facts and Submissions

I. The applicant (appellant) appealed against the decision of the Examining Division refusing European patent application No. 01909242.8, filed as international application PCT/US01/04812 and published as WO 01/61508.

II. The Examining Division decided that the subject-matter of claim 1 of the then main request and of the then auxiliary request lacked inventive step in view of the following document:

D1: US 5 841 978 A, published on 24 November 1998.

In addition, claim 1 of the auxiliary request was found to be unclear.

III. With the statement of grounds of appeal, the appellant filed four sets of claims according to a main request and first to third auxiliary requests. The main request was identical to the main request considered in the decision under appeal. The appellant submitted *inter alia* that the appealed decision was not a reasoned decision within the meaning of Rule 111(2) EPC and that its right to be heard as guaranteed by Article 113(1) EPC had been violated.

IV. In a communication accompanying a summons to oral proceedings, the Board informed the appellant that it provisionally agreed that there had been a violation of the right to be heard, but expressed the intention to deal with the substance of the case. None of the appellant's substantive requests appeared to comply with Article 123(2) EPC and the Board had doubt whether to admit the third auxiliary request into the

- proceedings. When interpreting claim 1 of the main request and of the first and second auxiliary requests along the lines of original claims 11 to 13 and the original description on page 13, lines 10 to 16, its subject-matter appeared to lack inventive step.
- V. With a letter dated 19 October 2015, the appellant filed a new main request and maintained the previous main request and first to third auxiliary requests as first to fourth auxiliary requests.
- VI. With a letter dated 18 November 2015, the appellant informed the Board that it would neither attend nor be represented at the oral proceedings.
- VII. Oral proceedings were held on 20 November 2015 in the appellant's absence. At the end of the oral proceedings, the chairman pronounced the Board's decision.
- VIII. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request or, in the alternative, on the basis of the claims of one of the first to fourth auxiliary requests. It further requested reimbursement of the appeal fee.
- IX. Claim 1 of the main request reads as follows:
- "A watermark decoder system for extracting a watermark including an encoded object identifier, the system comprising:
- an internet browser having a user interface for displaying a representation of media object files, the internet browser including:

a listener program for identifying a media object in an HTML document and for inserting a handler code into the HTML document when an object identifier is extracted from a watermark of the media object, wherein the handler code is operable to present a logo indicating the presence of the watermark and to display, when a user passes a cursor over the logo and selects it, a menu of options obtained from a metadata server using the object identifier,

wherein the watermark decoder system is configured to inhibit the display of the representation of the media object if the media object is not in a specified webpage document determined by control data in the watermark."

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

"A watermark decoder system for extracting a watermark including an encoded object identifier, the system comprising:

an internet browser having a user interface for displaying a representation of media object files; and

an extension to the internet browser for decoding a watermark embedded in a selected media object file and for displaying, in an extension of the user interface, metadata or an action associated with the media object file via the watermark, wherein the extension to the internet browser comprises: a listener program for identifying a media object in an HTML document and for inserting a handler code into the HTML document when an object identifier is decoded from a watermark embedded in the media object, wherein the handler code is operable to display, in response to user input, selectable options obtained from a metadata

server using the object identifier decoded from the watermark."

- XI. Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in the addition of the following text at the end of the claim:

", and wherein the extension to the internet browser forwards context information to the metadata server with the object identifier and the selectable options include metadata or an action returned from the server based on the context information."

- XII. Claim 1 of the third auxiliary request differs from claim 1 of the first auxiliary request in the addition of the following text at the end of the claim:

", and wherein the HTML document includes a control parameter to control selectively the enabling or disabling of the extension to the internet browser, and the handler code presents an indicator to the user indicating the presence of the watermark embedded in the media object."

- XIII. Claim 1 of the fourth auxiliary request differs from claim 1 of the first auxiliary request in the addition of the following text at the end of the claim:

", and wherein the extension is configured to inhibit the display of the representation of the media object file if the media object file is not in an HTML document determined by control data of the watermark."

- XIV. The appellant's arguments 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*

The application relates to using watermarks to associate a media object such as an image, video or audio file with metadata and actions. As explained on page 1, lines 23 to 30, digital watermarking is a process for modifying physical or electronic media to embed a machine-readable code into the media. The embedded code is imperceptible or nearly imperceptible to the user, but may be detected through an automated detection process.

In one embodiment, the metadata is stored outside the media object, and the watermark stored in the media object encodes an imperceptible and persistent link to this metadata, such as an object identifier (see page 4, line 29, to page 5, line 7).

3. *Alleged substantial procedural violation*
- 3.1 In the statement of grounds of appeal, the appellant submitted that the Examining Division had violated its right to be heard in refusing the main request.

In particular, the written decision relied on the examples "JavaScript, Java Applets, DHTML ..." as options for providing graphical user interfaces in the domain of the World Wide Web. These examples had not been presented during the oral proceedings. The appellant therefore had had no opportunity to be heard

on those examples. At the oral proceedings, the Examining Division had merely referred to the novel features of the invention as representing one of a number of well-known options and, referring to decision T 190/03 of 29 March 2006, had stated that no evidence was required.

Although the appellant did not necessarily disagree with the statement in decision T 190/03 that the "mental furniture" of the skilled person did not always need to be substantiated with evidence, the appellant had not been made aware of what the Division considered to be part of that "mental furniture" and had therefore been unable to give reasoned counterarguments.

- 3.2 In point A.1 of the reasons for the decision, the Examining Division argued that the insertion of handler code into HTML was obvious, essentially by observing that the known mechanisms for providing dynamic web-based GUIs involved incorporating one of "JavaScript, Java Applets, DHTML ..." into a base HTML page. This argument introduces, and relies on, facts. It therefore has to be examined whether the appellant was given an opportunity to comment on these facts as required by Article 113(1) EPC.

The argument was not presented in the written phase of the examination proceedings. In a communication faxed to the appellant on 28 April 2010, the Examining Division only stated that "the idea to provide the alternative implementation by means of not technically characterised listener programs and handlers falls under system architecture design that is routinely performed by the skilled person even in the absence of an explicit hint to do so" and referred to decision T 190/03 to justify that knowledge belonging to the

"mental furniture" of the skilled person did not always need to be proved.

The minutes of the oral proceedings before the Examining Division show that the appellant was heard on the merits of the distinguishing features, including the insertion of handler code into HTML, but they do not reflect any specific argument in relation to the obviousness of the insertion of handler code.

- 3.3 The Board therefore has to assume that the contested decision indeed relied on facts on which the appellant was not given the opportunity to present its comments. The Board thus agrees that the appellant's right to be heard as protected by Article 113(1) EPC was violated.

As the Examining Division no longer maintained its previous argument, its decision hinged on the new argument; had the appellant been given the opportunity to comment, that could at least potentially have changed the outcome of the decision. The infringement of the appellant's right to be heard therefore qualifies as a substantial procedural violation.

- 3.4 The appellant further submitted that the Examining Division had committed a procedural violation by acting contrary to Rule 111(2) EPC. This was so because the "actual decision - the decision being that which was pronounced orally - was not reasoned".

However, the reasons for the orally pronounced decision were communicated to the appellant in writing. That is what Rule 111(2) EPC requires.

- 3.5 According to Article 11 RPBA, a board is to remit a case to the department of first instance in case

fundamental deficiencies are apparent in the first-instance proceedings, unless special reasons present themselves for doing otherwise.

In the present case, the infringement of the right to be heard, although a substantial procedural violation, affected only a particular aspect of the Examining Division's inventive step reasoning. It does not hinder the Board's substantive examination of the case, nor does it, in the Board's view, impinge on the appellant's right to defend its case in appeal. In addition, although the appellant in its statement of grounds submitted that the procedural deficiencies it had pointed out were sufficient reason for setting aside the decision under appeal, it did not formally request a remittal to the Examining Division either in the statement of grounds or in response to the Board's communication. The Board further considers that the age of the application is a factor to be taken into account.

The Board hence considers that, even if the procedural violation were to be considered a fundamental deficiency, special reasons within the meaning of Article 11 RPBA are present. The Board therefore decides to exercise its discretion under Article 111(1) EPC and to proceed with the examination of the case.

4. *Admission of the main request and the fourth auxiliary request*

4.1 The main request was filed in response to the Board's communication. It corresponds to the third auxiliary request submitted with the statement of grounds of appeal with amendments addressing objections raised for the first time by the Board. Since these amendments

raise no further issues, they are no obstacle to admission of the main request under Article 13(1) RPBA.

- 4.2 However, in its communication the Board expressed doubts as to whether the then third auxiliary request, identical to the present fourth auxiliary request, should be admitted into the proceedings under Article 12(4) RPBA. Claim 1 of that request introduced a feature taken from the description which was directed to an aspect of the application not present in the originally filed claims. The feature might therefore not have been searched. In addition, it had not been presented to the Examining Division in the first-instance proceedings even though numerous opportunities for filing amendments had been given.

This feature is now also included in claim 1 of the main request. It is therefore a factor to be taken into account when deciding on the admission of both the main request and the fourth auxiliary request.

- 4.3 In support of admission of the main request, the appellant argued that the content of the "mental furniture" on which the Examining Division relied had been put forward only in the written decision. The applicant could not have been expected to put forward, before the Examining Division, a request corresponding to the third auxiliary request filed with the statement of grounds of appeal, because it had had no way to judge or consider the merit of the Examining Division's objections and it could therefore not reasonably have formulated amendments to address those objections. The appellant would have had to file many tens of different requests, each probing at the unevidenced mental furniture in an attempt to define its boundaries via a trial-and-improvement method.

The appellant further submitted that a search of the original claims should have covered the subject-matter now claimed, as it was clear from the application that the feature added to the independent claim related to a key fall-back position for the appellant.

4.4 The Board notes that in the first-instance proceedings the Examining Division did make clear its position and in fact gave arguments in respect of the claimed insertion of handler code into HTML. The fact that the appellant considered these arguments to be unconvincing should not have prevented it from preparing and filing further requests for the event that the Examining Division maintained its position. In addition, the amendments made in the third auxiliary request filed with the statement of grounds of appeal neither further define nor are otherwise related to the insertion of handler code.

4.5 Nevertheless, the Board accepts that the filing of amendments with the statement of grounds of appeal adding features taken from the description to the independent claims may under certain circumstances constitute a reasonable response to a decision refusing an application. The Board's main concern in respect of the main request and what is now the fourth auxiliary request is that the added feature appears not to have been disclosed in connection with the invention as originally claimed. Since in the present case this concern may be appropriately dealt with in the context of the examination of compliance with Article 123(2) EPC, the Board decided to exercise its discretion in the appellant's favour and to admit both the main request and the fourth auxiliary request into the proceedings.

5. *Main request - Article 123(2) EPC*

5.1 Claim 1 of the main request relates to a watermark decoder system comprising an internet browser which includes a "listener program". The internet browser is based on originally filed claims 11 to 13 and on the embodiment described on page 11, line 5, to page 13, line 22, of the published application. In particular, the features specifying that a logo is presented indicating the presence of a watermark in a media object and that a menu of options is displayed when a user passes a cursor over the logo are based on the description on page 13, lines 4 to 16.

5.2 Claim 1 further specifies that the watermark decoder system is configured to "inhibit the display of the representation of the media object if the media object is not in a specified webpage document determined by control data in the watermark".

The appellant submitted that this feature was based on page 22, line 12, to page 23, line 5, of the description. That section could clearly and unambiguously be combined with the embodiment described on page 11, line 5, to page 13, line 22, in particular in view of its references to web pages. The description on page 23 appeared to be dependent on the implementation of the listener program, which was described on page 13.

5.3 Original claims 11 to 13 and the passage of the description on page 13, lines 4 to 16, relate specifically to the use of watermarks in the context of an internet browser for associating a media object included in a web page with a set of options or items,

such as URL links to web pages related to the media object, stored on a metadata server. To this end, the watermark encodes an "object identifier".

- 5.4 The passage on page 22, line 12, to page 23, line 5, relates to a different use of watermarks. This section discloses that a watermark embedded in a media object may be used to control the use of the media object. In particular, "the watermark may instruct the decoder to inhibit rendering of a media object if its [sic] outside of a given file (e.g., a specified web page, computer system, computer network, etc.)". To this end, the watermark encodes "control data".
- 5.5 The watermark of present claim 1 encodes both an object identifier and control data. The application as filed does not explicitly disclose such a watermark. Even if the skilled person were to read both passages of the description as pertaining to a single embodiment, he would not directly and unambiguously derive the watermark of claim 1, but merely learn that **both** a watermark encoding an object identifier **and** a (separate) watermark encoding control data may be detected in a media object. For this reason the Board can already conclude that the subject-matter of claim 1 extends beyond the content of the application as filed.
- 5.6 The Board further considers that the skilled person would in fact not recognise the two passages unambiguously as describing a single embodiment.

Indeed, usage control of media objects is disclosed on page 22, line 12, to page 23, line 5, in a general context not restricted to internet browsers. Although media objects displayed in the context of a web page are given as an example and the skilled person would

understand the watermark decoder implementing the usage control in that case to be included in an internet browser, the disclosure on page 22, line 12, to page 23, line 5, stands on its own and does not require any details of the embodiment disclosed on page 11, line 5, to page 13, line 22. In particular, the Board sees no dependence on the specific listener program described on page 13. The application hence neither explicitly nor implicitly points to a combination of the two passages.

5.7 Finally, the Board notes that claim 1 refers to the inhibition of "the display of the representation of the media object", whereas the description on page 22, lines 18 and 19, discloses that the watermark may instruct the decoder to inhibit "rendering of a media object". In case of an audio or video media object, a representation of the object may be a static icon representing the object. Inhibiting rendering of the representation of a media object is hence not the same as inhibiting rendering (i.e. playback) of that object. Thus the description on page 22, line 12, to page 23, line 5, does not disclose the feature as claimed.

5.8 In view of the above, the main request contravenes Article 123(2) EPC.

6. *First auxiliary request - Article 123(2) EPC*

6.1 Claim 1 of the first auxiliary request is directed to a watermark decoder system comprising an internet browser and an "extension to the internet browser for decoding a watermark embedded in a selected media object file and for displaying, in an extension of the user interface, metadata or an action associated with the

media object file via the watermark". The extension to the internet browser comprises a listener program.

6.2 An internet browser comprising a listener program is described in the published application on page 11, line 5, to page 14, line 15, in connection with Figures 3 and 4, and in original claims 11 to 13. These passages mention neither an "extension to the internet browser", nor an "extension of the user interface" as claimed.

6.3 In the appeal proceedings the appellant has not indicated a basis in the application as filed for present claim 1. From the history of the file it is apparent that the claim was obtained by combining original independent claims 10 and 11. Original independent claim 10 reads as follows:

"A watermark decoder system comprising:

 a host application having a user interface for displaying a representation of media object files; and
 an extension to the host application for decoding a watermark from a selected media object file and for displaying in an extension of the user interface metadata or an action associated with the media object file via the watermark."

6.4 The only other passages of the published application referring to "host application" are page 3, lines 8 to 12, which merely summarises original claim 10, and page 6, lines 24 to 31. The latter passage is part of the description on page 5, line 26, to page 11, line 2, which describes the integration of a watermark decoder in a file browser. In this passage, the term "host application" apparently refers to the file browser application "hosting" the watermark decoder.

6.5 The Board accepts that the term "host application" as used in original claim 10 is intended to encompass internet browsers. The skilled person may hence attempt to read original claim 10 in combination with either original claim 11 or the passage on page 11, lines 5, to page 14, line 15.

However, when attempting to do so it is not apparent how the "extension to the host application for decoding a watermark ... and for displaying ..." relates to the "listener program for identifying a media object ... and for inserting a handler ... when an object identifier is extracted". The internet browser/host application may comprise both the extension and the listener program, or the listener program may be the extension, or the listener program may include the extension, or the listener program may be included in the extension. According to present claim 1 the last possibility is the correct one, but the Board considers that this is not directly and unambiguously derivable from the original application.

Furthermore, given that in claim 10 it is the extension that displays metadata (or an action) and in claim 11 it is handler code inserted by the listener program that displays metadata, the skilled person would, in the Board's view, conclude that claim 10 relates to an embodiment that cannot be combined with that of claim 11.

6.6 The Board notes that the same difficulties arise when attempting to combine original independent claim 11 with either of independent original claims 1 and 8. Since the latter two claims relate to a file browser system comprising a file browser and a file browser

extension as described on page 5, line 26, to page 11, line 2, with reference to Figures 1 and 2, there is even less justification for such a combination.

6.7 The subject-matter of claim 1 of the first auxiliary request hence extends beyond the content of the application as filed, contrary to Article 123(2) EPC.

7. *Second to fourth auxiliary requests - Article 123(2) EPC*

7.1 Claim 1 of each of the second to fourth auxiliary requests is similarly directed to a watermark decoder system comprising an internet browser and the "extension to the internet browser" of claim 1 of the first auxiliary request. The objection under Article 123(2) EPC raised in respect of the first auxiliary request hence applies likewise to the second to fourth auxiliary requests.

7.2 In addition, claim 1 of the fourth auxiliary request combines, like the main request, the internet browser of original claims 11 to 13 and described on page 11, line 5, to page 13, line 22, of the description, with a feature specifying that display of the representation of the media object file is inhibited if the media object file is not in an HTML document determined by control data of the watermark. The fourth auxiliary request hence violates Article 123(2) EPC for the same reasons as those given for the main request.

8. *Conclusion*

Since none of the substantive requests on file is allowable, the appeal is to be dismissed. Furthermore, since allowability of the appeal is a precondition for

reimbursement of the appeal fee under Rule 103(1) (a) EPC, the request for reimbursement of the appeal fee is to be refused.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



I. Aperribay

R. Moufang

Decision electronically authenticated