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**Datasheet for the decision
of 24 March 2021**

Case Number: T 1352/16 - 3.4.03

Application Number: 08005605.4

Publication Number: 2048634

IPC: G07F17/30, G06Q30/00, G11B27/00

Language of the proceedings: EN

Title of invention:

Digital downloading jukebox with enhanced communication features

Applicant:

TouchTunes Music Corporation

Headword:

Relevant legal provisions:

EPC Art. 52(1), 56, 97(2), 111(1)
RPBA Art. 12(4)
RPBA 2020 Art. 15(1), 24(1), 25(2)

Keyword:

Inventive step - main request, first and second auxiliary requests (no)

Third and fourth auxiliary requests filed with the grounds of appeal - admitted (no)

Decisions cited:

Catchword:



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Case Number: T 1352/16 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 24 March 2021

Appellant: TouchTunes Music Corporation
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 23 November
2015 refusing European patent application No.
08005605.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Eliasson
Members: T. M. Häusser
W. Van der Eijk

Summary of Facts and Submissions

- I. The appeal concerns the decision of the examining division refusing the European patent application No. 08 005 605 for lack of inventive step (Article 56 EPC 1973) in relation to the main request and auxiliary requests 1 to 3 underlying the decision and added subject-matter (Article 123(2) EPC) in relation to auxiliary requests 3 to 7 underlying the decision. Former auxiliary requests A, B, C, D were not admitted into the proceedings.
- II. Reference is made to the following documents:
- D1: EP 0 926 644 A2,
D2: WO 01/71608 A2,
D3: US 2004/0025185 A1,
D6: WO 03/024012 A2,
Exhibit 1: Wikipedia article on "M3U", last modified on 15 March 2016, submitted on 1 April 2016,
Exhibit 2: Todd Souvignier and Gary Hustwit, *The musician's Guide to the Internet*, 2nd edition 2002, Hal Leonard Corporation, Milwaukee, U.S.A., page 44,
Exhibit 3: Edward Haletky, *Deploying LINUX on the Desktop*, 2005, Elsevier Digital Press, Burlington, U.S.A., section 4.1.8 on pages 58-59.
- III. In writing the appellant had requested that the decision under appeal be set aside and a patent be granted based on the main request or one of the first

to fourth auxiliary requests, all requests filed with the grounds of appeal.

In its communication pursuant to Article 15(1) RPBA 2020 dated 12 June 2020 the board expressed its provisional negative opinion on the allowability of all requests on file and indicated that it would be discussed at the oral proceedings whether the third and fourth auxiliary requests should be admitted into the proceedings.

The appellant stated in its letter dated 5 November 2020 that it was not going to attend the scheduled oral proceedings before the board which were subsequently cancelled.

IV. The wording of respective claim 1 of the various requests is as follows (board's labelling "(i)" to "(x)"):

Main request:

- (i) "A method of distributing a playlist to one or more digital jukeboxes connected to an audiovisual distribution network, the method comprising:
- (ii) connecting a peripheral device having a peripheral playlist stored in a computer-readable storage medium thereon to a digital jukebox via a connector;
- (iii) retrieving the peripheral playlist for the digital jukebox;
- (iv) converting the peripheral playlist to a jukebox playlist; and
- (v) publishing the jukebox playlist at least on the jukebox."

First auxiliary request:

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the following additional feature is appended at the end of the claim:

(vi) ", wherein the peripheral device is a portable music player or a mobile phone."

Second auxiliary request:

Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in that the following additional feature is appended at the end of the claim:

(vii) ", the method further comprising requiring a user to log into the jukebox before importing of the peripheral playlist is enabled."

Third auxiliary request:

Claim 1 of the third auxiliary request differs from claim 1 of the first auxiliary request in that the following additional features are appended at the end of the claim:

(vii)' ", the method further comprising:
 requiring a user to log into the jukebox before importing of the peripheral playlist is enabled;
(viii) storing the jukebox playlist on the jukebox and associating the jukebox playlist with said logged in user; and

- (ix) enabling the user to edit the jukebox playlist on the jukebox."

Fourth auxiliary request:

Claim 1 of the fourth auxiliary request differs from claim 1 of the third auxiliary request in that the conjunction "and" before the last feature is deleted and the following additional feature is appended at the end of the claim:

- (x) "; and
sending the jukebox playlist to a server of the audiovisual distribution network."

V. The appellant argued essentially as follows:

(a) Main request - inventive step

The subject-matter of claim 1 of the main request addressed the problem of crowding of users around the jukebox and involved an inventive step over the cited state of the art documents, in particular document D1.

(b) First and second auxiliary requests - inventive step

The subject-matter of claim 1 of the first and second auxiliary request involved an inventive step over document D1.

(c) Third and fourth auxiliary requests - admission

The appellant provided no justification for filing the third and fourth auxiliary request only at the appeal stage.

Reasons for the Decision

1. Oral proceedings

Oral proceedings were scheduled to be held before the board on 19 November 2020 as requested by the appellant in the notice and grounds of appeal. In its letter dated 5 November 2020 the appellant stated that it was not going to attend these oral proceedings.

In accordance with settled case law the board considers this statement as equivalent to a withdrawal of the request for oral proceedings (see *Case Law of the Boards of Appeal of the EPO*, 9th edition 2019, section III.C.4.3.2). Consequently, the oral proceedings were cancelled and the proceedings were continued in writing.

2. Main request - inventive step

2.1 Closest state of the art

In the decision under appeal the examining division considered document D1 as a suitable starting point in its assessment of inventive step (see point 1.1 of the Reasons). The appellant also argued inventive step taking document D1 as the starting point (see points 7 to 39 of the grounds of appeal).

Indeed, document D1 discloses - as detailed below - subject-matter that is conceived for the same purpose as the claimed invention, namely for providing a method of distributing a playlist to a digital jukebox, and has the most relevant technical features in common with

it. Document D1 is therefore regarded as the closest state of the art.

2.2 Distinguishing features

2.2.1 Document D1 discloses (see paragraphs [0001], [0025]-[0029], [0031], and [0033]; Figures 1-5 and 7) a multimedia device 1 for playing music comprising a display 6, keyboard 5, loudspeaker 7 and coin slot 8. A control unit 4 is connected to an array 3 of plug-in memory cards 2 with memory chips 2a and to a coin processing module 8a. After the device is activated by the insertion of the required coin an overview of all musical pieces stored on the memory cards 2 is presented. The user can select one of the musical pieces by entering a related combination of letters or digits which is converted by the control unit 4 using a table of contents ("Inhaltsverzeichnis") stored on one of the memory chips 2a to a corresponding address on the memory chip 2a. The data stored under this address are transmitted in real time via a D/A converter 11 and amplifier 12 to the loudspeaker 7.

As shown in Figure 5 the control unit 4 may be connected via data transmission line 13 to a central unit 14, where a large number of musical pieces may be stored on suitable mass storage units. This allows new musical pieces to be loaded from the central unit 14 to the memory cards 2.

The example of Figure 7 shows an externally accessible plug-in card adaptor 15 with a slot for inserting and retrieving the memory cards 2.

2.2.2 In the decision under appeal the examining division held that the memory card 2 or the central server 14 of

document D1 could be considered the claimed "peripheral device" and that the document disclosed the retrieval, conversion and publication of a playlist (see points 1.1 and 1.5 of the Reasons).

- 2.2.3 The appellant argued (see points 7 to 39 of the grounds of appeal) that the examining division construed the terms "playlist", "peripheral device" and "converting" in an erroneous manner. A "playlist" was an electronic file of one of a number of different formats including information for identifying the location of the underlying media content as demonstrated in Exhibits 1 to 3. The claimed conversion ensured that the jukebox was able to read and utilize the imported playlist irrespective of its format. The table of contents of document D1 could not be considered the claimed playlist and was also not imported into the jukebox.

Moreover, the portable memory of D1 was not something that would typically be carried around by a user. The claimed "peripheral device" was however intended to be used in this way.

- 2.3 The board notes that the memory cards 2 of document D1 comprise contact areas 2b for plug-in connection to a corresponding retainer of the multimedia box 1 (see D1, paragraph [0027]). The memory cards 2 are therefore not integral parts of the multimedia box 1 and communicate with the latter via the cited contact areas 2b and the corresponding interface. They can also be readily removed from the multimedia box 1, especially in the embodiment comprising an external memory chip adaptor 15, and can in fact be carried around by a user (see paragraph [0033]).

In view of the above, the board agrees with the examining division in that one of the memory cards 2 disclosed in document D1 may be considered the claimed "peripheral device" when understood in the conventional sense in the art as a device connected to the digital jukebox for providing auxiliary functions, e. g. additional storage.

- 2.3.1 Furthermore, in document D1 it is disclosed that various pieces of information about the songs (title, music band, ...) stored in the table of contents ("Inhaltsverzeichnis") on the memory chip 2a may be read out by the processor 4 and shown on the display 6 (D1, paragraph [0028]). These data are therefore necessarily retrieved by the multimedia box 1. After the user has entered a numerical or letter code corresponding to the desired song to be played, the processor 4 of the multimedia box 1 calculates the relevant starting address in the memory chip 2a using the data information in the table of contents stored in the chip. The data stored under this address is then transferred in real time to the D/A converter 11 and played using the amplifier 12 and loudspeaker 7 (see D1, paragraph [0029]).

From the appellant's submissions it emerges that a "playlist" may be implemented as a file specifying the locations of one or more media files. In particular, it may have merely a single entry pointing to the location of a single media file (see Exhibit 1, section "File format"). The board is therefore of the opinion that the term "playlist" is to be understood broadly and that the table of contents stored on the chip 2a of D1 would fall under that term as it allows the starting addresses of the media files stored on the chip 2a to be located.

2.3.2 Using the wording of claim 1 document D1 discloses therefore a method of distributing a playlist (table of contents) to one or more digital jukeboxes (multimedia device 1) connected to an audio-visual distribution network (comprising the multimedia device 1 and the central unit 14), the method comprising:
connecting a peripheral device (memory card 2) having a peripheral playlist (table of contents) stored in a computer-readable storage medium (memory chip 2a) thereon to a digital jukebox (multimedia device 1) via a connector (contact area 2b);
retrieving the peripheral playlist (table of contents) for the digital jukebox (multimedia device 1).

2.3.3 The precise details of how the processor 4 performs the data transfer and display above are not described in document D1, in particular there is no disclosure of a "jukebox playlist".

Therefore, the subject-matter of claim 1 of the main request differs from the method of document D1 only in that the peripheral playlist is converted to a jukebox playlist (feature (iv)), and the jukebox playlist is published on the jukebox (feature (v)).

2.4 Objective technical problem

2.4.1 The appellant argued that the problem addressed by the invention related to the crowding of users around the jukebox, which had a negative impact on user experience. Moreover, the invention provided advantages with regard to user-convenience that were not provided by the method of document D1 (see points 4 and 35 of the grounds of appeal).

2.4.2 The board is of the opinion that the problem and the advantage mentioned by the appellant are related to the claimed use of a peripheral device. However, this is already known from document D1 and cannot be a valid basis for the formulation of the objective technical problem.

Rather, the problem to be solved by the invention has to be formulated considering the effect of the distinguishing features identified under point 2.3.3 above. These features merely relate to the implementation of the method of document D1, in particular to how precisely the information about the songs stored in the table of contents on the memory chip is read out by the processor and then displayed and used for addressing the relevant location on the memory chip. The objective technical problem is therefore merely to achieve such an implementation.

2.5 Obviousness

2.5.1 Concerning the functioning of the multimedia box of document D1 the appellant submitted that the skilled person would understand that the memory card would be read by appropriate software of the multimedia box and that the data stored on the memory card concerning the songs would be added to a file internally generated on the multimedia box. The pathnames in that file would point to the hardware port into which the memory card had been inserted (see points 19 and 20 of the grounds of appeal).

2.5.2 The board notes that document D1 does not disclose, either explicitly or implicitly, any of these details concerning the functioning of the multimedia box.

However, the board agrees with the appellant in that the skilled person would implement the processing of the multimedia box in this way. He would thus consider arranging this processing such that a file is created that is internal to the multimedia box, i. e. stored in its local memory, which is then used for displaying purposes and for addressing the relevant location on the memory chip 2a and for transferring the data in real time to the D/A converter 11 and playing the desired song using the amplifier 12 and loudspeaker 7. Such an internally created file can be considered the claimed "jukebox playlist".

The skilled person would thus arrive at the claimed subject-matter without exercising any inventive skills.

Therefore, the subject-matter of claim 1 of the main request does not involve an inventive step (Articles 52(1) and 56 EPC).

3. First and second auxiliary requests - inventive step
- 3.1 The examining division held that the subject-matter of claim 1 of the first and second auxiliary requests did not involve an inventive step as the additional features were well-known to the skilled person, in particular in view of documents D6 and D3 (see points 2 and 3 of the Reasons).
- 3.2 The appellant argued that the use of a portable music player or a mobile phone increased the user convenience. The skilled person would not consider replacing the memory cards of D1, which were dedicated products, by these devices which were in a different category to the memory cards.

The feature of requiring a user to log into the jukebox before enabling the importing of the peripheral playlist allowed an imported playlist to be associated with a particular user account such that it could be edited and managed by the user. The peripheral device might be disconnected while access to the imported playlist and the ability to edit and manage it was retained.

- 3.3 The board agrees with the appellant in that the use of a portable music player or a mobile phone (additional feature (vi) of claim 1 of the first auxiliary request) increases the user convenience. Since feature (vi) is functionally independent of the other distinguishing features (iv) and (v) of claim 1 of the first auxiliary request (see sections IV. and 2.3.3 above), which relate to the concrete implementation of the method of document D1, it is appropriate to formulate partial problems in relation to these features: the first partial problem in relation to features (iv) and (v) being said implementation as defined under section 2.4.2 above and the second partial problem in relation to feature (vi) being to increase the user convenience.

In relation to additional feature (vii) the board notes that there is no indication of an association of a peripheral playlist with a user account. This does not follow from the combination of feature (vii) with the other features of claim 1 of the second auxiliary request, either. The effect of feature (vii), which is again independent of the other distinguishing features (iv), (v) and (vi) of claim 1 of the second auxiliary request, is merely seen in an increase of the security of the method, so that the third partial problem corresponding to feature (vii) is to achieve this effect.

- 3.4 For the following reasons the claimed invention of the first and second auxiliary requests is obvious for the skilled person:
- 3.4.1 The claimed solution of the first partial problem is considered obvious for the skilled person for the reasons mentioned under point 2.5 above.
- 3.4.2 Furthermore, documents D3 and D6 both relate to digital jukebox systems (see D3, paragraph [0002]; D6, paragraphs [40] and [41]) and are thus residing in the same technical field as document D1. These documents would therefore be consulted by the skilled person in its attempt to solve the above second and third partial problems.
- 3.4.3 Document D6 discloses (paragraphs [41]-[45] and [49]; Figures 1 and 2) a dynamic content delivery system (DCDS) allowing users to request audio content using each user's Bluetooth enabled devices, e. g. mobile telephones 111. Within restaurant 101 are located Bluetooth transceivers 103, which are used to communicate with the mobile telephones 111. The Bluetooth transceivers 103 are connected to a DCDS server 105, which receives the user requests from the Bluetooth transceivers 103, determines which audio recording to play by maintaining a song playlist, and outputs audio recordings through amplifier 107 to speakers 109. In particular, when a user enters the restaurant 101, a connection between the user's mobile telephone 111 and the DCDS is established through the Bluetooth transceivers 103. The DCDS then sends a song playlist to the mobile telephone 111 (step 203). The user may navigate the song playlist on the mobile telephone (step 205) and select the desired song (step

207). The mobile telephone 111 then sends a request to the DCDS server 105 to play the selected song over the loudspeakers 109 (steps 209 and 211).

Hence, document D6 provides the skilled person with the teaching that a mobile telephone 111 may be used in combination with a digital jukebox system (dynamic content delivery system) and that the mobile telephone 111 is arranged such that a user may select a desired song from a playlist on the mobile telephone 111. In the context of the DCDS the mobile telephone 111 of document D6 has essentially the same storage function as the memory card 2 of document D1, which stores a playlist from which the user may select the desired song (see point 2.3.1 above). It would therefore occur to the skilled person without exercising any inventive skills to solve the second partial problem (increasing the user convenience) by providing feature (vi).

- 3.4.4 Document D3 discloses (see paragraph [0030], [0031], [0036], [0043]-[0047]; Figures 1, 4) a digital video jukebox network 10 which is organized in a server-client architecture including a jukebox server 11 and a jukebox client 13, which is connected to a touch screen input device 26. Jukebox server 11 may be coupled to several sources of multimedia content including, for example, a removable hard drive 15. The multimedia content (e. g. digital audio) is retrieved and decoded by jukebox server 11 and then reproduced for entertainment at a commercial enterprise. The user can select the desired song using the touch screen input device 26. By providing user identification (e. g. by providing the ability to input a user name and a password), a personal playlist of previously played selections can be retrieved.

Therefore, in the jukebox system of document D3 it is envisaged to protect the system and the access to personal playlists by requiring the users to enter personal identification codes such as user names and passwords. It would therefore be obvious for the skilled person when attempting to increase of the security of the method of D1 to incorporate such restrictions in this method thereby arriving at the subject-matter of feature (vii).

3.4.5 Consequently, the subject-matter of claim 1 of the first and second auxiliary requests does not involve an inventive step (Articles 52(1) and 56 EPC).

4. Third and fourth auxiliary requests - admission

4.1 The third and fourth auxiliary requests were filed for the first time with the grounds of appeal.

Under Article 12(4) RPBA 2007, which is applicable in the present case (Articles 24(1) and 25(2) RPBA 2020), the board has the power to hold these requests inadmissible.

4.2 The appellant did not provide any reasons why these request were not filed during the examination proceedings.

The statement of the grounds of appeal merely contain arguments why the appellant considered these requests to have a basis in the application as filed and why it considered the claimed subject-matter new and inventive (see points 61-74 of the grounds of appeal).

4.3 The board is of the opinion that an applicant should formulate fallback positions at the earliest possible

stage in order to allow the procedure to proceed in an efficient manner.

In the present case, a multitude of different requests were filed during the first instance proceedings: the decision is based on altogether twelve requests (former main request; former auxiliary requests 1 to 7; former auxiliary requests A, B, C, and D). The appellant did not argue why it was not in a position to file the fallback positions constituted by the third and fourth auxiliary requests already during the examination proceedings.

All requests on which the decision is based were filed either with the letter dated 11 September 2015 or during the oral proceedings before the examining division (see point 8 of the Facts and Submissions). No new developments after these dates justifying the submission of new request are apparent to the board. In particular, the examining division did not cite any new documents potentially providing such a justification. In fact, the most relevant documents D1 and D2, i. e. the starting points of the examining division's assessment of inventive step (see the decision, points 1.1 to 1.3 of the Reasons), had already been cited in the European Search Report.

The fallback position of the third and fourth auxiliary requests could therefore have been filed already during the examination proceedings. At the latest these requests should have been submitted during the oral proceedings before the examining division, especially since the patent proprietor was explicitly asked during these proceedings whether it had any further requests (see paragraph 4 on page 5 of the minutes of the oral proceedings).

Admitting the third and fourth auxiliary requests into the appeal proceedings might well compel the board either to give a first ruling on critical issues such as whether the subject-matter of the additional features has a basis in the application as filed, which runs counter to the purpose of appeal proceedings to review first instance decisions, or to remit the case to the examining division, which is contrary to procedural economy. In order to forestall these unsatisfactory options, Article 12(4) RPBA 2007 provides the board with the discretionary power to hold inadmissible requests which could have been presented in the first-instance proceedings.

The third and fourth auxiliary requests are therefore not admitted into the proceedings (Article 12(4) RPBA 2007).

5. Conclusion

Since the subject-matter of respective claim 1 of the main request and the first and second auxiliary requests does not involve an inventive step and the third and fourth auxiliary requests are not admitted into the proceedings, the examining division's decision refusing the application is confirmed. Consequently the appeal has to be dismissed (Articles 97(2) and 111(1) EPC).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Eliasson

Decision electronically authenticated