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**Datasheet for the decision
of 30 September 2022**

Case Number: T 1068/20 - 3.5.06

Application Number: 12177798.1

Publication Number: 2551766

IPC: G06F9/445

Language of the proceedings: EN

Title of invention:

Method and system for download of data package

Applicant:

Sony Computer Entertainment America LLC

Headword:

Data package download/SONY

Relevant legal provisions:

EPC Art. 113(1)
EPC R. 101(1)
RPBA 2020 Art. 11

Keyword:

Right to be heard - substantial procedural violation (yes)
Remittal - fundamental deficiency in first-instance
proceedings (yes)

Decisions cited:

Catchword:



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Case Number: T 1068/20 - 3.5.06

D E C I S I O N
of Technical Board of Appeal 3.5.06
of 30 September 2022

Appellant: Sony Computer Entertainment America LLC
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Representative: D Young & Co LLP
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 7 January 2020
refusing European patent application No.
12177798.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman M. Müller
Members: T. Alecu
A. Jimenez

Summary of Facts and Submissions

- I. The appeal is against the decision of the Examining Division to refuse the application.
- II. The appellant requests
 - (a) that the decision of the Examining Division be set aside,
 - (b) that a patent be granted on the basis of the main request, or on the basis of a sole auxiliary request; these requests are the same as the ones underlying the appealed decision,
 - (c) that the appeal fee be refunded, and
 - (d) that oral proceedings be held "if the Board would otherwise refuse the Main Request".
- III. The Examining Division refused the main request for a lack of novelty in view of
D2: ANDREW TRIDELL ET AL: "The rsync algorithm", 1998
The auxiliary request was refused for a lack of inventive step starting from the same document.
- IV. The set of claims according to the main request was filed with the letter of 9 May 2018. The next action of the Examining Division was a summons to oral proceedings. The auxiliary request was filed on 9 October 2019 in reply to those summons.
- V. With the grounds of appeal the appellant also submits that a substantial procedural violation occurred during examination.
- VI. The appellant submits that its right to be heard has not been observed for multiple reasons.

- (a) First, the feature of *"a data package corresponding to a first application"*, added to claim 1 with the current main request, was not considered, although the applicant explained how this feature distinguished the invention from D2. That the added feature was not considered is evident because the Examining Division made no reference to it in the subsequent communications.
- (b) Secondly, *"the most recent communications from the Examining Division (that of the communication under Article 94(3) EPC dated 18 January 2018, the Summons to Oral Proceedings dated 29 May 2019, and the Decision itself) have simply dismissed the arguments relating to the scope of the feature 'an inventory identifying existing content packages' without substantiating the reasoning beyond a comment stating that the words are given their normal meaning (or an equivalent statement). This is particularly inappropriate when the meaning of the words is being contested; a generic statement such as this cannot be considered to be a justification, and does not acknowledge any of the comments presented to the Examining Division in respect of this feature"*.

VII. The appellant also submits that the Examining Division has not considered the facts in full.

- (a) In particular the Examining Division did not indicate any passage in D2 where the feature added with the letter of 9 May 2018 was anticipated, nor did it provide any reasoning as to why such indication was omitted.
- (b) In addition, *"the broad interpretation of 'an inventory identifying existing content*

packages' [...] is not supported by any normal or technical definition of those words".

VIII. In conclusion, in the appellant's view, *"it is clear that the Examining Division have not fully observed the appellant's right to be heard" and "it is apparent that the Examining Division have not considered the facts of the case correctly. This represents a substantial procedural violation, and in view of this the original decision should be set aside [...]"*

IX. Claim 1 of the main request defines (the underlined text identifies the amendments of 9 May 2018):

In a client device configured to operate on a network, a method for efficient download of a data package corresponding to a first application, comprising:

- a) sending an inventory identifying existing content packages, corresponding to one or more other applications, stored in the client device to a server (105) operating on the network;*
- b) receiving (207) a response from the server containing information identifying one or more portions of the data package corresponding to one or more existing content elements stored on the client device;*
- c) gathering (209) the one or more identified portions of content within the data package from existing content elements stored in the client device; and*
- d) requesting (211) a remaining portion of the data package from the server; and*
- e) receiving (213) the remaining portion of the data package from the server.*

X. Claim 1 of the auxiliary request modifies step a) as follows:

a) *sending (205) ~~an inventory identifying~~ one or more content package identifiers, wherein each content package identifier identifies an existing content packages, corresponding to one or more other applications, stored in the client device to a server (105) operating on the network;*

Reasons for the Decision

Right to be heard (Article 113(1) EPC)

1. The appellant's summary of the facts concerning the features introduced with the letter of 9 May 2018 is correct. In particular the appellant stated in that letter (second page) that:
"the claims have been amended to note that the data/content packages relate to different applications. This therefore differentiates the claims further from D2, in that the method of D2 may only be performed when the source and target files are intended to be identical."
2. The Examining Division did not react to this particular argument, nor has it, in its decision, explained why the feature in question was disclosed in D2 and where, or why it might have been justified to ignore that feature for the novelty assessment, though this is necessary for a full appreciation of novelty. Indeed, in its previous communication of 18 January 2018, the Examining Division had maintained its novelty objection raised in its previous communications merely because the claim wording was "very general" (point 1), and in particular (point 2) because *"The meaning of data resp. content package may well encompass a data file to be updated as in document D2."*

3. The amendments carried out with the letter of 9 May 2018, and the accompanying arguments, were meant to address precisely this issue, and the Examining Division did not take this into consideration in any visible way. It can therefore be concluded that the appellant's right to be heard was not complied with on this issue.
4. The same is true regarding the matter of claim interpretation of the feature of "*an inventory identifying existing content packages*". It does not matter, in respect of the right to be heard, whether the Examining Division adopted a correct or an incorrect interpretation of the feature in question. However, it should have explained why the arguments of the appellant contesting this interpretation were not convincing (see for instance those in the letters of 9 May 2018 raising the issue of whether a checksum can be considered an identifier).
5. The Board concludes therefore that a substantial procedural violation occurred. According to established case law of the boards of appeal, this is a special reason justifying a remittal for further prosecution (Article 11 RPBA 2020) and makes reimbursement of the appeal fee (Rule 103(1)(a) EPC) equitable.

Patentability issues

6. With a view of avoiding "ping pong" between the two instances (cf. the explanatory remarks to the RPBA 2020 w.r.t. Article 11 RPBA), the Board adds the following considerations: D2 does not teach indicating to the "server" (computer β) any blocks other than those contained in file A, and thus, in the words of claim 1, does not disclose sending to the server "existing

content package[s] corresponding to [...] *other applications*" (see claim 1, step a). Likewise, D2 does not disclose building a "data package corresponding to [...] existing content elements" of *other applications* (see claim 1, step b). For completeness, it is also noted that D2 does not disclose a separate request for the "remaining portion" (see claim 1, step d). So claim 1 of the main request is new in view of D2.

7. The Board also notes that, although the algorithm in D2 has similarities with the one claimed from an algorithmic perspective, it relates to a different context, as also explained in page 3, lines 3-11 of the current application; this context has been first clarified in the claims with the amendments of 9 May 2018. D2 may thus not be a promising starting point for the assessment of inventive step. The Examining Division should consider this question and, accordingly, the need for an additional search.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution.
3. The appeal fee is reimbursed in full.

The Registrar:

The Chairman:



L. Stridde

M. Müller

Decision electronically authenticated