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Datasheet for the decision of 25 May 2023

Case Number: T 1621/21 - 3.4.02

Application Number: 12005997.7

Publication Number: 2587465

IPC: G09B7/00

Language of the proceedings: EN

Title of invention:
Variation and control of sensory work playback

Applicant:
Sony Computer Entertainment America Inc.

Headword:

Relevant legal provisions:
EPC Art. 56, 111(1)
RPBA 2020 Art. 11

Keyword:
Inventive step - identification of technical and non-technical features - problem-solution approach
Remittal - fundamental deficiency in first-instance proceedings (yes)

Decisions cited:

Catchword:

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Office européen des brevets

Beschwerdekammern

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Case Number: T 1621/21 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 25 May 2023

Appellant: (Applicant)	Sony Computer Entertainment America Inc. 919 East Hillsdale Boulevard, 2nd Floor Foster City, CA 94404 (US)
Representative:	Eisenführ Speiser Patentanwälte Rechtsanwälte PartGmbB Am Kaffee-Quartier 3 28217 Bremen (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 30 April 2021 refusing European patent application No. 12005997.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	R. Bekkering
Members:	A. Hornung
	B. Müller

Summary of Facts and Submissions

I. The applicant appealed against the decision of the examining division refusing European patent application No. 12005997.7 on the basis of Article 97(2) EPC because the requirements of Article 56 EPC were not fulfilled.

II. The applicant requested that the decision under appeal be set aside and a patent be granted on the basis of the claims in accordance with a main request or one of auxiliary requests 1 to 8', all requests filed with the statement setting out the grounds of appeal. The sets of claims of the main request and of auxiliary request 1 are identical to those of the main request and of auxiliary request 1 underlying the appealed decision, respectively.

III. The present communication refers to the following documents dealt with in the proceedings before the examining division:

D1: US 2004/0268384 A1,
D2: US 2003/0014768 A1.

IV. Claim 1 of the main request reads as follows (the features of claim 1 of the main request will be referred to as **F1** to **F7** added by the board):

F1 "A method for altering the playback of a sensory work for use in a network media system,

F2 the system comprising at least one sensory work playback device (14), a server (54) operating in conjunction with a database (58), the playback device (14)

and the server (54) being coupled to a network (56); the method comprising:

F3 receiving and recording at the server (54) playback control records generated by users of the playback devices (14), each of the user-generated playback records containing information to vary the playback of associated sensory work so as to provide a tailored version of that sensory work;

F4 receiving and recording at the server (56) feedback relating to the user-generated playback control records;

F5 transmitting via the network (56) from the server (54) to a user and its associated playback device (14) information regarding the user-generated playback control records and

F6 information regarding the received and recorded feedback associated with the user-generated playback control records; and

F7 transmitting via the network (56) from the server (54) to a user and its associated playback device (14) one or more of the user-generated playback control records, in order to playback one or more tailored versions of sensory work at the users playback device (14)".

Reasons for the Decision

1. Main request - inventive step

1.1 Appealed decision

The grounds for the decision concerning the lack of inventive step of the subject-matter of claim 1 of the main request are divided in three chapters having the titles "1 Preliminary Remarks", "2 Main Request" and "3 The Arguments of the Applicant", respectively.

1.1.1 In the first chapter "1 Preliminary Remarks", the examining division sets out its general view that "the subject-matter of the application concerns 'playback of sensory work', which is tantamount to the display on *[sic]* information within the meaning of Article 52(2) EPC" (grounds for the decision, point 1.1). In point 1.2 of the grounds for the decision, it is stated that "[t]he independent claim (...) all relate to what information is presented to whom at what time. This is inherently non-technical, and may therefore be considered to be a requirement specification for a skilled man to implement. That skilled man would then implement these *[sic]*, using well-known features (cf. also documents D1 and D2) of media players". All these statements of the examining division in points 1.1 and 1.2 of the grounds for the decision may be considered to be generally valid. However, the board is unable to see any concrete link between these general statements and the actual features of claim 1 of the main request.

The examining division further explains that a "suitable MPEG coding scheme" is disclosed in D1 (point 1.2.1 of the grounds for the decision) and that "fast forward and rewind operations" are notorious (point 1.2.2 of the grounds for the decision). The relevance of these brief statements of the examining division to the present claim 1, without further explanations, is not self-evident, because claim 1 neither comprises an "MPEG coding scheme" nor "fast forward or rewind operations".

Therefore, as suggested in its title, the first chapter "1 Preliminary Remarks" does not comprise a reasoning for refusing the main request.

1.1.2 The third chapter "3 The Arguments of the Applicant" sets out the applicant's arguments in favour of inventive step of the subject-matter of claim 1 and the examining division's reasons why the applicant's arguments were not found convincing. The purpose of this part of the decision is to demonstrate that the requirement of the applicant's right to be heard has been respected, in the sense that the applicant has had the opportunity to present its arguments in favour of granting a patent and to hear the examining division's reasoning as to why its arguments were not convincing. In this chapter, although the examining division explains why certain specific arguments of the applicant were not found convincing, no logical chain of reasoning can be found to show that the subject-matter of the claim lacks inventive step.

Therefore, the third chapter "3 The Arguments of the Applicant" cannot be regarded as self-contained reasoning of the examining division for denial of an inventive step of the subject-matter of claim 1 either.

1.1.3 It follows that the examining division's reasons for denying that the subject-matter of claim 1 involved an inventive step could be supposed to be found in the second chapter titled "2 Main Request".

(a) According to point 2.2 of the grounds for the decision, "[w]hat is claimed is a server with a database in a network like the Internet. That much is held to be notorious [...] in particular since it is also depicted in figure 1 of D1".

The board acknowledges that such an unspecific server is known in the art. However, claim 1 does not define an unspecific server but a server fulfilling specific functions, namely receiving and recording playback information generated by users of the playback devices and transmitting this playback information to a playback device. Such a specific server does not appear to be notorious or at least the examining division did not provide any evidence for its general assertion that such a server is notorious.

It is to be noted that D1 indeed discloses a server. In particular, D1, [0019], figure 1, discloses a storage medium (64) for receiving and storing an encoded video signal (20) which comprises control information (33) based on metadata (19). According to D1, [0020], the storage medium (64) may be a remote device, such as a server. In D1, the "control information (33) enables identification, extraction and replacement of advertising components (17) from encoded video signal (20) during (...) playback of encoded video signal (20)" (D1, [0019]).

(b) According to point 2.3 of the grounds for the decision, features **F3** and **F4** of claim 1 are "means for the user to input information about what should be displayed".

The board cannot follow the examining division's view. In particular, feature **F3** does not define *what* should be displayed, but actually defines a method step for receiving and recording information at the server about how to vary the playback of associated sensory work. Feature **F3** has the following technical content:

(i) The playback of the sensory work is to be modified on the basis of certain information.

(ii) The information about how to vary the playback is sent to a specifically identified device, namely to the server.

(iii) The information about how to vary the playback is recorded at a specifically identified device, namely at the server.

(iv) The information about how to vary the playback is generated by users of the playback devices.

(c) Furthermore, in point 2.3 of the grounds for the decision, the examining division, while broadly referring to technology disclosed in paragraph [0019] of D1, asserts that features **F3** and **F4** relate "to no more than the implementation of how to get the required playback information to the server, and the sensory work back to the user", using technology known to the skilled man.

The board is not convinced by the examining division's argument, because the playback information stored in the server of D1 corresponds to metadata (19) "inserted into channel signal (16) prior to broadcast (for example, during program creation and editing, or by a local system operator or station)" (D1, [0016]), i.e. the playback information stored in the server of D1 is not generated by individual users of the playback devices, independently from the generation of the initial video signal (12, 16) generated by the program provider itself. The playback information stored in the server of D1 is the same for all users of the playback devices. Nor does the examining division provide any reason why the skilled person would consider carrying out the method steps defined in features **F3** and **F4**. In the absence of an incentive

for users of the playback device to generate playback control records and send them to the server, the mere fact that the skilled person would know the general technology how to carry out the method steps defined in features **F3** and **F4** does not render them obvious.

(d) Point 2.4 of the grounds for the decision appears to deal with features **F5** to **F7** of claim 1. According to this paragraph of the decision, features **F5** to **F7** are "well within the reach of the skilled man". As the only justification for this assertion, the examining division generally refers to "the findings of section 1.2.1", i.e. the disclosure of a MPEG coding scheme in D1, [0019].

The board is not convinced by the examining division's argument, because D1 does not disclose transmitting user-generated playback information from a server to a playback device. Nor does the examining division provide any reason why the skilled person would consider carrying out the method steps defined in features **F5** to **F7**. The mere fact that the skilled person would know how to carry out the method steps defined in features **F5** to **F7** does not render them obvious.

(e) In point 2.5 of the grounds of the decision, the examining division concludes its reasoning for denying an inventive step by stating that "the driving force behind the subject-matter of claim 1 is the display of information (which cannot contribute to the technical character of the claim) and the implementation thereof being within the reach of the skilled man".

The board is not convinced by the examining division's argumentation. What the so-called "driving force

behind the subject-matter of claim 1" is, does not matter for assessing inventive step. The assessment of inventive step has to be based on the concrete features of the claim and not on a vague "driving force". Furthermore, even if the implementation of method steps of the claim are "within the reach of the skilled man", this does not necessarily mean that the subject-matter of the claim is obvious. In order to render obvious the subject-matter of the claim, the skilled person must have a clear incentive for carrying out the claimed method steps. The examining division did not address this point.

1.1.4 It follows that the reasons of the appealed decision for showing that the subject-matter of claim 1 lacks an inventive step are not found convincing by the board.

At least the method steps defined in features **F3** and **F7** are technical features having a technical content going beyond the mere display of information. It is to be noted that the technical character of feature **F4** may also have to be evaluated. Therefore, the technical content of these features may not be ignored when assessing the inventive step of the subject-matter of claim 1. Rather, the assessment of inventive step should be carried out on the basis of the problem-solution approach (see below, point 2.1), including the definition of an objective technical problem solved by the distinguishing technical features of claim 1.

1.2 Applicant's arguments

1.2.1 According to the applicant, D1 does not disclose features **F3**, **F5** and **F7** of claim 1 (statement of grounds of appeal, pages 5 and 6, point II.2.2).

The board tends to agree with the applicant's view, even though it is doubtful whether feature **F5** defines any further technical limitation that would go beyond the limitation defined by feature **F7**.

1.2.2 According to the applicant, claim 1 defines a method for altering the playback of a sensory work in which "it is not required that the entire tailored sensory work is submitted from the respective sensory playback device 14 to the server 54 /database 58" (statement of grounds of appeal, page 3, first paragraph), nor is it "required that the one or more entire tailored sensory works are submitted from the server 54 to the respective sensory playback device 14 over the network 56" (statement of grounds of appeal, page 3, second paragraph). From this, the applicant concludes that "the technical object of the present invention is to significantly reduce bandwidth requirements for a network media system that allows to share many tailored versions of sensory works between many users" (statement of grounds of appeal, page 3, third paragraph).

In the board's view, however, claim 1 does not seem to comprise any feature which would exclude that the entire tailored sensory work is transmitted between the server and the playback device. Actually, claim 1 seems to cover the possibility of transmitting the *entire* sensory work between the server and the playback device. Therefore, the objective technical problem as stated by the applicant does not appear to be a valid objective technical problem solved by the distinguishing features.

2. Further prosecution - remittal

2.1 The reasons given in the appealed decision for showing that the subject-matter of claim 1 lacks an inventive step are deficient and hardly comprehensible by the board.

As rightly objected by the applicant during the first-instance proceedings, the examining division did not clearly identify which features of claim 1 are technical features and which are not. The appealed decision merely states that "the Division will now give an example why it is difficult to separate the features in such a manner" (decision, page 7, fourth paragraph).

Moreover, the examining division's finding that the subject-matter of claim 1 lacked an inventive step was not based on applying the problem-solution approach, comprising the steps of identifying the distinguishing features of claim 1 over the disclosure of the closest prior art, determining which distinguishing features are technical features and which are non-technical features, determining the technical effect of the distinguishing features which are technical, deducing therefrom the objective technical problem solved by the distinguishing features, looking for an incentive for the skilled person to solve the objective technical problem and analysing whether the solution as claimed was obvious in view of the available prior art.

While the use of the problem-solution approach is not mandatory because it is not always reasonably applicable, if it is not used, the examining division should have explained the reasons for not using it.

Despite the serious deficiencies in the examining division's reasoning mentioned above, in the board's view the decision cannot be considered as not reasoned for the

purposes of Rule 111(2) EPC. The applicant did not rely on a lack of sufficient reasoning either.

2.2 As explained in point 2.1 above, the appealed decision is seriously flawed because the examining division neither made a clear division of the features of claim 1 into technical and non-technical features nor properly applied the problem-solution approach.

Therefore, the appealed decision must be set aside.

2.3 In order to determine the further course of action, the following aspects have to be considered:

Re-examination of the patentability of claim 1 on a different basis is necessary, including the consideration of the technical character of at least features **F3** and **F7** and a correct application of the problem-solution approach (if no reasons for not applying this approach are provided).

Furthermore, it should be noted that the applicant's justification of an inventive step might be based on an inadequate technical effect of claim 1.

Due to these aspects, the board is confronted with a fresh case, the examination of which is not compatible with the primary object of the appeal proceedings to review the decision under appeal in a judicial manner.

In view of these considerations, the board decides to make use of its discretion under Article 111(1) EPC and Article 11 RPBA 2020 in remitting the case to the examining division for further prosecution.

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.

The Registrar: The Chairman:

L. Gabor R. Bekkering

Decision electronically authenticated