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D E C I S I O N
of 27 May 2004

Case Number: T 0946/01 - 3.5.2

Application Number: 92104148.9

Publication Number: 0507119

IPC: G04G 15/00

Language of the proceedings: EN

Title of invention:
Improved video cassette recorder

Patentee:
EDICO S.r.l.

Opponent:
Koninklijke Philips Electronics N.V.
Interessengemeinschaft für Rundfunkschutzrechte GmbH
Schutzrechtsverwertung Co. KG

Headword:
-

Relevant legal provisions:
EPC Art. 56, 123(2), (3)

Keyword:
"Admissibility of the amendments (yes)"
"Inventive step (yes)"

Decisions cited:
-

Catchword:
G 0009/92, G 0001/99



Case Number: T 0946/01 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 27 May 2004

Appellant:
(Opponent 02)

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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted
20 June 2001 concerning maintenance of European
patent No. 0507119 in amended form.**

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: J.-M. Cannard
C. Holtz

Summary of Facts and Submissions

I. Opponent 02 appealed against the decision of the opposition division concerning the maintenance of European patent No. 0 507 119 in amended form in accordance with the proprietor's first auxiliary request filed on 28 March 2001 during the oral proceedings before the opposition division.

II. Prior art documents:

D1: EP-A-0 351 120, and

D3: US-A-4 206 483,

considered during the proceedings before the opposition division, remain relevant to the present appeal.

III. Claim 1 filed on 27 May 2004 during oral proceedings before the Board of appeal reads as follows:

"Video cassette recorder, supplied with means (1) for receiving a television program, means (7) for recording the latter, a clock (4), a data memory (3), means (53) for storing in said memory (3) the time at which a program that is desired to be recorded begins and control means (2) for reading said clock (4) and said memory (3) and for activating said receiving means (1) and said means for recording (7) the television program at the indicated time or at a pre-determined interval of time before and the programming of the recording operation can be maintained without interfering with the normal use of the recorder, characterized by the fact that means (303, 306) are provided for controlling,

whether the recorder is being used after having been programmed, controlling if the cassette tape position has been changed through said normal use, and by display means (312, 6, 8) for displaying a warning message for the user whether such said use may have placed the recording of the program at risk by said change of the tape position of the cassette."

Claims 2 to 26 are dependent on claim 1.

IV. The arguments of the appellant opponent 02 can be summarized as follows:

Claim 1 as maintained by the opposition division recited at the end: "said display means are activated as consequence of a change of the tape position of the cassette". The replacement of this by "by said change of the tape position of the cassette" was a broadening of the subject-matter of the claim which was not permissible as it would be a *reformatio in peius* for the appellant.

Document D1 disclosed a video cassette recorder which could be used in a normal way after it had been programmed. It comprised display means for displaying a warning message (cassette message) if this use had placed the recording at risk. The recorder according to D1 comprised means for fast wind to a specified point of the tape before entering the timer mode. This implied a detection of a change of position of the tape. Since D1 was concerned with the problem of informing the user of a risk caused by a normal use of the recorder after the programming of a recording operation, as in the invention, it would be obvious to the skilled

person to consider the display of a warning message if the recording may have been placed at risk by a change of the tape position.

Claim 1 did not involve an inventive step in view of the combination of documents D1 and D3. D3 disclosed a recorder displaying a warning message if a recording program which had been preset was not achievable, for instance because the amount of tape available for the recording was not sufficient. The skilled person, who wanted to make sure that there was sufficient tape available for a programmed recording in the recorder according to D1, would consider applying the solution disclosed in D3 which implied a detection of a change of the tape position.

V. The arguments of the respondent proprietor can be summarized as follows:

D1 neither disclosed, nor suggested, a video cassette recorder in which a warning message was displayed if a change of the tape position during a normal use of the recorder after the programming of a recording operation had placed the recording at risk. More specifically, the flashing of the timer legend took place as a consequence of the programming of a recording, irrespective of such a normal use or change of the tape position, and did not form a warning message.

The skilled person would have no good reason to combine the teachings of D1 and D3, because D3 was not concerned with the problem of a normal use of a video recorder after it had been programmed for making a future recording. D3 did not disclose any means for

displaying a warning message as a consequence of a change of the tape position after the programming had been done, so that a combination of D1 and D3 would not lead to the features recited in the characterizing part of claim 1.

VI. The appellant (opponent 02) requested that the decision under appeal be set aside and that the European patent No. 0 507 119 be revoked.

VII. The respondent (patentee) requested that the appeal be dismissed and that the patent be maintained on the basis of claim 1 as filed in the oral proceedings and claims 2 to 26 as maintained by the opposition division; description, columns 1 to 5 as maintained by the opposition division and columns 6 and 7 as filed in the oral proceedings; drawings, Figures 1 to 4 of the patent specification.

VIII. Opponent 01 withdrew its opposition (letter dated 9 July 2003).

Reasons for the Decision

1. The appeal is admissible.

2. *Admissibility of the amendments to the description*

The Board is satisfied that the amendments to the description are admissible. The description of the patent in suit has been amended *inter alia* to incorporate at column 6, between lines 31 and 32, the sentence "Block 305 provides to raise the motor

activated flag (PL); the control then passes to block 307." and to replace at column 7, line 6, the word "cassette" by the word "tape". These amendments bring the description of the patent into conformity with the original text of the application (which had been filed in Italian and incorrectly translated into English) and are admissible pursuant to Article 14(2) EPC.

3. *Admissibility of the amendments to the claims*

The Board is satisfied that the present claims satisfy the requirements of Article 84 EPC and do not contravene Article 123(2) or (3) EPC. More specifically:

3.1 Regarding Article 123(2) EPC, the video cassette recorder according to present claim 1 corresponds to a recorder as defined by the combination of original claims 1, 7 and 13 with the additional restriction to means for displaying a warning message for the user **whether such said use may have placed the recording of the program at risk by change of the tape position of the cassette.**

3.2 The description (column 5, line 42 to column 6, line 50) and figure 4 of the application as filed disclose two alternative ways for informing the user that a normal use of the recorder may have placed the recording at risk. According to one of these ways, during the normal use of the recorder, a block 308 checks whether the recorder has been programmed, blocks 303 and 311 check whether the motor of the recorder has been activated and a block 312 displays a warning message that the position of the tape has been changed.

3.3 The combination of the features recited in claims 1, 7 and 13 as originally filed, according to which the user of the claimed recorder is informed as to whether the normal use "may have placed the recording at risk" (claim 1), and the recorder is provided with means "for controlling whether the recorder is used after having been programmed and means for displaying a warning message" (claim 7), and means "for controlling whether, upon use of the recorder after having been programmed, the cassette tape position has been changed and means for warning the user" (claim 13) identifies a recorder which corresponds to a generalisation of the originally disclosed alternative way performed by the blocks 303, 308, 311 and 312. According to this disclosure, the warning message informing the user of a normal use having placed the recording at risk is displayed **as a consequence of the change of position of the cassette** (block 312). It follows that the restriction of the recorder identified by the combination of claims 1, 7 and 13 as originally filed to incorporate the additional feature mentioned in paragraph 3.1 above does not go beyond the content of the application as filed, and present claim 1 does not contravene Article 123(2) EPC.

3.4 Present claim 1 does not contravene Article 123(3) EPC because it comprises in substance all the features recited in claim 1 as granted and the additional features "controlling if the cassette tape position has been changed through said normal use" and "by said change of the tape position of the cassette".

3.5 The features "said display means **are activated** ... as consequence of a change of the tape position of the cassette" and "the recorder **has been** used after having been programmed", which were introduced in claim 1 maintained by the opposition division have been deleted from present claim 1, because they extended beyond the content of the application as filed, in contravention of Article 123(2) EPC. The deletion of these features, which widens the scope of the claim and puts the opponent 02, who is the sole appellant, in a situation worse than if he had not appealed, appears at first sight to offend against the prohibition of *reformatio in peius* (G 9/92, OJ 1994, 875). However, an exception to this principle may be made in circumstances, as in the present case, where the patent as maintained in amended form would otherwise have to be revoked as a consequence of an inadmissible amendment held allowable by the opposition division in its interlocutory decision (G 1/99, OJ 2001, 381).

3.6 Regarding Article 84 EPC, the amendments made to claim 1 are clear.

4. *Inventive step*

4.1 It is not in dispute that a video cassette recorder comprising the features recited in the pre-characterizing part of present claim 1 is disclosed in document D1 which is considered as the closest prior art.

4.2 The video recorder according to D1 is provided with means for delaying putting the recorder into automatic conventional timer mode (column 1, lines 19 to 25).

This recorder can be used in its normal mode after having being programmed and it "will remind the user that the timer has been armed by periodically flashing up the timer legend in the display" (column 2, lines 46 to 50). However, there is no disclosure in D1 of monitoring a change of the tape position. The flashing of the timer legend appears whenever the recorder has been programmed, irrespective of whether it is then used normally or not. This flashing thus does not form a warning message displayed for warning the user that a normal use after a programming of a recording operation may have placed the recording at risk by a change of the tape position. Nor is such monitoring or the display of a warning message implied by the provision of means for making sure that there will be sufficient available tape in the cassette, or means for winding to a specified point of the tape, at the time of entry to the timer mode, which are mentioned in D1 (column 1, lines 40 to 46; column 3, lines 44 to 46; claim 4). Accordingly, the features set out in the characterizing part of present claim 1 are not disclosed in D1.

5. Starting from D1 and having regard to the technical effects achieved by the invention (see the patent in suit, column 7, lines 17 to 25), the problem addressed by the present invention can be seen as providing a video cassette recorder that allows a normal use of a recorder after a programming for carrying out a recording has been made, and has sufficient protection against risks that may be caused by this use. This problem is solved by the characterizing features of claim 1.

5.1 D1 is not specifically directed to the problem of warning a user if a normal use may have placed a recording at risk, but is more generally concerned with the solution of the problem of allowing a normal use of a recorder which has been programmed (column 1, lines 4 to 15). According to D1, a timer legend is flashed in a display when the timer has been armed, to remind the user that the recorder has been programmed. D1 does not suggest giving a warning of a risk to the programmed recording caused by a change of the tape position. Nor is this suggested by adopting the timer mode and flashing a cassette message if the cassette is ejected whilst the timer is armed (D1, column 3, lines 2 to 5), or by providing means for making sure that there is sufficient tape available for recording, or by going to a specified point of the tape, at the record time (D1, column 1, lines 40 to 46). The last two measures attempt to avoid risks rather than warn about them. Therefore, the skilled person aware of D1 and faced with the problem of the present invention would not find in D1 any suggestion for checking whether the tape position has been changed by a normal use of the recorder after it has been programmed and displaying a warning message as a consequence of such a change.

5.2 D3 discloses a video cassette recorder comprising an indicator assembly (Figure 2: 32) displaying alarms in the event that a preset recording program is not achievable, for instance if the amount of tape available for recording is less than the amount of tape required for the preset recording program (column 4, line 61 to column 5, line 6; column 5, lines 51 to 56; column 7, lines 39 to 47; column 11, lines 39 to 54). However, D3, contrary to D1, does not contemplate a

normal use of the recorder which has been programmed. Nor is a monitoring of a position change of the cassette tape for displaying a warning message, when said change of position may have placed the recording of the program at risk, disclosed in D3, in particular, not in the passages cited by the appellant: column 7, line 48 to column 8, line 39; column 12, lines 13 to 26. The skilled person, aware of D1, thus would have no reason to consider the teaching of D3 to solve the technical problem addressed by the invention, nor would he find there the claimed solution to this problem.

6. Accordingly, the arguments of the opponent 02 have not convinced the Board that the subject-matter of present claim 1 was obvious to the person skilled in the art at the priority date of the patent. The Board concludes that the subject-matter of claim 1 involves an inventive step within the meaning of Article 56 EPC.
7. In the Board's judgement, taking into account the amendments made by the proprietor, the patent in suit and the invention to which it relates satisfy the requirements of the Convention.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to maintain the patent in the following version:

Claims: claim 1 as filed in the oral proceedings, claims 2 to 26 as maintained by the opposition division;

Description: columns 1 to 5 as maintained by the opposition division, columns 6 and 7 as filed in the oral proceedings;

Drawings: Figures 1 to 4 of the patent specification.

The Registrar:

The Chairman:

D. Sauter

W. J. L. Wheeler