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**Datasheet for the decision  
of 25 January 2008**

**Case Number:** T 1026/03 - 3.5.04

**Application Number:** 98114676.4

**Publication Number:** 0884907

**IPC:** H04N 7/173

**Language of the proceedings:** EN

**Title of invention:**

Caller identification system for television

**Applicant:**

Sedna Patent Services, LLC

**Headword:**

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**Relevant legal provisions:**

RPBA Art. 13(3)

**Relevant legal provisions (EPC 1973):**

EPC Art. 76(1)

**Keyword:**

"Subject-matter extending beyond the content of the earlier application as filed (yes)"

**Decisions cited:**

G 0001/06, T 0211/95

**Catchword:**

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Case Number: T 1026/03 - 3.5.04

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.04  
of 25 January 2008

**Appellant:** Sedna Patent Services, LLC  
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27th Floor  
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**Representative:** Strehl Schübel-Hopf & Partner  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 9 May 2003  
refusing European application No. 98114676.4  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** F. Edlinger  
**Members:** M. Paci  
C. Vallet

## Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division to refuse European patent application No. 98 114 676.4.
- II. The decision under appeal was based on the ground that the application, a divisional application from earlier European patent application No. 94 904 392.1 (published as international patent application WO 94/013107 A1), by the definitions given in claims 1 and 33, related to subject-matter extending beyond the content of the earlier application as filed, in violation of Article 76(1) EPC 1973.
- III. In an official communication accompanying the summons to oral proceedings the board informed the appellant of its preliminary non-binding opinion that claims 1 and 33 did not comply with Article 76(1) EPC 1973.
- IV. With a letter dated 21 December 2007 the appellant filed amended independent claims 1 and 33 forming the basis of a new main request.
- V. During the oral proceedings held before the board on 25 January 2008 the appellant submitted an auxiliary request including an amended claim 1.
- VI. Independent claim 33 according to the main request reads as follows:

"A set top terminal for use in displaying telephone call identification in a television delivery system (200), the set top terminal (220) being arranged for

decompressing digital program signals and generating menus for program selection, comprising:

(a) a receiver using a set top terminal software for receiving a telephone signal including a telephone number from which said call was initiated;

(b) a processor, operably connected to the receiver, for processing the received telephone signal to produce text and/or graphics based on said telephone number; and

(c) a generator, operably connected to the processor, for using the produced textual data and/or graphics to generate a signal for display on a television apparatus in said television delivery system (200)."

Claims 1 to 32 and 34 to 81 according to the main request have no bearing on the present decision.

VII. Independent claim 1 according to the auxiliary request reads as follows:

"A set top terminal having the capability to produce decompressed video for use in displaying telephone call identification in a television program delivery system (200) including a television apparatus, the set top terminal comprising:

means for receiving digitally compressed program signals and a control information stream that provides a menu generation capability;

means for demultiplexing the control information stream into graphics and text;

means for combining the text and graphics to produce a menu generation signal;

a receiver using a set top terminal software for receiving a telephone signal including a telephone number from which said call was initiated;

a processor, operably connected to the receiver, for processing the received telephone signal to produce a menu including text and/or graphics based on said telephone number and the menu generation signal; and

a generator, operably connected to the processor, for using the produced menu to generate a signal for display on a television apparatus in said television delivery system (200)."

VIII. The appellant's final requests are:

- as a main request, that the decision under appeal be set aside and that the case be remitted to the first instance on the basis of claims 1 and 33 as filed with letter dated 21 December 2007; and
- as an auxiliary request, that the decision under appeal be set aside and that the case be remitted to the first instance on the basis of claim 1 as filed in the oral proceedings before the board.

IX. The examining division's reasoning in the decision under appeal, as far as still relevant to the present more limited independent claims, can be summarised as follows.

The earlier application as filed contained eight independent apparatus claims and four independent method claims. None of these claims contained features or method steps relating to telephone call identification. Similarly, the background and general description of the invention on pages 1 to 7 of the

earlier application did not mention telephone call identification. A caller ID function was only disclosed on pages 78 to 80 of the description and in dependent claims 8, 23 and 31 of the earlier application as filed, and it was consistently presented as subordinate to other features. The caller ID function was never presented in the earlier application as filed as a separate invention.

Hence independent claims 1 and 33 related to subject-matter extending beyond the content of the earlier application as filed in violation of Article 76(1) EPC 1973.

X. The appellant argued essentially as follows:

*Regarding claim 33 of the main request*

According to established jurisprudence of the boards (see in particular decision T 211/95, not published in OJ EPO), Article 76(1) EPC 1973 does not require that subject-matter claimed in a divisional application must be contained in the claims of the earlier application as filed. Article 76(1) EPC 1973 only requires for the subject-matter to be disclosed as such anywhere in the earlier application as filed. Thus a divisional application can validly claim features which are derivable only from the description of the earlier application as filed.

The summary portion of the description on page 5, line 18 to page 6, line 4, in which the skilled reader regularly expects to find a definition of the invention in its most general terms, makes no limitation

comparable to the scope of the original independent claims of the earlier application. Moreover the subject-matter of present claim 33 is not hidden in the patent application. On the contrary, it is the subject of a chapter of its own, given its own subheading, namely "g. Caller ID". Also the statements on page 4, lines 18 to 19 and lines 22 to 23, and page 7, lines 8 to 12, alert the skilled reader that specific features providing the set top terminal with "advanced features and capabilities" may form an invention on their own.

Hence the features of claims 1 and 33 are disclosed as such in the **description** of the earlier application.

Moreover, also starting from claim 1 of the earlier application as filed, it is directly and unambiguously derivable for the skilled person from the whole disclosure of the earlier application that some of the features in claim 1 are in fact inessential. According to established jurisprudence of the boards, the deletion of features which are presented as inessential does not violate the requirements of Article 76(1) EPC 1973. This applies in particular to the following features of claim 1 as filed: a control information stream used for providing a menu generation capability, an interface means and a means for demultiplexing the control information stream into graphics and text. Indeed, these features relate to information to be displayed which is supplied with the television signals whereas, for the caller ID function, a telephone number may be displayed which is supplied via a telephone line and thus need not be displayed with complex menus designed for television programs.

In view of the above, the requirements of Article 76(1) EPC 1973 are met.

*Regarding claim 1 of the auxiliary request*

Claim 1 according to the auxiliary request is based on claim 1 of the earlier application as filed and thus should meet the requirements of Article 76(1) EPC 1973. Since the oral proceedings were called at short notice with little more than the two months' minimum notice and since the Christmas holidays fell in this period, it was difficult to contact the overseas applicant and file further amendments within the time limit set by the board. The amendments made are intended to overcome objections discussed in the oral proceedings and comprise hand-written amendments to a combination of claim 1 of the earlier application and claim 33 of the main request. The board should therefore admit claim 1 into the appeal procedure.

**Reasons for the Decision**

1. The appeal is admissible.

*Main request*

2. Request to remit the case to the first instance

Article 111(1) EPC 1973 provides that after examination as to the allowability of the appeal the board of appeal may remit the case to the department which was responsible for the decision. In the present case, the sole ground for refusing the application was based on



Article 76(1) EPC 1973 and therefore the board has a duty to examine this ground despite the fact that amended claims were filed with the statement of grounds of appeal.

3. *Requirements of Article 76(1) EPC 1973*

3.1 Since the present divisional application was filed before 13 December 2007 the applicable legal text is Article 76 EPC 1973 (see Special edition No. 1, OJ EPO 2007, pages 196-198). This has not been disputed.

3.2 According to established jurisprudence of the boards of appeal, anything disclosed in the divisional application must be **directly and unambiguously derivable** from what is disclosed in the earlier application as filed (see order of decision G 1/06, to be published in the OJ EPO). In other words, a divisional application may not be filed in respect of, or directed by amendment to, subject-matter which extends beyond the content of the parent application if the skilled person is presented with technical information in the divisional application which is not disclosed in the earlier application as filed, even when account is taken of matter which is implicit to that person (see G 1/06, points 5.1 and 9.2 of the reasons; Case Law of the Boards of Appeal of the European Patent Office, 5th edition 2006, pages 281 to 285). The board agrees with the appellant that Article 76(1) EPC 1973 does not require that subject-matter claimed in a divisional application be contained in the claims of the earlier application as filed; it only requires that the subject-matter be disclosed as such anywhere in the whole disclosure of the earlier

application (see G 1/06, point 9.2 of the reasons; also T 211/95, point 3.1 of the reasons, not published in OJ EPO, cited by the appellant).

4. *Disclosure of the earlier application as filed*

4.1 The section "BACKGROUND OF THE INVENTION" on pages 2 to 5 of the earlier application as filed discloses limitations of existing systems for delivering television programs to the home viewers. The recurrent theme in this section is the lack of user-friendliness of these systems when it comes to informing the viewer faced with the difficulty of choosing from many programs on a large number of television channels. The first listed need that the invention aims to fulfil reads as follows: *"What is needed is a system which can deliver and present television programming through a user friendly interface which allows the consumer to easily select from among the many program choices"* (see page 4, lines 9 to 12).

Other needs are also mentioned, including the following ones referred to by the appellant in support of his arguments: *"What is needed is a set top converter with enhanced functionality"*, *"What is needed is a set top converter that provides users with advanced features and capabilities"* and *"What is needed is technology that upgrades the functionality of existing set top converters"* (see page 4, lines 16 to 19 and 22 to 23). However the sentence *"As programming presentation becomes more user friendly, users seek additional features and functional capabilities"* (see page 4, lines 6 to 8) immediately preceding the list of needs appears to convey the message that the user-

friendliness of program selection must first be improved (the first listed need) before these additional needs regarding enhanced functionality and advanced features and capabilities arise and may then be addressed, or that they go hand in hand with improved user-friendliness.

4.2 In the section "SUMMARY OF INVENTION" of the earlier application as filed the broadest general concept comprising features aimed at fulfilling at least one of the aforementioned needs is found on page 5, lines 21 to 23 in the sentence reading "*The preferred set top terminal provides both a menu generation capability as well as a number of advanced features and functional capabilities*". This sentence, as well as the remainder of the section, thus conveys the impression that the advanced features and functional capabilities are provided in addition to the menu generation capability aimed at improving the user-friendliness of the set top terminal.

4.3 In the section entitled "DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT" of the earlier application as filed the telephone caller identification function is mentioned only on pages 78 to 80 under subsection "*g. Caller ID*". This subsection has the following hierarchical position in the description:

*"DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT"*

*"C. Detailed Description of Advanced Set Top Terminal"*

*"4. Advanced Features and Functional Capabilities"*

*"g. Caller ID"*

The first sentence of subsection "g. Caller ID" reads:  
*"Using the capability of the set top terminal and a connected modem, the set top terminal is able to perform the function of caller ID"* (see page 78, lines 15 to 17). It is further explained that the *"set top terminal is able to use the television as its display means to communicate to the viewer information about incoming telephone calls"* and that *"the strong local processing capability of the set top terminal allows the caller ID function to be much more user friendly and convenient"* (see page 78, lines 19 to 24). When an incoming telephone call arriving through the modem is detected by the set top terminal software either the telephone number from which the telephone call was initiated or text or graphics representing it (such as the name of the person placing the call or a "smiley face") is flashed on the television screen using an overlay menu generated by the set top terminal (see page 78, line 25, to page 80, line 1).

4.4 In the claims of the earlier application as filed only dependent claims 8 (dependent on claim 1), 23 (dependent on claim 19) and 31 (dependent on claims 25 and 26) mention a caller ID function. These claims comprise features relating to a telephone caller identification function, but also a number of other features further defining the claimed upgrade module (claims 1 and 8), upgraded set top converter (claims 19 and 23) or advanced set top terminal (claims 25, 26 and 31).

4.5 The drawings of the earlier application as filed do not disclose a caller ID function either.

5. *Claim 33 of the main request*

5.1 Claim 33 (main request) of the present divisional application is directed to a set top terminal for use in displaying telephone call identification in a television delivery system. Compared to the three claims of the earlier application as filed, which contained features relating to telephone caller identification (i.e. claim 8 dependent on claim 1, claim 23 dependent on claim 19 and claim 31 dependent on claims 25 and 26), claim 33 of the present application has been broadened by the omission of a number of features, in particular of the following ones which are present, albeit with slightly varying wordings, in all three claims:

- (a) a control information stream received from a remote location and providing menu generation capability;
- (b) means for demultiplexing the control information stream to extract menu content information such as text and graphics and
- (c) means for transferring a menu generation signal to an interface means for output to the decompression box (or combining the menu information with a video signal to produce a menu generation signal) for display.

As explained under section 3 above, the description of the earlier application as filed consistently described the main object of the invention as being to provide home viewers with a user-friendly interface allowing them to easily navigate through hundreds of programming choices.

This object is achieved according to the earlier application as filed by a menu-driven access scheme that allows each subscriber to select individual programs by sequencing a series of menus (see for instance page 10, lines 15 to 18). For the generation of menus the set top terminal depends on control signals (the so-called "control information stream") transmitted together with the television signals from a remote television station (see for instance page 21, lines 7 to 23, and page 27, lines 11 to 24). The received signals are demultiplexed by the set top terminal and menu information is extracted from which menu templates can be created and stored in the set top terminal (see page 21, line 11, to page 22, line 17). Once the menu templates are stored in memory, the set top terminal can generate the appropriate menus. The menu templates may also be deleted or altered using control signals sent from the remote station (see page 22, lines 2 to 5). Several types of menus may be displayed, including the so-called "overlay menus" (see page 26, lines 4 to 21).

As already set out under point 4.3 above, subsection "g. Caller ID" on pages 78 to 80 of the earlier application as filed, being the only part of the description mentioning the telephone caller identification function, starts with the following sentence: *"Using the capability of the set top terminal and a connected modem, the set top terminal is able to perform the function of caller ID"*. Since the description of the earlier application consistently describes the essential capability of the set top terminal as being to use control signals transmitted with the television

signals for generating menus, the skilled person would understand when reading this opening sentence that the set top terminal having the caller ID functionality described in subsection "g. Caller ID" would at least also have this capability of using a control information stream for generating menus. Moreover, according to subsection "g. Caller ID", every time the telephone number (or text or graphics representing this number) of an incoming call is displayed on the television screen it is done via an overlay menu (see page 79, lines 11 to 13, 18 to 19, and the sentence bridging pages 79 and 80).

5.2 In view of the above, the whole disclosure of the earlier application as filed consistently presents the telephone caller identification features as being in addition to the above features (a) to (c) in the set top terminal. Since claim 33 of the main request claims a set top terminal comprising telephone call identification features but none of features (a) to (c), it introduces the new technical information that the telephone call identification features could be applied to a set top terminal not having any of features (a) to (c). For the reasons set out above, the board regards this information as not directly and unambiguously derivable from the content of the earlier application as filed.

5.3 The appellant argued that features (a) to (c) only relate to information supplied with the television signals, whereas the telephone number to be displayed is supplied via a telephone line and thus need not be displayed with complex menus designed for television programs.

5.4 The board is not convinced by this argument because, even in the simplest case where only the telephone number of the incoming call is displayed on the television screen, the description of the earlier application as filed explicitly indicates that an overlay menu is used (see sentence bridging pages 79 and 80). The earlier application as filed does not contain any indication that overlay menus could be generated by other means than those of features (a) to (c). Although it might well be obvious to the skilled person to use other means for generating overlay menus, this information is not directly and unambiguously derivable from the earlier application as filed.

5.5 For the above reasons the divisional application, even after amendment to claim 33 according to the main request, is still directed to subject-matter extending beyond the content of the earlier application as filed, contrary to Article 76(1) EPC 1973.

5.6 Since the board has come to the conclusion that the application already does not pass the hurdle of Article 76(1) EPC 1973, the appellant's request for remittal to the first instance for further prosecution does not come into play as there is nothing left to prosecute.

#### *Auxiliary request*

#### 6. *Admissibility of late amendments*

6.1 Claim 1 according to the auxiliary request was filed during the oral proceedings before the board. It was



formed by combining claim 1 of the earlier application as filed with claim 33 according to the main request and by making numerous amendments in the form of deleted, redrafted or displaced features.

- 6.2 No justification for the late filing of this claim was given except for the fact that the oral proceedings were called at short notice with little more than the two months' minimum notice specified in Rule 71(1) EPC 1973.
- 6.3 During the oral proceedings the board informed the appellant that claim 1 contained many amendments raising fresh issues, under both Article 76(1) EPC 1973 and Article 123(2) EPC 2000, which the board could not reasonably be expected to deal with without adjournment of the oral proceedings. Moreover the board can see no reasonable explanation why the auxiliary request could not have been filed together with the main request which was filed in time, or at least a short time before the oral proceedings, if the minimum time limit was too harsh in the particular circumstances of the present case. Accordingly the board, in application of Article 13(3) RPBA (published in OJ EPO 11/2007, pages 536 to 547), did not admit this late amendment to the appellant's case according to the auxiliary request.

### *Conclusion*

7. Since the main request cannot be allowed and the auxiliary request is not admitted, the appeal must be dismissed.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

D. Sauter

F. Edlinger