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**Datasheet for the decision  
of 5 July 2007**

**Case Number:** T 0089/04 - 3.5.04

**Application Number:** 97908915.8

**Publication Number:** 0885525

**IPC:** H04N 7/08

**Language of the proceedings:** EN

**Title of invention:**

An integrated interactive video and internet system

**Patentee:**

ACTV, INC.

**Opponent:**

IGR GmbH & Co. KG.

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 54(3), 56, 84, 123(2)

RPBA Art 10a(2)(4)

**Keyword:**

"Amendments - clarity (yes)"

"Amendments - added subject-matter (no)"

"Novelty - prior European application (yes)"

"Inventive step - problem and solution (yes)"

"Oral proceeding - submissions by an accompanying person (no)"

**Decisions cited:**

G 0004/95, T 0621/98

**Catchword:**

Oral submissions by an accompanying person (point 2)



Case Number: T 0089/04 - 3.5.04

**DECISION**  
of the Technical Board of Appeal 3.5.04  
of 5 July 2007

**Appellant:** IGR GmbH & Co. KG.  
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**Representative:** Eichstädt, Alfred  
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**Respondent:** ACTV, INC.  
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**Representative:** Riesenberg, Axel  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
17 November 2003 concerning maintenance of the  
European Patent No. 0885525 in amended form.

**Composition of the Board:**

**Chairman:** F. Edlinger  
**Members:** A. Dumont  
T. Karamanli

## Summary of Facts and Submissions

I. The opponent filed an appeal against the decision of the opposition division to maintain European patent No. 0 885 525 in amended form. The application as filed had been published as International patent application WO 97/33434.

II. The opposition was based on Article 100(a) EPC together with Articles 54(3) and 56 EPC, in particular relying on the following prior art documents:

D10: DE 44 27 046 A1;

D12: Bach et al. "Multimedia-Terminal als Endgerät" In: Funkschau, Fachzeitschrift für elektronische Kommunikation, 6/96, 1 March 1996, pages 70 to 75; and

D13: WO 97/22207 A1.

III. The independent claims in the version (main request) maintained by the opposition division read as follows.

"1. A system for presenting video programming and related Internet information, the system comprising: means (16, 18, 24, 28) for receiving programming containing a video signal (36), an audio signal and one or more embedded uniform resource locators, wherein the embedded uniform resource locators specify one or more Internet addresses of information segments which relate specifically to the content of the video and audio signals of the programming; a controller (16) connected to the receiving means (16, 18, 24, 28) comprising decoding means (12), and

display means (18) connected to the controller (16) and to the receiving means (16, 18, 24, 28) for presenting the video and audio signals and for presenting the related Internet information;

said decoding means (12) being arranged to automatically decode the uniform resource locators to determine the specified Internet addresses; and the controller (16) further comprising means (98) connected to the decoding means (12) and arranged to retrieve one or more Internet information segments residing at the determined Internet addresses; the system being adapted such that, after decoding of the specified Internet addresses by the decoding means (12), the one or more Internet information segments are automatically retrieved by the means (98) for retrieving;

and such that said display means (18) is arranged to present the video and audio signals concurrently with the retrieved Internet information segments."

"6. A method for integrating video programming with related Internet information, the method comprising the steps of:

receiving at receiving means (16, 18, 24, 28) programming containing a video signal (36), an audio signal and one or more embedded uniform resource locators, wherein the uniform resource locators specify one or more Internet addresses (102) of information segments which relate specifically to the content of the video and audio signals of the programming;

presenting the video and audio signals and related Internet information by way of display means (18) operatively connected to a controller (16) and to the receiving means (16, 18, 24, 28), the controller being

connected to the receiving means which comprise decoding means (12); and automatically decoding, by way of the decoding means (12), the uniform resource locators to determine the specified Internet addresses; the controller (16) being arranged to retrieve one or more Internet information segments residing at the determined Internet addresses (102); the method further comprising the steps of: after the decoding of the specified Internet addresses automatically retrieving the one or more Internet information segments; and presenting the video and audio signals by way of the display means (18) concurrently with the retrieved Internet information segments."

IV. The decision under appeal held that the opponent's objections to the amendments made (Articles 84 and 123(2) EPC) were not convincing because it was clear what was meant by the term "automatically" (no viewer interaction is needed for the functionality further described in the claims) and that this was implicitly disclosed in the application as filed. D13 did not disclose that a presently running advertisement was actually displayed while the additionally accessed information was being displayed. There was no indication in the prior art that the Internet content might be related to the broadcast TV content, that the one may exercise automatic control over the other in a form of master/slave relationship of the kind implied in claims 1 and 6.

V. With the statement of grounds of appeal the appellant reiterated all the objections raised during the

opposition proceedings and further referred to the following document:

D14: W.Kaiser, "Interaktive Breitbandkommunikation, Nutzungsformen und Technik von Systemen mit Rückkanälen", Telecommunications 8, Münchner Kreis, Springer-Verlag Berlin Heidelberg New York, 1982, pages 79, 80 and 120 to 123.

- VI. In a letter dated 26 October 2007 the appellant submitted a change of name and filed a copy of the corresponding extract from the German commercial register.
- VII. In a letter dated 2 July 2007 the respondent (patentee) requested permission for Mr A. Delpuch to make submissions as a technical expert on the technical background of the invention and with respect to the prior art.
- VIII. Oral proceedings before the board took place on 5 July 2007. The board, after hearing the parties, did not allow Mr Delpuch to make oral submissions.
- IX. The appellant requested that the decision under appeal to be set aside and that the European patent be revoked. He further requested that the submissions by the technical expert accompanying the representative not be admitted.
- X. The respondent requested that the appeal be dismissed. As an auxiliary measure he requested that the patent be maintained on the basis of independent claims 1 and 6

filed with letter dated 5 June 2007 according to auxiliary requests 1 to 3.

- XI. The parties' arguments regarding the request for Mr Delpuch to make oral submissions may be summarised as follows.

Appellant: The request was made three days before the oral proceedings, which is too late for the appellant to properly react. The board, following the decision of the Enlarged Board of Appeal G 4/95 (OJ EPO 1996, 412) and the case law of the boards of appeal, should refuse permission.

Respondent: Mr Delpuch is a vice-president of the company OpenTV. As explained in the letter of 2 October 2003, OpenTV has acquired the patentee's company ACTV, Inc. He is therefore not an accompanying person in the meaning of decision G 4/95 and he may make oral submissions at any time without advance notice (see decision T 621/98 (not published in OJ)). Furthermore, the summons to attend oral proceedings scheduled at short notice (hardly more than two months before the scheduled date), public holidays in the USA (where Mr Delpuch resides) and the need to arrange for interpreting prevented an earlier notice. The request should therefore be granted.

- XII. The parties' arguments regarding Article 84 and 123(2) EPC may be summarised as follows.

Appellant: Claims 1 and 6 encompass embodiments not consistent with the assumption made by the opposition division that the user may remain totally passive. They

set out that the decoding of the uniform resource locators and the retrieval of the Internet information segments take place automatically. However the wording of the last paragraph of the claims leaves totally open whether the presentation of the retrieved Internet information segments on the display means is initiated by an active intervention of the user, i.e. not automatically. In particular, the claims do not exclude a user having to operate a key first before the information segments are automatically retrieved and only then presented concurrently with the video and audio signals. They therefore add subject-matter to the application as filed. Furthermore completely automatic operations go against the aim pursued in the present patent which is to provide for an interactive system (see for instance the title of the patent). This renders the claims unclear.

Respondent: A fair reading of the original application by a person skilled in the art would yield that the invention provides for the automatic decoding of Internet addresses, as well as the automatic retrieval and delivery to the user of Internet information synchronised with the audio/video program, in particular by the use of client software with a JAVA enabled browser. This does not preclude interactivity after the additional information has been presented to the user. The subject-matter of the claims is therefore originally disclosed and also clear.

XIII. The parties' arguments regarding Article 54(3) EPC may be summarised as follows.



Appellant: D13 discloses the automatic decoding of Internet addresses embedded in the television signal and the presentation of Internet information concurrently with a television programme. Retrieval and presentation of Internet information upon depression of a key by the user is covered by the claims of the patent in suit. As a result, the subject-matter of the claims lacks novelty.

Respondent: The retrieval and display of the Internet information in D13 is subject to the desire or option of the user, who has to depress a key. The invention as claimed does not require such a user action. Furthermore, D13 does not disclose Internet information being presented concurrently with the TV picture on the screen. As a result D13 does not disclose the subject-matter of the claims. Moreover D13 was originally filed under the Patent Cooperation Treaty, so that the relevant provisions of the Paris Convention for the Protection of Industrial Property prevail. Since the applicant of D13 is domiciled in the British Virgin Islands, which is not a contracting state of the Paris Convention, he may not validly claim priority from the German application 195 45 882.6 under the provisions of the Paris Convention. The actual filing date of D13 (28 November 1996) being later than any of the priority dates of the opposed patent, D13 is not prior art under Article 54(3) EPC.

XIV. The parties' arguments regarding Article 56 EPC may be summarised as follows.

Appellant: D10 discloses the presentation of additional information (for instance a telephone number)

concurrently with a television programme. The additional information may be used to automatically establish bidirectional communication through a different channel (for instance a telephone line). D12 discloses a user-friendly multimedia terminal embodying the technological convergence of television and computer services, with a television receiver and Internet access. Combining D10 and D12 in order to increase the available additional information and to use Internet, as a commonly known source of information, to automatically provide additional information in the context of television programmes was therefore obvious. D14 further illustrates the common practice of combining different channels to provide an interactive service to the end user.

Respondent: The present invention resorts to two different channels, a first one used to convey a television signal and a second one to automatically convey additional Internet information related to the specific television programme. A controller and display means act as a "push" service presenting video programming and synchronised Internet information segments. D10 relates to home shopping television in which additional information is conveyed over the television channel as teletext pages. D12 discloses the integration of services using different channels within a single terminal in order to share expensive hardware components. However the services are not merged. D14 was filed after the end of the term for filing an opposition and was thus late filed. It is also of little relevance because it relates to an interactive service requiring intervention by the user and therefore need not be considered. As a result, none of

the prior art documents suggests the concept underlying the present invention, so that the formulation of the technical problem (increasing the available information) and the argumentation put forward by the appellant show an ex post facto analysis.

## **Reasons for the Decision**

1. The appeal is admissible.
2. *Oral submissions by Mr Delpuch as an accompanying person*
  - 2.1 Mr Delpuch is a vice-president of the company OpenTV. Since the company ACTV, Inc. is recorded in the Register of European Patents as the patentee, the company OpenTV, which is a different legal person, is not a party to the present proceedings in accordance with Articles 99(4) and 107, second sentence EPC. Decision T 621/98, to which the patentee refers, does not apply to the present case because it deals with a different situation where the professional representative was accompanied by the patentee (see point 2 of the reasons). Thus Mr Delpuch is considered to be a person accompanying the representative and, therefore, the criteria set out in decision G 4/95 (supra) have to be met.
  - 2.2 According to decision G 4/95, oral submissions by a person accompanying the professional representative can only be made with the permission of and under the discretion of the EPO. The permission to make oral submissions should be requested sufficiently in advance,

so that the other party is not taken by surprise. The party making the request should do so as soon as he has decided that he wishes such oral submissions to be presented. A request made shortly before the oral proceedings should, in the absence of exceptional circumstances, be refused by the EPO, unless the opposing party agrees to the making of the oral submissions (see G 4/95 (supra), point 10 of the reasons).

2.3 In the present case the request to allow Mr Delpuch to make oral submissions was submitted three days before the oral proceedings. The board holds that this is not sufficiently in advance. Therefore the board has to establish whether the circumstances were exceptional, as referred to in decision G 4/95. The reasons adduced by the respondent (summons to attend oral proceedings about two months before the scheduled date, public holidays in the USA, where Mr Delpuch resides, and the need to arrange for interpreting) may explain why the practical arrangements took some time after the decision to present oral submissions was taken. They do not however justify the request not being made as soon as this decision was taken. As a result, the board does not see any exceptional circumstances.

2.4 A request which was not made sufficiently in advance should, in the absence of exceptional circumstances, be permitted only if the opposing party agrees. Since the appellant objected that he could not prepare himself properly, the board did not allow Mr Delpuch to make oral submissions on behalf of the respondent (patentee) at the oral proceedings.

3. *Amendments to the claims during opposition proceedings*

3.1 Independent claims 1 and 6 as maintained by the opposition division differ in substance from claims 1 and 6 as granted by the removal of an alternative to the concurrent presentation of video and audio signals ("or independently from the retrieved Internet information segments") in the last paragraph of the claims. The appellant did not object to this amendment and the board sees no reason to object to it either.

3.2 Claims 1 and 6 further differ by additionally setting out that the decoding of the uniform resource locators and the retrieval of the Internet information segments take place "automatically". The appellant objects to these amendments.

4. *Article 84 EPC*

4.1 In the context of the present invention the term "automatically" implies that an active intervention of the user is not necessary for the decoding and retrieving operations to take place in the context of these features of claims 1 and 6 (cf. the distinction between "active participant" versus "passive observer" made in paragraph [0009] of the patent specification). This corresponds to the usual meaning of the word, namely "self-acting". Interactive operation is expected only after completion of the automatic operations, for instance purchasing a product seen on television, responding to polls, etc (see paragraphs [0012] and [0013] of the patent specification).

4.2 As a result, automatic decoding and retrieval are not contradictory to a posterior interactive use of the system, and the expressions used in the claims are clear.

5. *Article 123(2) EPC*

5.1 The present invention integrates video programming and Internet information in that at least one uniform resource locator (URL) for Internet information segments specifically relating to the content of the programming is embedded in and received with the programming. In practice the use of a (hardware) decoder to extract the URL excludes an intervention of the user in the decoding operation (see, for instance, page 11, lines 3 to 11, of WO 97/33434 and paragraph [0025] of the opposed patent). The system automates the tasks of processing the URL and retrieving the specified Internet information for example by using a client software (see page 14, line 22, to page 15, line 11 and figure 3 of WO 97/33434 and paragraph [0035] of the opposed patent). As a result, although automatic decoding and retrieval are not explicitly mentioned, to a person skilled in the art they are implicitly disclosed in the application as filed.

5.2 The present invention proposes to synchronise specific Internet information segments with the programming so as to put the Internet in context (see page 4, lines 15 to 19, of WO 97/33434 and paragraph [0010] of the opposed patent). The independent claims explicitly set out that the video and audio signals are presented concurrently with the retrieved Internet information segments and that the segments relate specifically to

the content of the programming. It would not be consistent with these definitions if the user could determine himself when the information is presented. On the other hand, it is clear from the wording "concurrently with" in the context of the present invention that this does not refer to presenting the information segments before or after the current programming (for example a commercial), or that the presentation is consecutive, replacing the current video and audio signals by the information segments. Read in context, the expression refers to simultaneous presentation (on the same screen or on separate screens; see page 16, line 15, to page 18, line 6, of WO 97/33434 and paragraphs [0039] to [0041] of the opposed patent). In the board's view, the concurrency and the requirement of content relationship set out in the claims therefore imply that the system itself determines when (synchronised) presentation takes place ("automatically").

5.3 In conclusion, the amendments made during the opposition proceedings, in particular those to independent claims 1 and 6, comply with Article 123(2) EPC.

6. *Article 54(3) EPC*

6.1 D13 discloses the retrieval of Internet information related to a current television programme ("einer noch laufenden Fernsehwerbung" in the sentence bridging pages 2 and 3) upon depression of a key by the user ("Befehl des Benutzers (Knopfdruck)"). D13 further mentions the necessity to synchronise the retrieved information with clocking of the television signal

("Synchronisation mit dem Takt des Fernsehsignals" in the last sentence on page 3). Similarly to other technical aspects mentioned in the relevant passage, such as digital to analogue conversion, this synchronisation reflects a technical prerequisite for the information to be properly processed and displayed by the television set. It leaves open whether the Internet information is displayed concurrently with the current programme or whether it replaces it, so that the feature set out in the last paragraph of the independent claims 1 and 6 is not known from D13.

6.2 As a result, D13 cannot deprive the subject-matter of independent claims 1 and 6 of novelty. In view of the foregoing, it need not be decided whether the priority claimed in D13 is valid.

7. *Article 56 EPC*

7.1 D10 discloses a home shopping system in which additional information, for example a telephone number, is embedded in the television programme, in particular as teletext pages (see column 2, lines 5 to 9). The additional information may be displayed on the screen in response to a first key depression by the user and a communication over a telephone line may be established in response to a second key depression, for instance to enable the user to easily place a buying order or transmit the identity (ID) of a product to be purchased, without first having to write down a telephone number and dial up the corresponding homeshopping service (see column 1, lines 14 to 35 and column 2, line 55 to column 3, line 10). An acknowledgement that the commercial transaction is completed may be sent back



over the bidirectional telephone line and displayed on the screen ("Quittiermeldung"; see column 4, lines 10 to 13 and claims 6 and 7). As a result, the telephone line is not used in D10 to retrieve additional information to complement the television programme, let alone to retrieve it automatically.

7.2 D12 discloses a multimedia terminal allowing the user to access broadcast services (television) as well as bidirectional interactive services (for instance the Internet) over various channels (cable, satellite, telephone) using a unified user interface and sharing hardware components (see page 72, right-hand column, last paragraph). Each service, once selected by the user, operates in its usual fashion. In particular the television broadcast services may offer additional information such as Videotext or an Electronic Program Guide. D12 pursues the goal of presenting the various services in a customer-oriented way ("kundengerecht" on page 72, right-hand column) and may also allow the user to simultaneously run different services (see the possibility of mixing different audio sources on page 74, left-hand column). However the individual services offered remain independent, and nothing in D12 suggests that a broadcast service and a bidirectional online service might cooperate.

7.3 D14 was filed with the statement of grounds of appeal in reaction to the reasons given in the appealed decision. Therefore D14 is not late-filed, and it is taken into account by the board as it relates to the case under appeal (Article 10a (2) and (4) RPBA). It discloses a broadband channel for transmitting moving pictures and a narrowband channel for transmitting text

and data being combined to offer an interactive service (see figure 3.24 on page 79 and figure 3.60 on page 121). Interactivity results from an active demand by a subscriber to receive a desired service available over the broadband channel (see the workflow for interactive broadband communication on page 123). D14 does not suggest an automatic retrieval of additional pieces of information to supplement the moving pictures.

- 7.4 In view of the above, none of the documents referred to by the appellant and belonging to the prior art under Article 54(2) EPC discloses the embedding of Internet information segments into video programming. None of these documents identifies the problem underlying the present invention originating from an insufficiency of the additional information presented to the user when Web pages are embedded in the audio/video content (see paragraph [0016] of the opposed patent). Therefore, in the judgment of the board, the system and method of claims 1 and 6, specifying inter alia uniform resource locators embedded in the video programming and automatically retrieving additional pieces of information over the Internet for concurrent display with the video and audio signals, would not have been obvious to a person skilled in the art at the priority date of the opposed patent. The appellant's arguments, linking the embedding of a telephone number in the video signal for automatically dialling it up when the user consents to the embedding of uniform resource locators which will automatically be retrieved for display, show the use of hindsight in knowledge of the invention, which has to be avoided in an objective assessment of inventive step.

7.5 The subject-matter of the independent claims 1 and 6 of the patentee's main request therefore involves an inventive step. The board thus comes to the same conclusion as the opposition division that the patent and the invention to which it relates according to the main request meet the requirements of the EPC.

## **Order**

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

The appeal is dismissed.

The Registrar

The Chairman

D. Sauter

F. Edlinger