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**Datasheet for the decision
of 7 September 2010**

Case Number: T 0689/05 - 3.5.04

Application Number: 96938526.9

Publication Number: 0863509

IPC: G11B 27/00

Language of the proceedings: EN

Title of invention:

Multi-language recording medium and reproducing device for the same

Applicant:

KABUSHIKI KAISHA TOSHIBA

Headword:

-

Vienna Convention on the Law of Treaties

Art. 25, 28

European Convention on Human Rights

Art. 7

Act revising the Convention on the Grant of European Patents

Art. 4(1)(2), 6, 7

Transitional Provisions:

Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC

Decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the European Patent Convention 2000

Relevant legal provisions (EPC 1973):

EPC Art. 9(2)(4), 10(1)(2), 54(1)(2), 56, 83, 87(1), 113(1),
116(1)(2), 172(1)(3)
EPC R. 67, 68(2), 71(1)

Relevant legal provisions:

EPC Art. 16, 17, 18, 104
RPBA Art. 11

Keyword:

"Remittal to first instance - no - partial lack of reasoning
does not amount to a fundamental deficiency and summons to
oral proceedings in The Hague does not violate
Article 113(1)EPC"

"Inventive step (main and first auxiliary request - no)"

"Sufficiency of disclosure (second auxiliary request - yes -
claimed recording medium not a DVD as defined in the DVD
standard)"

"Priority (not valid for the second auxiliary request)"

"Novelty (second auxiliary request - no)"

"Request for reimbursement of appeal fee (refused)"

"Request for reimbursement of travel cost for the
representative to oral proceedings held in the Hague (refused)
- no competence of the board to decide on such a request"

Decisions cited:

G 0002/98, J 0007/83, J 0014/87, J 0013/02, J 0010/07,
T 0278/00, T 1012/03

Catchword:

-



Case Number: T 0689/05 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 7 September 2010

Appellant:

KABUSHIKI KAISHA TOSHIBA
72, Horikawa-cho
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Kawasaki-shi
Kanagawa-ken 210-8572 (JP)

Representative:

Henkel, Feiler & Hänzel
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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 29 April 2004
refusing European patent application
No. 96938526.9 pursuant to Article 97(1) EPC
1973.

Composition of the Board:

Chairman: F. Edlinger
Members: M. Paci
T. Karamanli

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division refusing European patent application No. 96 938 526.9, which was published as EP 0 863 509 A1. The application was filed on 22 November 1996 and claims priority from the Japanese patent application 305965/95 filed on 24 November 1995.
- II. The present application was allocated to an examining division at the EPO branch in The Hague (hereinafter "The Hague") which, by communication dated 6 November 2003, summoned the applicant to oral proceedings in The Hague.
- III. In a letter dated 13 January 2004 the applicant requested that a patent be granted on the basis of a main request or an auxiliary request. The appellant further requested that the oral proceedings be transferred to Munich. As an auxiliary request, it was requested that the EPO should bear any additional costs incurred due to oral proceedings taking place in The Hague. The applicant submitted that, in view of Articles 6, 16 and 17 EPC 1973, there was no legal basis for holding oral proceedings before an examining division in The Hague. In particular the revised Article 17 EPC did not apply to the present application since the Diplomatic Conference did not have the power to amend the EPC and therefore also did not have the power to declare an amendment to the EPC to be provisionally applicable. Moreover, according to Article 7 of the Act revising the European Patent Convention of 29 November 2000, the revised version of the Convention was not to apply to European patent

applications pending at that time, unless otherwise decided by the Administrative Council of the EPO. In its decision of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC of 29 November 2000, the Administrative Council did not refer to Articles 6, 16 or 17 EPC at all. Therefore, the amended Article 17 EPC could not be applied to the present application with a filing date of 22 November 1996. The applicant further argued that, when filing a patent application, the applicant had to be able to calculate the costs for the grant procedure, including possible oral proceedings. However, due to the fact that, surprisingly, the oral proceedings were to take place in The Hague, the applicant was faced with additional expenses for travelling and this was unjustified.

- IV. During a consultation by telephone with the first examiner of the examining division on 21 January 2004 (see minutes of this consultation posted on 5 February 2004), the applicant's representative submitted that high costs would be involved if the applicant were to attend the oral proceedings in The Hague. The first examiner proposed that oral proceedings could be held as a video-conference, thereby avoiding travelling costs to The Hague. The applicant's representative, however, refused this proposal and stated that they would rather have oral proceedings held in the traditional manner in The Hague. The minutes of this consultation were sent to the applicant's representative on 5 February 2004.
- V. In a fax letter dated 6 February 2004, the applicant's representative referred to the Guidelines for

Examination, Part C-VI,6 and submitted that "oral proceedings" were meant to be formal proceedings within the meaning of Article 116 EPC and that the term therefore did not include informal personal interviews or telephone conversations, such as occurred in examination proceedings. Moreover, oral proceedings had to take place before the competent body, e.g. during the examination or opposition procedure before the whole division. A video conference, in the best case, would be "cyber proceedings" but never real "oral proceedings". Accordingly, the examiner's suggestion could not be accepted by the representative.

- VI. Oral proceedings before the examining division took place on 13 February 2004 in The Hague.

According to point 59 of the minutes of the oral proceedings before the examining division (hereinafter "minutes"), at the end of the oral proceedings and after the discussion on the patentability of the subject-matter of the claims then on file, the applicant's representative pointed out that he had further requested in writing that the oral proceedings should be transferred to Munich and that, in the event that oral proceedings took place in The Hague, any additional costs should be borne by the EPO. The representative also stated that he had refused the video conference offered by the first examiner during the telephone conversation of 21 January 2004, as contact during oral proceedings was essential.

Point 60 of the minutes reads:

"The Chairman commented that these requests were not of the competence of the Examining Division, that the Representative would have to complain to the relevant bodies of the EPO. The Examining Division was just handling his requests in line with administrative instructions. As formally a decision as to these two requests had to be made, the Examining Division announced that it had not allowed the transfer of the Oral Proceedings to Munich, and that it would not pay the Representative for any additional costs he might have incurred."

At the end of the oral proceedings the chairman announced the decision that the present application was refused.

VII. In the decision under appeal, posted on 29 April 2004, the following documents, *inter alia*, were cited as prior art:

D1: EP 0 677 843 A1

D2: Patent Abstracts of Japan, vol. 017, no. 179
(P-1517), 7 April 1993 (1993-04-07) &
JP 04 332918 A (YAMAHA CORP), 19 November 1992
(1992-11-19)

VIII. The application was refused on the grounds that, contrary to Article 56 EPC 1973, the subject-matter of claim 1 according to the main request did not involve an inventive step in view of D1 and D2, and that the subject-matter of claim 1 according to the auxiliary

request did not meet the requirement of sufficiency of disclosure under Article 83 EPC 1973. The reasons of the decision, however, are silent on the applicant's requests that the oral proceedings be transferred to Munich and, in the event that oral proceedings were held in The Hague, that any additional costs be borne by the EPO.

IX. In the statement of grounds of appeal, the appellant requested that the decision of the examining division be set aside and a patent be granted based on the main request of the appealed decision. As an auxiliary request the appellant requested that a patent be granted based on the documents of the auxiliary request of the appealed decision. Furthermore, the appellant requested the reimbursement of the appeal fee and of the travel costs for the representative for the oral proceedings held before the examining division in The Hague.

X. In a communication annexed to the summons to oral proceedings the board gave a preliminary opinion.

As to the main request, the board expressed doubts that the subject-matter of claim 1 involved an inventive step in view of D1 alone.

As to the auxiliary request, the board explained why it was not convinced by the examining division's reasoning regarding sufficiency of disclosure. The board further examined claim 1 *ex officio*. The board indicated that claim 1 included several amendments violating the provisions of Article 123(2) EPC. The board also noted that the claimed priority seemed not to be valid for

the subject-matter of claim 1 according to the auxiliary request and introduced into the proceedings the following document, published between the priority date and the filing date of the present application, which it regarded as novelty-destroying for the subject-matter of claim 1:

D10: EP 0 737 009 A2.

As to the requests for reimbursement of the appeal fee and of the travel costs for the representative, the board expressed doubts as to whether the appealed decision was sufficiently reasoned with regard to the requests that the oral proceedings be transferred to Munich and that the EPO bear any additional costs resulting from the oral proceedings in The Hague. However, the board referred to decision T 1198/97 and expressed a negative preliminary opinion on a reimbursement of the appeal fee, since a causal link between a procedural violation and the necessity to appeal had not been submitted by the appellant, nor was it evident from the circumstances of the present case.

As to the oral proceedings which were held at the EPO branch in the Hague, the board considered that there was a legal basis for this and referred also to decision T 1012/03. Accordingly, the board raised doubts as to whether a reimbursement of the travel costs was justified.

- XI. With a letter dated 6 August 2010 the appellant filed two new sets of claims according to a first and a second auxiliary request, respectively, which replaced the claims of the previous auxiliary request.

Regarding the appellant's request for reimbursement of the appeal fee and the travel costs, further submissions were filed.

- XII. Oral proceedings were held on 7 September 2010, during which the appellant's representative filed a set of amended claims according to a second auxiliary request replacing the previous second auxiliary request. After a discussion on the claims according to the main and auxiliary requests and the deliberation of the board, the chairman informed the appellant's representative that in the board's opinion none of these requests was allowable. Thereupon a discussion followed on the request for reimbursement of the appeal fee and for a refund of the travel costs which had been incurred because of the oral proceedings before the examining division in The Hague. In the course of this discussion the appellant submitted for the first time that the decision under appeal had to be set aside because it was not sufficiently reasoned with respect to the requests that the oral proceedings be transferred to Munich and that the EPO bear any additional costs resulting from the oral proceedings in The Hague.

After that discussion the appellant's representative was asked, for the sake of clarity, to submit the appellant's final requests in writing. The appellant's final requests then presented in writing read as follows:

"1. It is requested to set aside the decision of the Examining Division dated April 29, 2004 and to remit the case to the Examining Division.

1.1 It is requested to refund the appeal fee.

1.2 It is requested to refund the travel costs for the representative in connection with the Oral Proceedings in Den Haag of February 13, 2004.

2. It is requested to set aside the decision of the Examining Division and

2.1 to grant a patent based on the claims of the main request of January 13, 2004 and the corresponding description and drawings,

2.2 as a first auxiliary request, to grant a patent based on the claims of the first auxiliary request of August 6, 2010 and the description and drawings as for the main request,

2.3 as a second auxiliary request, to grant a patent based on the claims of the second auxiliary request of September 7, 2010, and the description and drawings as for the main request."

XIII. Independent claim 1 according to **the main request** reads as follows:

"A multilingual recording medium having a data area containing main picture information, sub-picture information for constructing sub-picture streams, and audio information and having a management area containing attribute information for identifying said sub-picture streams, said multilingual recording medium comprising:

 a specific code, included in said attribute information for each of said sub-picture streams, for

indicating a language related to a corresponding sub-picture stream from a plurality of different languages;

characterized by comprising

a code extension, included in said attribute information for each of said sub-picture streams, said code extension indicating at least one of a plurality of sub-picture character sizes and sub-picture descriptions in said language,

wherein said sub-picture streams are determined by said specific code and said code extension."

XIV. Independent claim 1 according to **the first auxiliary request** reads as follows:

"A multilingual recording medium having a data area containing main picture information, sub-picture information, and audio information and having a management area containing attribute information for identifying a specific sub-picture information, said multilingual recording medium comprising:

a specific code, included in said attribute information for indicating a language related to a corresponding specific sub-picture information from a plurality of different languages;

wherein

said specific sub-picture information comprises literal pictures used for constructing a sub-picture stream;

a code extension, included in said attribute information for each of said sub-picture streams, said code extension indicating one of a plurality of sub-picture character sizes in said language,

wherein said sub-picture streams are determined by said specific code and said code extension."

XV. Independent claim 1 according to **the second auxiliary request** reads as follows:

"A multilingual recording medium having

a data area in which main picture information, a plurality of pieces of audio information representing each a different language and pieces of sub-picture information adapted to be used to construct streams have been recorded, said pieces of sub-picture information representing one of a plurality of languages, and

a management area in which attribute information adapted to be used to identify said streams has been recorded,

said attribute information is supplemented with specific code indicating kinds of languages and a code extension indicating differences in the size of characters and/or description in the same language, and said data area has said sub-picture information stream determined by said specific code and code extension recorded in it;

the data area of the information recording medium recording a plurality of video title sets (VTS), each of the video title sets (VTS) including a video object set (VOBS) and video title set information (VTSI) serving as management information which is referred to in order to reproduce the video object set,

the video object set (VOBS) including a plurality of video object units (VOBUs), each of which includes more than one video packs (V_PCK), a plurality of sub-picture packs (SP_PCKs) for storing sub-picture data and a plurality of audio packs (A PCKs) for storing audio data,

the sub-picture data having a plurality of streams,
and the audio data having a plurality of streams,

the video title set information (VTSI) including a
video title set information management table (VTSI_MAT),
a video title set part-of-title search pointer table
(VTS_pn_SRPT), and a video title set program chain
information table (VTS_PGCIT),

the video title set information management table
(VTSI_MAT) having a sub-picture stream attribute table
(VTS_SPST_ATRT) indicating attributes of the streams of
the sub-picture data and an audio stream attribute
table (VTS_AST_ATRT) indicating attributes of the
streams of the audio data,

the sub-picture stream attribute table
(VTS_SPST_ATRT) having information indicating a coding
mode of the sub-picture, type information representing
whether a language code is present or absent, a
language [sic] code indicating the kind of the
languages of the sub-picture, and said extension code
related to the languages,

the extension code capable of including
distinction information of "Caption in standard-sized
characters", "Caption in large-sized characters",
"Caption for children") [sic] "Director's comments in
standard-sized characters", "Director's comments in
large-sized characters", and "Director's comments for
children" ,

the audio stream attribute table (VTS_AST_ATRT)
having audio coding mode information, audio type
information representing whether a language [sic] code
is present or absent, a specific code indicating the
kind of the languages of the audio data, an extension
code related to the languages, and application

information indicating which of a karaoke mode or a surround mode is used, and

the extension code capable of writing distinction information of "Standard caption", "Speech for visually handicapped persons", and "Director's comments".

- XVI. The examining division's reasoning in the decision under appeal with respect to claim 1 according to the main request then on file (identical to claim 1 of the present main request) and claim 1 according to the auxiliary request then on file (closely related to claim 1 of the present second auxiliary request) can be summarised as follows.

Main request then on file - inventive step

D1 represents the closest prior art. It discloses a multilingual multimedia medium having all the features of the medium of claim 1 except an extension code included in the attribute information for indicating at least one of a plurality of sub-picture character sizes and sub-picture descriptions in said language.

The objective technical problem to be solved by claim 1 is therefore to improve the displaying of sub-picture information from the medium with respect to display size.

When confronted with the above problem, the skilled person would look in the field of character display in multimedia recording media and would consider D2, which teaches the use of "modification information" to supplement character code information in order to

"enhance display quality [...] such as [...] a character size".

The skilled person would apply the teaching of D2 to the medium of D1 and arrive thereby at the subject-matter of claim 1.

Hence, contrary to Article 56 EPC 1973, the subject matter of claim 1 does not involve an inventive step in view of D1 and D2.

Auxiliary request then on file - sufficiency of disclosure

Claim 1 according to the auxiliary request defines a medium comprising video title sets, video object sets, video title set information, video object units, a video title set information management table, a video title set information attribute table, video packs, sub-picture packs and audio packs.

These data structures are defined in the description of the present application as being the data structures of a DVD video zone (page 6, line 16, to page 9, line 37). Moreover, the extension code of the invention is defined with respect to the attribute information data structure (page 11, line 25, to page 13, line 13).

It is therefore directly and unambiguously derivable from the description of the present application that the claimed invention is a DVD recording medium (see point III.2.1 of the Reasons).

According to Rule 27(1)(e) EPC 1973 "at least one way of carrying out the invention claimed using examples where appropriate" shall be provided. Therefore a sufficient disclosure of the embodiment of the claims must be provided in the application, supplemented with the skilled person's common general knowledge if necessary.

Access to the DVD standard, and in particular to the DVD VIDEO specifications, was necessary in order to carry out the only embodiment disclosed in the description. The word DVD refers unambiguously to the recording medium agreed upon in September 1995 by the DVD consortium, of which the applicant was a member, and did not cover any other recording medium at the priority date of the application. The DVD standard was available for sale only in August 1996 but the meaning of DVD as a recording medium was already fixed at the priority date. Furthermore, the DVD standard was not available to the public at the priority date of the present application.

For the above reasons, the auxiliary request does not meet the requirement of sufficiency of disclosure under Article 83 EPC 1973.

XVII. In the appeal proceedings the appellant essentially argued as follows:

Request to set aside the decision under appeal and remit the case to the department of first instance because of a procedural violation and request to refund the appeal fee and the travel costs

Since the decision under appeal was not reasoned with regard to the requests for transferring the oral proceedings to Munich and refunding the travel costs to The Hague, a procedural violation had occurred which was one of the decisive elements leading to the present appeal. Therefore, the board's conclusion, in its preliminary opinion, that there was no causal link between the procedural violation and the necessity to appeal seemed unjustified. This lack of reasoning by the examining division was a fundamental procedural violation which justified setting aside the impugned decision and remitting the case to the department of first instance. Accordingly, the appeal fee had to be refunded.

As already submitted in first instance proceedings (letters of 13 January 2004 and 6 February 2004), the refund of the travel costs was justified because there was no legal basis for holding oral proceedings before the examining division within the meaning of Article 116 EPC at any other place than Munich. Articles 16, 17 and 18 EPC 2000 were not applicable in the present case, in which the European patent application had been filed before 29 November 2000. According to point 2 of the Explanatory remarks on the Transitional provisions of the EPC 2000, Article 7's transitional provisions did not apply to the revised text's purely organisational and institutional provisions, whose applicability was governed by general principles of international treaty law, in particular that of "non-retroactivity" (see Article 28 Vienna Convention). However, the changes adopted for Articles 16, 17 and 18 EPC 2000 had a direct economic impact on applicants, especially on those who were

represented by law firms based in Munich, as considerable travel costs for oral proceedings could surprisingly occur. Therefore, those provisions could not be regarded as "purely organisational and institutional". It might be acceptable to apply the amended Articles 16, 17 and 18 EPC 2000 to European patent applications filed after 29 November 2000. This seemed to be supported by Article 7 of the Act revising the EPC. However, it seemed to be contrary to general principles of all modern democratic countries and to the principles of human rights as applied by the European Court of Human Rights to extend Article 25 of the Vienna Convention on the Law of Treaties to the provisions of Articles 16, 17 and 18 EPC 2000. If said Articles were provisionally applied, this would retroactively interfere with the rights of individuals contrary to the provisions of Article 28 of the Vienna Convention.

Request to grant a patent on the basis of the claims according to the main request

Inventive step

At the priority date of the present application, in November 1995, there were no DVDs on the market. The DVD specification was only finalised in 1996. The DVD standard had already been announced in 1994 but the technical details had not been disclosed. The standard optical disc at the priority date was the Laserdisc, which had a limited data storage space hardly sufficient for storing even a short movie.

D1 disclosed an optical disc storing video, audio and subtitles in three different languages. The document did not mention whether the video data was recorded in a digital or analogue form. In view of the filing date of D1 (29 October 1993), the optical medium of D1 was probably a Laserdisc, i.e. an optical disc of limited storage space, intended for karaoke, not for storing movies. The MPEG Standard for digital video encoding was only published in the same year as D1 (1995). Therefore, D1 did not disclose sub-picture "streams" in the sense of the present application (an MPEG stream). Although D1 referred to "sub-pictures", they appeared to be only subtitles stored as text. The fact that the subtitles were offered in no more than three different languages was probably a consequence of the limited storage space.

The objective technical problem when starting from D1 was to improve the displaying of sub-picture information from the medium with respect to display size and functionality (see page 3 of the statement of grounds of appeal). As defined in claim 1, this problem was solved by adding a code extension for each sub-picture stream, thereby allowing identification of different sub-picture streams in the same language.

The skilled person would have had no incentive to increase the number of subtitles recorded on the medium of D1 because storage space was in short supply. Moreover, there was no suggestion in D1 of offering subtitles of different character sizes. Even if the skilled person nevertheless had come to this idea, he would still not have needed a code extension because the "language code" stored on the medium of D1 could

have been used to identify these additional subtitles without recurring to a specific code and an extension code in combination. This had the advantage that the codes were stored separately, the specific code indicating a preferred language and the code extension for instance a character size. When another disc was inserted which did not offer different character sizes, the preferred language would nevertheless be selected whereas a single code indicating both language and character size in this situation could not offer a preferred language to the user.

Hence the medium of claim 1 was not rendered obvious by D1 alone.

Request to grant a patent on the basis of the claims according to the first auxiliary request

Compared to claim 1 according the main request, claim 1 according to the first auxiliary request was further limited in that:

- the sub-picture information comprised literal pictures used for constructing a sub-picture stream; and
- the code extension (only) indicated one of a plurality of sub-picture character sizes.

The expression "literal pictures", read in the context of the description, must be understood as text information recorded as pictures (see sentence bridging pages 10 and 11, and page 19, lines 15 and 18). Storing subtitles as literal pictures, i.e. as images, made the decoder cheaper because no extra hardware was required

for enlarging text characters. There was no suggestion of storing subtitles as literal pictures in D1.

Request to grant a patent on the basis of the claims according to the second auxiliary request

Sufficiency of disclosure

It was not disputed that the DVD specification was only finalised in 1996 and therefore did not form part of the state of the art at the priority date of 24 November 1995. However, this fact was irrelevant to the sufficiency of disclosure of the subject-matter of claim 1 because claim 1 contained no reference to a DVD. The skilled person could have carried out the subject-matter of claim 1 without knowledge of the DVD specification. The examining division had not objected to any particular feature of claim 1, but only generically to the claim as a whole.

For the above reasons, the subject-matter of claim 1 was sufficiently disclosed.

Novelty

The priority claimed by the present application was valid for the second auxiliary request. Hence D10, which was published after the priority date of the present application, did not form part of the state of the art. The subject-matter of claim 1 was therefore novel.

Reasons for the Decision

Introductory note

1. The present decision was taken after the Act revising the EPC (hereinafter "Revision Act") was adopted on 29 November 2000 and after the revised European Patent Convention entered into force on 13 December 2007. Since the European patent application in suit was pending at that time, the board applied, where necessary, the transitional provisions in accordance with Article 7(1), second sentence, of the Revision Act and the Decisions of the Administrative Council of 28 June 2001 (Special edition No. 1, OJ EPO 2007, 197) and 7 December 2006 (Special edition No. 1, OJ EPO 2007, 89). Articles and Rules of the revised EPC and of the EPC valid until that time are cited in accordance with the Citation Practice (see the 14th edition of the European Patent Convention, page 6).

Admissibility of the appeal

2. The appeal meets the requirements of Articles 106 to 108 and Rule 64 EPC 1973. Those provisions are to be applied in the present case with regard to the admissibility of the appeal since all the time limits for complying with the conditions for filing an appeal expired before the revised EPC entered into force (see also J 10/07, OJ EPO 2008, 567, Reasons, point 1). Thus the appeal is admissible.

Request to set aside the impugned decision and remit the case to the department of first instance because of a procedural violation

3. Article 11 of the Rules of Procedure of the Boards of Appeal of the EPO (RPBA, OJ EPO 2007, 536) stipulates that a board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first-instance proceedings, unless special reasons present themselves for doing otherwise.

4. The appellant argues that the decision was not reasoned regarding the requests to transfer the oral proceedings to Munich and to refund (hereinafter "reimburse" because the travel costs were actually not paid to the EPO) the travel costs to The Hague and that this lack of reasoning amounted to a fundamental procedural violation which justified setting aside the impugned decision and remitting the case to the department of first instance.
 - 4.1 Firstly the board has to establish whether or not the reasoning of the impugned decision complies with the relevant provisions of the EPC 1973, in force at the date of the decision.

Rule 68(2), first sentence, EPC 1973 provides that decisions of the European Patent Office open to appeal shall be reasoned. According to the established jurisprudence of the Boards of Appeal, to satisfy the requirement of Rule 68(2) EPC 1973 a decision must contain, in logical sequence, those arguments which justify its order. The conclusions drawn by the deciding body from the facts and evidence must be made

clear. Therefore all the facts, evidence and arguments which are essential to the decision must be discussed in detail in the decision, including all the decisive considerations in respect of the factual and legal aspects of the case. The purpose of the requirement to reason the decision is to enable the parties and, in the case of an appeal, also the board of appeal to examine whether the decision could be considered to be justified or not (see e.g. T 278/00, OJ EPO, 2003, 546).

The board agrees with the appellant that the impugned decision is not reasoned with regard to the refusal of the applicant's requests to transfer the oral proceedings to Munich and reimburse the travel costs to The Hague, as announced by the chairman of the examining division at the oral proceedings (see point VI *supra*). To that extent, the decision does indeed not comply with Rule 68(2), first sentence, EPC 1973. In the board's view, this (partial) lack of reasoning amounts to a procedural violation.

- 4.2 However, the board is not convinced that, in the present case, this procedural violation constitutes a fundamental deficiency in the first-instance proceedings within the meaning of Article 11 RPBA justifying setting aside the decision under appeal and remitting the case to the examining division. In the board's view a fundamental deficiency is not caused by all procedural violations but rather by a substantial procedural violation. A "substantial procedural violation" is an objective deficiency affecting the entire proceedings (J 7/83, OJ EPO 1984, 211). In the present case, however, the above established procedural

violation does not affect the entire proceedings before the examining division for the reasons that follow.

- 4.3 The subject and the main issue of the present appeal is the examining division's decision to refuse the present application. It is undisputed that the decision under appeal contains reasoning which complies with Rule 68(2), first sentence, EPC 1973 as far as the grounds for refusal of the application are concerned, namely that, in the view of the examining division, the subject-matter of claim 1 according to the main request then on file did not involve an inventive step, contrary to Article 56 EPC 1973, and that the subject-matter of claim 1 according to the auxiliary request then on file did not meet the requirement of sufficiency of disclosure under Article 83 EPC 1973. The impugned decision undisputedly contains, in logical sequence, those facts and arguments which justify its order. The course of the appeal proceedings also shows that the reasons of the impugned decision enabled the appellant as well as the board to examine whether the refusal of the application could be considered to be justified or not. In the statement of grounds of appeal the appellant discussed the reasons and arguments indicated in the first instance decision for lack of inventive step of the subject-matter of the main request then on file. The appellant argued in detail as to why the decision on this main request was wrong and put forward arguments in support of inventive step. The appellant also dealt with the reasons of the impugned decision for rejecting the auxiliary request under Article 83 EPC 1973 and argued as to why the examining division's conclusion was wrong. The board, too, was in a position to examine the first instance decision to

refuse the application on the basis of the reasons given for lack of inventive step and insufficient disclosure, as can be seen from the provisional opinion given in the communication annexed to the summons to oral proceedings. Also at the beginning of the oral proceedings, the board and the appellant discussed in detail the patentability of the subject-matter of the claims according to the main and auxiliary requests, this being the main issue of the present appeal. This discussion raised no doubts as to the sufficient reasoning of the impugned decision as far as the refusal of the application was concerned. Up to and also during this discussion the appellant never submitted that the case required immediate remittal to the first instance because of the alleged procedural violation (insufficient reasoning). To the contrary, the appellant had requested a decision by the board to grant a patent on the basis of the claims according to the main request or the first or second auxiliary request. It was only after the information on the board's negative opinion regarding the allowability of any of these requests and the discussion on the reimbursement of the appeal fee and travel costs that the appellant requested that the decision be set aside and that the case be remitted to the first instance department because of the insufficient reasoning of the impugned decision.

- 4.4 From the foregoing it can be concluded that, since the reasons of the impugned decision for refusing the present application comply with Rule 68(2), first sentence EPC, 1973, the board and the appellant were in a position to examine and discuss the reasons for the decision to refuse the application of the examining

division and that the missing part of the reasoning of the impugned decision had no influence on that discussion. Hence the first instance proceedings are not deficient as far as the reasons of the decision to refuse the present application are concerned. Consequently, the procedural violation as established above (see point 4.1 *supra*) did not affect the entire proceedings and can thus not amount to a fundamental deficiency within the meaning of Article 11 RPBA. Hence it would not be justified to set aside the impugned decision and to remit the case to the first instance department under Article 11 RPBA and Article 111(1) EPC 1973 for that reason alone.

- 4.5 The procedural violation as established above (see point 4.1 *supra*) concerns the examining division's decision not to transfer the oral proceedings to Munich and not to pay the travel costs to The Hague. The board considers both issues rather to be a subsidiary matter in the present case. Moreover the board was in a position to take a decision on the main issue of the present appeal at the oral proceedings. Therefore the board is also of the view that it would have been disproportionate to set aside the entire impugned decision and to remit the case to the examining division pursuant to Article 11 RPBA because of the partial lack of reasoning of the decision under appeal.
5. The appellant alleged a further procedural violation in the statement of grounds of appeal. It submitted that there was no legal basis for holding oral proceedings according to Article 116 EPC 1973 at any other place than Munich and that, therefore, conducting oral

proceedings in The Hague amounted to a procedural violation.

5.1 The right to oral proceedings pursuant to Article 116 EPC 1973 is a codified part of the procedural right to be heard under Article 113(1) EPC 1973. This right to be heard at oral proceedings also includes the right of a party to present its arguments at the correct place according to the EPC provisions (see also T 1012/03, Reasons, point 25). Hence, in the present case, the appellant's right to be heard pursuant to Article 113(1) EPC 1973 would have been violated if the summons to oral proceedings in The Hague were contrary to the relevant provisions of the EPC applicable at the date of the oral proceedings. Such a violation would then have been a fundamental deficiency within the meaning of Article 11 RPBA even if the appellant had accepted that oral proceedings were held as a video conference.

5.2 In the present case oral proceedings before the examining division took place on 13 February 2004 in The Hague and thus after the Diplomatic Conference in November 2000 and before the revised European Patent Convention entered into force on 13 December 2007. Hence the facts of the present case are comparable to those of case T 1012/03, in which oral proceedings before the examining division took place on 3 June 2003 in The Hague.

5.3 The present board concurs with the view taken in decision T 1012/03. In that decision it was held that the justification for conducting oral proceedings before an examining division in The Hague after the Diplomatic Conference in November 2000 and before the

revised EPC entered into force on 13 December 2007 could be deduced from Article 116 EPC 1973 in conjunction with Article 10(1),(2)(a),(b) EPC 1973 since Articles 16 and 17 EPC were provisionally applicable as from 29 November 2000 pursuant to Article 6 of the Revision Act and clearly indicated that the Convention no longer restricted the competence of the President of the EPO to decide which transactions of the EPO departments should be carried out in Munich and which in The Hague (see Reasons, points 22 to 59).

- 5.4 Although the present board referred to decision T 1012/03 in the communication annexed to the summons to oral proceedings, the appellant maintained the objection that holding oral proceedings in The Hague at the relevant time violated procedural rights of the appellant because Articles 16 to 18 EPC were not provisionally applicable in the present case.
- 5.5 Turning now to the appellant's arguments in support of the point of view that the provisions of Articles 16 to 18 EPC were not provisionally applicable in the present case, the board takes the following view.
- 5.6 The appellant argues that the Diplomatic Conference did not have the power to amend the EPC and, consequently, also not the power to declare an amendment to be provisionally applicable. The board, however, is of the opinion that this argument must fail since Article 172(1) EPC 1973 clearly stipulates that the EPC 1973 "may be revised by a Conference of the Contracting States". On this legal basis a Diplomatic Conference of the EPC Contracting States met in Munich from 20 to

29 November 2000 and amended the EPC 1973. The Revision Act was unanimously adopted by the Conference on 29 November 2000 and has been signed by 17 Contracting States by 1 September 2001 (the end of the period for signature in accordance with Article 4(1) of the Revision Act). That this Revision Act was subject to ratification concerned its entry into force according to Article 172(3) EPC 1973 and Article 4(2) of the Revision Act and not the competence of the Diplomatic Conference to revise the texts of the EPC 1973. Hence the conference had the power to amend the EPC 1973.

5.7 The appellant further argues that the provisions of Articles 16 to 18 EPC were not applicable to European patent applications filed before 29 November 2000 since those provisions were not "purely organisational and institutional" and therefore, according to item 2 of the Explanatory remarks on the Transitional provisions of the EPC (OJ EPO 2001, Special edition No. 4, 134 and hereinafter "Explanatory remarks"), Article 7's transitional provisions applied to the revised Articles 16 to 18 EPC. The board, however, does not agree with the appellant.

5.8 First of all, Article 6 of the Revision Act has to be distinguished from Article 7 of the Revision Act. The transitional provisions pursuant to Article 7 of the Revision Act in conjunction with the Decision of the Administrative Council of 28 June 2001 provide for the applicability of the provisions of the revised version of the EPC at its entry into force and thereafter. Article 6 of the Revision Act, however, contains no transitional provisions but lays down the provisional application of parts of the Revision Act from the date

of its adoption on 29 November 2000 and thus already before its entry into force (see also Explanatory remarks, item 2, last sentence). This means that these parts were effective as from 29 November 2000 (see also first paragraph on page 2 of the "Foreword", Special Edition No. 4, OJ EPO 2001, 1).

5.9 The formal validity of Article 6 of the Revision Act and its ruling that *inter alia* the revised text of some Articles of the EPC took effect as from the date of the adoption of the Revision Act has already been acknowledged by the decisions J 13/02 (see Reasons, point 2.1) and T 1012/03 (see Reasons, point 54). There is no reason for the board to disagree with these. In particular the provisional application pursuant to Article 6 of the Revision Act does not contravene Article 25 of the Vienna Convention on the Law of Treaties of 23 May 1969 (hereinafter "Vienna Convention"). This Article stipulates that "a treaty or a part of a treaty is applied provisionally pending its entry into force if the treaty itself so provides". This is exactly what happened when the Conference adopted Article 6 of the Revision Act.

5.10 In the board's view, it is not a prerequisite for the provisional application of the revised text of some of the EPC provisions pursuant to Article 6 of the Revision Act that these provisions should be purely organisational and institutional. Article 6 of the Revision Act merely states that "Article 1, items 4-6 and 12-15, Article 2, items 2 and 3 and Articles 3 and 7 of this Revision Act shall be applied provisionally". Article 1, items 4-6 of the Revision Act contain only the amended text of Articles 16 to 18 EPC. This clearly

indicates that the provisional application of the amended Articles 16 to 18 EPC is not dependent on whether these articles are of a purely organisational and institutional nature (see also T 1012/03, Reasons, point 53). Since Article 6 of the Revision Act exclusively provides for the immediate provisional application of the revised Articles 16 to 18 EPC, the Explanatory remarks cannot introduce a further condition for the provisional application of parts of the Revision Act.

Moreover, the Explanatory remarks state under item 16:

"Special transitional arrangements are not necessary for the revised text's purely organisational and institutional provisions (see point 2 above), i.e. Articles 4a, 11, 16, 17, 18, 21, 22, 23, 33, 35, 37, 38, 42, 50, 130, 134, 134a, 140, 149a and 164, the new Protocol on the Staff Complement, and revised Section I of the Protocol on Centralisation. These will apply as from the revised text's entry into force, except that, under Article 6 Revision Act, Articles 16 to 18, 37, 38, 42 and 50, the Protocol on the Staff Complement and Section I of the Protocol on Centralisation apply provisionally as from 29 November 2000."

- 5.11 The board also does not agree with the appellant's further argument that the provisional application of the amended Articles 16 to 18 EPC as from 29 November 2000 was contrary to the "general principles of all modern democratic countries, and to the principles of human rights as applied by the European Court of Human Rights" and to the provisions of Article 28 of the Vienna Convention since this would

retroactively interfere with the individual rights of applicants who had filed European patent applications before that date.

- 5.12 The principle of non-retroactivity of treaties is established in Article 28 of the Vienna Convention, which reads:

"Unless a different intention appears from the treaty or is otherwise established, its provisions do not bind a party in relation to any act or fact which took place or any situation which ceased to exist before the date of the entry into force of the treaty with respect to that party."

It is clear from the wording of this provision that the parties to a treaty are not prevented from giving to provisions of the treaty retroactive effect provided that their "intention appears from the treaty or is otherwise established".

- 5.13 The board notes that unlike Article 7 of the Revision Act, Article 6 of the Revision Act does not differentiate with regard to the provisional application between European patent applications which were filed before or after a specific date and, therefore there are no transitional provisions in respect of it for pending applications. This fact alone, however, does not mean that the general legal principle of "non-retroactivity" has been violated (see also T 1012/03, Reasons, point 55). However, it does not mean either that the Conference intended to give to the provisionally applicable provisions any retroactive effect.

Hence, in the absence of any indication of such an intention, the principle of non-retroactivity of international treaties had to be observed in the present case when revised Articles 16 to 18 EPC were applied provisionally. This position of the board is supported by the Explanatory remarks (item 2, third sentence, in combination with the preceding sentences and item 16) which explain that the provisions which apply provisionally under Article 6 of the Revision Act, can apply only to measures taken after the date on which the Revision Act was adopted, i.e. after 29 November 2000.

5.14 The present application was filed on 22 November 1996 and therefore before the date on which Article 6 of the Revision Act was adopted by the Diplomatic Conference. In view of this fact it has to be examined whether the summons to oral proceedings before the examining division on 13 February 2004 in The Hague, which was posted on 6 November 2003 and thus after the date of adoption of the Revision Act, infringed the non-retroactivity principle under Article 28 of the Vienna Convention.

5.15 It is generally accepted that the principle of non-retroactivity only guarantees that a new treaty is not applied to acts or facts which were already completed when the new treaty entered into force and that, therefore, "if an act or fact or situation which took place or arose prior to the entry into force of a treaty continues to occur or exist after the treaty has come into force, it will be caught by the provisions of the treaty" (see Wetzel/Rauschning, "The Vienna

Convention on the Law of Treaties - Travaux
Preparatoires", Metzner, Frankfurt am Main, 1978,
page 220, paragraph (3), with further references). In
other words, the principle of non-retroactivity under
Article 28 of the Vienna Convention is observed if a
treaty is applied to matters that occur or exist on or
after the entry into force of that treaty, even if
these matters are based on an event prior to the entry
into force of that treaty. It follows from this that
the principle of "non-retroactivity" does not mean
that, for example, procedural provisions cannot be
amended during the pendency of a European patent
application.

The principle of "non-retroactivity" and the above
general rules also apply under the European Convention
on Human Rights (formally European Convention for the
Protection of Human Rights and Fundamental Freedoms):
see for example Wetzel/Rauschnig, "The Vienna
Convention on the Law of Treaties - Travaux
Preparatoires", Metzner, Frankfurt am Main, 1978,
page 220, paragraphs (2) - (4), with further
references, and Article 7 of the European Convention on
Human Rights, which, however, prohibits the
retrospective criminalization of acts and omissions.

As far as the "general principles of all modern
democratic countries" are concerned, the board is not
aware of any exception to the above general rules.

- 5.16 The board considers that, taking into account the above
general rules in the present case, the provisional
application of the revised Articles 16 to 18 EPC did
not retroactively interfere with the applicant's

individual rights. Although the present application was filed before the date on which Article 6 of the Revision Act was adopted, the examination proceedings initiated by that filing were still pending and therefore "continued to exist" when the applicant was summoned to oral proceedings after that date. Moreover, the summons and the oral proceedings themselves occurred after the provisional application under Article 6 of the Revision Act was adopted.

- 5.17 Further, the board accepts that the provisional application of the revised Articles 16 to 18 EPC had a direct economic impact on applicants who had filed a European patent application before 29 November 2000 and appointed a representative in Munich (or nearby) if they were confronted with travel costs for oral proceedings in The Hague. However, the board is of the view that, when filing a European patent application before the adoption of the Revision Act, applicants could have no legitimate expectation that they could never be summoned to oral proceedings in The Hague. It is obvious from the wording of Article 116(2) and (3) EPC 1973 that oral proceedings could take place before the Receiving Section, which was set up exclusively in The Hague in accordance with the provisions of Article 16 EPC 1973, valid until the provisional application of the amended Article 16 EPC. Hence it was not excluded under the EPC 1973 that parties or their representatives would have to travel to The Hague if the Receiving Section summoned them to oral proceedings pursuant to Article 116(1),(2) and Rule 71(1) EPC 1973. The board is aware that, in first instance proceedings, oral proceedings only exceptionally take place before the Receiving Section, but are usual before the

examining or opposition division. However, it is the board's view that recognising a legitimate expectation in the present case on the basis of "chances" would undermine the seriousness of the concept of the protection of legitimate expectations.

5.18 In view of the above considerations the board concludes that, in accordance with Article 6 of the Revision Act, Articles 16 to 18 EPC as revised by the Revision Act provisionally applied to the present European patent application as from 29 November 2000 without any retroactive effect and that the transitional provisions under Article 7 of the Revision Act do not apply. Hence the appellant's contention that the revised Articles 16 to 18 EPC were not applicable in the present case and thus that there was no legal basis in the EPC for holding oral proceedings in The Hague in the present case does not succeed.

Consequently, the provisions of Article 116 EPC 1973 in conjunction with Article 10(1),(2)(a),(b) EPC 1973 form the legal basis for conducting oral proceedings before the examining division in The Hague. As the appellant was summoned in proper form, in sufficient time before the oral proceedings and to the correct place, the right to be heard in oral proceedings (Articles 113(1) and 116(1) EPC 1973) was not violated in the present case. Thus there is no reason to apply Article 11 RPBA.

6. Conclusions

For the above reasons, the appellant's request to set aside the impugned decision and remit the case to the

department of first instance because of a fundamental deficiency must be refused.

Request to grant a patent on the basis of the claims according to the main request

7. Claim 1 - Inventive step (Article 56 EPC 1973)

7.1 Technical background

A brief description of the level of technical advancement in the field of optical discs at the priority date of the present application (24 November 1995) might be useful for an understanding of the skilled person's knowledge and expectations at that time.

Compact discs and digital video encoding according to the MPEG-1 standard were in widespread use. It is undisputed that there were no DVDs on the market at that time. The DVD specification was only finalised in 1996. The DVD standard had already been announced as early as 1994 but the technical details had not been disclosed. The future DVD format was eagerly awaited by the optical disc community because it promised to offer much larger storage capacity and used the fully digital coding of the newly developed MPEG-2 international standard (published as ISO/IEC 13818 by the International Organization for Standardization) for video and audio data. The DVD and MPEG-2 standards were regarded as bringing major improvements over the techniques used in optical discs already on the market, such as the Laserdisc, which stored analogue video data and digital audio data and had a data storage space

limited to only approximately one hour of video per disc side.

7.2 Disclosure of D1

D1 - undisputedly the closest prior art for claim 1 of the main request - discloses an optical disc having a data area (see fig. 3A and 3B) containing main picture information, sub-picture information for constructing sub-picture streams, and audio information (see column 10, lines 20 to 56, and fig. 3B) and having a management area (see fig. 3A and 3B) containing attribute information (see column 11, fig. 4A and 4B) for identifying said sub-picture streams. Moreover, a specific code ("language code" in column 11 and fig. 4A and 4B) is included in said attribute information of each sub-picture stream, for the purpose of indicating a language related to a corresponding sub-picture stream from a plurality of different languages.

The appellant submitted that D1 does not explicitly disclose sub-picture "streams".

The board agrees that the term "stream" is not used in D1, but considers that this feature is nevertheless implicitly disclosed in D1 for the following reasons. The present application does not define the term "stream". The term is therefore to be construed according to its commonly accepted meaning before the priority date in the field of data processing, in particular of audiovisual information, which was that of a "continuous flow of data or instructions". In D1, the attribute information identifies "data strings" of sub-picture information in different languages (see,

for instance, column 15, lines 21 to 35) which, during reproduction of the recorded data on the medium, are used to construct "sub-picture streams" according to the above definition, namely a continuous flow of data for display at a given frame rate.

7.3 Distinguishing features

The recording medium of claim 1 thus differs from that of D1 in that the attribute information of each sub-picture stream further includes a code extension indicating at least one of a plurality of sub-picture character sizes and sub-picture descriptions in said language, and that said sub-picture streams are determined by both the specific code and the code extension.

7.4 Objective technical problem

According to the appellant the objective technical problem when starting from D1 is to improve the displaying of sub-picture information from the medium with respect to display size and functionality. The board has no objection to this formulation of the objective technical problem.

7.5 Obviousness

The board notes that D1 teaches the recording of several sub-picture streams, each in a different language, for a given video sequence in order to let the user select the subtitles in the language of his/her choice. However, in D1, the user's choice as to

the subtitles is limited to the selection of the language.

A key question in the present case is whether it would have been obvious for the skilled person starting from D1 to provide additional attribute information for each sub-picture stream, for instance in order to let the user choose subtitles based on other criteria.

In the board's view, this question should be answered in the affirmative because as soon as the possibility is offered (by D1) to let the user choose the language of the subtitles, it would be natural for the skilled person to want to give more freedom of choice to the user. This can be done in several ways. Offering subtitles with larger characters for people with poor eyesight is regarded as an obvious one, which is the very reason why books with larger print exist (and why D2 (see Abstract) allows the character size on the display of a CD reproducing apparatus to be changed). Offering a choice from among a plurality of subtitles in the same language thus appears to result from the natural desire to give the user more freedom of choice.

As to the implementation, the purpose of the language code of D1 (see fig. 4A) is meant to make it possible to distinguish between sub-picture streams in different languages, not between sub-picture streams in the same language. The skilled person would thus either have to extend this code or to record at least one additional code on the optical disc of D1 for this purpose. The choice would in particular depend on a meaningful structure for presenting user selections. Presenting the possible selections depending on a preferred

language (which is unlikely to be frequently changed) makes it possible to reduce the number of selections. A specific code for the language and an (additional) extension code for defining further options would be a straightforward structure for implementing such a presentation of selections. The board thus considers that providing both a specific code and an extension code by which the sub-picture streams are determined merely constituted an obvious choice for a person skilled in the art.

7.6 The board is not convinced by the appellant's arguments (see section XVII *supra*) for the following reasons.

- According to column 10, lines 47 to 49, the video data recorded on the optical disc of D1 is recorded "by high-efficient coding image compression techniques". This statement strongly indicates that the video data is recorded in digital form, whereas a Laserdisc stores analogue video data. Moreover, the optical disc of D1 is intended not only for karaoke but also for storing movies (see, for instance, column 10, lines 30 to 33).

- The board does not agree that the subtitles in D1 are necessarily stored as text. D1 refers to the subtitles as sub-picture information, but does not state whether they are stored as text or image data. For alphanumerical subtitles (e.g. in English) it would make sense to store them as text (ASCII). However, Japanese subtitles (see figure 5A) could be stored either as text or image data. In any case, this point is irrelevant to claim 1 because the claim contains no limitation as to the form in which (i.e. text or image) the sub-picture information is recorded.

- Contrary to the appellant's contention, the number of languages for the subtitles in D1 is not limited to three. D1 states that subtitle information is stored in at least three languages (see column 3, lines 25 to 28) and gives an example with four languages, namely Japanese, English, French and German (see column 12, lines 18 to 27, and figure 5B). Moreover, storing subtitle data takes very little space compared to storing the associated video and audio data. Hence the board is not convinced that lack of space would have dissuaded the skilled person from adding more subtitles. Moreover, at the priority date of the application, the skilled person knew that optical discs according to the already announced, but not yet released, DVD standard would be available in the near future with a much larger storage capacity.

7.7 Conclusions

For the above reasons, the board judges that the subject-matter of claim 1 according to the main request does not involve an inventive step in view of D1.

As a consequence, the appellant's main request is not allowable.

Request to grant a patent on the basis of the claims according to the first auxiliary request

8. Claim 1 - Inventive step (Article 56 EPC 1973)

8.1 Compared to claim 1 according to the main request, claim 1 according to the first auxiliary request is further limited in that:

- the sub-picture information comprises literal pictures used for constructing a sub-picture stream; and
- the code extension indicates "one of a plurality of sub-picture character sizes in said language" (as opposed to "at least one of a plurality of sub-picture character sizes and sub-picture descriptions in said language" in claim 1 according to the main request).

8.2 The appellant explained during the oral proceedings that the expression "literal pictures", read in the context of the description, had to be understood as meaning text information recorded as pictures.

The board has some reservations about the appellant's interpretation of the expression "literal pictures". However, since the board has come to the conclusion that, even applying the appellant's interpretation, the subject-matter of claim 1 does not involve an inventive step, it can be left unanswered whether this expression should be construed more broadly.

As already explained in point 7.6 *supra*, the board does not agree that the subtitles in D1 are necessarily stored as text. D1 refers to the subtitles as sub-picture information, but does not state whether they are stored as text or image data. For alphanumerical subtitles (e.g. in English) it would make sense to store them as text (ASCII). However, Japanese subtitles (see, for example, figure 5A) could be stored either as text or image data, both being regarded as obvious alternatives by the board. Japanese characters stored

as image data would be "literal pictures" according to the appellant's definition of the term.

8.3 The obviousness of the second feature, i.e. the code extension indicating "one of a plurality of sub-picture character sizes in said language", has already been addressed in points 7.5 and 7.6 *supra*. Also the combination of both features, i.e. literal pictures for constructing sub-picture streams of different character sizes, merely makes use of known coding/decoding techniques for text or image information. There is no information in the present application that a particular problem had to be overcome once the obvious choice was made to determine a particular sub-picture stream by providing a specific code and a code extension.

8.4 For the above reasons, the board concludes that the subject-matter of claim 1 according to the first auxiliary request does not involve an inventive step in view of D1.

9. Accordingly, the appellant's first auxiliary request is not allowable.

Request to grant a patent on the basis of the claims according to the second auxiliary request

10. Claim 1 - Sufficiency of disclosure (Article 83 EPC 1973)

In the reasons of the decision under appeal, the examining division argued that the application did not meet the requirement of sufficiency of disclosure under

Article 83 EPC 1973. The examining division's reasoning rested on the finding that it was directly and unambiguously derivable from the description of the application that the invention of claim 1 according to the then auxiliary request (closely related to claim 1 of the present second auxiliary request) was a DVD recording medium.

The board, however, is not convinced that this finding is correct.

Claim 1 does not mention the term DVD, nor does any other claim according to the second auxiliary request. The only direct references to DVD in the whole application are found in the description (page 6, lines 17 and 21, and page 7, line 10) and in the drawings (figure 2). The board does not dispute that it is quite likely from these references that many, if not all, of the technical features of the described embodiments are derived from the DVD specifications, which were not publicly available at the priority date of the present application, as admitted by the appellant on pages 5 and 6 of the letter dated 6 August 2010. However, importantly, nowhere in the application is there any indication that optical discs according to the embodiments disclosed in the description and drawings must comprise **all** the features required by the DVD specifications for a "DVD recording medium". The structure, terms and expressions used in the claims and the description, which appear to correspond at least partly to features of DVD specifications, are not necessarily identical in all aspects with those defined in the DVD specifications (which are not available to the board). Moreover, the examining division did not

identify any particular feature of the medium of claim 1 which the skilled person would have been unable to carry out.

For the above reasons, the board judges that the examining division's reasoning failed to show convincingly that the DVD standard was necessary for carrying out the claimed invention and hence that the requirement under Article 83 EPC 1973 was not met in the present case.

11. *Ex officio* examination by the board

In the present appeal the board considered it appropriate to exercise the power within the competence of the examining division in accordance with Article 111(1) EPC 1973 to further examine *ex officio* the claims of the second auxiliary request.

12. Validity of the priority

12.1 Many of the features (such as elements of the data area serving as management information and referred to by the reference signs VTS, VTSI, VOBS, VOBUs, ...) present in claim 1 according to the second auxiliary request were not disclosed in the Japanese priority application. As a consequence, the requirement for claiming priority of "the same invention", referred to in Article 87(1) EPC 1973 and interpreted by the Enlarged Board of Appeal in its opinion G 2/98 (OJ EPO 2001, 413), is not fulfilled in the present case. Therefore, no priority has been validly claimed for the subject-matter of claim 1 according to the second auxiliary request.

12.2 The appellant has stated that the claimed priority is also valid for the subject-matter of claim 1 according to the second auxiliary request, but has submitted no argument in support of this assertion.

13. Novelty

13.1 In view of the fact that the priority claim is invalid for the subject-matter of claim 1 according to the second auxiliary request, the disclosure of D10, which was published on 9 October 1996, belongs to the state of the art under Article 54(2) EPC 1973 for the subject-matter of claim 1 of the second auxiliary request.

13.2 D10 discloses a multilingual recording medium having
a data area (*see "playback data area" in column 2, lines 16 to 19*) in which main picture information, a plurality of pieces of audio information representing each a different language (*see column 11, lines 5 to 7*) and pieces of sub-picture information adapted to be used to construct streams have been recorded, said pieces of sub-picture information representing one of a plurality of languages (*see column 11, lines 7 to 10*), and

a management area (*see "playback information area" in column 2, lines 20 to 28*) in which attribute information adapted to be used to identify said streams has been recorded,

said attribute information is supplemented with specific code indicating kinds of languages and a code extension indicating differences in the size of characters and/or description in the same language, and

said data area has said sub-picture information stream determined by said specific code and code extension recorded in it (*see "specific code" and "code extension" in column 26, lines 11 to 21, column 27, lines 29 to 43, and figure 12*);

the data area of the information recording medium recording a plurality of video title sets (VTSS), each of the video title sets (VTS) including a video object set (VOBS) and video title set information (VTSI) serving as management information which is referred to in order to reproduce the video object set (*see fig. 4, 6 and 21, column 11, lines 20 to 27, and column 20, lines 4 to 23*),

the video object set (VOBS) including a plurality of video object units (VOBUs), each of which includes more than one video packs (V_PCK), a plurality of sub-picture packs (SP_PCKs) for storing sub-picture data and a plurality of audio packs (A_PCKs) for storing audio data (*see fig. 6*),

the sub-picture data having a plurality of streams, and the audio data having a plurality of streams (*see column 22, lines 18 to 26*),

the video title set information (VTSI) including a video title set information management table (VTSI_MAT), a video title set part-of-title search pointer table (VTS_PTT_SRPT), and a video title set program chain information table (VTS_PGCIT) (*see fig. 21*),

the video title set information management table (VTSI_MAT) having a sub-picture stream attribute table (VTS_SPST_ATRT) indicating attributes of the streams of the sub-picture data and an audio stream attribute table (VTS_AST_ATRT) indicating attributes of the streams of the audio data (*see fig. 22*),

the sub-picture stream attribute table (VTS_SPST_ATRT) having information indicating a coding mode of the sub-picture, type information representing whether a language code is present or absent, a language code indicating the kind of the languages of the sub-picture, and said extension code related to the languages (*see column 26, lines 11 to 21, and fig. 12*),

the extension code capable of including distinction information of "Caption in standard-sized characters", "Caption in large-sized characters", "Caption for children", "Director's comments in standard-sized characters", "Director's comments in large-sized characters", and "Director's comments for children" (*the "code extension" shown in fig. 12 is coded with 8 bits (b15-b8), which is sufficient for it to be "capable" of including distinction information for these seven types of captions; moreover, the board considers that a different content of the distinction information does not provide any technical effect in the context of claim 1*),

the audio stream attribute table (VTS_AST_ATRT) having audio coding mode information, audio type information representing whether a language code is present or absent, a specific code indicating the kind of the languages of the audio data, an extension code related to the languages (*see fig. 23 and from column 23, line 48 to column 24, line 56, and column 25, lines 38 to 44*), and application information indicating which of a karaoke mode or a surround mode is used (*see column 25, lines 2 to 8*), and

the extension code capable of writing distinction information of "Standard caption", "Speech for visually handicapped persons", and "Director's comments" (*the "specific code" in bits b47-b32 in fig. 23*

corresponding to the "extension code" of present claim 1 has enough bits to be "capable" of including distinction information for these audio types).

- 13.3 Hence the subject-matter of claim 1 according to the second auxiliary request lacks novelty within the meaning of Article 54(1) EPC 1973 in view of D10.
- 13.4 The appellant has not disputed that D10 discloses all the features of the subject-matter of claim 1 according to the second auxiliary request.
14. Accordingly, the appellant's second auxiliary request is not allowable.
15. Conclusion

Since no request of the appellant is allowable in the present case, the appeal must be dismissed.

Request for refund of the appeal fee

16. According to Rule 67 EPC 1973 the appeal fee shall be reimbursed if the appeal is allowable and the reimbursement is equitable by reason of a substantial procedural violation.

As the appeal is not allowable (see point 15 *supra*), the request for refund of the appeal fee must be refused.

Request for reimbursement of the travel costs

17. The board has to refuse the appellant's request for a reimbursement of the travel costs to The Hague for the following reasons.
- 17.1 Article 104 EPC is not applicable in the present *ex parte* case since this provision concerns the apportionment of costs in opposition proceedings to be borne by the parties to it.
- 17.2 The board also has no competence to make an order against the EPO to pay any costs to the appellant incurred because the oral proceedings were held in The Hague. Neither the EPC nor any other legal text empowers the board to consider claims against the EPO for compensation in respect of loss or damage allegedly sustained in the course of European patent grant proceedings (see also J 14/87, OJ EPO 1988, 295, Reasons, point 13). According to Article 9(2) EPC 1973, any damages claim against the EPO is governed by national law and has to be asserted before the competent court according to Article 9(4) EPC 1973.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for reimbursement of the appeal fee is refused.
3. The request for payment of the travel costs is refused.

The Registrar:

The Chairman:

L. Fernández Gómez

F. Edlinger