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**Datasheet for the decision
of 14 September 2011**

Case Number: T 1724/08 - 3.5.04

Application Number: 06076059.2

Publication Number: 1686797

IPC: H04N5/445, H04N5/45

Language of the proceedings: EN

Title of invention:

Combination of VCR index and EPG

Applicant:

Gemstar Development Corporation

Headword:

Relevant legal provisions:

EPC 1973 Art. 76(1)

RPBA Art. 13(1)

Keyword:

Extension (yes) - over an earlier application

Late filing of amended claims

Decisions cited:

T 289/95, T 274/03

Catchword:

see point 3.5



Case Number: T1724/08 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 14 September 2011

Appellant: Gemstar Development Corporation
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted 18 April 2008
refusing European patent application No.
06076059.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: F. Edlinger
Members: R. Gerdes
C. Vallet

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division refusing European patent application No. 06 076 059.2, which was filed as a divisional application of earlier European patent application No. 97 915 090.1, published as WO 97/34413 A1.
- II. The present application was refused by the examining division in accordance with Article 97(2) EPC because the subject-matter of the independent claims according to the applicant's main and first to third auxiliary requests was found to contain subject-matter extending beyond the content of the earlier European application as filed (Article 76(1) EPC).
- III. The appellant lodged an appeal and requested that the decision of the examining division be set aside. He maintained the main request on which the appealed decision was based and filed claims of first and second auxiliary requests to replace the auxiliary requests on file.
- IV. In a communication annexed to the summons to oral proceedings, the board set out its provisional opinion in which it agreed with the examining division.
- V. With a letter of reply dated 15 August 2011 the appellant filed a new set of claims as a main request and, additionally, claims of a third auxiliary request.
- VI. Oral proceedings were held on 14 September 2011. During the oral proceedings the appellant submitted claims of a fourth auxiliary request.

VII. The appellant requested that the decision under appeal be set aside and that the application be allowed for grant on the basis of the claims of the main request filed with letter of 15 August 2011; in the alternative, on the basis of the claims of the first or second auxiliary requests filed with the statement of grounds of appeal, or of the third auxiliary request filed with the letter of 15 August 2011; or as a last alternative, on the basis of the claims of the fourth auxiliary request submitted in the oral proceedings.

VIII. Claim 1 of the **main request** reads as follows (letters in bold typeface and brackets have been added by the board and reflect the same breakdown of features as provided for the corresponding features in the statement of grounds of appeal).

"**(i)** A method for use in an interactive television guide system in which program listings are available for broadcast programs and recorded programs, the method comprising:

(ii) displaying in the same screen of an on-screen guide at least two program listings, wherein a first program listing corresponds to a recorded program and a second program listing corresponds to a broadcast program;

(iii) receiving a user selection of a program listing displayed in the on-screen guide; and

(iv) in response to the user selection, displaying a program that corresponds to the selected program listing."

IX. Claim 1 of the **first auxiliary request** reads as follows.

"A method for use in an interactive television guide system in which program listings are available for broadcast programs and recorded programs, the method comprising:
displaying an on-screen guide comprising at least two program listings, wherein a first program listing corresponds to a recorded program and a second program listing corresponds to a broadcast program;
receiving an input for displaying the recorded or broadcast program corresponding to one of the program listings displayed in the on-screen guide; and
in response to the input, displaying the program that corresponds to said program listing."

X. Claim 1 of the **second auxiliary request** differs from claim 1 of the first auxiliary request in the receiving step:

"receiving from a remote controller for operating the guide system a user initiated input for displaying the recorded or broadcast program".

XI. Claim 1 of the **third auxiliary request** reads as follows.

"A method for use in an interactive television guide on a television system operated by a separate device in which program listings are available for broadcast programs and recorded programs, the method comprising:
in response to operation of the device to produce a first input, displaying in the same screen of an on-screen guide at least two program listings, wherein a first program listing corresponds to a recorded program

and a second program listing corresponds to a broadcast program;
receiving a user selection of a program listing displayed in the on-screen guide by user operation of the device to produce a second input to the guide, or receiving a user selection of the second program listing displayed in the on-screen guide by user operation of the device to produce a third input to the guide; and
in response to the user input, displaying a program that corresponds to the selected program listing."

XII. Claim 1 of the **fourth auxiliary request** reads as follows.

"A method for use in an interactive television guide system in which program listings are available for broadcast programs and recorded programs, the method comprising:
displaying in the same screen of an on-screen guide a program listing, the listing including a plurality of recorded programs and a program currently being broadcast;
receiving a user input to select between the program currently being broadcast and one of the recorded programs; and
in response to the user input, displaying the selected program."

XIII. The examining division stated in the decision under appeal (see point 2 of the Reasons):

"..., the division cannot see any basis for selecting a program from the second listing 62. Insofar claim 1, being a collection of generalized and broadened features of the application, adds the novel technical

teaching that the program guide displays two different listings and that a user can select a program from either listing. According to the novel teaching the program guide creates and displays a "fully" mixed listing having selectable entries of broadcast and recorded programs. Such teaching is, however, not only not derivable from the documents of the earlier application as filed but also in contrast with the original teaching according to which only entries of either a broadcast or a recording listing can be selected."

XIV. The appellant's arguments may be summarised as follows.

The appellant was entitled to broaden the scope of a claim within the limits of Article 76(1) EPC 1973 and Article 123(2) EPC, provided that there was a disclosure that enabled a person skilled in the art to achieve the envisaged result, i.e. the claimed functionality, without undue difficulty.

The "fully" mixed listing guide that is referred to in the decision under appeal is an artificial construct, which is not disclosed in the application, but which is also not claimed. In this context reference is made to T 289/95, in particular section 5, which clarifies the difference between what a claim covers and what it discloses.

With regard to the disclosure of features (ii) to (iv), reference is made to figure 7, with reference number 60 corresponding to a recorded program listing and number 62 referring to a broadcast program listing. The passages on page 7, lines 9 to 15 and lines 22 to 30, in particular, show features (iii) and (iv).

The term "selection" in features (iii) and (iv) should be understood in the sense of "choosing out of two or more possibilities". There is no requirement in the claim for the selection methodology to be the same; the claim merely requires the receipt of a user selection of one of the program listings, which causes the corresponding program to be displayed. Selection of the recorded program in area 60 may be effected by pressing the PLAY button once (see page 7, lines 11 to 14). Pressing the GUIDE/TV button results in the display of the program corresponding to the listing in highlighted area 62 (see page 8, lines 6 to 11). Alternatively, the PLAY button may be pressed twice to display the broadcast program in the PIP window 50 since it switches between the VCR and tuner outputs (see page 7, lines 22 to 25).

The independent claims according to the first to third auxiliary requests further specify how the selection is effected.

The fourth auxiliary request should be admitted because it provides further limitations compared to the claims of the previous requests. Examination of this request does not necessitate a new search, because it only adds features to claim 1 according to the main request, see also T 274/03.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. In the following, references to the description, claims or drawings relate to the earlier application as filed, which was published as WO 97/34413 A1.

3. According to Article 76(1), second sentence, EPC 1973 a European divisional application "may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed".
 - 3.1 The earlier application as filed relates to a "method and apparatus for switching between a television viewing mode and a guide mode which comprises **program guide screens**, for telecast programs, and **video tape index guide screens**, for recorded programs" (see page 1, lines 6 to 9 and figure 1, emphasis added by the board). The technical problem is stated in the earlier application as "to provide a television system which has both types of guides ... and which facilitates navigation in a guide mode between the various guide screens ...". The problem is solved by provision of "a tape indexing and searching (TIS) apparatus for generating a tape index display" and "an electronic program guide (EPG) apparatus for generating an EPG display" (see "Summary of the Invention", page 2, lines 4 to 6). A number of options are provided to switch between various displays, inter alia "by pressing a guide/tv button on the remote controller, the viewer may enter **either** an EPG **or** tape index guide" (page 2, lines 16 to 18, emphasis added by the board). A picture-in-picture (PIP) window is additionally provided which is operative to display real-time images of a selected program overlaid on a background comprising guide information (page 2, lines 9 to 15).

3.2 Figure 7 shows a tape index guide screen comprising a listing area 58 with several program listings corresponding to programs recorded on the tape. In addition, figure 7 shows a "highlighted area 62" which - in one of several embodiments referring to figure 7 - "includes the program listing for the program tuned by the tuner" (see page 7, lines 27 to 29). The purpose of this area 62 is to allow "the viewer to identify the currently telecast program displayed in the PIP window 50 while in the tape index guide" (page 7, lines 29 and 30).

By pressing the PLAY button the currently highlighted program listing 60 of the tape index guide may be located on the tape and displayed in the PIP window (see page 7, lines 11 to 14). Moreover, by pressing the GUIDE/TV button the user may exit the guide mode, and the program shown in the PIP window is displayed full-screen (see page 2, lines 16 to 18, and page 8, lines 6 to 11).

3.3 The board holds that the concept of the invention as summarised in point 3.1 above envisages separate screens for the display of a program guide and a tape index guide (see passages marked in bold typeface). The embodiment based on figure 7 does not depart from this concept.

The fact that pressing the GUIDE/TV button results in a full-screen display of the program which was previously displayed in the PIP window 50 does not imply that the program is displayed in response to the user selection of the program listing. Pressing the GUIDE/TV button is not a user selection of a program listing in the meaning of "choosing out of two or more possibilities", but a selection of a different mode and only results in

the full-screen display of a program that was displayed before in the PIP window. Claim 1, feature (iv), specifies that the display of the program that corresponds to the selected (one of at least two) program listing(s) is effected **in response** to the user selection. At least this feature is not directly and unambiguously derivable from the earlier application as filed.

The appellant argued that pressing the PLAY button twice would result in a change of the content of the PIP window from the broadcast program to a recorded program and then back to the broadcast program. However, the application as filed discloses a "program source button" which switches ("toggles") the input to the PIP chip 23 to either a VCR or a tuner (see page 2, lines 18 to 20, and figure 1). Page 7, lines 22 to 25, discloses in the context of figures 3 and 4 that, in either the television mode or the guide mode, the PLAY button 32 may control this program source switch (see page 7, lines 22 to 25). Even if this functionality of the PLAY button were disclosed in the context of figure 7, the sequence of operations only results in the same program being displayed as before execution of the sequence. Feature (iv) is therefore not directly and unambiguously disclosed in this context either.

3.4 The board concludes that the subject-matter of claim 1 of the main request extends beyond the content of the earlier application as filed (Article 76(1) EPC 1973).

3.5 The appellant's arguments did not convince the board for the following reasons.

The appellant referred to decision T 289/95, which in point 5 of the Reasons states "that the question of

whether or not a claim in a patent deriving from a divisional application 'covers' or 'embraces' something which was not specifically disclosed in the parent application is not the proper standard of comparison for determining whether there has been an inadmissible extension of subject-matter. What is required ... is an analysis of whether the subject-matter of the contested patent is directly and unambiguously derivable from, and consistent with, the disclosure in the parent application".

The board agrees with this statement. Although broadening of individual disclosed features, in particular those of an independent claim as filed, is not prohibited by Article 76(1) EPC 1973, such amendments likewise require a direct and unambiguous disclosure in the earlier application as filed. The criterion of "direct and unambiguous disclosure" is quite different from the criterion submitted by the appellant, namely whether a person skilled in the art in view of the disclosure is enabled to achieve the envisaged result, i.e. the claimed functionality, without undue difficulty. This latter criterion would allow many different new definitions of subject-matter, none of which would need to be derivable "directly" and "unambiguously" from the earlier application as filed.

In the present case, however, the claimed subject-matter, which may be seen as a "collection of generalized and broadened features of the application" as filed (as the examining division saw it), cannot be derived directly and unambiguously from the parent application as filed (see point 3.3 above). The examining division only referred to 'fully' mixed listings in the decision under appeal to illustrate the fact that such teaching is "in contrast with the

original teaching according to which only entries of **either** a broadcast **or** a recording listing can be selected" (see points XIII and 3.1).

Auxiliary requests 1 to 3

4. Claim 1 of each of the first to third auxiliary requests refers to displaying of the program that corresponds to the (selected one of a broadcast and a recorded) program listing in response to user selection/user input.
- 4.1 Claim 1 of auxiliary requests 1 and 2 specifies an "input for displaying" instead of a user selection. However, displaying the tuner program in the PIP window in response to a GUIDE/TV button input when starting from an index guide (as shown in figure 7) does not display a program corresponding to one of the program listings which are shown in separate screens according to the teaching of the application as filed. Rather, this corresponds to switching to a different mode (see point 3.3 above). The fact that the input is received from a remote controller as specified in claim 1 of auxiliary request 2 does not change this reasoning.
- 4.2 Claim 1 of auxiliary request 3 again specifies that a program that corresponds to "the selected program listing" is displayed. As already set out above (see point 3.3) the board sees no disclosure in the context of an index guide that a broadcast program could be displayed in response to a user input selecting one out of two or more broadcast programs.
- 4.3 Hence, the claims of auxiliary requests 1, 2 and 3 are not allowable for substantially the same reasons as claim 1 of the main request.

Auxiliary request 4

5. According to Article 13(1) RPBA (Rules of Procedure of the Boards of Appeal of the European Patent Office, OJ EPO 2007, 536), any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the board's discretion. The board's discretion is to be exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.
 - 5.1 According to established jurisprudence, claims that are clearly not allowable will not normally be admitted during oral proceedings (see Case Law of the Boards of Appeal of the European Patent Office, 6th edition, 2010, section VII.E.16.3.3).
 - 5.2 The examining division in the decision under appeal set out the opinion that the teaching of a claim according to which "the program guide displays two different listings and [...] a user can select a program from either listing" was not disclosed in the earlier application as filed (see point XIII above). The same argument was repeated by the board in the communication accompanying the summons to oral proceedings (see points 6.1 and 6.2 of that communication).

The appellant could, therefore, not be surprised that the claims of the main and first to third auxiliary requests were refused for this reason. There were several opportunities to submit a new set of claims, which the appellant also availed himself of, but without overcoming the objection. Hence, *a priori* it was not likely that a new set of claims not clearly

overcoming the objection would be admitted during the oral proceedings.

The subject-matter of claim 1 of the fourth auxiliary request again relates to the display of a selected broadcast or tape-recorded program **in response** to user selection/input. On a *prima facie* evaluation, therefore, it does not appear suitable to overcome the objection under Article 76(1) EPC 1973. In addition, in the earlier application as filed as well as in the previous requests the expression "program listing" consistently refers to a single program entry corresponding to a recorded or broadcast program. In independent claims 1 and 11 of the fourth auxiliary request the listing is defined to include "a plurality of programs". Hence, the terminology in the independent claims and the earlier application as filed is inconsistent.

5.3 The appellant referred to T 274/03 and argued that the fourth auxiliary request should be admitted because the resulting subject-matter did not require a new search to be carried out. T 274/03 concerns the question whether an objection under Rule 86(4) EPC 1973 was justified in a case in which a claim was amended by adding features from the description to it. This case therefore relates to allowability of amendments under Rule 86(4) EPC 1973 and not to admissibility of late amendments under Rule 13(1) RPBA. It is, consequently, not relevant for the present case.

5.4 In view of the above the board decided not to admit the fourth auxiliary request into the appeal proceedings in application of Article 13(1) RPBA.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

K. Boelicke

F. Edlinger

Decision electronically authenticated