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**Datasheet for the decision
of 8 November 2012**

Case Number: T 1874/08 - 3.5.05

Application Number: 99919436.8

Publication Number: 1076968

IPC: H04L 12/64, H04N 5/00

Language of the proceedings: EN

Title of invention:

Networked conditional access module

Patent Proprietor:

SONY UNITED KINGDOM LIMITED

Opponents:

NAGRACARD SA

Interessengemeinschaft für Rundfunkschutzrechte e.V.

Headword:

Home network CA module with scrambling capability/SONY

Relevant legal provisions:

EPC Art. 123(2), 123(3)

Keyword:

"Added subject-matter - Main and auxiliary requests (yes)"

Decisions cited:

G 0001/93

Catchword:

-



Case Number: T 1874/08 - 3.5.05

DECISION
of the Technical Board of Appeal 3.5.05
of 8 November 2012

Appellant: SONY UNITED KINGDOM LIMITED
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 23 July 2008
revoking European patent No. 1076968 pursuant
to Article 101(3) (b) EPC.

Composition of the Board:

Chair: A. Ritzka
Members: P. Cretaine
D. Prietzel-Funk

Summary of Facts and Submissions

- I. This appeal is against the decision of the opposition division to revoke the European patent 1 076 968, dispatched on 23 July 2008. The patent was revoked on the ground that the claims of the main request as amended in the opposition proceedings did not meet the requirements of Article 123(2) EPC. An auxiliary request filed during the oral proceedings before the opposition division was not admitted into the proceedings because it was late filed (Rule 116(1) EPC) and did not meet the requirements of Articles 84, 123(2), and 123(3) EPC.
- II. Notice of appeal was submitted by the patentee on 17 September 2008. The appeal fee was paid on the same day.
- III. By letter received on 9 October 2008, respondent II (opponent 02) requested that the appeal be dismissed or, as an auxiliary request, that oral proceedings be arranged.
- IV. The statement setting out the grounds of appeal was submitted on 24 November 2008.

The appellant (patentee) requested cancellation of the decision and maintenance of the patent in amended form according to claims 1 to 7 of the main request or to claims 1 to 4 of the auxiliary request, both requests as filed with the statement setting out the grounds of appeal. In support of its arguments, the appellant filed three DVB-IHDN draft specification documents and

- referred to decision G 1/93, in particular the part dealing with remedies for the "Article 123(2)- 123(3) trap". Further, the appellant requested that, if the board was minded to dismiss the appeal, this should be based only on the ground for opposition cited in Article 100(c) EPC since the other grounds for opposition had not yet been discussed at the oral proceedings before the opposition division.
- V. By letter received on 16 February 2009 the appellant withdrew the main request and maintained the previous auxiliary request as its new main request.
- VI. By letter received on 8 May 2009 respondent II commented on the statement of grounds of appeal and requested that the appeal be dismissed because the claims of the main request did not meet the requirements of Article 123(2) and (3) EPC. Respondent II further requested that the case be remitted to the department of first instance if the board was to decide that the claims fulfil the requirements of Article 123(2) and (3) EPC. Oral proceedings were requested on an auxiliary basis.
- VII. Respondent I (opponent 01) did not reply to the statement setting out the grounds of appeal.
- VIII. In a communication accompanying the summons to oral proceedings dated 13 July 2012, the board listed the points under Article 123(2) and (3) EPC to be discussed during the oral proceedings.
- IX. By letter dated 3 September 2012 in response to the board's communication, respondent I, party to the

proceedings as of right, informed the board that it would be attending the oral proceedings.

- X. In a letter dated 5 October 2012 in response to the board's communication, the appellant presented arguments in favour of the compliance of the claims of the main request with the requirements of Article 123(2) EPC, in particular that the findings of G 1/93 with respect to the Article 123(2)- 123(3) trap applied in the present case. Furthermore, the appellant filed claims 1 to 4 of a new auxiliary request.
- XI. In a letter dated 9 October 2012 in response to the board's communication and to the appellant's submission of 5 October 2012, respondent II presented arguments against the compliance of the claims of both the main and the auxiliary requests with the requirements of Article 123(2) and (3) EPC.
- XII. Oral proceedings took place on 8 November 2012. The Chair first announced that, since the decision to revoke the patent was based solely on the ground for opposition under Article 100(c) EPC, the grounds for opposition under Article 100(a) and (b) EPC would not be dealt with by the board, but, in the event that the appeal was allowed, the case would be remitted to the opposition division. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request submitted as an auxiliary request with the letter setting out the grounds of appeal, or on the basis of the auxiliary request submitted with the letter dated 5 October 2012. Respondents I and II requested that the

appeal be dismissed. At the end of the oral proceedings the Chair announced the board's decision.

XIII. Claim 1 of the main request reads as follows:

"A digital television signal receiver for use on a network, comprising:
a tuner for receiving a scrambled digital television signal;
means for producing, from the scrambled digital television signal, a partial transport stream containing the elements of the digital television signal which the digital television signal receiver wishes descrambled;
an interface for outputting said partial transport stream to a conditional access subunit (2) attachable via the network to said receiver and for inputting a locally scrambled digital television signal from said conditional access subunit (2);
a local descrambler for descrambling said locally scrambled digital television signal received from said conditional access subunit; and
a demultiplexer for receiving and demultiplexing said local descrambled digital television signal."

Claim 1 of the auxiliary request reads as follows:

"A digital television signal receiver for use on a network comprising:
a tuner for receiving a scrambled digital television signal;
means for producing, from the scrambled digital television signal, a partial transport stream containing the digital television signal which the

digital television signal receiver wishes descrambled;
an interface for outputting said scrambled digital
television signal to a conditional access subunit (2)
attachable via the network to said receiver and for
inputting a locally scrambled digital television signal
from said conditional access subunit (2) wherein said
interface outputs the partial transport stream to said
conditional access subunit (2);
a local descrambler for descrambling said locally
scrambled digital television signal received from said
conditional access subunit; and
a demultiplexer for receiving and demultiplexing said
local descrambled digital television signal."

The main and auxiliary requests both comprise a further
independent claim 2 directed to a conditional access
subunit adapted to cooperate with the digital
television receiver defined in claim 1 and a further
independent claim 4 directed to a method of
descrambling a digital television signal using the
digital television receiver defined in claim 1 and the
conditional access subunit defined in claim 2.

Reasons for the Decision

1. Admissibility of the appeal

The appeal complies with the provisions of Articles 106
to 108 EPC (cf. point II and IV above) and is therefore
admissible.

2. Main request:

2.1 Article 123(2) EPC

The feature of a "demultiplexer for receiving and demultiplexing said local descrambled digital television signal" present in claim 1 according to the main request is not disclosed in the application documents as originally filed.

2.1.1 It is clear from the description as a whole that the received television signal is a scrambled signal which is first descrambled in the conditional access subunit and further locally scrambled by the conditional access subunit before being output to the receiver and locally descrambled therein. The only basis in the originally filed application documents for a demultiplexer positioned after the conditional access subunit in the signal flow is Figure 15 as originally filed. This figure shows that this demultiplexer receives a clear transport stream from the conditional access subunit. The board agrees with the appellant that the wording "clear transport stream" refers unambiguously, based on the description, to a television signal which has been received by the tuner and has been descrambled by the conditional access subunit, i.e. to a television signal which has not been locally scrambled by the conditional access subunit. Figure 15 does not show any local scrambler in the conditional access subunit or any local descrambler in the receiver, and furthermore is not referred to in the description of the preferred embodiment, which uses a local scrambling/descrambling scheme. There is thus no explicit disclosure of a

demultiplexer positioned after a local descrambler in the receiver.

2.1.2 According to the appellant, the skilled person would however understand from the application as a whole that the concept of the invention relies on the use of a local scrambler in the conditional access subunit and a local descrambler in the receiver. The term "clear" from Figure 15, since referring unambiguously to the main scrambling/descrambling (see 2.1.1 above), would not preclude additional local copy protection, i.e. local scrambling, as described in the application as filed. As a consequence, Figure 15 should be considered as an implicit disclosure of a conditional access subunit comprising a local scrambler coupled to a receiver comprising a local descrambler and a demultiplexer. Furthermore, the skilled person would realise that only two options are available for positioning the demultiplexer in the receiver, either before or after the local descrambler in the direction of the signal flow. The appellant thereafter argued that, since Figure 15 does not show the local descrambler, none of the above mentioned options is excluded and the skilled person would consider either of the two options as implicitly disclosed by Figure 15.

The board is however not convinced by this argument. It may well be that the skilled person would consider that the demultiplexer of Figure 15 is implicitly disclosed as being part of a receiver comprising a local descrambler. However, the demultiplexer in the receiver aims at separating different subsignals, e.g. television channels, multiplexed within one television signal issued by the conditional access subunit. The

skilled person could choose to have a local scrambling performed in the conditional access subunit by applying a scrambling algorithm either to the multiplexed television signal as a whole or to each subsignal composing the multiplexed television signal. In the first case, the descrambling algorithm, corresponding to the scrambling algorithm, should be applied by the receiver to the locally scrambled multiplexed television signal before it is demultiplexed in order to separate the subsignals. In the second case, the locally scrambled television signal should **first** be demultiplexed in locally scrambled subsignals and then the descrambling algorithm should be applied to each locally scrambled subsignal. In the first case, the demultiplexer has to be positioned after the local descrambler. In the second case, it has to be positioned before the local descrambler. An inappropriate relative position of the demultiplexer would render the signal issued by the receiver unreadable for the user. Therefore the position of the demultiplexer is inherently linked to the kind of local scrambling performed, and as such represents a feature essential to the definition of the invention. In the board's judgement, the skilled person cannot deduce from Figure 15, as interpreted on the basis of the description, that the option defined by claim 1, which is to have the local scrambling performed on the television signal as a whole and therefore the demultiplexer positioned behind the local descrambler, is disclosed in the application as originally filed.

Therefore claim 1 does not meet the requirements of Article 123(2) EPC.

2.2 Article 123(2)- 123(3) trap

It was common ground during the proceedings that the removal of the feature of the demultiplexer from claim 1 would extend the protection conferred by this claim, as compared with claim 1 as granted, to digital television signal receivers not provided with a demultiplexer for receiving the signal issued from the conditional access subunit. The removal of the demultiplexer would thus contravene Article 123(3) EPC. Since the board decided that the introduction of the demultiplexer in claim 1 contravenes Article 123(2) EPC (see point 2.1 above), this feature falls within the so-called Article 123(2)- 123(3) trap.

The appellant argued that the requirements established in decision G 1/93 (see Order, point 2) are met and requested that the feature of the demultiplexer remained in claim 1 without being considered to violate Article 123(2) EPC.

Decision G 1/93 indicates in the Order, point 2, that:

"A feature which has not been disclosed in the application as filed but which had been added to the application during examination and which, without providing a technical contribution to the subject-matter of the claimed invention, merely limits the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, is not to be considered as subject-matter which extends beyond the content of the application as filed in the sense of Article 123(2) EPC."

The board concurs with the appellant that the relative position of the demultiplexer with respect to the local descrambler is to be considered, for the application of G 1/93, as a feature in claim 1 which has not been disclosed in the application as filed (see point 2.1 above) and which merely limits the protection conferred by the patent as granted to one of the two options, namely first the descrambling and then the demultiplexing, by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, namely the case where the descrambling occurs after the demultiplexing.

According to the appellant, this feature was clearly not an essential part of the invention, to the extent within so far as that the position of the demultiplexer did not contribute to and technically affect the invention, which was based on the local scrambling of the signal by the conditional access subunit and not on whether the locally scrambled signal was demultiplexed first or descrambled first.

However the board does not regard this argument as persuasive. As already mentioned in detail in point 2.1.2 above, in order to achieve a successful descrambling of the locally scrambled digital television signal, the demultiplexer in the receiver should be positioned with respect to the local descrambler according to the kind of local scrambling performed on the multiplexed television signal by the conditional access unit. An inappropriate positioning of the demultiplexer with respect to the local descrambler would lead to an MPEG signal probably

completely unreadable for the user at the output of the receiver. Therefore the board finds that the position of the demultiplexer is a feature which definitively provides a technical contribution to the subject-matter of the invention. The requirements stipulated by G 1/93 are thus not met by the feature of the demultiplexer in claim 1 of the main request.

2.3 The board therefore judges that the main request is not allowable (Article 123(2) EPC).

3. Auxiliary request

Claim 1 according to the auxiliary request has been amended with respect to claim 1 of the main request by the addition of features relating to the generation in the receiver of a partial transport stream for outputting to the conditional access subunit. Since claim 1 also contains the feature of "a demultiplexer for receiving and demultiplexing said local descrambled digital television", the findings of the board with respect to claim 1 of the main request (see points 2.1 and 2.2 above) are also valid for claim 1 of the auxiliary request.

The board therefore judges that the auxiliary request is not allowable (Article 123(2) EPC).

4. Thus, the ground for opposition mentioned in Article 100(c) EPC prejudices the maintenance of the patent as amended according to the appellant's main and auxiliary requests.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:

K. Götz

A. Ritzka