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**Datasheet for the decision
of 9 October 2014**

Case Number: T 2471/10 - 3.5.04

Application Number: 99935637.1

Publication Number: 1099341

IPC: H04N5/445

Language of the proceedings: EN

Title of invention:

INTERACTIVE TELEVISION PROGRAM GUIDE WITH REMOTE ACCESS

Patent Proprietor:

United Video Properties, Inc.

Opponents:

Fast LTA AG
Velocity 303 Limited

Headword:

Relevant legal provisions:

EPC 1973 Art. 100(a), 100(b), 100(c), 54, 111(1)
RPBA Art. 13(1), 13(3)

Keyword:

Late-filed request - admitted (yes)
Novelty - after amendment (yes)
Remittal to the department of first instance

Decisions cited:

G 0004/92, T 0202/92, T 0512/13

Catchword:



**Beschwerdekammern
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Case Number: T 2471/10 - 3.5.04

**D E C I S I O N
of Technical Board of Appeal 3.5.04
of 9 October 2014**

Appellant: United Video Properties, Inc.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted on 19 October 2010
revoking European patent No. 1099341 pursuant to
Article 101(3)(b) EPC.

Composition of the Board:

Chairman	F. Edlinger
Members:	R. Gerdes
	T. Karamanli

Summary of Facts and Submissions

- I. The appeal is against the decision of the opposition division revoking European patent No. 1 099 341, which had been filed as an international application and published as WO 00/04709 A1.
- II. Oppositions based on the grounds of Articles 100(a), (b) and (c) EPC 1973 were filed against the patent by three opponents. Opponent 3 (Interessengemeinschaft für Rundfunkschutzrechte GmbH Schutzrechtsverwertung & Co. KG, Germany) withdrew its opposition by letter dated 12 April 2007. In the opposition proceedings, the patent proprietor requested that the patent be maintained in amended form on the basis of the claims according to a main request and an auxiliary request.
- III. The opposition division revoked the patent on the grounds that the subject-matter of claim 4 according to both requests extended beyond the content of the application as filed and that the subject-matter of the independent claims 1 and 7 according to both requests lacked novelty in view of the following document

D4: WO 98/10589 A1.
- IV. The patent proprietor (appellant) lodged an appeal against this decision and filed amended claims of a main and an auxiliary request with the statement of grounds of appeal, which essentially corresponded to those underlying the decision under appeal except that claim 4 had been deleted.
- V. Opponent 2 (respondent 2) filed a response by letter dated 8 July 2011 and requested that the appeal be

- dismissed. Opponent 1 (respondent 1) did not reply to the statement of grounds.
- VI. In a communication annexed to a summons to oral proceedings, the board indicated that the deletion of claim 4 from both requests seemed to address the ground of revocation under Article 100(c) EPC 1973. Furthermore, the board expressed the preliminary opinion that the finding of the opposition division with respect to sufficiency of disclosure and extended subject-matter in the decision under appeal was correct. The board informed the parties that novelty and inventive step over D4 would have to be dealt with in the oral proceedings, and that the board wished to deal also with the other objections raised by respondent 2 instead of remitting the case to the department of first instance.
- VII. With a letter dated 9 September 2014, the appellant submitted new claims of a revised main request and of a second auxiliary request.
- VIII. With a letter of the same date, respondent 2 made further submissions. With regard to its objection of lack of inventive step, respondent 2 supplied a copy of decision T 512/13 and argued that Board 3.5.04 in a different composition had decided that the subject-matter of a similar independent claim lacked an inventive step in view of D4.
- IX. Oral proceedings were held on 9 October 2014. As announced beforehand, neither duly summoned respondent attended. After the discussion on novelty and inventive step with regard to document D4 the appellant withdrew all requests on file and filed a new sole request. The appellant requested that the decision under appeal be

set aside and that the patent be maintained in amended form on the basis of claims 1 to 10 according to the sole request, filed during the oral proceedings of 9 October 2014. The chairman noted that respondent 2 had requested in writing that the appeal be dismissed and that respondent 1 had filed no request.

X. The independent claims of the **sole request** read as follows (amendments to independent claims 1 and 7 of the main request underlying the decision under appeal are marked in bold):

"1. A method for recording television programs in a system having local program guide equipment arranged to implement an interactive television program guide, said interactive television program guide being operable to select a television program for recording and to schedule the recording of the selected television program and a remote program guide access device arranged to implement an interactive television program guide, the method comprising;
receiving a user selection at the interactive television program guide of the remote program guide access device;
communicating between the interactive television program guide of the remote program guide access device and the interactive television program guide of the local program guide equipment, thereby causing said interactive television program guide of the local program guide equipment to select a television program for recording and schedule the recording of the selected television program; and using the local interactive television program guide, recording the selected television program, **and further comprising receiving a user selection corresponding to selecting a**

recorded television program for playback using the remote access interactive television program guide; obtaining the recorded television program selected by the user for playback from the local interactive television program guide over the remote access link (19) using the remote program guide access device (24); and playing the obtained recorded television program selected by the user for playback with the remote program guide access device (24)."

and

"5. A system for recording television programs, the system having:

local program guide equipment arranged to implement an interactive television program guide, said interactive television program guide being operable to select a television program for recording and to schedule the recording of the selected television program;
a remote program guide access device arranged to implement an interactive television program guide;
means for communication between the interactive television program guide of the remote program guide access device and the interactive television program guide of the local program guide equipment, whereby the user of said program guide access device by using the interactive television program guide of the remote program guide access device can cause said interactive television program guide of the local program guide equipment to select a television program for recording and schedule the recording of the selected television program, **and having means operable to select a recorded television program for playback using the remote interactive television program guide;**

means for obtaining the recorded television program selected by the user for playback from the local interactive television program guide using the remote program guide access device (24); and means for playing the recorded television program selected by the user for playback with the remote program guide access device (24)."

XI. In the decision under appeal, the opposition division only considered the prior art disclosed in D4 and found that the subject-matter of the independent claims 1 and 7 of both requests then on file lacked novelty for the reasons as follows.

In the first part of the description of D4 (pages 4 to 16), the functionality of an interactive television programme guide was disclosed. The section "Enhanced Recording Capability" (pages 16 to 18) disclosed how this functionality could be mapped on a scenario in which a remote input device was used. The central processing system which was referred to in this section comprised all the functionality of the interactive television programme guide of the first part of D4. In particular, it also accessed the schedule data structure and controlled the recorder.

Concerning the other grounds for opposition raised by the opponents, the opposition division further decided that the subject-matter of dependent claims 3 and 10 according to the main request and the auxiliary request was sufficiently disclosed within the meaning of Article 100(b) EPC 1973. Furthermore, it held that the subject-matter of claims 5, 6, 12 and 13 of both requests did not extend beyond the content of the application as filed (Article 100(c) EPC 1973).

XII. Concerning the admissibility of the sole request filed during the oral proceedings before the board, the appellant argued that the amended independent claims were a straightforward combination of the previous independent claims and dependent claims. The request clearly overcame the lack of novelty objection in the decision under appeal. It had been filed late because the appellant had been surprised by the board's interpretation of D4.

The appellant's arguments on novelty of the independent claims in view of D4 may be summarised as follows.

Independent claims 1 and 5 of the sole request submitted in the oral proceedings comprised the additional features of dependent claims 6 and 13 as granted. D4 did not disclose an inter-guide communication as specified in the method step of communicating between the interactive television programme guide of the remote programme guide access device and the interactive television programme guide of the local programme guide equipment. It also did not disclose the subsequent step that the interactive television programme guide of the local programme guide equipment was employed to select a television programme for recording and to schedule the recording of the selected television programme.

XIII. With respect to the novelty, in view of D4, of the subject-matter of claims 1 and 7 of the main request underlying the decision under appeal, respondent 2 argued that the embodiments of pages 17 and 18 were interrelated and built upon one another. All the features of these claims were thus disclosed in combination in D4. Respondent 2, having not attended the oral proceedings, did not comment on claim 1 of the

appellant's new sole request. Nor did it submit any observations in the appeal proceedings on the features of dependent claims 6 and 13 as granted which had been incorporated into claims 1 and 5 of the appellant's sole request, respectively.

Respondent 2 argued with respect to sufficiency of disclosure (Article 100(b) EPC 1973) that there was no disclosure in the application as filed of how to record the television programme at a television distribution facility.

Furthermore, the omission of the reference to a "remote access link" in the independent claims represented a broadening of the claimed subject-matter that infringed Article 123(2) EPC. A "remote access link" or more specifically an "Internet access link" was present in each of the independent claims as originally filed. In addition, this feature was presented throughout the description as an essential feature, for example in each of the arrangements of figures 2 to 6.

Reasons for the Decision

1. The appeal is admissible.
2. *Non-attendance of the respondents at the oral proceedings*

The duly summoned respondents did not attend the oral proceedings. According to Rule 71(2) EPC 1973, the proceedings could however continue without them. In accordance with Article 15(3) of the Rules of Procedure of the Boards of Appeal (RPBA, OJ EPO 2007, 536) the board relied for its decision only on the respondents'

written submissions. The board was in a position to decide at the conclusion of the oral proceedings, since the case was ready for decision (Article 15(5) and (6) RPBA), and the voluntary absence of the respondents was not a reason for delaying a decision (Article 15(3) RPBA).

3. *Admissibility of the sole request*

3.1 The appellant's sole request was filed in the oral proceedings before the board. It thus constitutes an amendment to the appellant's case after the grounds of appeal have been filed and may be admitted and considered at the board's discretion (Article 13(1) RPBA), this discretion being 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. Moreover the new request is an amendment to the appellant's case after oral proceedings have been arranged and thus, in accordance with Article 13(3) RPBA, it should not be admitted if it raises issues which the board or the other parties cannot reasonably be expected to deal with without adjournment of the oral proceedings.

3.2 The present claims differ from those according to the revised main request filed with the letter of 9 September 2014 in that the additional features of dependent claims 5 and 12 of that request have been incorporated into the respective independent claim. Former claims 5 and 12 have consequentially been deleted and the remaining claims have been renumbered.

3.3 The claims of the sole request are more limited in scope than the previous sets of claims and include features which were already present in dependent

claims 6 and 13 as granted as well as in all further sets of claims submitted in the opposition and appeal proceedings. These amendments were submitted following a discussion on the novelty and inventive step over D4 of previously claimed subject-matter and are clearly suitable to overcome the grounds for revocation in the decision under appeal. The submission of the sole request can thus be considered as a prompt reaction to the discussion in the oral proceedings.

- 3.4 The respondents were not present at the oral proceedings before the board and were, therefore, not in a position to comment on the amendments made in the appellant's new request. According to the decision of the Enlarged Board of Appeal G 4/92 (OJ EPO 1994, 149), a party who fails to appear at oral proceedings must have the opportunity, in accordance with Article 113(1) EPC 1973, to comment on new facts and evidence submitted in the proceedings. In accordance with the established case law (see for example decision T 202/92 of 19 July 1994), the finding in decision G 4/92 does not, however, prevent the admission into the proceedings of new claims or requests introduced only at the oral proceedings before the board, and a decision thereon, where the amendments made overcome objections raised in the written proceedings and the amendments are of a nature that the absent respondents might have expected.

In the board's view, in the present case the respondents could have reasonably expected amendments like those made in the claims of the appellant's new request and thus they could not have been taken by surprise. Accordingly, the absence of the respondents was no obstacle to admitting the appellant's new

request into the proceedings and taking a decision on it.

3.5 As far as Article 13(3) RPBA is concerned, the board takes the view that a remittal to the first-instance department has to be considered equivalent to an adjournment of the oral proceedings. Thus, if the appellant's new request raised issues which the board could not reasonably be expected to deal with without adjournment or remittal, it should not have been admitted into the appeal proceedings. In the oral proceedings the board was able to deal with the question whether the claims of the new request overcame the objections raised in the decision under appeal. However, in the decision under appeal, the prior art was only dealt with in respect of novelty over D4. Therefore, the board would in any case have considered a remittal of the present case to the department of first instance once novelty over D4 was established, in order to give all parties the benefit of two instances. Thus, the remittal of the present case to the department of first instance (see point 7 below) is not a new issue caused by the appellant's amended request.

3.6 In view of the above, the board considered it appropriate to admit the appellant's sole request into the proceedings under Article 13(1) and (3) RPBA.

4. *Added subject-matter, Article 100(c) EPC 1973*

4.1 Since dependent claim 4 of the main request underlying the decision under appeal was deleted from the present set of claims, this reason for revocation has been overcome.

4.2 The board agrees with the opposition division that the feature of a "remote access link" is implied by the wording of the independent claims. In particular, the step of "communicating between the interactive television program guide of the remote program guide access device and the interactive television program guide of the local program guide equipment, thereby causing said interactive television program guide of the local program guide equipment to select a television program for recording and schedule the recording of the selected television program" unambiguously implies an access to the local programme guide equipment from the remote programme guide access device and, hence, the presence of a remote access link. As a result, the omission of an explicit reference to a "remote access link" does not constitute an extension of subject-matter over the application as filed.

4.3 The decision under appeal is also correct in that the subject-matter of claims 5, 6, 12 and 13 of the main request underlying the decision under appeal could unambiguously be derived from the application as originally filed. Therefore present claims 1, 4, 5 and 10, which comprise these features, do not extend the content of the application as filed.

4.4 Hence, the board concurs with the reasoning in the decision under appeal concerning Article 100(c) EPC 1973 and holds that the present claims comply with Article 123(2) EPC.

5. *Sufficiency of disclosure, Article 100(b) EPC 1973*

Furthermore, the board concurs with the reasoning in the decision under appeal that the subject-matter of

claims 3 and 8 (corresponding to claims 3 and 10 of the main request considered in the decision under appeal) is disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. The board finds that the skilled person would be able to implement means for recording at the television distribution facility, for instance in a similar way to corresponding means implemented at the local programme guide equipment.

6. *Novelty in view of document D4, Articles 54(1), (2) and 100(a) EPC 1973*

6.1 D4 relates to a method for recording television programmes in response to commands given by a user via a local programme guide (see page 5, lines 1 to 6, and page 14, line 25 to page 15, line 28) and, in a preferred embodiment, from a remote location (page 2, line 10 to page 3, line 13 and page 17, lines 1 and 2). The method is implemented in a system having local programme guide equipment arranged to implement an interactive television programme guide (see page 4, line 24 to page 5, line 11; page 6, lines 5 to 17). A programme may be selected and scheduled for recording via the interactive television programme guide of the local programme guide equipment. The local programme guide stores time and channel information of programmes to be recorded in a schedule data structure, which is monitored by a scheduler to determine when a programme is to be recorded. If a programme to be recorded at the current time is identified, the channel broadcasting the programme is selected and the VCR is controlled to record the programme (page 4, line 24 to page 5, line 6; page 14, line 25 to page 15, line 28; page 16, lines 12 to 34).

Furthermore, D4 discloses in its sections "summary of the invention" and "enhanced recording capability" that television programmes may be selected for recording by a user at a remote location using, for instance, a computer as a remote programme guide access device. These selections may be carried out using a remote interactive television programme guide (see page 2, lines 10 to 18; page 17, lines 3 to 21 and page 18, lines 1 to 23).

- 6.2 D4 does not disclose at least the features that were appended to independent claim 1 of the sole request (see the features marked in bold, point X above). In addition, there is no unambiguous disclosure of the features relating to a guide-to-guide communication, in particular not in the context of a communication relating to the playing of a recorded television programme in response to a user selection from the remote access guide.
- 6.3 The same reasoning applies with respect to independent claim 5, which specifies the corresponding system for recording television programmes.
- 6.4 It follows that the subject-matter of the claims according to the appellant's sole request is novel in view of document D4 (Article 54(1) and (2) EPC 1973).
- 6.5 Respondent 2 argued with respect to its objection of lack of inventive step that, in its decision T 512/13, Board 3.5.04 in a different composition had decided that the subject-matter of a similar independent claim lacked an inventive step in view of document D4. This argument does not apply to the question whether the present claims are novel, since the features of claims 1 and 5 which render the claimed subject-matter

novel (see points 6.2 and 6.3 above) were not present in the independent claims, forming the basis of decision T 512/13. Moreover, the present board concurs with the finding in point 2.2.4 of that decision that D4 does not disclose that the EPG used for local recording is also used when the user schedules recordings from a remote location.

7. *Remittal (Article 111(1) EPC 1973)*

The decision under appeal was based on the grounds of extended subject-matter and lack of novelty, in view of document D4, of the claims then on file. These grounds for revocation do not apply to the present claims and the decision under appeal must consequently be set aside. However, at this stage the patent cannot be maintained in amended form on the basis of the claims of the appellant's sole request without being further examined in terms of the Convention. However, the department of first instance has not yet carried out such an examination for the present set of claims.

In the circumstances of the present case, the board declines to carry out such an examination itself, with the possible introduction of new prior-art documents, and considers a remittal justified, in order to give the parties the benefit of two instances.

Under these circumstances the board exercises its discretion under Article 111(1) EPC 1973 in remitting the case to the department of first instance for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



K. Boelicke

F. Edlinger

Decision electronically authenticated