

Internal distribution code:

- (A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 20 July 2017**

Case Number: T 1176/12 - 3.5.04

Application Number: 04003609.7

Publication Number: 1450564

IPC: H04N7/26, H04N7/36, H04N7/50

Language of the proceedings: EN

Title of invention:
Moving picture coding and decoding methods

Applicant:
Panasonic Intellectual Property Corporation
of America

Headword:

Relevant legal provisions:
RPBA Art. 12(4)

Keyword:
Request could, and should, have been filed in first instance
proceedings (yes)

Decisions cited:
T 0273/11, T 0419/12, T 0023/10, T 1525/10

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1176/12 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 20 July 2017

Appellant: Panasonic Intellectual Property Corporation
(Applicant) of America
20000 Mariner Avenue, Suite 200
Torrance, CA 90503 (US)

Representative: Eisenführ Speiser
Patentanwälte Rechtsanwälte PartGmbB
Postfach 10 60 78
28060 Bremen (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 28 December
2011 refusing European patent application
No. 04003609.7 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman C. Kunzelmann
Members: B. Willems
B. Müller

Summary of Facts and Submissions

I. The appeal is against the decision of the examining division refusing European patent application No. 04003609.7 published as EP 1 450 564 A2.

II. In the decision under appeal the following documents were cited:

D1: "TEXT OF FINAL COMMITTEE DRAFT OF JOINT VIDEO SPECIFICATION (ITU-T REC. H.264/ISO/IEC 14496-10 AVC)", INTERNATIONAL ORGANIZATION FOR STANDARDIZATION - ORGANISATION INTERNATIONALE DE NORMALISATION, July 2002 (2002-07-01), pages I - XV, 1, XP001100641

D3: "TEXT OF FINAL COMMITTEE DRAFT OF JOINT VIDEO SPECIFICATION (ITU-T REC. H.264/ISO/IEC 14496-10 AVC)", JVT: "Study of Final Committee Draft of Joint Video Specification (ITU-T Rec. H.264 ISO/IEC 14496-10 AVC)", ITU STUDY GROUP 16 - VIDEO CODING EXPERTS GROUP - ISO/IEC MPEG & ITU-T VCEG (ISO/IEC JTC1/SC29/WG11 AND ITU-T SG16 Q6), no. JVT-F100, 13 December 2002 (2002-12-13), XP030005665

III. The application was refused on the grounds that the subject-matter of the independent claims on file lacked inventive step with respect to the combination of the disclosure of either D1 or D3 and the common general knowledge of the person skilled in the art (Article 56 EPC 1973).

IV. The applicant filed an appeal and requested that the decision be set aside. With the statement of grounds of appeal, the appellant (applicant) filed amended claims according to a main request. It requested that a patent be granted on the basis of the amended claims filed

with the statement of grounds of appeal. As an auxiliary request, it requested that the case be remitted to the examining division for further substantive examination of the claims of the main request. It submitted that, in comparison with claim 1 forming the basis for the impugned decision, amended claim 1 specified the insertion of flag A2 (*"wherein said flag insertion step includes one of: (1) inserting, into the coded stream, the flag and the position information in a sequence parameter set or in User Data Registered Supplemental Enhancement Information that is uniquely definable by a user; and (2) performing said inserting by storing the flag and the position information at a head of the coded stream or in a file that manages the coded stream"*). The appellant (applicant) also submitted that the amendment was based on claim 5 as originally filed and the description page 26, line 28 to page 27, line 7, and provided arguments as to why the subject-matter of the amended claims was considered to be new and involve an inventive step.

- V. In a communication under Article 15(1) RPBA (Rules of Procedure of the Boards of Appeal, OJ EPO 2007, 536), annexed to the summons to oral proceedings, the board informed the appellant of its provisional opinion that the main request was not to be admitted into the appeal proceedings (Article 12(4) RPBA) and ergo the auxiliary request for remittal of the case to the examining division for further substantive examination of the claims of the main request had no object. In this communication the board addressed in particular the questions whether the claims of the main request should have been presented in the first-instance proceedings and whether the subject-matter of these claims had been searched.

- VI. With a letter of reply dated 18 May 2017, the appellant provided arguments as to why the board, exercising its discretion under Article 12(4) RPBA, should admit the main request into the proceedings.
- VII. The board held oral proceedings on 20 July 2017. The appellant was represented.

The appellant requested that the decision under appeal be set aside and that a European patent be granted on the basis of the claims of the main request filed with the statement of grounds of appeal. It withdrew the auxiliary request filed with the statement of grounds of appeal.

At the end of the oral proceedings, the chairman announced the board's decision.

- VIII. Claim 1 of the main request reads as follows:

"A moving picture coding method for coding a moving picture signal on a picture-by-picture basis and generating a coded stream, the method characterized by:

a flag generation step of generating (i) a flag indicating that values indicated by a Picture Order Count POC of the pictures are non-sequential *and* (ii) *position information for identifying a position of an editing point at which the values indicated by the POC are non-sequential*; and

a flag insertion step of inserting the flag and the position information,

wherein said flag insertion step includes one of: (1) inserting, into the coded stream, the flag and the position information in a sequence parameter set or in User Data Registered Supplemental Enhancement Information that is uniquely definable by a user; and (2) performing said inserting by storing the flag and the position information at a head of the coded stream or in a file that manages the coded stream".

Amendments to claim 1 underlying the decision under appeal are set in *italics*.

- IX. The examining division's reasons for the decision under appeal which are relevant to the present decision may be summarised as follows:

D1 or D3 disclosed inserting a "broken_link_flag" at the location of a splice point. The "*claimed flag indicates non-sequentiality in the sequence exactly as the flag 'broken_link_flag' of D1, D3*" (see decision under appeal, Reasons point 1.3). During encoding, information was available as to whether the POC (picture order count) was sequential. The skilled person would have used this information to generate the flag indicating non-sequentiality.

- X. The appellant's arguments relevant to the present decision may be summarised as follows:

(a) There was no specific reason why the particular amendments should have been filed before the examining division (see, for example, T 0273/11 or T 0419/12):

- (i) Position information being inserted together with a flag was only discussed

with respect to dependent claims.

Introducing the features of present claim 1 could only have affected dependent claims.

- (ii) During the written proceedings the examining division had repeatedly raised a novelty objection based on a particular interpretation of the claims and the prior art. The appellant had successfully persuaded the examining division that the subject-matter of the claims was novel, and was convinced that "*also the presence of an inventive step would be acknowledged*" (see letter dated 18 May 2017, page 3, third full paragraph). Therefore, it had had no reason to amend the claims during the procedure before the examining division.
- (iii) The appellant had first realised the full extent of the position of the examining division in the course of the discussion of inventive step during the oral proceedings and "*upon careful consideration of the grounds for the decision to refuse the application*" (see letter dated 18 May 2017, page 3, fourth full paragraph). Only then it had become aware that the location of the flag A2 might be a basis for amendment.
- (iv) If the "*tiniest reason*" why the appellant should have filed the amendments during the examination proceedings now prevented it under Article 12(4) RPBA from doing so, then this would result in non-streamlined proceedings in examination, with a "*huge number*" of auxiliary requests having to be

submitted at an early stage. This would overly complicate first-instance proceedings. Therefore, not filing auxiliary requests should not be held against the appellant.

- (b) The board's assessment as to whether or not to admit the request should further be based on other relevant factors or aspects of the case (see, for example, T 0023/10 or T 1525/10), such as:
- (i) the appellant had not actively withheld the present claims "*from the consideration of the Examining Division*" (see letter dated 18 May 2017, page 5, second paragraph);
 - (ii) no prima facie objections had been raised against the "*substance of the amended claims*" (see letter dated 18 May 2017, page 5, third paragraph);
 - (iii) the amendment was a "*bona fide attempt to address the finding of obviousness*" (see letter dated 18 May 2017, page 5, fourth paragraph);
 - (iv) the amendment met the requirements of Rule 137(5) EPC (see letter dated 18 May 2017, page 5, fifth paragraph);
 - (v) "*upon proper construction of the application as filed*" the location of the A2 flag should have been searched (see letter dated 18 May 2017, page 5, fifth paragraph);

- (vi) a further search would not have resulted "*in any more relevant document that [sic] those already cited in the proceedings*" (see letter dated 18 May 2017, page 6, first full paragraph);
- (vii) the "*single request may be considered converging*" and had been filed with the statement of grounds of appeal (see letter dated 18 May 2017, page 6, second and third full paragraphs);
- (viii) the long period between the start of the appeal proceedings and the summons to oral proceedings had affected the cost of filing a divisional application (see letter dated 18 May 2017, page 6, fourth paragraph);
- (ix) when the present appeal proceedings had been initiated, in 2012, the boards would have considered the present case on its technical merits. Since then, the boards had become more stringent in applying Article 12(4) RPBA and not admitting requests into the appeal proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. *Main (and sole) request - admission into the appeal proceedings (Article 12(4) RPBA)*
 - 2.1 The main request was submitted with the statement of grounds of appeal. This means that, according to Article 12(1) RPBA, it forms part of the basis of the appeal proceedings.
 - 2.2 Under Article 12(4) RPBA, the board has the power to hold inadmissible a request which could have been presented in the first-instance proceedings. Since in fact almost every claim request could have been presented to the department of first instance, the question is whether the situation was such that the claim request **should** have been presented at that stage (see, for instance, T 0273/11, point 1.1 of the Reasons, with references to further decisions).
 - 2.3 In comparison with claim 1 of the request forming the basis for the decision, claim 1 of the current request has been amended by specifying:
 - (a) *"position information for identifying a position of an editing point at which the values indicated by the POC are non-sequential"*;
 - (b) *"wherein said flag insertion step includes one of:
(1) inserting, into the coded stream, the flag and the position information in a sequence parameter set or in User Data Registered Supplemental*

Enhancement Information that is uniquely definable by a user; and (2) performing said inserting by storing the flag and the position information at a head of the coded stream or in a file that manages the coded stream".

- 2.4 Feature (a) was taken from originally filed claim 5. Feature (b) was not present in any of the previously filed claims and is based on the description, page 26, line 24 to page 27, line 7 (see statement of grounds of appeal, page 3, second full paragraph).
- 2.5 Original dependent claim 5 specified that *"in the information insertion step, the position information is inserted together with the flag information"*. In the communication pursuant to Article 96(2) EPC 1973 dated 13 February 2006, the examining division raised the objection that inserting position information together with the flag was disclosed in D1. In the communication pursuant to Article 94(3) EPC 2000 dated 21 July 2008, the examining division repeated this objection against then claim 3. In the annex to the summons to oral proceedings, section 4, the examining division pointed out that according to the embodiment described on page 23, the flag referred to in then claim 1 corresponded to a *"broken_link_flag"* inserted in a recovery point SEI. The board agrees with this assessment since page 23, lines 19 to 27 disclose: *"The following information is stored in the RAP SEI: "broken_link_flag" indicating that the decoded moving picture may be different from the original moving picture due to editing, or other reasons ... In the present invention, when "broken_link_flag" indicates "1", it shows that the editing is carried out..."*. In section 3 of the annex to the summons, the examining division reasoned that *"In D1, the flag*

"broken_link_flag" is inserted in the random access SEI which precedes the picture data to which it refers (see the reasoning for claim 2 above). Therefore, the flag "broken_link_flag" itself which is in the random access point SEI indicates the position of the splicing. It has to be noted that each of the flags "preroll_count" and "postroll_count" which are inserted together with "broken_link_flag" in the same RAP SEI also indicates position information". This reasoning was repeated in a brief communication dated 31 August 2011. Summarising, the examining division argued on several occasions during the written proceedings that the prior art disclosed the embodiment described on page 23 according to which a broken_link_flag was inserted at the editing point.

2.6 *The appellant acknowledged on page 2 of the letter dated 18 May 2017, that "the Examining Division provided, at several occasions during the examination procedure, comments on originally provided claim 5 or the corresponding amended claim 3, as to the aspect of position information being inserted together with the flag (or flag information)".*

2.7 *In the board's view, the paragraph starting at page 26, line 24 of the application as filed ("the flag indicating the non-sequentiality in the display order information POC is inserted between the pictures whose values indicated by the display order information POC are non-sequential, but the present invention is not limited to this ... [The flag and position] information may be stored in a sequence parameter set or in the User Data Registered SEI ... for instance, at the head of the sequence. The information may be stored in a medium which records the sequence or in a file format which manages the sequence. Such storing format is*

called "flag A2") clearly presents two distinct options for inserting the flag (and the position information): either between pictures whose POCs are not sequential or at the positions specified in present claim 1 (i.e. at the head of the coded stream or in a file that manages the coded stream). In view of the objections raised by the examining division, the present set of claims directed to the option not yet discussed in the first-instance proceedings could and should have been presented in those proceedings, at least as an auxiliary request, either in reaction to one of the communications of the examining division or during the oral proceedings. Instead, the difference between the two options was not addressed (see the appellant's statement that "*the issue of flag A and flag A2 in their differences were not discussed*" in point 4 of the statement of grounds of appeal), and in the first-instance proceedings the appellant consistently argued that the technical meaning of the flag according to the invention was different from the technical meaning of the flags in D1 or D3.

- 2.8 The board has not been persuaded by the argument that the reasons for refusing the application first became apparent during the oral proceedings and the appellant had no opportunity to realise the full extent of the position of the examining division until after "*careful consideration of the grounds for the decision to refuse the application*". Although the examining division raised the inventive step objection (Article 56 EPC) against the subject-matter of the independent claims for the first time during the oral proceedings, the underlying assessment of the prior art had not changed in comparison with the analysis repeatedly presented in the context of the novelty objection (Article 54 EPC) raised in the written

proceedings. The examining division had only changed its reasoning with respect to the question whether it was implicit or obvious that the flag was generated when detecting non-sequential POCs. However, throughout the proceedings, the examining division maintained that both the embodiment described on page 22, lines 22 to 26 (*"The flag information generation unit 112 generates a flag indicating a non-sequentiality of the values presented as display order information POC, when the values indicated by the display order information POC are non-sequential because of editing or for other reasons"*) and the prior art disclosed generating a "broken_link_flag" upon detecting non-sequentiality in the sequence. Therefore, the board is not convinced that it was legitimate to assume that *"once a proper understanding of the cited prior art and the features of the claims was reached, arriving at a finding of novelty, also the presence of an inventive step would be acknowledged"* (see page 3, of the letter dated 18 May 2017, third full paragraph).

- 2.9 Given that the present set of claims directed to the option not yet discussed in the first-instance proceedings could and should have been presented in those proceedings, the board, under Article 12(4) RPBA, has the power to hold this claim request inadmissible. In exercising its discretion to admit or not to admit the request, the board *arguendo* regarded the numerous factors cited in the appellant's letter dated 18 May 2017 as being indeed relevant to this case. These factors include, in particular, the assertion that the present claims had not actively been withheld from consideration by the examining division and were a *bona fide* attempt to address the finding of obviousness of the previously claimed subject-matter; an additional search would not have revealed any more relevant

document; the amended claims had been submitted at the earliest stage of the appeal proceedings; the substantial length of these proceedings would have a significant impact on the cost of filing a divisional application.

However, even considering the above factors *arguendo* to be relevant to the exercise of the board's discretion, the board has concluded that the general principle that appeal proceedings in *ex parte* cases are mainly concerned with examining the contested decision (G 10/93, OJ 1995, 172, at point 4) must prevail over those factors. The board has consequently decided to exercise its discretion in not admitting the claim request at issue into the appeal proceedings.

2.10 The appellant's concern about the possible impact on first-instance proceedings of not admitting requests, and its concern that the way the boards apply Article 12(4) RPBA might have changed since 2012, have not affected the exercise of the board's discretion. Neither concern is specific to the present case. As to the first concern, the board has to correctly apply the law to the facts before it, without regard to any possible impact on first-instance proceedings. And the second concern seems to reflect a subjective general perception and an assumption, without any supporting evidence, about how such discretionary decisions would have been taken years ago. As a consequence, the second concern could not have affected the exercise of the board's discretion, either.

2.11 In view of the above, the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



K. Boelicke

C. Kunzelmann

Decision electronically authenticated