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**Datasheet for the decision
of 17 October 2013**

Case Number: T 0370/13 - 3.5.04

Application Number: 05076852.2

Publication Number: 1608158

IPC: H04N5/445

Language of the proceedings: EN

Title of invention:

User interface for television schedule system

Applicant:

Starsight Telecast, Inc.

Headword:

Relevant legal provisions:

EPC 1973 Art. 76(1)

Keyword:

Divisional application - subject-matter extends beyond content of earlier application (yes)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 0370/13 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 17 October 2013

Appellant: Starsight Telecast, Inc.
(Applicant) 2830 De La Cruz Boulevard
Santa Clara, CA 95050 (US)

Representative: Hale, Peter
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 12 September 2012 refusing European patent application No. 05076852.2 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. 05 076 852.2, which was filed as a (fifth generation) divisional application of a series of European patent applications: 03 076 605.9, 00 204 781.9, 99 202 116.2 and 91 919 325.0. The first in this sequence of earlier applications, i.e. the "root" application, is based on international application PCT/US91/06367, which was published as WO 92/04801 A1.
- II. The examining division refused the present application on the grounds that claims 1 and 8 then on file contained subject-matter extending beyond the content of the earlier application as filed, i.e. WO 92/04801 A1 (Article 76(1) EPC).
- III. The appellant lodged an appeal and with the statement of grounds of appeal re-filed as a main request the claims considered by the first-instance department. It also submitted a set of claims as an auxiliary request, and requested accelerated processing of the appeal in view of the old filing date of the application.
- IV. In a communication annexed to a summons to oral proceedings, the board questioned the admissibility of the auxiliary request under Article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA, OJ EPO 2007, 536). In addition, the board *inter alia* expressed doubts as to whether the claims of the appellant's requests fulfilled the requirements of Article 76(1) EPC 1973.

- V. With a letter of reply dated 17 September 2013 the appellant filed claims of a new auxiliary request replacing the auxiliary request on file.
- VI. Oral proceedings were held on 17 October 2013. The appellant withdrew all other requests on file and requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 8 filed with letter of 17 September 2013.
- VII. Claim 1 of the sole request reads as follows:
- "A method comprising:
receiving television program listings;
storing the received television program listings in a television guide system;
examining the stored television program listings for stored television program listings corresponding to a television program with matching titles in a series of television programs;
displaying a guide screen in response to a user input, including titles of some of the stored television program listings corresponding to television programs, wherein at least one of the television program listings corresponds to a television program in the series of television programs; and
displaying, in response to the user input and together with the title, an identifier with the at least one television program listing indicating to a viewer that the television program is in the series of television programs."
- VIII. The appellant argued essentially as follows with respect to the objection under Article 76(1) EPC 1973:

In the root application, a program linking icon 46 was introduced on page 10, line 22, and was shown in figure 5. Programs to be recorded were indicated by a red outline whereas linking was indicated by the icon 46 of figure 5. Therefore, recording and linking were always decoupled from one another. The recording was optional, as evidenced by the fact that linking was the primary and only consistent feature of the disclosed embodiments. The separation between marking for recording and the linking icon became apparent from the reference to the prior art on page 2, lines 18 to 29, of the root application, which emphasised the importance of "a highly intuitive user interface". From the fact that the linking icon was persistent even if recording of the title had been cancelled, the skilled person would have understood that the linking icon could be displayed independently of the recording. Hence, the subject-matter of claim 1 of the sole request did not extend beyond the content of the root application as filed.

Reasons for the Decision

1. The appeal is admissible.
2. 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".
 - 2.1 In the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor, it is a necessary and sufficient condition for a divisional

application of that sequence to comply with Article 76(1), second sentence, EPC [1973] that anything disclosed in that divisional application be directly and unambiguously derivable from what is disclosed in each of the preceding applications as filed (see G 1/06, OJ EPO 2008, 307; Headnote). It follows that it is a necessary condition for the present application that the claimed subject-matter must be directly and unambiguously derivable from the root application.

- 2.2 The root application as filed relates to a television schedule system which allows access and use of program listings in a convenient way to control operation of a recording device. In particular, the application extensively refers to the difficulties of setting a VCR for automatic recording (see page 1, line 19 to page 2, line 29; page 3, lines 4 to 19, and page 4, lines 2 to 10). In this context the application presents elements of a television schedule system that simplify automatic recording of titles of interest to the user. Such elements are presented in figures 5 and 23 together with the corresponding sections of the description, page 10, line 22, to page 11, line 19, on which the claims of the appellant's sole request are based. These passages relate to a function of the television schedule system that allows automatic tagging for recording if a new program listing matches "a title in Linked Titles (Figure 23)" (page 10, line 25). Matching titles, i.e. titles of a television series that have been selected for recording, are marked with a red outline and a linking icon 46. Hence, the linking of titles serves to simplify recording of a series of interest to the user. The linking icon indicates that a television listing has been tagged for

recording ("link-selected") because its title matches a title in the Linked Titles menu.

The root application discloses two improvements to the series recording linking feature. Exceptionally, in case of "conflict with a pending recording" or "when there is a likelihood of excessive candidates for recording" (page 11, lines 2 to 5, 9 and 10), the recording may be suspended or cancelled. These improvements presuppose an initial tagging for recording, i.e. the titles need to be de-selected manually in the menu of figure 23 (page 11, line 4). The understanding of the linking icon as an indicator of automatic tagging for recording is also supported by claims 7, 32, 74 and 96 of the root application as filed, which specify that the linking icon is displayed "with programs that are to be recorded in combination with other programs."

2.3 The feature that the linking icon indicates automatic tagging for recording is not present in claim 1 as filed with the present application and in claim 1 of the appellant's sole request. Instead, claim 1 only specifies "an identifier ... indicating to a viewer that the television program is in the series of television programs". Since there is no direct and unambiguous disclosure for a linking icon independently of automatic tagging for recording a series of linked titles, the present application is directed to subject-matter which extends beyond the content of the earlier application as filed, contrary to Article 76(1) EPC 1973.

2.4 The board is not convinced by the appellant's arguments. The appellant stated that the background art indicated in the root application (see page 2, lines 18

to 29) refers to the necessity of a "highly intuitive user interface". However, even this reference to the background art relates to user selections "for automatic control of a VCR". Nor does the fact that the linking icon continues to be displayed after being de-selected mean that the skilled person would have derived that the linking icon could be dissolved from its context, which is the "automatic tagging for recording" of any titles that "match a title in Linked Titles". Hence, there is no direct and unambiguous disclosure for an identifier "indicating to a viewer that the television program is in the series of television programs" (see claim 1, last feature).

3. As a consequence, the set of claims submitted as the appellant's sole request is not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



K. Boelicke

F. Edlinger

Decision electronically authenticated