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**Datasheet for the decision
of 20 April 2016**

Case Number: T 2313/13 - 3.5.05

Application Number: 09016035.9

Publication Number: 2175362

IPC: G06F3/16, G11B27/00

Language of the proceedings: EN

Title of invention:

Playback apparatus and playback method

Applicant:

Sony Corporation

Headword:

Sequential display switching/SONY

Relevant legal provisions:

EPC Art. 123(2), 76(1), 111(1)

Keyword:

Intermediate generalisation - main request (yes)

Intermediate generalisation - auxiliary request (no, after amendment)

Remittal to the first instance for further prosecution - (yes)

Decisions cited:

T 0962/98, T 0461/05, T 1501/07



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Case Number: T 2313/13 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 20 April 2016

Appellant: Sony Corporation
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 6 August 2013
refusing European patent application
No. 09016035.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair A. Ritzka
Members: K. Bengi-Akyuerek
F. Blumer

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division to refuse the present European patent application (divided from its parent application EP 01304288.2) on the sole ground of added subject-matter (Articles 123(2) and 76(1) EPC) with respect to the independent claims of a main request and an auxiliary request.

- II. Prior to the refusal, the examining division had issued a communication under Rule 71(3) EPC indicating its intention to grant a patent based on the claims of a second auxiliary request alongside the reasons for the non-compliance of the main and first auxiliary request with Articles 123(2) and 76(1) EPC, and the applicant subsequently did not approve the text proposed for grant on the basis of that second auxiliary request. Instead, it indicated that it wished to pursue the application on the basis of the main and the first auxiliary requests, and requested that the application be refused on the basis of those claim requests (cf. applicant's letter dated 1 May 2013).

- III. With the statement setting out the grounds of appeal, the appellant withdrew its main request and re-filed the claims of the first auxiliary request underlying the appealed decision. It requested that the decision under appeal be set aside and that a patent be granted on the basis of the first auxiliary request.

- IV. In an annex to the summons to oral proceedings pursuant to Article 15(1) RPBA, the board gave its preliminary opinion on the appeal. In particular, it raised objections under Articles 123(2) and 76(1) EPC based however on reasons different from those set out in the

decision under appeal.

- V. With a letter of reply, the appellant submitted counter-arguments to the objections raised in the board's communication under Article 15(1) RPBA, referring in particular to the Guidelines for Examination in the European Patent Office, H-V, 3.2.1 and to decisions T 461/05 and T 962/98 relating to "intermediate generalisations".
- VI. Oral proceedings were held on 20 April 2016, during which the appellant renamed the pending first auxiliary request as "main request" and filed amended claims according to a new "first auxiliary request". Both claim requests were admitted into the proceedings, and their allowability was discussed.

The appellant's final request was that the decision under appeal be set aside and that a patent be granted on the basis of the main request or, subsidiarily, on the basis of the first auxiliary request, both claim requests as filed during the oral proceedings before the board.

At the end of the oral proceedings, the decision of the board was announced.

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

"A method for playing back a plurality of audio content items in sequence on a playback apparatus, the method comprising:

storing said plurality of content items (50), each content item being stored together with respective information associated with the content item, said information comprising at least one of the music title,

the artist's name and the album name;

displaying on a display: on a piece-of-music display area (ARP), information associated with a current content item currently being played back: on a stock tray area (ST1), information associated with the subsequent content item to be played back; and on a play list area (P1), the information associated with respective ones of the other of said plurality of content items which are not said current or subsequent content item,

the method being characterised in that:

said piece-of-music display area (ARP), said stock tray area (ST1) and said play list area (P1) are at predetermined areas on the display, wherein the colour and luminance of the information associated with a content item which has not been played are such as to give a stronger impression than the colour and luminance of the information associated with a content item whose playback has been terminated;

and by the steps of:

after a playback instruction has been received, when playback is switched from said current content item being played back to said subsequent content item, sequentially moving the display of the information associated with said current content item from said piece-of-music display area (ARP) to said play list area (P1) and causing the display of the information associated with said subsequent content item to be moved from said stock tray area (ST1) to said piece-of-music display area (ARP), the display of the information associated with other of the content items within said plurality of content items moving in sequence to fill the stock tray area (ST1) and sequential parts of said play list area (P1), following movement of the display of the information associated with said subsequent content item from said stock tray

area (ST1) to said piece-of-music display area (ARP), thereby providing a user with an indication of the playback process through the plurality of content items."

Claim 1 of the **first auxiliary request** reads as follows (amendments compared with the main request emphasised by the board):

"A method for playing back a plurality of audio content items in sequence on a playback apparatus, the method comprising:

storing said plurality of content items (50), each content item being stored together with respective information associated with the content item, said information comprising at least one of the music title, the artist's name and the album name;

displaying on a display: on a piece-of-music display area (ARP), information associated with a current content item currently being played back: on a stock tray area (ST1), information associated with the subsequent content item to be played back; and on a play list area (P1), the information associated with respective ones of the other of said plurality of content items which are not said current or subsequent content item,

the method being characterised in that:

said piece-of-music display area (ARP), said stock tray area (ST1) and said play list area (P1) are at predetermined areas on the display, ~~wherein the colour and luminance of the information associated with a content item which has not been played are such as to give a stronger impression than the colour and luminance of the information associated with a content item whose playback has been terminated;~~

and by the steps of:

after a playback instruction has been received and after responding to any user set cut-out function with regard to the current content item, when playback is switched from said current content item being played back to said subsequent content item, sequentially moving the display of the information associated with said current content item from said piece-of-music display area (ARP) to said play list area (P1) and causing the display of the information associated with said subsequent content item to be moved from said stock tray area (ST1) to said piece-of-music display area (ARP), the display of the information associated with other of the content items within said plurality of content items moving in sequence to fill the stock tray area (ST1) and sequential parts of said play list area (P1), following movement of the display of the information associated with said subsequent content item from said stock tray area (ST1) to said piece-of-music display area (ARP), thereby providing a user with an indication of the playback process through the plurality of content items, wherein the colour and luminance of the information associated with a content item which has not been played are such as to give a stronger impression than the colour and luminance of the information associated with a content item whose playback has been terminated."

Further independent claim 6 of both claim requests is directed to a corresponding apparatus.

Reasons for the Decision

1. MAIN REQUEST

The claims of this request are identical to those of the first auxiliary request underlying the appealed decision.

1.1 Articles 123(2) and 76(1) EPC

1.1.1 Independent claims 1 and 6 of the main request are obviously based on the embodiment relating to Figures 9 and 10 which describe the general playback processing procedure performed by CPU 12 of the playback apparatus claimed (cf. page 30, line 9 to page 34, line 10 of the parent and the present application as originally filed).

1.1.2 The examining division found that independent claims 1 and 6 did not comply with Articles 123(2) and 76(1) EPC because the description of the parent and present applications as originally filed taught that *two* play lists (P1, P2) were displayed in display areas AR1 and AR2, but the independent claims relied only on a single "play list area" (cf. appealed decision, reasons 2.1).

1.1.3 The board, however, agrees with the appellant that the omission of displaying a second play list in claims 1 and 6 does not go beyond the content as originally filed, for the reasons set out below.

It is true that the parent and the present applications as originally filed indicate that the underlying playback process *generally* relies on playing back music items according to *two* play lists in alternate sequence

(see e.g. page 30, lines 13-18 and page 33, lines 11-20; emphasis added by the board):

*"... The central processing unit 12 plays back pieces of music according to **two** play lists in alternate sequence as a result of executing this processing procedure, and switches the displays of the play lists P1 and P2 and the stock trays ST1 and ST2 in such a manner as to correspond to this playback."*

and

*"... As a result, ..., the central processing unit 12 alternately selects a piece of music and plays it back with regard to the **two** play lists, and switches the display of music names in a cyclical sequence ..., so that audio data is played back in sequence ... in accordance with the **two** play lists."*

But the original description also states e.g. at its closing part under the heading "Other embodiments" (cf. page 65, lines 2-6; emphasis added by the board):

*"Although in the above-described embodiment, a case is described in which **two** play lists are alternately played back, the present invention is not limited to this case, and can be widely applied to a case in which **one** play list is played back."*

From the above the board concludes that the skilled person would understand that the corresponding processing procedure could equally be applied to a *single* play list. The skilled person would also be well aware that this case would imply that simply the music

items of that single play list were to be played back, i.e. without alternating between music items of two different play lists. Hence, the objection under Articles 123(2) and 76(1) EPC raised in the decision under appeal is held to be unfounded.

However, the board sees another problem as regards compliance with Articles 123(2) and 76(1) EPC:

1.1.4 In particular, the characterising portion of claim 1 includes the following features:

- A) the colour and luminance of the information associated with a content item which has not been played are such as to give a stronger impression than the colour and luminance of the information associated with a content item whose playback has been terminated;
- B) after a playback instruction has been received, when playback is switched from said current content item being played back to said subsequent content item, sequentially moving the display of the information associated with said current content item from said ARP to said P1 and causing the display of the information associated with said subsequent content item to be moved from said ST1 to said ARP, the display of the information associated with other of the content items within said plurality of content items moving in sequence to fill the stock tray area ST1 and sequential parts of said play list area P1, following movement of the display of the information associated with said subsequent content item from said ST1 to said ARP, thereby providing a user with an indication of the playback process through the plurality of content items.

Feature A) was introduced for the first time during the first-instance oral proceedings held on 18 December 2012, while feature B) was essentially added with the applicant's letter dated 29 October 2012 (providing paragraphs [0072] and [0073] of the published application as a basis, which correspond to page 32, line 20 to page 33, line 20 of the parent and present applications as filed).

- 1.1.5 As to feature A), the original application teaches (see e.g. page 33, lines 21-22; emphasis added by the board):

*"When switching the display of music names **in this manner**, ..., the central processing unit 12 displays it by using a color and luminance which give a strong impression to the user ...".*

That means that the colour and luminance changes are only effective *when* the display is cyclically switched from ARP to P1 to ST1 to ARP according to step SP10 of Figure 9. Hence, feature A) is not supported by the original teaching, contrary to Articles 123(2) and 76(1) EPC.

- 1.1.6 As to feature B), the parent and present applications as originally filed teach that the sequential display switching from ARP to P1 to ST1 to ARP in a cyclical manner, as required by feature B), is only performed in step SP10 ("Update Play List Display") of Figure 9, i.e. *after* execution of all the previous method steps, in particular the **cut-out process** according to step SP3 (see page 32, line 20 to page 33, line 20 in conjunction with Fig. 10 of the parent and present applications as filed). Step SP2, which is also related

to updating the play list display, involves however either a non-cyclical display switching from P1 to ST1 to ARP (when starting from the default state; see page 31, lines 15-19 of the parent and present applications as filed) or no switching at all (when starting from the pause state; see page 31, lines 9-15 of the parent and present applications as filed).

The appellant quoted the following passages of the original parent and present applications (cf. page 64, lines 10-17) as a basis for feature B):

"Although in the above-described embodiment, a case is described in which contents are cut out by changing the cut-out method according to a play style and a sound effect is interposed in between, and playback is performed according to an atmosphere corresponding to the playback style, the present invention is not limited to this case, and can be widely applied to a case in which all the pieces of music of each of content are played back."

From this the appellant derived that the cut-out process according to Figure 9 was not mandatory and thus could be dispensed with (mainly due to the statement "all the pieces of music of each of content are played back") without affecting the claimed switching of the display. Although it is not fully clear to which embodiment the cited passage actually applies (in view of the many embodiments described throughout the present application; see e.g. pages 14 and 51, last paragraphs, headings "Construction of the embodiments"; "Operation of the embodiments"), the board assumes, in favour of the appellant, that the statement "above-described embodiment" refers to the

relevant embodiment relating to the sequential, cyclical display movement based on Figures 9 and 10. In this context, the board finds it expedient to further investigate what is in fact done within the cut-out process (corresponding to SP3 in Fig. 9) according to the original teaching. The accompanying text on page 31, line 20 to page 32, first line of the original application reads (emphasis added by the board):

*"In the following step SP3, the central processing unit 12 sets an editing point based on the conditions set by the user with regard to the piece of music displayed in the piece-of-music information display area ARP, thereby **cutting out** a portion of this piece of music and setting a playback object. In the following step SP4, the playback of this playback object is started ..."*

The board understands this passage to prescribe that, in order to be able to actually play back a piece of music, a "playback object" *must* be set. Such playback object is in turn inevitably created by setting an editing point, based on the conditions set by the user, with regard to the piece of music displayed. This editing of a piece of music is apparently called "cutting out" in the context of this embodiment. The appellant argued that even the editing step was not necessary, depending on the "conditions set by the user", i.e. that the user may prefer not to edit at all and consequently not to initiate any cut-out process. But the following passages further elucidate the "user-set conditions" in respect of the editing function:

*"... the central processing unit 12 sets the operating **conditions** of the signal processing*

*system in accordance with a corresponding **template**, thereby cutting out audio data ..."* (cf. page 42, lines 7-13; emphasis added by the board),

*"Fig. 15 is a flowchart showing a cut-out process in which a **template** which is set in this manner is used ..."* (cf. page 42, lines 19-20; emphasis added by the board),

and

*"The central processing unit 12 then proceeds to step SP14, whereby an **in-point** is randomly set on the basis of the ... playback reference time of the **template** ..."* (cf. page 43, lines 7-10; emphasis added by the board).

So, the "conditions set by the user" are compiled in a template which is supposed to include *inter alia* the "playback reference time" (see also Fig. 11 of the present application), and they are used for setting the editing point ("in-point") in the cut-out process, rather than including the option of no editing at all, as the appellant argued. Consequently, the fact that "all the pieces of music of each of content" may be played back (according to the passage at page 64, lines 10-17 quoted by the appellant) in no way implies that no cut-out process is performed, but - at best - that the "in-point" and the "out-point" of the editing function associated with the cut-out process correspond exactly to the actual start and end points of the entire piece of music in question. Also, claim 29 of the parent application as filed (reproduced in the present application as filed) cannot be taken as a basis for feature B), since it is not related to the sequential, cyclical display movement according to the

specific embodiment based on Figures 9 and 10.

The appellant further submitted that the feature of the cut-out process was analogous to Example 2 of the Guidelines for Examination in the European Patent Office, H-V, 3.2.1 relating to "intermediate generalisations" based on case T 461/05 and that, by analogy, the omission of the feature was allowable under Article 123(2) EPC since it had its own recognisable function independent of the functioning of the rest of the system and was neither presented as essential in the original application nor recognised as essential by the skilled person for carrying out the invention. Furthermore, according to the appellant, the criteria set out in case T 962/98 for the allowability of an intermediate generalisation were fulfilled. The above arguments, however, must fail for the following reasons:

Firstly, as regards the quoted Guideline H-V, 3.2.1, which states *inter alia*:

"Extracting a specific feature in isolation from an originally disclosed combination of features and using it to delimit claimed subject-matter may be allowed only if there is no structural and functional relationship between the features" (see also **T 1501/07**, reasons 2.2 as quoted by the appellant at the oral proceedings),

and the conclusion of the deciding board in case **T 962/98** (see reasons 2.5) that

"... an intermediate generalization is only admissible if the skilled person can recognize without any doubt from the application as filed

that those characteristics are not closely related to the other characteristics of the working example and apply directly and unambiguously to the more general context ...",

the board stresses that the use of the cut-off process is inextricably linked to and thus has a close functional relationship with the other features of the playback processing, in particular the sequential, cyclical display switching (see e.g. steps SP8 to SP10), as originally described at page 30, line 9 to page 34, line 10 in conjunction with Figures 9 and 10 of the parent and present applications as filed.

Secondly, in case **T 461/05**, the subject-matter of a new independent claim was admissibly limited with respect to an original independent claim by adding some features of a specific embodiment disclosed in the application as originally filed, but which were not considered to be essential for executing the invention under consideration. The facts and conclusions underlying that case, however, are not applicable to the present situation in which the incorporation of the cut-out process is in fact essential and necessary for carrying out the present invention, since above all the initial creation of a "playback object" by the cut-out process constitutes an integral and inevitable prerequisite for the further processing of this object, as specially demonstrated by the flow diagram of Figure 9 in conjunction with the corresponding description at page 31, line 20 to page 33, line 11 of the original application.

- 1.2 In view of the above, features A) and B) of claim 1 are not supported by the parent and present applications as filed. Those objections apply *mutatis mutandis* to

independent apparatus claim 6.

1.3 Hence, the main request is not allowable under Articles 123(2) and 76(1) EPC.

2. FIRST AUXILIARY REQUEST

This request was filed as a direct reaction to the objections under Article 123(2) and 76(1) EPC raised by the board at the oral proceedings, and its independent claims 1 and 6 differ from those of the main request essentially in that

i) the sequential movement of the displays according to feature B) is performed after responding to any user set cut-out function with regard to the current content item;

ii) the colour and luminance of content items according to feature A) are changed in connection with the sequential movement of the displays.

2.1 Amendment i) is based on page 31, lines 20-25 in conjunction with Figure 9, while amendment ii) is supported by page 33, line 21 to page 34, line 10 of the parent and present applications as originally filed.

2.2 As a consequence, the objections raised in points 1.1.5 and 1.1.6 above no longer apply, and thus the independent claims of the first auxiliary request comply with Articles 123(2) and 76(1) EPC.

3. *Remittal of the case for further prosecution*

3.1 The amended claims according to the first auxiliary request were filed for the very first time in the

appeal proceedings and remedied the sole ground for refusal given in the appealed decision (i.e. added subject-matter under Articles 123(2) and 76(1) EPC). Consequently, the department of first instance has not yet examined and decided upon the patentability (Articles 54 and 56 EPC) of those claims (i.e. including the claims underlying the communication under Rule 71(3) EPC; cf. point II above), nor has it assessed novelty and inventive step in particular in view of the features relating to the use of only *one* play list and the involvement of a *cut-out process* before the actual display movement, having regard to the pertinent prior art - whether already cited or to be identified following an additional search. The board is therefore not in a position to pass final judgment on novelty and inventive step of the amended claims for the first time in these second-instance proceedings.

- 3.2 In view of the foregoing, the board decides to exercise its discretion under Article 111(1) EPC to remit the case to the department of first instance for further prosecution, on the basis of claims 1 to 10 of the first auxiliary request submitted during the oral proceedings before the board.

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 on the basis of the first auxiliary request (claims 1 to 10) as filed during the oral proceedings before the board.

The Registrar:

The Chair:



L. Malécot-Grob

A. Ritzka

Decision electronically authenticated