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**Datasheet for the decision
of 5 July 2019**

Case Number: T 0986/15 - 3.5.07

Application Number: 07798910.1

Publication Number: 2036091

IPC: G11B27/10, H04N5/00, H04N5/76

Language of the proceedings: EN

Title of invention:
Digital media device having media content transfer capability

Applicant:
Thomson Licensing

Headword:
Media-content transfer/THOMSON LICENSING

Relevant legal provisions:
EPC Art. 84, 113(2), 123(2)

Keyword:
Basis of decision - pending requests
Amendments - added subject-matter (yes)
Claims - clarity (no)

Decisions cited:
T 0255/05, T 1312/13



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Case Number: T 0986/15 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 5 July 2019

Appellant: Thomson Licensing
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 2 December 2014
refusing European patent application No.
07798910.1 pursuant to Article 97(2) EPC**

Composition of the Board:

Chairman B. Müller
Members: R. de Man
C. Barel-Faucheux

Summary of Facts and Submissions

- I. The applicant appealed against the decision of the Examining Division refusing European patent application No. 07798910.1, which was published as WO 2008/005701.
- II. The Examining Division decided that claim 6 of the then sole substantive request was not clear and that the subject-matter of all claims 1 to 9 lacked inventive step in view of the following document:

D2: WO 2005/101411 A2, published on 27 October 2005.
- III. In its statement of grounds of appeal, the appellant replaced its sole substantive request with a main request and a first auxiliary request. The main request corresponded to the sole request considered in the contested decision with amendments made to claim 6. In the first auxiliary request, claims 6 to 9 were deleted.
- IV. In a communication accompanying the summons to oral proceedings, the Board expressed the preliminary view that the subject-matter of claim 1 of both requests lacked inventive step over document D2.
- V. In a letter dated 5 June 2019, the appellant submitted an amended set of claims. It gave arguments as to why the amended set of claims complied with the EPC and requested "the case to be transferred back to the Examining Division so that the Examining Division issues a Communication pursuant to Rule 71 (3) EPC, based on the amended set of claims presented herein".
- VI. In a further communication dated 13 June 2019, the Board informed the appellant that it understood the

appellant's intention to be that the newly filed claims replaced the previously pending substantive requests as a sole substantive request. It noted that the amendments made, which introduced new features taken from the description, appeared not to have been occasioned by developments during the appeal proceedings and appeared to raise new issues under Articles 84 and 123(2) EPC. Admission of the amended set of claims into the proceedings would therefore have to be discussed at the oral proceedings.

VII. In a letter dated 27 June 2019, the appellant informed the Board that it would not be attending the oral proceedings. It did not comment on the Board's further communication.

VIII. Oral proceedings were held on 5 July 2019 in the appellant's absence. At the end of the oral proceedings, the chairman pronounced the Board's decision.

IX. Claim 1 of the "amended set of claims" filed with the letter dated 5 June 2019 reads as follows:

"A method for transferring media content from a first digital video recorder DVR set-top (402) to a second DVR set-top (412) comprising:

recording (702) instances of media content (46) to a first storage medium (404) located internal to a housing of the first DVR set-top (402),

storing a plurality of catalog data comprising at least one logical data management rule associated with each of the instances of media content, wherein the logical data management rule comprises a retention rule for

determining which of the instances of media content can be deleted at a particular opportunity;

wherein the particular opportunity comprises an instant after the media content is transferred from the first DVR set-top to the external storage device, and after the particular opportunity, the media content is deleted from the first DVR set-top;

receiving (704) an indication that the instances of media content (406) stored to the first storage medium (404) are to be made available for playback using the second DVR set-top (412), wherein the indication is triggered by the detection of a connection of an external storage device to the first DVR set-top (402);

removing the first storage medium (404) from the housing of the first DVR set-top (402);

installing the first storage medium (404) into the external storage device (408); communicatively coupling the external storage device (408) to the external port of the second DVR set-top (412); and

in response to receiving the indication that the instances of media content stored to the first storage medium (404) are to be made available for playback using the second DVR set-top (412), transferring the instances of media content and the associated catalog data from the external storage device (408) to the second DVR set-top (412) over a communication interface (222) of the second DVR set-top (412), the communication interface (222) accessible from the external port of the second DVR set-top; and

wherein the communication interface of the second DVR set-top (412) is a high-speed communication bus; and

wherein the indication that the instances of media content stored to the first storage medium (404) are to be made available for playback using the second DVR set-top (412) is received in response to a user selection via a graphical user interface; and

wherein providing the media content stored to the second storage medium (410) comprises providing access to the instances of media content using at least one of a keying scheme or a trans-encryption scheme; and

wherein the media content is encrypted by the first DVR set-top (402) using a control key for each instance of media content; and

wherein the content key is encrypted by a secure element of the first DVR set-top (402) with a second key; and

wherein the content key is provided from the first DVR set-top (402) to the second DVR set-top (412) by re-encrypting the content key using an encryption key that is capable of being decrypted by the second DVR set-top."

Reasons for the Decision

1. The appeal complies with the provisions referred to in Rule 101 EPC and is admissible.

2. *The appellant's requests*

2.1 In its letter of 5 June 2019, the appellant filed an amended set of claims but did not explicitly state whether it maintained or withdrew the main request and the auxiliary request filed with the statement of grounds of appeal. Normally, the failure to explicitly state that pending substantive requests are maintained cannot be taken to mean that those requests have been withdrawn.

2.2 In the present case, however, the letter lacks any arguments in support of the previously filed requests and merely gives reasons why the newly filed amended set of claims complies with the EPC. In addition, the appellant requested that the case be remitted to the Examining Division "so that the Examining Division issues a Communication pursuant to Rule 71 (3) EPC based on the amended set of claims". These are indications that the appellant meant to replace its pending requests with the newly filed claims.

2.3 Moreover, if it were to be assumed that the main request and the auxiliary request were maintained, the appellant's letter would leave the Board in doubt about the order in which it was to consider the requests: the appellant referred to the newly filed claims only as "an amended set of claims", not as "a new main request" or "a second auxiliary request". Under Article 113(2) EPC, the EPO is to examine, and decide upon, the European patent application only in the text submitted to it, or agreed, by the applicant. In the case of multiple substantive requests, this means that it is the responsibility of the applicant or appellant to specify the order in which its requests are to be

examined (see decisions T 255/05 of 18 October 2005, reasons 17; T 1312/13 of 6 December 2017, reasons 2.3).

2.4 In view of these considerations, the Board informed the appellant, in its further communication of 13 June 2019, that it assumed that the previously filed requests had been withdrawn and that the amended set of claims formed the basis for the appellant's sole substantive request. Since the appellant did not express disagreement with this position, the Board considers it to have been established that the main request and the auxiliary request filed with the statement of grounds of appeal are no longer maintained and that the appellant is requesting that the decision under appeal be set aside and that a patent be granted on the basis of the claims filed with the letter of 5 June 2019 as the sole substantive request. The Board will therefore proceed with the examination of the appeal on this basis. In any case, the Board affirms its preliminary conclusion expressed in the communication accompanying the summons to oral proceedings that the subject-matter of claim 1 of both the main and first auxiliary request filed with the statement of grounds of appeal lacks inventive step.

3. *The application*

The application relates to digital media recording devices such as digital video recorders (DVRs). Its background section explains that users wishing to upgrade or replace their DVR are faced with the problem of transferring media content from their current DVR to the new DVR. The invention proposes transferring media content from a first DVR (the term "DVR" is used in the description, but "DVR set-top" is used in the claims) to a second DVR by first transferring the media content

from the first DVR to an external storage device and then connecting the external storage device to the second DVR.

4. *Admission into the proceedings of the sole substantive request - Article 13(1) and (3) RPBA*

The sole substantive request was filed after the Board had arranged oral proceedings. As set out in the Board's further communication, it includes amendments which do not appear to have been occasioned by developments during the appeal proceedings and which raise a number of new issues. Nevertheless, since the Board can decide on the allowability of the request without adjournment of the oral proceedings, it admits the sole substantive request into the proceedings. In this respect, the Board notes that the objections raised below arise from the amendments made, and that the appellant could have expected the amendments to be examined under Articles 84 and 123(2) EPC.

5. *Added subject-matter - Article 123(2) EPC*

5.1 According to claim 1, "the detection of a connection of an external storage device to the first DVR set-top" triggers an indication that media content stored to a first storage medium located inside the housing of a first DVR is to be made available for playback by the second DVR.

This feature is disclosed on page 16, lines 18 to 24, of the published application, which clarifies that "the attachment of external storage 408 to first DVR 402 can serve to automatically imply that the media content is to be copied from internal storage 404 to the storage medium 410 of external storage 408".

Hence, this feature is part of an embodiment in which an external storage device is connected/attached to the first DVR and media content is copied from the internal storage medium of the first DVR to the storage medium of the external storage device. This embodiment is illustrated in Figure 7, which is described on page 15, line 24, to page 18, line 11:

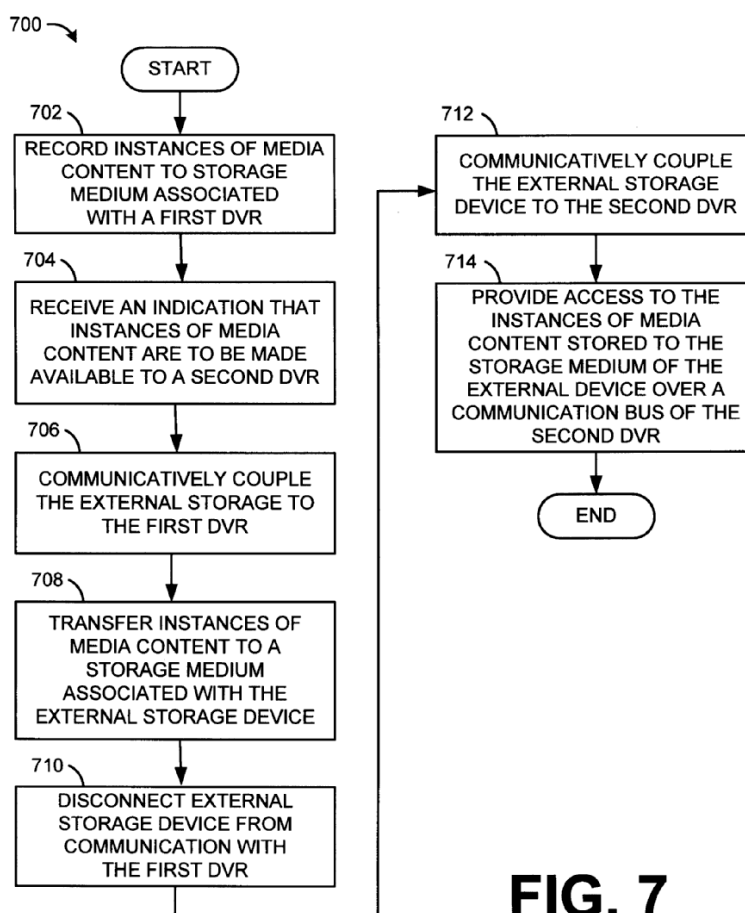


FIG. 7

5.2 Claim 1 also includes the features "removing the first storage medium from the housing of the first DVR set-top" and "installing the first storage medium into the external storage device".

In its letter of 5 June 2019, the appellant indicated the passage on page 18, lines 2 to 11, as a basis for

these features. However, this passage describes blocks 710, 712 and 714 of Figure 7, which are unrelated to those features.

The features are disclosed on page 20, line 7, to page 22, line 10, which describes the embodiment depicted in Figure 11:

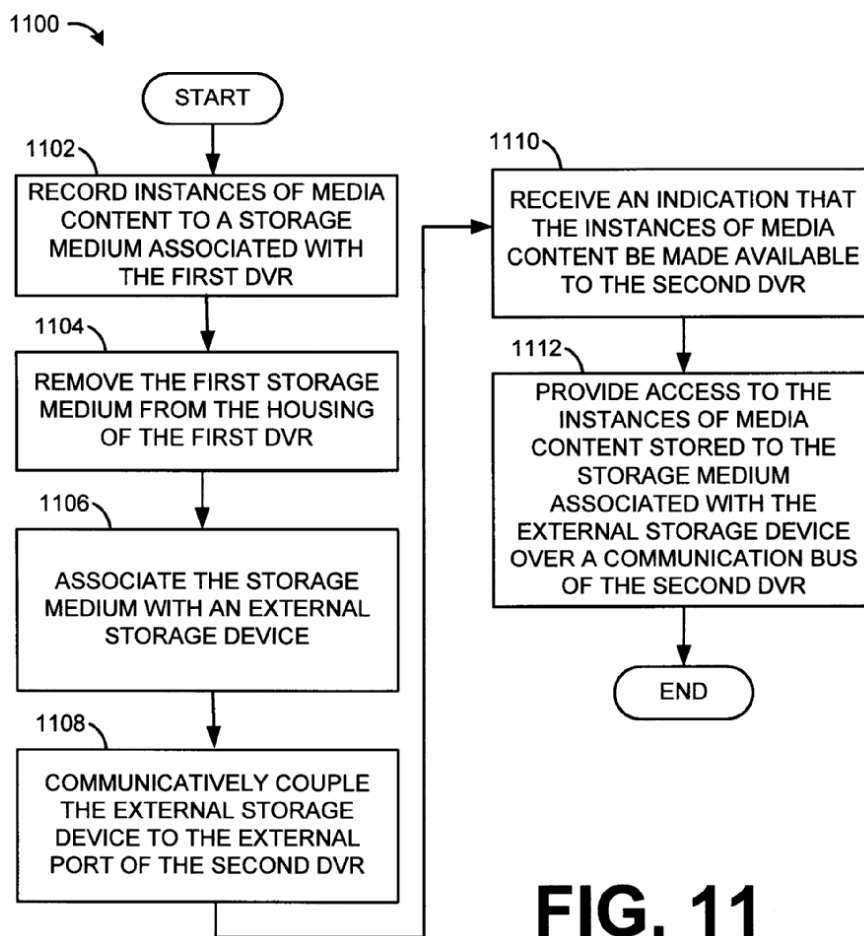


FIG. 11

In this embodiment, media content is not copied from the internal storage medium of the first DVR to the storage medium of the external storage device. Instead, the internal storage medium is removed from the housing of the first DVR and installed in the external storage device. The embodiment is therefore clearly distinct from and even incompatible with the embodiment depicted in Figure 7.

5.3 Hence, present claim 1 combines features taken from distinct embodiments. Since the appellant has not indicated a justification for this combination, and since no such justification is apparent to the Board, the Board concludes that the subject-matter of claim 1 extends beyond the content of the application as filed (Article 123(2) EPC).

6. *Clarity - Article 84 EPC*

6.1 According to claim 1, "transferring the instances of media content and the associated catalog data from the external storage device to the second DVR set-top" takes place "in response to receiving the indication that the instances of media content stored to the first storage medium are to be made available for playback using the second DVR set-top".

Claim 1 specifies that this indication is "triggered by the detection of a connection of an external storage device to the first DVR set-top".

However, it is not clear how connecting the external storage device to the first DVR could trigger the transfer of media content from the external storage device to the second DVR (Article 84 EPC).

6.2 Claim 1 further states that the indication is "received in response to a user selection via a graphical user interface". But it is not clear how the indication can both be triggered by the detection of a connection and be received in response to a user selection via a graphical user interface (Article 84 EPC).

7. *Conclusion*

Since the sole substantive request is not allowable,
the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



I. Aperribay

B. Müller

Decision electronically authenticated