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**Datasheet for the decision
of 18 August 2021**

Case Number: T 1920/15 - 3.5.04

Application Number: 07838976.4

Publication Number: 2064887

IPC: H04N7/173

Language of the proceedings: EN

Title of invention:

MANAGEMENT OF PROFILES FOR INTERACTIVE MEDIA GUIDANCE
APPLICATIONS

Patent Proprietor:

Rovi Guides, Inc.

Former Opponent:

Virgin Media Limited

Headword:

Relevant legal provisions:

EPC 1973 Art. 56

Keyword:

Inventive step - (yes)

Decisions cited:

Catchword:



Beschwerdekammern
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Case Number: T 1920/15 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 18 August 2021

Appellant: Rovi Guides, Inc.
(Patent Proprietor) 2160 Gold Street
San Jose, CA 95002 (US)

Representative: Haley Guiliano International LLP
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 23 July 2015
revoking European patent No. 2064887 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman B. Müller
Members: B. Le Guen
M. Paci

Summary of Facts and Submissions

- I. The appeal is against the opposition division's decision to revoke European patent No. 2 064 887.
- II. The documents cited in the decision included the following:

D22: US 2006/0218226 A1
- III. The patent was revoked *inter alia* on the ground that the subject-matter of claim 1 of the fourth auxiliary request then on file lacked inventive step in view of the disclosure of document D22 combined with the common general knowledge of the person skilled in the art (Articles 52(1) and 56 EPC).
- IV. The patent proprietor ("appellant") filed notice of appeal. In its statement of grounds of appeal, it requested, as a main request, that the decision under appeal be set aside and that the patent be maintained as amended on the basis of the claims of the fourth auxiliary request that had formed the basis of the decision under appeal. The appellant provided arguments as to why the subject-matter of claims 1 and 2 of that request involved an inventive step in view of the disclosure of document D22 combined with the common general knowledge of the person skilled in the art.
- V. In its reply dated 15 April 2016, the opponent ("respondent") expressed the view that the claims of the then main request were not clear (Article 84 EPC) and contained subject-matter which extended beyond the content of the application as filed (Article 123(2)).

EPC). The respondent also provided arguments as to why the claimed subject-matter did not involve an inventive step in view of the disclosure of document D22 combined with the common general knowledge of the person skilled in the art.

- VI. After filing its reply, the opponent withdrew its opposition (see its letter dated 9 November 2017). It will therefore be referred to below as the "former respondent".
- VII. By letter dated 22 July 2019, the appellant filed claims according to five requests. According to the appellant, the claims of the second auxiliary request corresponded to the claims of the main request submitted with the statement of grounds of appeal. For that request, the appellant referred to the submission made in the statement of grounds of appeal.
- VIII. The board issued a summons to oral proceedings.
- IX. In a communication under Article 15(1) RPBA 2020 (Rules of Procedure of the Boards of Appeal 2020; OJ EPO 2019, A63), the board *inter alia* expressed its preliminary opinion that the subject-matter of claim 1 of the second auxiliary request lacked inventive step in view of the disclosure of document D22 combined with the common general knowledge of the person skilled in the art.
- X. By letter of reply dated 16 July 2021, the appellant maintained the requests submitted with its reply dated 22 July 2019 and provided further arguments as to why the subject-matter of claim 1 of the second auxiliary involved an inventive step.

XI. The oral proceedings were held before the board on 18 August 2021. They were conducted via videoconference on the Zoom platform, as agreed to by the appellant (see attendance note about a phone conversation dated 19 July 2021).

XII. At the oral proceedings, the appellant filed adapted description pages 2 and 3 of the patent specification.

The appellant declared that the request labelled "Second Auxiliary Request" was its sole request and that it was withdrawing all other pending requests.

The appellant requested that the decision under appeal be set aside and the patent be maintained as amended in the following version:

Description

Pages 4 to 20 of the patent specification
Pages 2 and 3 filed during the oral proceedings on
18 August 2021

Claims

Nos. 1 and 2 of the "Second Auxiliary Request" (clean version) filed with the letter dated 22 July 2019

Drawings

Figures 1 to 20 of the patent specification

XIII. Claim 1 of the appellant's sole request reads as follows:

"A method for identifying media content using an interactive media guidance application, the method comprising:

monitoring the user's interactions with a plurality of user equipment devices (802,804,806) of a media network (800), wherein monitoring the user's interactions includes monitoring the media content the user is accessing and wherein accessing the media content includes viewing the media content;

storing on a server (824) user profile information (1006,1206) comprising information on the user's monitored interactions;

identifying media content (108,206,208,210,212) based on the stored information on the user's monitored interactions (1006,1206) and based on characteristics of a first user equipment device of the plurality of user equipment devices (802,804,806) to which an indication of the identified media content is to be transmitted, wherein the characteristics include whether the first user equipment device will be available at the time the media content will be available; and

transmitting the indication of the identified media content (108,206,208,210,212) from the server (824) to the first user equipment device (802,804,806) of the plurality of user equipment devices (802,804,806), wherein the indication is presented to the user by the first user equipment device (802, 804, 806)."

XIV. The former respondent's arguments, in so far as relevant to the present decision, may be summarised as follows.

It is not clear what is meant by "availability" when the availability is part of the device characteristics. Whether a device is switched on or off might be

considered an example of device availability, but this would not normally be considered part of the device characteristics (see former respondent's letter dated 15 April 2016, page 2, third paragraph).

The use of the word "also" on page 71, lines 8 to 11 of the description of the application as filed implies that there are two alternatives for identifying media content, namely on the basis of characteristics of the user equipment device to which the recommendation is to be transmitted or the availability of that device. Therefore, the fact that the characteristics of the first user equipment device include whether the first user equipment device will be available at the time the media content will be available (claim 1, lines 12 to 14) extends beyond the content of the application as filed (see former respondent's letter dated 15 April 2016, page 1, last full paragraph, to page 2, first full paragraph).

The term "available" is sufficiently broad to encompass the device availability described in paragraphs [0038], [0045] and [0046] and in Figure 5 of document D22, which includes both the user's location and the user's schedule. Even if "available" were given a more restrictive interpretation, using user equipment device characteristics which "*include whether the first user equipment device will be available*" is obvious for the reasons given by the opposition division, namely because the skilled person would not send recommendations for content to a device which cannot be consumed by the device user (see former respondent's letter dated 15 April 2016, page 6, last paragraph).

Reasons for the Decision

The appeal is admissible.

1. *Inventive step (Article 56 EPC 1973)*

1.1 Under Article 56 EPC 1973, an invention is to be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

1.2 The opposition division found that the subject-matter of claim 1 did not involve an inventive step in view of the disclosure of document D22 combined with the common general knowledge of the person skilled in the art.

1.3 Document D22 discloses a media management system (see Figure 2) comprising an intelligent agent configured to carry out the following steps:

- identifying media content available from various content providers on the basis of previously established user preferences (see Figure 5, step 100 and paragraph [0031], third sentence)
- locating the user's current device (see Figure 5, step 104, paragraph [0046] and paragraph [0047], second sentence: "*user's current device*")
- sending a notification message to the user's current device "*to alert the consumer of the existence of possible content of interest*" (see Figure 5, step 108 and paragraph [0031], fourth sentence)

- handling the purchase of the recommended content, preferably by *"giving the user a simple question for which a yes/no response is all that is required"* (see Figure 5, step 112 and paragraph [0050], first sentence)
- mediating the download of the media content by taking into account *inter alia "the desired physical device to receive the download"* (see Figure 5, step 116 and paragraph [0052], third sentence)

1.4 It is common ground that the media management system described in document D22 is not configured to execute the following step of the method defined in claim 1 of the appellant's request:

"identifying media content ... based on characteristics of a first user equipment device ... to which an indication of the identified device is to be transmitted, wherein the characteristics include whether the first user equipment device will be available at the time the media content will be available"

(see impugned decision, pages 7 and 8, "Auxiliary Request 4" and former respondent's letter dated 15 April 2016, page 5, second paragraph and page 6, "Lack of inventive step of the Main Request").

1.5 The opposition division's decision was based on the premise that *"the skilled person would **inevitably** try to avoid sending **recommendations** to the telephone **for** content which cannot be consumed since the user is busy with something else"* (see page 8 of the impugned decision, second paragraph; emphasis by the board).

1.6 The board notes that document D22 does not disclose that the device selected for downloading (or consuming) the recommended media content is the device to which the recommendations are sent (i.e. the user's current device). The last two sentences of paragraph [0050] suggest that the device on which the media content is to be downloaded is determined according to default settings which can be overridden by the user. D22 does not disclose any embodiment in which the default device receiving the media content is the user's current device as determined by the user schedule. Consequently, there is no **need** (see point 1.5, "*inevitably*") to try and avoid sending recommendations for content to a device which cannot be downloaded to (or consumed on) that device. This means that the opposition division based its decision on an incorrect premise.

1.7 The board notes that neither the EPC nor the established case law of the boards of appeal indicates that a problem must "*inevitably*" or "*necessarily*" arise from the closest prior-art document for it to be considered by the person skilled in the art. The person skilled in the art would want to solve a problem in the expectation of some improvement or advantage (see Case Law, I.D.5). This expectation may come from their common general knowledge or other prior-art documents.

The board cannot find any explanation from the opposition division or the former respondent regarding improvements or advantages that the person skilled in the art would have expected to achieve by "*avoid[ing] sending recommendations to the telephone for content which cannot be consumed since the user is busy with*

something else". It therefore does not find this line of reasoning persuasive.

- 1.8 The board considered which situations a person skilled in the art would likely have been confronted with when implementing the system disclosed in document D22. It found that the person skilled in the art would have been confronted with the situation in which the download in step 116 of Figure 5 cannot be executed because the device supposed to receive the download (namely the "desired physical device" according to paragraph [0052]) is unavailable, for example because it is turned off or not currently connected to the network (see definition of the term "unavailable" in paragraph [00588] of the description of the application in hand).

At the oral proceedings before the board, the appellant accepted that the person skilled in the art would have tried to avoid this situation.

However, there is no evidence on file that the person skilled in the art would have arrived at the feature identified under point 1.4 *supra* when trying to solve this problem. Indeed, document D22 - the only prior-art document relied upon in the impugned decision and the former respondent's letter dated 15 April 2016 - does not disclose any information about the future availability of the various devices mentioned in Table I of paragraph [0025] for downloading media content. The user schedule mentioned in paragraphs [0038] and [0046] provides information about which device the user is or will be using, but not information about the future availability of the user's devices for downloading media content. In the absence of any such information, the intelligent agent

described in D22 does not have the necessary information to identify media content depending on whether a user equipment device "*will be available at the time the media content will be available*".

1.9 For the above reasons, the arguments on file put forward by the opposition division and/or by the former respondent have not convinced the board that the subject-matter of claim 1 lacks inventive step in view of the disclosure of document D22 combined with the common general knowledge of the person skilled in the art.

2. *Clarity and added subject-matter (Article 84 EPC 1973, Article 123(2) EPC)*

2.1 In its letter dated 15 April 2016 (pages 1 and 2, "*Main request*"), the former respondent argued that it was not clear what was meant by "availability" when the availability was part of the device characteristics. Whether a device was switched on or off might be considered an example of device availability, but this would not normally be considered part of the device characteristics.

The board considers that claim 1 as a whole clearly specifies that media content is identified *inter alia* depending on whether the first user equipment device will be available at the time the media content will be available. Considering this criterion to be a "characteristic" of the first user equipment device does not affect the matter for which protection is sought (Article 84 EPC 1973).

2.2 In its letter dated 15 April 2016 (*ibid.*), the former respondent further argued that the use of the word

"also" on page 71, lines 8 to 11 of the description of the application as filed implied that there were two alternatives for identifying media content, namely on the basis of characteristics of the user equipment device to which the recommendation was to be transmitted or the availability of that device. Therefore, the fact that the characteristics of the first user equipment device included whether the first user equipment device would be available at the time the media content was available (claim 1, lines 12 to 14) extended beyond the content of the application as filed.

The board did not find these arguments persuasive because, as submitted by the appellant at the oral proceedings before the opposition division, "*the word 'also' [on page 71, lines 8 to 11 of the description of the application as filed] is used in the sense of equally*" (see minutes, page 3, third-to-last paragraph).

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 with the order to grant a patent in the following version:

Description

Pages 4 to 20 of the patent specification

Pages 2 and 3 filed during the oral proceedings on
18 August 2021

Claims

Nos. 1 and 2 of the "Second Auxiliary Request" (clean
version) filed with the letter dated 22 July 2019

Drawings

Figures 1 to 20 of the patent specification

The Registrar:

The Chairman:



K. Boelicke

B. Müller

Decision electronically authenticated