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**Datasheet for the decision
of 16 November 2021**

Case Number: T 0509/16 - 3.5.04

Application Number: 10002919.8

Publication Number: 2207347

IPC: H04N21/472, H04N21/482,
H04N21/45, H04N5/445

Language of the proceedings: EN

Title of invention:

Electronic program guide for indicating availability of past programs in the future

Patent Proprietor:

Rovi Guides, Inc.

Former Opponent:

Virgin Media Limited

Headword:

Relevant legal provisions:

EPC Art. 100(c), 111(1)
RPBA 2020 Art. 11

Keyword:

Claims - interpretation of ambiguous terms

Grounds for opposition - subject-matter extends beyond content
of earlier application (no)

Remittal - special reasons for remittal

Decisions cited:

G 0010/91, G 0003/14

Catchword:



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Case Number: T 0509/16 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 16 November 2021

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

Representative: Haley Guiliano International LLP
26-28 Bedford Row
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 23 December
2015 revoking European patent No. 2207347
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairwoman B. Willems
Members: M. Paci
T. Karamanli

Summary of Facts and Submissions

- I. The appeal was filed by the patent proprietor ("the appellant") against the decision of the opposition division to revoke the patent in suit ("the patent").
- II. During the opposition proceedings, the opponent had raised grounds for opposition under Articles 100(a) and 56 EPC (lack of inventive step) and Article 100(c) EPC (subject-matter extending beyond the content of the earlier application as filed).
- III. The opposition division revoked the patent according to Articles 101(2) and 101(3) (b) EPC for the following reasons:
 - The subject-matter of claim 1 of the main request extended beyond the content of the earlier application as filed (Article 100(c) EPC).
 - The first auxiliary request was late filed. It was not admitted into the opposition proceedings because claim 1 *prima facie* did not meet the requirements of Articles 76(1) and 84 EPC.
 - The subject-matter of claim 1 of the second to ninth auxiliary requests extended beyond the content of the earlier application as filed (Articles 100(c) and 76(1) EPC).
- IV. The patent proprietor filed notice of appeal. In the statement of grounds of appeal, the appellant maintained its main request (the patent as granted, i.e. the rejection of the opposition) and filed claims according to the first to fourth auxiliary requests. It

also requested oral proceedings if the board was not minded to allow any of these requests.

V. The opponent ("the respondent" or "the former respondent") filed a reply to the appeal in which it requested that the appeal be dismissed. It further requested oral proceedings as a precaution. It submitted the following arguments:

- The subject-matter of claim 1 of the main request extended beyond the content of the earlier application as filed (Article 100(c) EPC).
- The subject-matter of claim 1 of the second to fourth auxiliary requests extended beyond the content of the earlier application as filed (Articles 100(c) and 76(1) EPC).
- The claimed subject-matter according to all requests did not involve an inventive step in view of the cited prior art (Articles 100(a) and 56 EPC).

VI. By letter dated 9 November 2017 the respondent unconditionally and irrevocably withdrew its opposition.

VII. The board issued a summons to oral proceedings. In its communication under Article 15(1) RPBA 2020, the board gave *inter alia* the following preliminary opinion.

- (a) Claim 1 of the patent as granted was not clear. However, the requirement of clarity of Article 84 EPC was not a ground for opposition and therefore, the claims of the patent may not be examined for compliance with the requirements of Article 84 EPC (see G 3/14 (OJ 2015, A102)). Nevertheless, in such

a case the board had to establish how the claimed subject-matter should be interpreted.

- (b) The appellant was invited to explain how the terms "*currently*", "*previously*", "*successively*" and "*not scheduled to start being broadcast again*" should be interpreted. In particular, the appellant was invited to explain how the "*previously stored listings data*" related to the "*currently stored listings data*".
- (c) Since the appellant had not been heard on how claim 1 should be interpreted, it was premature for the board to express a provisional opinion on whether the subject-matter of claim 1 of the main request or any of the auxiliary requests extended beyond the content of the earlier application as filed (Article 100(c) EPC).
- (d) Should the board arrive at the conclusion that the subject-matter of claim 1 of the patent as granted (or of one the auxiliary requests) did not extend beyond the content of the earlier application as filed, the case would be remitted to the opposition division for further prosecution.

VIII. In its letter of reply dated 15 October 2021, the appellant submitted its interpretation of the terms addressed in the board's communication and also arguments as to why the subject-matter of claim 1 of each of the requests on file did not extend beyond the content of the earlier application as filed.

IX. The board held oral proceedings on 16 November 2021.

The appellant's final requests were that the decision under appeal be set aside and that the opposition be rejected (main request) or, alternatively, that the patent be maintained as amended on the basis of the claims of one of the first to fourth auxiliary requests.

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

- X. Claim 1 of the patent as granted reads as follows (the letters (a) to (k) used by the opposition division and the parties to identify features have been added by the board):

- (a) "A system (1,2) for providing an electronic program guide comprising:*
- (b) means (5,12,25,19,20) for receiving and storing program guide listings data for multiple channels;*
- (c) means (15,28) for presenting on-screen, from the currently stored listings data, a selection of listings of programs that are currently being broadcast or programs that will start being broadcast in the future;*
- (d) means (15,28) for presenting on-screen, from the currently stored listings data, some listings of programs that have finished being broadcast;*
- (e) means (3,17) for automatically identifying in the currently stored listings data which of the programs that have finished being broadcast are scheduled to start being broadcast again at a future time;*
- (f) means (5,12,25,19,20) for successively receiving and storing future program guide listings data for multiple channels;*
- (g) means (3,17) for automatically comparing the previously stored listings data with the successively*

stored listings data to further identify in the previously stored listings data which of the programs that have finished being broadcast are scheduled to start being broadcast again at a future time;

(h) means (15,28) for differentiating the appearance of the on-screen listings of programs that have finished being broadcast and are scheduled to start being broadcast again in the future from the on-screen listings of programs that have finished being broadcast and are not scheduled to start being broadcast again in the future;

(i) means for receiving a user selection of a function to be activated for one of the on-screen listings of programs that have finished being broadcast and are not scheduled to start being broadcast again in the future;

(j) means for automatically comparing the one of the on-screen listings of programs with successively received and stored future program guide listings data to attempt to find a match for the one of the on-screen listings of programs; and

(k) means for, if the match is found, activating the function selected by the user."

Reasons for the Decision

1. The appeal is admissible.
2. Since the opponent (respondent) withdrew its opposition, it is no longer a party to the appeal proceedings. However, the board has taken into account the former respondent's arguments filed by its letter of reply to the statement of grounds of appeal.

The invention

3. The invention relates to an improved electronic program guide (EPG) which allows a user to select a past program and to indicate that it should be recorded if it is broadcast again in the future.

Appellant's main request

4. Interpretation of claim 1 of the patent as granted
- 4.1 The established case law of the boards of appeal concerning the general principles for the interpretation of claims, to which this board also subscribes, is summarised in the Case Law of the Boards of Appeal of the EPO, 9th edition 2019, section II.A.6, as follows:

"The skilled person, when considering a claim, should rule out interpretations which are illogical or which do not make technical sense. He should try, with synthetic propensity, i.e. building up rather than tearing down, to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent. The patent must be construed by a mind willing to understand, not a mind desirous of misunderstanding".

- 4.2 The board concurs with the appellant that the following terms of claim 1 should be understood as set out below.

4.3 Re the terms "*currently*", "*previously*" and "*successively*"

Features (c) to (e) refer to "*currently stored listings data*", which should be understood as referring to the listings data received and stored at feature (b).

Feature (f) refers to "*successively*" receiving and storing future program guide listings data, which should be understood as future program guide listings data received **after** the program guide listings data received at feature (b) and **in successive downloads** (which is consistent with the expression "*each successive download of future listings data*" on page 22, lines 25 and 26, of the application as filed). The successively received listings data are used for updating the stored listings.

Feature (g) refers to a comparison of "*previously*" stored listings data with "*successively*" stored listings data. The "*previously*" stored listings data should be understood as those which have been received and stored **before** the ones "*successively*" received and stored at feature (f). The "*previously*" stored listings data are thus essentially the listing data received and stored at feature (b) and updated by subsequent successive downloads, if any. During the comparison, the data on past programs in the "*previously*" stored listings data is compared with the data on future programs in the "*successively*" received listings data.

In the board's view, the above technically sensible interpretation is based on the wording of claim 1 and is consistent with the description of the application as filed, in particular from page 17, line 21, to page 23, line 2.

- 4.4 Re the expression "*not scheduled to start being broadcast again*"

The expression "*not scheduled to start being broadcast again in the future*" is used in features (h) and (i) of claim 1. However, features (i) to (k) only make technical sense if this expression is interpreted as meaning not **yet** scheduled to start being broadcast again in the future according to the successively received and stored future program guide listings data of feature (g) which have **already** been received, but which might still be scheduled to start being broadcast again in the future according to the successively received and stored future program guide listings data of feature (g) which have **not yet** been received. Otherwise, a match would never be found at feature (j) and the function selected by the user at feature (i) would never be activated at feature (k). The board notes that this interpretation is consistent with page 22, line 15 to page 23, line 2, and page 29, lines 5 to 7, of the application as filed.

5. Ground for opposition under Article 100(c) EPC

- 5.1 The opposition division held that the subject-matter of claim 1 of the main request extended beyond the content of the parent application as filed and that therefore the ground for opposition under Article 100(c) EPC prejudiced the maintenance of the patent as granted.

More specifically, the opposition division concurred with the opponent that the combination of **features (e) and (g)** was compatible with the "*cache method*", but not with the "*carousel method*". These were the two methods of receiving and storing program guide listings data

disclosed in the description of the parent application as filed. Since claim 1 also covered the carousel method, it contained subject-matter extending beyond the content of the parent application as filed (see section 15.3 of the Reasons for the decision).

- 5.2 The appellant's arguments regarding features (e) and (g) may be summarised as follows:

The main difference between the cache method and the carousel method is that the cache method involves downloading program guide listings data "*in advance of user's interaction within the EPG system*", while the carousel method involves downloading the same data "*during interaction with the user*" (see page 17, lines 21 to 27, of the description of the parent application as filed). Whereas in the cache method the listings data are downloaded daily at given times, in the carousel method the download of listings data is triggered by the user's interaction with the guide, for instance, by opening the guide. In both methods, the successively downloaded data is used to update the already available data. The wording of claim 1 is thus compatible with both the cache method and the carousel method.

- 5.3 The former respondent's arguments regarding features (e) and (g) in its reply to the statement of grounds of appeal may be summarised as follows:

The wording of claim 1 is not compatible with the carousel method disclosed in the parent application as filed for the following reasons:

(a) There is no suggestion in the parent application that downloading of future listings data continues

after the EPG is constructed in the carousel method and so there is no "*successively stored listings data*" as required by feature (g) of claim 1.

(b) The subject-matter of feature (e) cannot be found in the carousel method, i.e. there is no mention in the parent application of the carousel method downloading both retrospective and future listings data ("*currently stored listings data*") and then identifying, within this dataset, which of the programs that have finished being broadcast are scheduled to start being broadcast again at a future time.

5.4 The board concurs with the appellant that the combination of features (e) and (g) of claim 1 is compatible with both the "*cache method*" and the "*carousel method*", for the reasons set out below.

5.4.1 The part of the description of the parent application as filed describing embodiments using either the cache method or the carousel method in the context of a method having steps corresponding to features (a) to (k) of the system of claim 1 runs from page 17, line 21, to page 23, line 2.

In that part of the description, it is indicated where steps are performed differently depending on whether the cache method or the carousel method is used. For the remaining steps, the reader would understand the description to apply to both methods. It should also be noted that cache and carousel methods were well known in the art. The skilled reader would thus have been able to fill possible gaps in the disclosure of these methods from common general knowledge.

The main differences between the two methods relate to when program guide listings data are received.

According to the **cache** method, the program guide listings data are received (downloaded) from the VBI of a predetermined channel **in advance of** a user's interaction with the EPG system and stored in the set-top-box (see page 17, lines 21 to 24).

According to the **carousel** method, the program guide listings data are received (downloaded) from the VBI of a predetermined channel **during** a user's interaction with the EPG system and stored in the set-top-box (see page 17, lines 24 to 27).

According to both methods, listings data is received for current and future programs. In the cache method, listings for past programs ("*retrospective listings*") which were not broadcast longer ago than a predetermined "*retention period*" are downloaded as listings of past programs or become listings of past programs after the corresponding programs have finished being broadcast (see page 19, lines 5 to 10). In the carousel method, the retrospective listings of programs broadcast within the retention period are downloaded in reaction to a user's interaction with the EPG system (see page 19, lines 10 to 12). In both methods, a retrospective EPG (i.e. an EPG showing both past and future programs) is created from the stored listings data in response to a user selection of the guide (see page 20, lines 11 to 16). This corresponds to **features (a) to (d)** of claim 1.

The step corresponding to **feature (e)** of claim 1, i.e. the automatic identification in the currently stored listings data of the retrospective programs which are scheduled to be broadcast again in the future, is carried out in a similar manner, whether according to

the cache method (see page 19, lines 18 to 26) or according to the carousel method (see page 20, lines 1 to 9). In both methods, it is done by comparing the stored retrospective listings with the stored future listings in order to find a match.

According to both methods, successive downloads of future program guide listings data are received. This data is used to update the available (stored) program listings data. Each of the successively downloaded future listings data is compared with the already stored past (retrospective) program guide listings data to attempt to find a match between those downloaded future listings and the already stored past program guide listings, i.e. a past program scheduled to be broadcast again in the future (see from page 22, line 25, to page 23, line 1), which corresponds to **features (f) and (g)** in claim 1.

According to both methods, the retrospective EPG differentiates the appearance of program listings of past programs which are already scheduled to be repeated from past programs which are not scheduled to be repeated (see from page 21, line 25, to page 22, line 2), which corresponds to **feature (h)** of claim 1.

According to both methods, the user may select a function for a past program which is not yet scheduled to be broadcast in the future. During "*each successive download of future listings data*", the EPG system compares the thus selected past program with the newly received future listings in order to find a match. If a match is found, the function selected by the user, such as a record function, is activated (see from page 22, line 15, to page 23, line 2). This corresponds to **features (i) to (k)** of claim 1.

5.4.2 In light of the above analysis of the description of the parent application, the board considers that the wording of claim 1, including features (e) and (g), is compatible with both the cache method and the carousel method.

5.4.3 Under point 15.3.3 of the decision under appeal, the opposition division gave the following specific reasons as to why it held that feature (g) was not compatible with the carousel method:

"In the description of the parent application on page 20, lines 1-6 it is illustrated that for the comparison operation in the carousel method only retrospective listings data of the current download are used.

According to description page 17, lines 21-24 in the cache method the listings data is stored in a RAM.

According to page 19 lines 5-7 data is stored for a predetermined retention period in said RAM.

According to page 19, lines 10-12 in the carousel method the retrospective listings data is broadcast for the retention period. Hence, it is not stored in the RAM of the system for the retention period, but it is downloaded in real time according to description page 20, lines 1-7."

5.4.4 The board does not share the opposition division's view for the following reasons:

The board agrees with the opposition division that, according to the carousel method, in contrast to the cache method, there are no pre-stored program guide listings data before the first user's interaction with the set-top-box. The program guide listings data only

starts being downloaded from the VBI when the user starts interacting with the set-top-box (see page 17, line 24, to page 18, line 2). The board further agrees that the downloaded program guide listings data may be stored in a volatile memory (DRAM) (see page 18, lines 10 to 12) and thus would be automatically erased when the set-top-box is turned off.

However, the board disagrees that according to the carousel method successively stored future program guide listings data are **not** compared to previously stored past program guide listings (feature (g) of claim 1). Indeed, for as long as the set-top-box remains switched on, the listings data remains stored in the volatile memory. In practice, it could be for one or more days. During that time, the set-top-box would receive successive downloads of future program guide listing data and compare them to the already stored past program guide listings (see page 17, lines 24 to 27; page 20, lines 1 to 9; and from page 22, line 25, to page 23, line 1). Thus, similarly to the case in which the listings data is stored in a non-volatile memory, the stored listings data can be compared with successively downloaded future program guide listings data. Claim 1 does not mention a retention period and thus does not require that the past program guide listings remain stored for a duration as long as the retention period.

For the above reasons, feature (g) is compatible with the carousel method.

5.4.5 The former respondent, on pages 3 and 4 of its letter of reply to the statement of grounds of appeal, stated the following:

- *"There is no suggestion in the parent application that downloading of future listings data continues after the EPG is constructed and so there is no 'successively stored listings data' as required by feature (g) of claim 1."*
- *"There is no mention in the parent application of the carousel method downloading both retrospective and future listings data ("currently stored listings data") and then identifying, within this dataset, which of the programs that have finished being broadcast are scheduled to start being broadcast again at a future time."*

5.4.6 The board disagrees with these statements for the reasons given under points 5.4.1 and 5.4.4 above.

5.5 Re the other objections under Article 100(c) EPC

The opposition division held that several objections raised by the opponent under Article 100(c) EPC against claim 1 were not persuasive (see points 15.2, 15.4 and 15.5 of the Reasons for the decision). The board concurs with the reasons given by the opposition division. The former respondent did not submit arguments at the appeal stage regarding these objections.

The former respondent also raised a few fresh objections under Article 100(c) EPC in its letter of reply to the statements of grounds of appeal. However, the board does not find these objections persuasive for the reasons given under section 5.4 above.

5.6 Re claim 10

The method of claim 10 comprises steps corresponding to the features of the system of claim 1. The above reasoning applies *mutatis mutandis* to claim 10.

5.7 Re the dependent claims

The board is satisfied that the subject-matter of the dependent claims does not extend beyond the content of the earlier application as filed.

6. Conclusion on the main request

The board is satisfied that the subject-matter of the claims of the appellant's main request (i.e. the claims of the patent as granted) does not extend beyond the content of the earlier application as filed.

7. Additional observations on the main request

The description of the divisional application as filed, on which the granted patent is based, consists of the description and claims of the earlier application as filed. The drawings are identical in both applications as filed. Hence the subject-matter of the claims of the patent as granted does not extend beyond the content of the application as filed.

8. Remittal

8.1 The opposition division did not allow the patent proprietor's main request that the opposition be rejected because it found that the subject-matter of claim 1 of the patent as granted extended beyond the content of the earlier application as filed and that therefore the ground for opposition under Article 100(c) EPC prejudiced the maintenance of the

patent as granted. The impugned decision did not deal with the remaining ground for opposition under Articles 100(a) and 56 EPC, raised against claim 1 of the main request, namely lack of inventive step.

8.2 In accordance with Article 111(1), second sentence, EPC the board may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution. Since the main purpose of the appeal proceedings is to give the losing party a possibility to challenge the decision of the opposition division on its merits (see G 10/91, OJ EPO 1993, 420, point 18), remittal in accordance with Article 111(1) EPC has normally been considered by the boards to be appropriate in cases where the opposition division issues a decision solely upon a particular issue (e.g. added subject-matter) and leaves other substantive issues (e.g. inventive step) undecided. This existing practice realises the primary object of appeal proceedings to review the decision under appeal in a judicial manner, as expressed in Article 12(2) RPBA 2020.

In the board's view, all these elements constitute special reasons that justify a remittal of the case to the opposition division in accordance with Article 11 RPBA 2020.

8.3 The appellant, which is the sole remaining party to the appeal proceedings, stated during the oral proceedings that it agreed with the case being remitted to the opposition division for further prosecution.

8.4 In the light of the above, the board therefore considers it appropriate to remit the case to the opposition division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairwoman:



A. Voyé

B. Willems

Decision electronically authenticated