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**D E C I S I O N**  
**of 28 January 2005**

**Case Number:** T 0800/00 - 3.5.1

**Application Number:** 90901995.2

**Publication Number:** 0449985

**IPC:** H04N 5/782

**Language of the proceedings:** EN

**Title of invention:**

Apparatus and method for using encoded video recorder/player  
timer preprogramming information

**Patentee:**

Gemstar Development Corporation

**Opponent:**

Interessengemeinschaft für Rundfunkschutzrechte GmbH  
Schutzrechtsverwertung & Co. KG

**Headword:**

Preprogramming/GEMSTAR

**Relevant legal provisions:**

EPC Art. 69(1), 84, 123(2)

**Keyword:**

"Clarity after amendment of claims - no"  
"Added subject-matter - yes"

**Decisions cited:**

-

**Catchword:**

One of the principal purposes of patent claims is to define the matter for which protection is sought (Article 84 EPC) and thus the extent of protection conferred by a European patent (Article 69(1) EPC). It must be possible, during the whole term of the patent, to determine the scope of protection with a reasonable degree of certainty for third parties (see the Protocol on the Interpretation of Article 69 of the Convention). If the terms of the claims do not, even when interpreted in the light of the description and drawings, warrant such a degree of certainty to third parties, they lack the required clarity and are not allowable under the provisions of Article 84 EPC.



Case Number: T 0800/00 - 3.5.1

**DECISION**  
of the Technical Board of Appeal 3.5.1  
of 28 January 2005

**Appellant:** Gemstar Development Corporation  
(Proprietor of the patent) 135 Los Robles Avenue  
Suite 870  
Pasadena, California 91101 (US)

**Representative:** Hale, Peter  
Kilburn & Strode  
20 Red Lion Street  
London WC1R 4PJ (GB)

**Respondent:** Interessengemeinschaft für  
(Opponent) Rundfunkschutzrechte GmbH  
Schutzrechtsverwertung & Co. KG  
Bahnstrasse 62  
D-40210 Düsseldorf (DE)

**Representative:** Eichstädt, Alfred, Dipl.-Ing.  
Maryniok & Eichstädt  
Kuhbergstrasse 23  
D-96317 Kronach (DE)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 2 June 2000  
revoking European patent No. 0449985 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** S. V. Steinbrener  
**Members:** R. R. K. Zimmermann  
B. J. Schachenmann

## Summary of Facts and Submissions

I. European patent number 0 449 985 granted on the basis of EURO-PCT patent application number 90901995.2 (PCT publication number WO 90/07844) claimed priority dates back to December 1988 for an invention concerning the use of encoded video recorder/player timer preprogramming information. In four independent claims it sought protection, *inter alia*, for a system for automatically controlling recording by a video cassette recorder (claim 1) and for a method of programming a system for automatically controlling recording by a video cassette recorder (claim 18). Method claim 18 of the patent as granted has the following wording:

"18. A method of programming a system for automatically controlling recording by a video cassette recorder of a channel of video signals specified by a channel command beginning at the time of day specified by a time-of-day command, on the calendar day specified by a day command and for the length of time specified by a length command, the steps comprising:  
receiving coded indications, each representative of the combination of one of each said channel command, day command, time-of-day command and length command; and  
decoding any said coded indications to individual said channel command, day command, time-of-day command and length command for control of the video cassette controller, characterised in that the received coded indications are compressed coded indications and in that decoding step includes expanding said compressed coded indications."

- II. An opposition was filed against the patent in its entirety on the sole grounds of lack of novelty and inventive step.
  
- III. In a decision posted on 2 June 2000 the opposition division revoked the patent. The patent proprietor lodged an appeal against the decision. The notice of appeal was filed on 21 July 2000; the same day, the appeal fee was paid. The written statement setting out the grounds of appeal was filed on 2 October 2000.
  
- IV. The appellant (patent proprietor) as well as the respondent (opponent) took the opportunity to present their views in written statements filed with the Board. In oral proceedings on 15 October 2004, the matter in issue was further discussed, also in respect of method claims filed by the appellant with the Board for the first time on 15 October 2004.

According to each of five new requests, a main request and four auxiliary requests, system claim 1 was replaced by method claim 18 as granted but in an amended form which left the first part of method claim 18 unchanged, except for the numbering of the claim. The respective second part of claims 1 of these requests were amended to read as follows:

Main request: "characterised in that the received coded indications are compressed coded indications, and in that the decoding step includes expanding said compressed coded indications and using said expanded coded indications to control said video cassette recorder."

Auxiliary request 1: "characterised in that the coded indications received by the input are a compressed and interdependent combination of one of each of said channel command, day command, time-of-day command and length command, and in that the decoder expands said compressed coded indications received and uses the expanded coded indications to control said video cassette recorder."

Auxiliary Request 2: "characterised in that the representations of coded indications received by the input are a [sic!] compressed and reordered versions of one of each of said channel command, day command, time-of-day command and length command, and in that the decoding step includes expanding the compressed representation, ordering the coded indications and using the expanded ordered indications to control said video cassette recorder."

Auxiliary request 3: "characterised in that the coded indications received by the input are compressed and reordered versions of one of each of said channel command, day command, time-of-day command and length command, in that the numerical value of each coded indication is inversely related to the likelihood of use of the commands, and in that the decoder expands the compressed coded indications received to control said video cassette recorder."

Auxiliary Request 4: "characterised in that the coded indications received by the input are compressed and reordered versions of one of each of said channel command, day command, time-of-day command and length

command, in that the decoder expands the compressed coded indications received to control said video cassette recorder, in that the coded indications are ordered so that coded indications for programs most likely to be subject to timer preprogramming have a low numerical value, and in that the decoder expands the compressed coded indications received and uses the expanded coded indications to control said video cassette recorder."

- V. In addition to contesting the patentability of the invention, the respondent raised formal objections against the new requests, arguing in particular on lack of clarity and added subject-matter in each of the amended claims 1. According to the respondent the feature in the main and several auxiliary requests that linked the decoding step to the control function of the video cassette recorder did not find any support in the application as originally filed. The same held for the definition of the coded indications as an "interdependent combination " (auxiliary request 1) or as "reordered versions of one of each of said channel command, day command, time-of-day command and length command" (auxiliary requests 2 to 4) since the application as originally filed only referred to the reordering of the bits or of the binary code, the so-called G-code, but did not define any ordering, nor any reordering, of the channel command, day command, time-of-day command and length command (the "CDTL commands"). Finally, the reference in auxiliary requests 3 and 4 to the "likelihood of use of the commands", or similar formulations, did not clearly define a technical feature of controlling a video cassette recorder.

VI. According to the appellant, the objection of added subject-matter was without any merits: the decoder was disclosed in the application as being used for controlling the video cassette recorder since the invention used the CDTL commands provided by the controller for controlling the video cassette recorder. Moreover, there was no substantial difference between reordering the CDTL commands and reordering the bits or the binary codes encoding the CDTL commands, the last feature being undisputedly disclosed in the application as filed.

Neither was there any basis for objecting against the feature that the coded indications are a "interdependent combination of one of each of said channel commands"; page 8, lines 47 to 50 of the patent specification (corresponding to PCT publication, page 20, lines 20 to 27) disclosed the interdependent combination in the context of the "priority vectors" made interdependent by "making the length priority vector dependent on different groups of channels". Finally, the appellant argued that the skilled person would clearly understand the likelihood-of-use feature to mean the encoding and compressing of the preprogramming data so as to provide a decimal number as small as possible for the most likely selected programmes. The use of such numbers would be very convenient to the user in programming the video cassette recorder.

VII. The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of:



claims 1 filed at the oral proceedings as main and first to fourth auxiliary requests, each replacing claim 18 as granted, with dependent claims to be adapted; independent claim 35 as granted with dependent claims to be adapted; whereas claims 1 to 17 and independent claim 46 as granted being withdrawn.

VIII. The respondent requested that the appeal be dismissed.

IX. In the course of the oral proceedings of 15 October 2004 the Board indicated to the parties that it considered the objections of lack of clarity and added subject-matter raised by the respondent as relevant and invited the parties to discuss and comment on these issues. At the end of the oral proceedings the Board closed the debate and declared that the decision would be given in writing.

### **Reasons for the Decision**

1. The appeal complies with the requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC and is thus admissible.
2. The appeal, however, is not allowable since by failing to meet the requirements of Articles 84 and 123(2) EPC, the claims filed with the Board on 15 October 2004 do not provide a valid basis for maintaining the patent in the amended form as requested.
  - 2.1 The amendments objected to by the respondent as well as by the Board during the oral proceedings fall into four

groups, referred to in the following as amendments A, B, C, and D, respectively:

(A) The amendment defining the control of the video cassette recorder as part of the decoding function, which reads in the various requests as follows:

Main request and auxiliary request 2 "the decoding step includes expanding ... and using said expanded coded indications to control said video cassette recorder".

Auxiliary requests 1 and 4: "the decoder expands ... and uses the expanded coded indications to control said video cassette recorder".

(B) The amendment according to auxiliary request 1 defining that the coded indications received by the input are a compressed and "interdependent combination of one of each of said channel command, day command, time-of-day command and length command".

(C) The amendment according to auxiliary requests 2 to 4 defining that the coded indications received by the input or their representations are compressed and "reordered versions of one of each of said channel command, day command, time-of-day command and length command".

(D) The amendment referring to a "likelihood of use" in the context of the coding of commands, which reads as follows:

Auxiliary request 3: the "numerical value of each coded indication is inversely related to the likelihood of use of the commands".

Auxiliary request 4: the "coded indications for programs most likely to be subject to timer preprogramming have a low numerical value".

- 2.2 The amendment A (the decoding step includes controlling the video cassette recorder) is neither disclosed explicitly in the application as originally filed nor does it implicitly follow from any other technical teaching given in the application. As can be seen from figures 1, 3 and 5 (see the PCT-publication), the "G-code decoder" which performs the decoding step is either part of the video cassette recorder (figure 1) or part of a separate remote controller (figures 3 and 5). In both embodiments the decoder does not comprise the controller but is only coupled to it for producing the decoded CDTL commands (see page 40, lines 15 to 17, for example). Although the decoder, therefore, may be considered to control, in some broad sense, the controller (see page 53, lines 8 to 10), the control of the video cassette recorder itself is done only by the controller (see, for instance, page 51, line 25 to page 52, line 2). Extending the meaning of control of the video cassette recorder to include the functions of the decoder would be an interpretation of the kind that in some respect everything controls everything, which is certainly not an interpretation a skilled person would apply to understand a piece of technical information. Since it is not derivable directly and unambiguously that the decoder itself controls the video cassette recorder, amendment A adds

new subject-matter to the content of the application as filed and thus infringes Article 123(2) EPC.

2.3 Amendments B and C (see above) use similar definitions: "interdependent combination" (amendment B) and "reordered versions" (amendment C), respectively, "of one of each of said channel command, day command, time-of-day command and length command". The first claim part defines each of the received coded indications as being "representative of the combination of one of each said channel command, day command, time-of-day command and length command".

2.4 Amendment B qualifies this combination as "interdependent", a term having the ordinary meaning of "mutually dependent", which requires not just one but at least two objects between which a relationship of dependency may exist. A "combination", however, is a single entity. Even if the term "interdependent" is read on the individual CDTL commands the meaning remains obscure since the CDTL commands are not mutually dependent: the user may produce a valid G-code on the basis of a quasi deliberate choice of CDTL commands. Since the physical aspects of the method to be defined by the term "interdependent" remain obscure, which is particularly serious in the present case since the amendment is intended to distinguish the claimed subject-matter from the relevant prior art, amendment B is not admissible under the provisions of Article 84 EPC.

2.5 There is also no explicit support for amendment B in the application as originally filed. The text portion cited by the appellant (which is, in the PCT

publication, page 20, lines 21 to 23) refers to an embodiment of the invention where the priority vectors are made interdependent, "such as making the length priority vector dependent on different groups of channels" (loc. cit.). This clearly formulated idea is not directly and unambiguously linked to the present vaguely broadened definition of an "interdependent combination of one of each of said channel command (...)". Amendment B has no direct and unambiguous basis in the application as filed and thus infringes Article 123(2) EPC.

2.6 Neither is amendment C admissible. First, the technical meaning of the term "versions", in the context of encoding data, remains unclear. It seems also to be inconsistent with the wording of the first part of the claim which defines the same indications as a "combination" of CDTL commands.

Moreover, the "versions" are characterized as "compressed and reordered". According to the patent specification, however, neither the CDTL commands nor "versions of one of each of" the CDTL commands are reordered. Only the bits encoding the CDTL commands are the subject of a reordering process using a bit hierarchy key", however, before compressing the reordered bits. (see for example the PCT publication, figure 7, steps 150 and 154). This feature has thus no direct and unambiguous support in the application as originally filed.

Amendment C is consequently inadmissible under the provisions of Article 84 EPC and Article 123(2) EPC.

2.7 Referring to amendment D (see above), the Board considers the wording "ordered so that coded indications for programs most likely to be subject to timer preprogramming have a low numerical value" in auxiliary request 4 and the similar reference to the "likelihood of use" in auxiliary request 3 as definitions inappropriate in the context of patent claims.

One of the principal purposes of patent claims is to define the matter for which protection is sought (Article 84 EPC) and thus the extent of protection conferred by a European patent (Article 69(1) EPC). It must be possible, during the whole term of the patent, to determine the scope of protection with a reasonable degree of certainty for third parties (see the Protocol on the Interpretation of Article 69 of the Convention). If the terms of the claims do not, even when interpreted in the light of the description and drawings, warrant such a degree of certainty to third parties, they lack the required clarity and are not allowable under the provisions of Article 84 EPC.

The likelihood-of-use feature introduced by amendment D does not define a characteristic which is inherent to the invention as it is not capable of being verified in any objective manner based on the teaching of the patent. The scope of this feature rather depends on the changing preferences of the users of video cassette recorders, which would have to be determined by a kind of quota survey. Moreover, the result of such a survey can only characterize the media behaviour of a particular social group of TV users and normally changes depending on the region and social environment

to which the group surveyed belongs as well as on the time and the circumstances when and where the survey was made. If the likelihood-of-use was mentioned in the claims only for explanatory or illustrative purposes, albeit superfluous, it might not be objectionable. However, in the present case as it is - and was meant to be - a defining feature of the matter for which protection is sought, the necessity to conduct such a quota survey with changing results valid only in a particular social context becomes a serious hindrance to determining the scope of protection with any reasonable degree of certainty. Amendment D is thus not acceptable under the provisions of Article 84 EPC.

2.8 Since in claim 1 of all requests one or more of the above deficiencies are present, none of the requests can be allowed and the appeal must be dismissed.

## **Order**

### **For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

S. V. Steinbrener