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D E C I S I O N
of 6 February 2003

Case Number: T 0124/01 - 3.5.1
Application Number: 89909061.7
Publication Number: 0424469
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G11B 27/02, H04H 1/00

Language of the proceedings: EN

Title of invention:
System and process for VCR scheduling

Patentee:
STARSIGHT TELECAST, INC.

Opponents:
Cable & Wireless Communications plc
Interessengeneinschaft für Rundfunkschutzrechte GmbH
Schutzrechtsverwertung & Co. KG

Headword:
VCR scheduling/STARSIGHT TELECAST

Relevant legal provisions:
EPC Art. 54

Keyword:
"Novelty (no)"
"Late filed auxiliary request (not admitted)"

Decisions cited:
-

Catchword:
-



Case Number: T 0124/01 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 6 February 2003

Appellant: STARSIGHT TELECAST, INC.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 20 November 2000
revoking European patent No. 0 424 469 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: S. V. Steinbrener
Members: R. S. Wibergh
E. Lachacinski

Summary of Facts and Submissions

- I. This is an appeal by the proprietor of European Patent No. 0 424 469 against the decision of the Opposition Division to revoke the patent.
- II. Respondents 01 and 02 opposed the patent *inter alia* on the grounds that the invention was not new or did not involve an inventive step (Article 100(a) EPC). Among the documents cited were:
- D1-1:** WO-A-88/04507
- D1-11:** U. Bensch, "VPV - Videotext programs videorecorder", IEEE, © 1988, pages 788 to 792
- D2-4:** G. Hofmann et al., "Videotext programmiert Videorecorder", Rundfunktechnische Mitteilungen No. 6, 1982, pages 254 to 257.
- III. The Opposition Division held that the subject-matter of independent claims 1, 10 and 18 as amended during oral proceedings was not new over D1-1.
- IV. Together with the statement setting out the grounds of appeal the patent proprietor filed new claims according to a main request and two auxiliary requests.
- V. In a communication pursuant to Article 11(2) of the Rules of Procedure of the Boards of Appeal the Board gave the preliminary opinion that claim 1 of the main request was not clear. Some remarks were made on the claims as granted and it was indicated that the question of their construction would have to be discussed. Oral proceedings were scheduled for

6 February 2003 and any amendments to the patent should be filed at least one month before that date.

VI. On 16 January 2003 the appellant filed newly amended independent claims 1, 10 and 18. It was appreciated that the request was late but, as the appellant explained, if the Board was "willing to accept and consider the claims being filed now they can be treated as the Main Request of the patentee in order to trim down the issues to be discussed at the Oral Proceedings".

VII. Oral proceedings before the Board were held on 6 February 2003. In the course of the proceedings the appellant amended the main request in particular by cancelling process claim 10 and making some slight amendments to system claims 1 and 18, which latter claim was renumbered 10. Furthermore, claims 1, 2, 10, 11, and 18 according to an auxiliary request were presented.

VIII. Claim 1 of the *main request* read as follows:

"A system to allow interactive selection for presentation to a user of supplemental broadcast information pertaining to a primary broadcast, the system comprising a recording device (30), a broadcast receiver (60), a data processor (5) connected to said recording device (30) and to said broadcast receiver (60), characterized in that the system is to allow interactive selection for presentation to a user of supplemental broadcast information pertaining to a primary broadcast in which a cue is broadcast at a first time with, and in addition to, a program comprising the primary broadcast, the system being

characterized by (*sic*) said data processor including means responsive to the cue for presenting the cue on the broadcast receiver (60) during and simultaneous with presenting the primary broadcast on the receiver (60), the cue indicating the availability at a second time later than the first time of the supplemental broadcast information; means (20) connected to the data processor for receiving a user response to the cue and means (6,5,32) responsive to the received cue response for causing data in the broadcast to be used by means for controlling said recording device (30) to record the supplemental broadcast information automatically at the second time".

Claim 10 was directed to a system having the same features as claim 1 except that the supplemental broadcast information was not recorded but only received.

- IX. According to claim 1 of the *auxiliary request* "embedded data, including schedule information and a cue" were broadcast, rather than only "a cue". Furthermore, the means for presenting the cue on the broadcast receiver were defined as responsive to the "embedded data" rather than to the "cue". Finally, the expression "schedule information" replaced "data in a broadcast".
- X. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or alternatively on the basis of the auxiliary request, both requests as submitted at the oral proceedings before the Board.
- XI. The respondents requested that the appeal be dismissed.

XII. At the end of the oral proceedings the Chairman announced the Board's decision.

Reasons for the Decision

1. *The invention*

The present invention will first be briefly explained by reference to the description (cf columns 1 and 2 of the specification). In case of a product being advertised during a regular TV broadcast viewers may be interested in more information about the product than can be provided during the commercial itself. Such supplemental information may be broadcast at a later time. In order to advise the viewer of the existence of such supplemental information a "cue" is broadcast. The cue is a caption on the screen, an audio signal or message, or anything that can alert the viewer. The viewer responds to the cue by pushing a key on a remote controller or by any other means that will activate the system. At the right time the system will automatically tune the video cassette recorder (VCR) to the channel on which the supplemental information is broadcast. The necessary schedule data are provided with the broadcast. Thus, the viewer only has to read (or listen to) the cue and press a button. The rest is taken care of by the system.

2. *Construction of claim 1*

2.1 Claim 1 is directed to a system. It comprises in particular a recording device, a broadcast receiver and a data processor. The claim further refers to five signals: a "primary broadcast", "supplemental broadcast

information", a "cue", a "user response" or "cue response", and certain "data in the broadcast".

- 2.2 The described embodiment is a VCR schedule controller built into a VCR (column 3, 1.18,19). Its general function being that of a TV receiver (cf claim 3 as granted) a distinction should be made between the system as such and the signals it receives: the system does not *contain* - eg in the meaning of "generate" - the signals mentioned in the claim. Still, it may be defined by such signals since it must be suitable for receiving and processing them in the indicated way. In the following each signal's consequence for the definition of the system will be examined.

The "primary broadcast" and the "supplemental broadcast information" are common TV transmissions. Since the claim explicitly mentions a broadcast receiver, which is by definition suitable for receiving TV signals, these features do not further define the invention.

The "cue" is, according to claim 1, "broadcast... with, and in addition to, a program comprising the primary broadcast". The system's data processor includes means "responsive to the cue for presenting the cue on the broadcast receiver (60) during and simultaneous with presenting the primary broadcast on the receiver". At first glance these features appear to limit the system considerably. It is however explained in the description that the cue may simply be "an audio or visual stimulus that is part of the sound or video portion of the broadcast" (column 3, 1.45-47). The patent proprietor confirmed at the oral proceedings before the Board that the claim wording was not intended to exclude these possibilities. Thus, since a

broadcast receiver including a screen suffices to present the cue to the viewer, the above features are regarded as redundant.

As to the "user response", the "viewer responds to the cue... by any... means that will activate the system to store the supplemental data in memory" (column 2, 1.47-50). It is termed "response" because the viewer is expected to respond to the displayed cue by giving this signal. But technically speaking it is just an input signal to which the system should be capable of reacting in the way indicated in the claim. It may be given by means of a remote controller. The system must thus be able to receive such a signal.

The reception of the "data in the broadcast" will be taken care of by the broadcast receiver.

2.3 The Opposition Division points out in the decision that "/s/ome of the claimed features relate rather to the content or the character of a received signal than to technical features of the system" (page 7, bottom). The Board fully agrees with this assessment: whether or not the supplemental broadcast information "pertains" to a primary broadcast can have no technical consequences, and the same applies to the cue "indicating" the availability of the supplemental broadcast information. But the broadcast and the cue signal are in fact not even part of the claimed system, as noted above.

2.4 To sum up, the Board considers that claim 1 encompasses systems which comprise only the following technical features:

- a recording device,

- a broadcast receiver,
- a data processor,
- means for receiving a signal from a remote controller,
- means responsive to this signal for causing data in the broadcast to be used by means for controlling the recording device to record a programme automatically.

3. *Novelty*

3.1 There are several prior art documents which describe TV receivers capable of displaying a teletext page containing a listing of programmes and, after the viewer has selected one of the programme items, typically using his remote controller, controlling automatically a connected VCR such that the programme is recorded. D1-1 mentions such a system at page 1, paragraph 2. D2-4 contains a detailed description under the heading "Funktionsbeschreibung" on page 254 ff. In D1-11 the technique is referred to as the "VPV standard" (page 789), where "VPV" stands for "videotext programmes videorecorder". (It is noted in this context that although D1-11 does not indicate its precise date of publication the appellant has not questioned its being prior art.)

Systems featuring VPV comprise - like practically any combination TV/VCR - a recording device, a broadcast receiver, a data processor and means for receiving a signal from a remote controller. They also contain means responsive to the received signal for causing

data in the broadcast (namely teletext data) to be used by means for controlling the recording device to record a programme automatically at a later time.

- 3.2 It follows that the system of claim 1 is not new (Article 54 EPC). Also the system according to claim 10, which claim is broader than claim 1 since it omits the VCR, is not new.
- 3.3 At the oral proceedings before the Board the appellant insisted on a causal relationship said to exist between the cue, the cue response and the automatic recording. When the viewer responded to the cue by pressing a key on the remote controller he would know that data had been received by the system which would guarantee that the supplemental broadcast information would be recorded. In the prior art there was no such guarantee. Here the viewer, having been informed of a later programme which he desired to record, would have to rely on there existing a teletext page which admitted automatic recording of exactly that programme. That would be a matter of luck since there was no relationship between the cue - for example a visual message - and the teletext programming facility.

The Board however takes the view that no such difference is expressed by claim 1. If the "cue" is part of the TV picture it will have no relationship with other data signals. It is true that the "cue response" causes the recording to take place by using broadcast data, but this is so also in the prior art: the recording is triggered by the viewer and performed under the control of broadcast teletext data.

4. *The appellant's auxiliary request*

During the oral proceedings before the Board the appellant presented claims according to an auxiliary request. The respondents having objected to the lateness of the request, the Board decided not to admit the claims for consideration for the following reasons.

First, also the claims according to the main request had been filed late, namely about three weeks before the oral proceedings. At that time the appellant had stated in the accompanying letter that these claims could be "treated as the Main Request of the patentee in order to trim down the issues to be discussed at the Oral Proceedings". It was therefore unexpected that the appellant would nevertheless wish to file a new set of claims at the oral proceedings.

Second, although the opposed patent is based on an application which was filed in 1989, ie over thirteen years ago, the discussions still centre on what claim 1 actually states, and the appellant has not yet been able to establish novelty over prior art which, since standardised (cf D1-1), must have been well known at the priority date. (D1-1 was in fact cited by the ISA already in 1989, as testified by the International Search Report.) Considering that the applicant or patent proprietor alone is responsible for the wording of the claims (cf Article 113(2) EPC) such failure must be to the detriment of the appellant. Against this background it is to be feared that the amendments proposed would raise further questions of construction. The Board finds that it would be unfair against the respondents if they were to reassess the invention in a matter of hours when the appellant has had such a long time to arrive at an appropriate claim text.

Third, the difficulties to formulate an acceptable claim taken together with the fact that the description of the single embodiment is limited to a block diagram and one column of text suggest that the limits of the disclosure are now being explored. If so, it cannot be assumed *a priori* that even the examination of amendments under Article 123(2) EPC would be straight forward.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

S. Steinbrener