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D E C I S I O N
of 25 May 2004

Case Number: T 0396/01 - 3.5.1

Application Number: 96930873.3

Publication Number: 0850541

IPC: H04N 9/87

Language of the proceedings: EN

Title of invention:
Upgradable on-screen display

Patentee:
THOMSON CONSUMER ELECTRONICS, INC.

Opponent:
Interessengemeinschaft für Rundfunkschutzrechte GmbH
Schutzrechtsverwertung & Co. KG

Headword:
On-screen display/THOMSON CONSUMER ELECTRONICS

Relevant legal provisions:
EPC Art. 84, 123(3)

Keyword:
"Extension of the protection (main and first auxiliary request:
yes)"
"Clarity (second auxiliary request: no)"

Decisions cited:
T 1018/02

Catchword:
-



Case Number: T 0396/01 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 25 May 2004

Appellant: THOMSON CONSUMER ELECTRONICS, INC.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 6 February 2001
revoking European patent No. 0850541 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: S. V. Steinbrener
Members: R. S. Wibergh
V. Di Cerbo

Summary of Facts and Submissions

I. This is an appeal against the decision of the opposition division to revoke European patent No 0 850 541.

II. Claim 1 as granted reads:

"A digital recording and replay apparatus (200) with on-screen message generator and inserter (520), said digital recording and replay apparatus comprising: a transducer (251) for reproducing a video representative digital signal from a recorded medium; replay electronics (220) coupled to said transducer (251) for processing said video representative digital signal to produce an output signal bit stream (221); a decoder (117) having an input coupled to said replay electronics (220) and an output which produces a video signal; a status message signal generator (205/270), responsive to an operating mode of said digital recording and replay apparatus (200), for generating a status message signal (TAG/CMD); and means for inserting said status message signal into the video signal (102) decoded from said output signal bit stream (221)."

Independent claims 4 and 9 are directed to a digital television receiver.

III. The opposition was filed on the sole ground that the invention did not involve an inventive step (Articles 100(a) and 56 EPC). According to the decision,

the invention of claim 1 (as granted) was indeed obvious to the skilled person.

IV. In the grounds of appeal, dated 14 June 2001, the appellant (patent proprietor) requested grant of a patent based on amended claims filed together with the grounds.

V. By communication dated 29 January 2004, the Board indicated that the amendments to claim 1 might contravene Article 123(3) EPC.

VI. Sets of claims according to a main request and an auxiliary request (subsequently to become the first auxiliary request) were filed with letter dated 23 April 2004.

VII. Claim 1 according to the *main request* reads:

"A digital recording and replay apparatus (200) for use with a decoder (117) and an insertions means (275, 520); said digital recording and replay apparatus comprising:
a transducer (251) for recording or reproducing a video representative digital signal from/of a recorded medium;

replay electronics (220) coupled to said transducer (251) for processing said video representative digital signal to produce an output signal bit stream (221) without encoding or decoding;

an on-screen display generator (270) coupled to a controller (205) responsive to an operating mode of said digital recording and replay apparatus (200) for generating a status message (TAG/CMD);

characterized in that the output signal bit stream (221) is sent to the input of the decoder (117), said input being coupled to said replay electronics (220) and the status message signal is inserted through the insertion means (275, 520) into the video signal (102) decoded from said output signal beam /sic/ stream (221)".

- VIII. Claim 1 according to the *first auxiliary request* differs from the main request essentially in that the decoder is an "external decoder".
- IX. Oral proceedings were held on 25 May 2004. The appellant filed, as second auxiliary request, a new set of claims 1 to 10. In comparison with claim 1 as granted, the only difference consisted in the addition of the word "external" in connection with the decoder:

"an external decoder (117)...".
- X. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main or first auxiliary request filed with letter dated 23 April 2004, or on the basis of the second auxiliary request filed at the oral proceedings.
- XI. The respondent (opponent) requested that the appeal be dismissed.
- XII. At the end of the oral proceedings the Board announced its decision.

Reasons for the Decision

1. Admissibility of the appeal

The appeal meets the requirements referred to in Rule 65(1) EPC and is therefore admissible.

The appellant's main request

2. *Modifications*

2.1 Claim 1 as granted is directed to a digital recording and replay apparatus "with on-screen message generator and inserter (520)", said apparatus "comprising: ... a decoder (117)". Claim 1 according to the appellant's main request has been modified in the way that the claimed recording and replay apparatus is "for use with a decoder (117) and an insertion means (275, 520)". The respondent has objected that this amendment extends the scope of protection.

2.2 The Board agrees with the respondent that the proposed amendment leads to an extension of the scope of protection. According to Article 84 EPC, the claims shall define the matter for which protection is sought. The apparatus according to claim 1 as granted contains both an inserter and a decoder since these features are introduced by the expressions "with" and "comprising", respectively. These features are thus not optional but part of the claimed matter.

According to Article 69(1) EPC, the extent of the protection conferred by a European patent shall be *determined* by the terms of the claims, and the

description and drawings shall be used to *interpret* the claims. Since the features inserter and decoder are part of claim 1 as granted, they are to be considered when determining the protection conferred. Therefore, the scope of protection of the patent as granted is limited to a digital recording and replay apparatus equipped with an inserter and a decoder. (Independent claims 4 and 9 as granted are directed to different subject-matters and do not influence the scope of protection with regard to the recording and replay apparatus.)

According to the appellant's main request, however, the apparatus is merely "for use with" a decoder and insertion means. This implies that these means are optional, ie that they are not necessarily part of the claimed subject-matter and do not limit the scope of protection (except, at most, indirectly, by contributing to the definition of the claimed apparatus in that the apparatus must be suitable for the use specified). Therefore, the scope of protection has been extended after grant to include apparatuses not comprising an inserter and a decoder.

- 2.3 The appellant has argued that it is clear from the description that the inserter and the decoder are in fact not part of the "digital video cassette recorder" 200, but of the "integrated receiver decoder" 100 (cf. for example fig. 2). This is agreed. However, whether or not claim 1 as granted is properly based on the description, the apparatus as *claimed* clearly contains these features. It is not possible, by way of construction, to attribute to a claim another meaning than the one which is clearly deducible from the claim

itself (cf. decision T 1018/02, not published in the OJ EPO, point 3.8 of the reasons). In particular, features of a granted claim cannot be regarded as optional merely because the description suggests that it was the patent proprietor's original intention that these features should not - or not necessarily - be part of the invention.

- 2.4 Thus the proposed amendment is contrary to Article 123(3) EPC, and the main request must be refused.

The appellant's first auxiliary request

3. Claim 1 of this request differs from the main request in that the decoder and insertion means are explicitly indicated as "external". Although in line with the description, this modification only makes it even clearer that the subject-matter of the claim does not comprise these two features. Thus also this modification is not allowable under Article 123(3) EPC, and the request is refused.

The appellant's second auxiliary request

4. According to this request, claim 1 as granted is modified in that the words "an external decoder" are substituted for "a decoder".

The respondent has objected that this modification renders the claim and the scope of protection of the patent unclear since an apparatus cannot "comprise" an "external" feature. This is also the Board's view. If a feature is "comprised" by a claimed apparatus, then it

is part of the matter for which protection is sought; but if it is "external", it is normally not part of the matter for which protection is sought (although it may serve to define that matter indirectly). The word combination used in the claim is therefore self-contradictory.

Again, the appellant has referred to the description, which shows (eg in fig. 2) that the decoder 117 is "external" (ie not part of) the cassette recorder 200. However, as already mentioned, the cassette recorder 200 as described cannot simply be identified with the claimed apparatus, which is defined in a way which does not fully correspond to the cassette recorder of the description. The claimed subject-matter rather corresponds to a combination of the cassette recorder 200 and certain parts of the integrated receiver decoder 100. The decoder is not external *to that combination*, and to state in claim 1 that it is, introduces obscurity, contrary to Article 84 EPC.

For these reasons the request must be refused.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

S. Steinbrener