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**DECISION  
of 12 August 2004**

**Case Number:** T 0604/01 - 3.5.3

**Application Number:** 93307708.3

**Publication Number:** 0606703

**IPC:** H04H 9/00

**Language of the proceedings:** EN

**Title of invention:**

Method for surveying a radio or a television audience,  
carrying programme identification signals in the sound channel

**Patentee:**

Weinblatt, Lee S.

**Opponent:**

CERIDIAN CORPORATION

**Headword:**

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**Relevant legal provisions:**

EPC Art. 56, 123, 113(1), 114(2)

EPC R. 68(2), 67

**Keyword:**

"Inventive step - main request (yes)"

"Amendments - added subject-matter (no), protection extended  
(no)"

"Late-filed arguments not duly considered by Opposition  
Division"

"Substantial procedural violation (yes)"

**Decisions cited:**

G 0009/91, T 0508/01

**Catchword:**

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Case Number: T 0604/01 - 3.5.3

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.3  
of 12 August 2004

**Appellant:** CERIDIAN CORPORATION  
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**Respondent:** Weinblatt, Lee S.  
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**Representative:** Beresford, Keith Denis Lewis  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
30 March 2001 concerning maintenance of  
European patent No. 0606703 in amended form.

**Composition of the Board:**

**Chairman:** A. S. Clelland  
**Members:** F. van der Voort  
R. Moufang

## Summary of Facts and Submissions

- I. This appeal is against the decision of the Opposition Division finding European patent No. 0 606 703 in amended form to meet the requirements of the EPC.
- II. The opposition was filed against the patent as a whole and on the grounds pursuant to Article 100(a) to (c) EPC. During the opposition proceedings, the opponent referred, *inter alia*, to the following document:
- D2: US 4 718 106 A.
- III. With letter of 20 April 2000, the proprietor filed amended claims and requested maintenance of the patent in amended form.

In an annex to a communication dated 25 October 2000 concerning the preparation of oral proceedings, the Opposition Division indicated that one of the points which would be considered at the oral proceedings was "Addition of subject-matter extending beyond the content of the application as filed, Article 123(2), and extension of the scope of the claims, Article 123(3).".

With letter of 12 February 2001, in response to the summons to attend oral proceedings and the proprietor's letter, the opponent submitted, without giving any reasons, that the amended claims contravened Article 100(c) EPC and Article 123(2) and (3) EPC.

With letter of 7 March 2001, the proprietor noted that the opponent had not indicated the facts and arguments in support of the objections under Article 123(2) EPC and submitted that not stating the facts upon which the opponent intended to rely amounted to an abuse of procedure on the opponent's side.

With the reply dated 7 March 2001, the opponent reiterated the objections under Articles 100(c) and 123(2) and (3) EPC and argued that, since no new facts and evidence were required or relied upon by the opponent, no additional submission was required to be made.

By letter of 8 March 2001, the proprietor reiterated the position as set out in the letter of 7 March 2001.

- IV. Oral proceedings before the Opposition Division were held on 14 March 2001. According to the minutes of the oral proceedings, the opponent withdrew the objections of lack of novelty and those based on Article 100(c) EPC against the patent as granted, but maintained the objections to the amendments made to the claims as granted and explained why the amendments contravened Article 123(2) and (3) EPC.
- V. In the written decision, the Opposition Division held that the opponent's submission made during the oral proceedings concerning Article 123(2) and (3) EPC included late-filed facts, namely "the indication which amendments are objected to under Article 123(2) and (3)", rather than merely new arguments. None of the facts and arguments were deemed to be *prima facie* prejudicial to the admissibility of the claims on file

(see also the minutes, point 7). Further, "considering the possibility of abuse of the procedure and the likelihood of substantial delay to enable the proprietor to consider the arguments, the opponent's submission pursuant to Article 123(2) and (3) was disregarded as late filed, Rule 71a(1)". It was also held that the grounds for opposition pursuant to Article 100(a) and (b) EPC did not prejudice the maintenance of the patent as amended.

VI. The appellant (opponent) filed an appeal and requested that the impugned decision be set aside and the patent be revoked in its entirety. Oral proceedings were conditionally requested. Further, the appellant requested that the following documents be admitted to the appeal proceedings:

D9: US 2 573 279 A;

D10: US 3 058 065 A; and

D11: US 3 492 577 A.

The appellant submitted that the claimed subject-matter lacked an inventive step (Articles 56 and 100(a) EPC) and extended beyond the content of the application as originally filed (Article 100(c) EPC). Further, the appellant challenged the finding of the Opposition Division that the disclosure of the invention met the requirements of Article 83 EPC and argued that the patent had been amended in such a way that Article 123(2) and (3) EPC was contravened.

The appellant further argued that the Opposition Division was wrong in the decision not to admit the opponent's submission relating to Article 123 EPC during the oral proceedings, since objections under Article 123 EPC had already been raised by the opponent in writing and, furthermore, the submission did not include late filed facts but merely arguments. The Opposition Division therefore effectively denied any proper consideration being given to the objections under Article 123 EPC.

- VII. In response to the notice of appeal, the respondent (proprietor) argued against the appellant's objections and effectively requested that the appeal be dismissed. Oral proceedings were conditionally requested.
- VIII. The parties were summoned by the Board to oral proceedings. In a communication accompanying the summons, the Board gave a preliminary opinion and drew attention to matters to be discussed at the oral proceedings.
- IX. In response to the Board's communication, the respondent filed four sets of amended claims by way of a main request and three auxiliary requests.

The independent claims of the set of claims according to the main request read as follows:

"1. A system for surveying an audience to determine whether a person is tuned to a given signal source transmitting a programming signal along with a survey signal characteristic of said signal source, said programming signal and said survey signal being in a

frequency range to be audibly reproduced by a receiver unit, comprising:

transmission means (7, 9) for combining said programming signal and said survey signal for transmission thereof as a combined signal;

receiving means responsive to said combined signal for separating the survey signal from the programming signal; and

characterised by conversion means for converting the separated survey signal to an output signal in a frequency range non-audible to a human being;

means (15, 16) for acoustically reproducing the output signal outside of the audible frequency range for human beings; and

detecting means (22, 24) for detecting the acoustically reproduced output signal as being indicative of the transmitting signal source."

"3. Apparatus for surveying an audience to determine whether a person is tuned to a given signal source transmitting both a programming signal and a survey signal characteristic of said signal source as a combined signal, said programming signal and said survey signal being in a frequency range to be audibly reproduced by a receiver unit, comprising:

receiving means (11, 12, 13) responsive to the combined signal for separating the survey signal from the programming signal; and

characterised by conversion means (15) for converting the separated survey signal to an output signal in a frequency range non-audible to a human being; and

means (15) for acoustically reproducing the output signal outside of the audible frequency range for human beings; and

means (22, 24) for detecting the acoustically reproduced output signal as being indicative of the transmitting signal source."

- X. In response to the Board's communication, the appellant requested that the following documents be admitted to the appeal proceedings:

D12: Operation and Reference Manual Seiko Datagraph  
2001 Version, allegedly published in May 1984; and

D13: US 4 955 070 A.

- XI. Oral proceedings were held on 12 August 2004. The appellant requested that the decision under appeal be set aside and that the patent be revoked. The respondent requested that the decision under appeal be set aside and that the patent be maintained on the basis of either the main or one of the auxiliary requests. At the end of the oral proceedings the chairman announced the Board's decision.

## **Reasons for the Decision**

1. *Admissibility of D9 to D13*

- 1.1 In accordance with Article 114(2) EPC, the Board may disregard facts or evidence which are not submitted in due time. In the present case, D9 to D11 were referred to by the appellant at the commencement of the appeal



proceedings. D12 and D13 were referred to for the first time in the appellant's response to the Board's communication and in respect of a feature present in the independent claims then on file, namely the wireless transmission of the reproduced output signal, which is not however in the claims according to any of the present requests. At the oral proceedings, the appellant accepted that D12 and D13 were no longer relevant.

1.2 In view of the above the Board admitted D9 to D11, but not D12 and D13, into the appeal proceedings.

2. *Article 123 EPC (main request)*

2.1 Claim 1 as granted has been amended, *inter alia*, by the introduction of "acoustically" in "means (15, 16) for acoustically reproducing the output signal ..." and "detecting means (22, 24) for detecting the acoustically reproduced output signal ...". Claim 3 as granted has been amended correspondingly. At the oral proceedings, the appellant argued that the application exclusively disclosed acoustic reproduction by means of a speaker, so that an intermediate generalisation was claimed. However, the Board notes that column 6, lines 3 to 5, of the application as published refers to "... a sound source such as a speaker ..."; it follows that in the originally filed application means other than a speaker were envisaged for acoustic reproduction.

A further objection under Article 123(2) EPC was raised by the appellant in the statement of grounds of appeal and related to the wireless transmission of the output signal. However, this objection does not apply to

present claims 1 and 3, since they do not include the wording in question. For the same reason, issues under Article 123(2) EPC mentioned in the Board's communication have been satisfactorily dealt with by amendment.

- 2.2 In the statement of grounds, the appellant objected to the introduction in claim 1 of the wording "an output signal in" in "conversion means for converting the separated survey signal to an output signal in a frequency range non-audible to a human being", arguing that the conversion means no longer merely changed the frequency range but could act as a trigger for providing an output signal which was not related to the survey signal. This was not originally disclosed and resulted in a broadening of the claim, thereby violating Article 123(2) and (3) EPC.

The Board notes however that claim 1 as originally filed already included the wording "conversion means for converting the separated survey signal to an output signal". The introduction of the wording "an output signal in" therefore does not contravene Article 123(2) EPC.

- 2.3 Further, with respect to Article 123(3) EPC, the Board takes the view that this provision does not prohibit amendments resulting in an extension of the protection conferred by a specific claim, provided that the protection conferred by the patent as a whole has not been extended by the amendments made. In the present case, claim 1 corresponds to claim 3 as granted, but has a narrower scope due to the introduction of several

limiting features, such as the transmission means (7, 9).

2.4 The Board thus concludes that the claims do not give rise to objection under Article 123(2) and (3) EPC.

3. *Inventive step (main request)*

3.1 At the oral proceedings it was common ground between the parties that D2 represented the closest prior art. D2 relates to a system for surveying a radio audience, in which, along with the programming signal, a survey signal, which is unique to the particular radio station, is transmitted by the radio station. Both signals are received and audibly reproduced by a radio set 4 (see D2, the drawing and column 2, lines 3 to 9). A portable signal detector unit 5, to be carried by the listener, includes a detection circuit 11 which is responsive only to the survey signal and which, on detection of the survey signal, produces a store signal which is input to a memory 13 and which indicates to what extent the listener was tuned to the particular radio station (column 3, lines 55 to 58 and column 4, lines 39 to 41). In order not to materially distract or irritate the listener, the survey signal is preferably transmitted once every 15 minutes only (column 3, lines 42 to 51).

3.2 The system according to claim 1 particularly differs from that disclosed in D2 in that conversion means are provided for converting the survey signal to an output signal in a frequency range non-audible to a human being. The claimed system thus allows the acoustic reproduction and subsequent detection of a frequency-converted survey signal which is inaudible to the

listener, in order to avoid the survey signal disturbing the listener.

- 3.3 At the oral proceedings, the appellant argued that a person skilled in the art would immediately recognise that merely reducing the repeat frequency as suggested in D2 would, at the most, partially solve the problem of the survey signal distracting or irritating the listener. The skilled person would therefore be encouraged to seek a better solution. D11 clearly hinted at selecting a frequency for the survey signal which is non-audible to a human being, thereby solving the problem.

The Board cannot follow this argument. D11 proposes to overcome the problem of listening enjoyment of the program being interfered with by the survey signal (see column 2, lines 16 to 20) by transmitting and reproducing a survey signal consisting of coded signals at a frequency sufficiently high that the survey signal as reproduced by the receiver 120 (Figure 6, column 7, lines 25 to 32) is barely audible, i.e. cannot be readily heard by a human ear but is still within the **audio** bandwidth permitted in accordance with the Federal Communications Commission regulations; 15 kHz is said to be the highest frequency allowable, with 12 kHz as the preferred frequency (column 2, line 69, to column 3, line 11). It follows that, even if the skilled person were to consider D11 in order to improve the apparatus of D2, he would not select a frequency which is non-audible to a human being, since this would go against the teaching of D11 to select the frequency from within the **audio** bandwidth as defined by the FCC. If, for the sake of argument, he were to select a

frequency outside the audio bandwidth, the survey signal to be transmitted would not be in a frequency range to be audibly reproduced by the receiver, as required by claim 1. Furthermore, since the transmitted survey signal would then already be inaudible, there would be no reason to provide the conversion means as defined in claim 1.

Hence, the combination of D2 with D11 does not render the subject-matter of claim 1 obvious.

- 3.4 In the course of the appeal proceedings, the appellant has also argued that the subject-matter of claim 1 lacked an inventive step in view of the disclosure of D2 in combination with either D9 or D10.

The survey system according to D9 is very similar to the system disclosed in D11 in that a substantially non-audible survey signal is transmitted together with the program signal. In D9, the frequency of the survey signal to be transmitted is selected at the lower limit of the audible frequency range, e.g. 30 Hz (see column 4, lines 48 to 54, and column 20, lines 35 to 42). Hence, for the same reasons as given above in relation to D11, D9 does not give the skilled person any reason for providing conversion means as defined in claim 1.

D10 discloses a monitoring system in which, in response to an interrogation radio signal transmitted by a central office 10 (see Figure 1) and having a frequency of, e.g., 500 MHz (column 5, lines 1 to 2), a transponder receiver 20, connected to the receivers #1, #2 to be monitored, generates and transmits a binary

coded signal containing frequency components in the range of, e.g., 400 to 2500 Hz indicating the operating conditions of the monitored receivers (column 8, line 45 to column 9, line 3). D10 thus does not suggest the provision of a conversion means for converting a received survey signal, in a frequency range to be audibly reproduced, to an output signal in a frequency range non-audible to a human being; indeed, it rather suggests the opposite, i.e. a conversion from inaudible to audible.

3.5 The Board therefore considers that the subject-matter of claim 1 of the main request involves an inventive step having regard to the prior art cited by the appellant. Since independent claim 3 defines an apparatus including all the features of claim 1 except for the provision of the transmission means, the reasoning given above in relation to claim 1 applies *mutatis mutandis* to independent claim 3.

4. *Article 100(b) and (c) EPC*

4.1 During the appeal proceedings, the appellant did not substantiate the objections pursuant to Article 83 EPC raised in the notice of appeal. The Board endorses the conclusion of the Opposition Division that the ground for opposition pursuant to Article 100(b) EPC does not prejudice the maintenance of the patent in amended form.

4.2 The ground for opposition pursuant to Article 100(c) EPC was not substantiated during either the opposition or the appeal proceedings and therefore will not be further considered by the Board.

5. In view of the foregoing, the respondent's main request is found allowable and, consequently, it has not proved necessary to consider the auxiliary requests.

6. *Procedural matters*

6.1 The Opposition Division held that the appellant's submission made during the oral proceedings concerning Article 123(2) and (3) EPC included late-filed facts (see point V above). In the Board's view, this conclusion was based on a wrong interpretation of the expression "facts". Facts in the legal sense are to be understood as the circumstances and incidents of a case, looked at apart from their legal bearing (cf. Oxford English Dictionary, second edition). In the present case, the facts necessary in order to examine whether or not the patent and claims comply with the requirements of Article 123(2) and (3) EPC are the application as filed, the patent as granted, and the claims as amended. These facts were available before the oral proceedings and, hence, the appellant's submission at the oral proceedings should have been considered as merely arguments as to whether or not the amended claims comply with Article 123(2) and (3) EPC.

6.2 Considering the appellant's submission to include new facts was therefore the result of a wrong assessment by the Opposition Division, which had the consequence that the arguments of the appellant as to Article 123 EPC were not fully considered, but disregarded after a mere *prima facie* evaluation. This amounts to a substantial procedural violation, since the right of the appellant to be heard (Article 113(1) EPC) was thereby violated. The right of a party to argue its case implies not only

the right to formally present comments but also the right to have these comments duly considered by the Opposition Division (see T 508/01, point 4, not published in OJ EPO).

- 6.3 In addition, it follows from the minutes that, after disregarding the appellant's submissions concerning Article 123(2) and (3) EPC, the Opposition Division did not further deal with the issue of compliance with Article 123 EPC in the oral proceedings, even though it was finally decided that, taking into consideration the amendments made by the proprietor, the patent and the invention to which it relates met the requirements of the EPC (Article 102(3) EPC). The reasons for the decision only refer to Article 123 EPC in relation to an examination for *prima facie* relevancy of what were considered late-filed facts (see the decision, point 2 "Late filed facts"). However, in accordance with G 9/91 (OJ EPO 1993, 408), point 19, the Opposition Division has to fully examine amendments as to their compatibility with the requirements of Article 123 EPC. Since, moreover, in the present case the issue of Article 123 EPC was in dispute, the first instance should have considered this issue in substance both in the oral proceedings and in the reasons of its written decision (Rule 68(2) EPC).

7. *Remittal to the department of first instance*

In accordance with Article 10 of the Rules of procedure of the Boards of Appeal, a Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves



for doing otherwise. In the case under consideration, in view of its age (date of filing 29 September 1993), the Board has refrained from remitting the case directly to the first instance and, instead, dealt itself with the substantive issues in order to avoid any further delay. Further, none of the parties requested that the case be remitted directly.

8. *Reimbursement of the appeal fee*

- 8.1 A reimbursement of the appeal fee may be ordered if the Board deems the appeal allowable and if such reimbursement is equitable by reason of a substantial procedural violation (Rule 67 EPC). In the present case, the appellant's request to set aside the decision under appeal was allowed, whereas the request to revoke the patent was not. A partially allowable appeal, however, does not necessarily exclude a refund of the appeal fee, since Rule 67 EPC does not require the appeal to be fully allowable. However, in the judgement of the Board, in the present case the further requirement that a reimbursement of the appeal fee must be equitable is not fulfilled for the following reasons:

First, the appeal (see point VI above) was not solely based on the lack of proper consideration of the appellant's objections under Article 123 EPC. In addition, the amendments made by the respondent during the appeal proceedings to the claims held allowable by the Opposition Division, which led to the decision under appeal to be set aside, were only occasioned by observations made by the Board regarding Article 123 EPC in the written communication.

Further, even though the Opposition Division did not properly consider the appellant's arguments as presented during the oral proceedings, the appellant had ample opportunity to file the arguments in writing after having received the set of amended claims, but chose to postpone the submission of these arguments until at the oral proceedings (see point III above). Although an opponent can not be denied the right to act in this manner, in the Board's view, in the present case it would have been appropriate for the appellant to have submitted the arguments in writing before the oral proceedings in order to enable the proprietor and the Opposition Division to prepare for the oral proceedings.

The Board further notes that the appellant made no request for a reimbursement of the appeal fee.

- 8.2 For the above reasons, the Board has concluded that the appeal fee should not be reimbursed.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to maintain the patent as amended in the following version:
  - claims: 1 to 6 according to the main request filed with letter dated 12 July 2004;
  - description: columns 1, 4, 6 and 7 of the patent specification and columns 2, 3 and 5 filed with letter dated 12 July 2004; and
  - drawings: Figures 1 and 2 of the patent specification.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland