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D E C I S I O N
of 13 July 2004

Case Number: T 0822/01 - 3.5.3

Application Number: 91307355.7

Publication Number: 0476826

IPC: H04H 1/00

Language of the proceedings: EN

Title of invention:

A method of selecting receiving frequency for RDS receiver

Patentee:

MITSUBISHI DENKI KABUSHIKI KAISHA

Opponent:

Interessengemeinschaft für Rundfunkschutzrechte GmbH
Schutzrechtsverwertung & Co. KG

Headword:

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Relevant legal provisions:

EPC Art. 123, 84, 56

Keyword:

"Amendments - added subject-matter (no)"
"Extension of protection (no)"
"Reformatio in peius"
"Inventive step (yes)"

Decisions cited:

G 0001/99, T 0301/87

Catchword:

-



Case Number: T 0822/01 - 3.5.3

D E C I S I O N
of the Technical Board of Appeal 3.5.3
of 13 July 2004

Appellant:
(Opponent)

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

Representative:

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

Respondent:
(Proprietor of the patent)

mitsubishi denki kabushiki kaisha
2-3, Marunouchi 2-chome
Chiyoda-ku
Tokyo 100 (JP)

Representative:

Nicholls, Michael John
J.A. KEMP & CO.
14 South Square
Gray's Inn
London WC1R 5JJ (GB)

Decision under appeal:

Interlocutory decision of the Opposition
Division of the European Patent Office posted
15 May 2001 concerning maintenance of European
patent No. 0476826 in amended form.

Composition of the Board:

Chairman: A. S. Clelland
Members: F. van der Voort
R. T. Menapace

Summary of Facts and Submissions

- I. This appeal is against the decision of the Opposition Division finding European patent No. 0 476 826 in amended form to meet the requirements of the EPC.
- II. An opposition was filed against the patent as a whole and on the grounds that the claimed subject-matter was not new and did not involve an inventive step (Article 100(a) EPC). During the opposition proceedings, the opponent referred, *inter alia*, to the following documents:
- D3: DE 3917236 C1; and
- D6: DE 3934314 A.
- III. Following oral proceedings, the Opposition Division held that the patent in amended form, including claims 1 to 5 according to a main request as filed during the oral proceedings, met the requirements of Article 123(2) EPC and that the claimed subject-matter was new and involved an inventive step.
- IV. The opponent lodged an appeal against the decision and requested that the impugned decision be set aside and the patent be revoked in its entirety. The appellant argued that claim 1 violated Article 123(2) EPC and that its subject-matter lacked an inventive step having regard to D3 and D6. Oral proceedings were conditionally requested.
- V. In response to the notice of appeal, the respondent (proprietor) argued that the appeal should be rejected

(main request). Further, the Board was requested to consider an alternative formulation of claim 1 (auxiliary request). Oral proceedings were conditionally requested.

- VI. The parties were summoned by the Board to oral proceedings. In a communication accompanying the summons, the Board gave a preliminary opinion.
- VII. In response to the Board's communication, the respondent filed a new main request and three new auxiliary requests.
- VIII. Oral proceedings were held on 13 July 2004 during which the respondent withdrew all existing requests and filed an amended independent claim 1, which reads as follows:

"1. A receiving frequency selecting method for a RDS receiver comprising the steps of:

receiving RDS broadcast waves including a list of alternative frequencies data (AF) for a group of broadcasting stations (A-E) in the same broadcasting network and program identification codes (PI);

storing in a memory of the RDS receiver a list of alternative frequencies data for previously received broadcasting stations;

storing a list of alternative frequencies data transmitted by the currently received broadcasting station (A-E) in addition to the stored list of alternative frequencies data for previously received broadcasting stations to create a new list of alternative frequencies data;

chasing the same broadcast program by varying a receiving frequency of the RDS receiver to a frequency

that corresponds to one of the list of alternative frequencies data (AF) for currently and previously received broadcasting stations (A-E) characterised in that

said chasing step occurs in order to maintain a receiving signal level at or above a prescribed receiving signal level or that of the broadcasting station presently in contact, and

that said new list includes a count value associated with each alternative frequency (AF), the method including the step of adding one count uniformly to said count value every time the alternative frequencies data are renewed through the operation of chasing the same broadcast program and of setting the count value to zero for each of the alternative frequencies of the currently recieved [sic] broadcasting station, to designate an old and new history of the alternative frequencies data, whereby the larger the count values are the older the alternative frequencies data are."

The respondent requested that the appeal be dismissed and that the patent be maintained on the basis of claim 1 above and dependent claims 2 to 5 as in the decision under appeal and of an amended description.

- IX. With respect to the respondent's single request as filed during the oral proceedings the appellant argued that claim 1 contravened Article 84 EPC and that its subject-matter lacked an inventive step having regard to D3. Further, the appellant argued that, if the Board were to decide to maintain the patent on the basis of this claim, it would put the opponent and sole appellant in a worse position than under the impugned

decision, which was contrary to the principle of the prohibition of *reformatio in peius*.

The appellant requested that the impugned decision be set aside and that the patent be revoked.

- X. At the end of the oral proceedings the chairman announced the Board's decision.

Reasons for the Decision

1. *Amendments (Article 123 EPC)*

- 1.1 Claim 1 is based on claim 1 as originally filed, *inter alia* amended by the introduction of features based on page 4, lines 47 to 49 and page 5, lines 28 to 29 and 56 to 58 (reference is made to the application as published), these features concerning the storage of previously received alternative frequencies and the definition of the memory as part of the RDS receiver. The claim has further been restricted by the introduction of features based on Figures 5 and 7A and the corresponding passage on page 6, lines 1 to 13 of the application as published and relating to count values associated with the stored alternative frequencies.
- 1.2 At the oral proceedings the appellant did not raise objections under Article 123(2) EPC with respect to present claim 1. The objection under Article 123(2) EPC raised in the statement of grounds of appeal does not apply to present claim 1, since it does not include the wording in question. Further, issues under

Article 123(2) EPC mentioned in the Board's communication have been satisfactorily dealt with by amendment.

1.3 The Board is thus satisfied that claim 1 does not contain subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC).

1.4 As compared to claim 1 as granted, present claim 1 additionally includes the feature that the memory is part of the RDS receiver as well as features relating to the count values. Although features from the preamble and characterizing portion have been combined and/or reworded, in the Board's view none of the features of claim 1 as granted has been deleted without adequate replacement.

1.5 Consequently, the Board is satisfied that claim 1 of the patent has not been amended in such a way as to extend the protection conferred (Article 123(3) EPC).

2. *Reformatio in peius*

2.1 At the oral proceedings the appellant submitted that in present claim 1 the count value merely indicated that the larger the count value, the older the associated alternative frequency was. This was said to be an indication in relative terms. It no longer indicated **when** the associated alternative frequency was received, *i.e.* in absolute terms, as was implied by the wording in the amended claim 1 according to the impugned decision, which stated that the count value was changed "to indicate how recently the associated alternative frequency was received". If the Board were to decide to

maintain the patent on the basis of present claim 1, it would put the opponent and sole appellant in a worse position than under the impugned decision, since the scope of the claim was broader than that of the claim accepted by the Opposition Division, thereby violating the principle of the prohibition of *reformatio in peius*.

- 2.2 The Board cannot follow this argument for the following reasons. The deleted feature of "changing said count value to indicate how recently the associated alternative frequency was received" was replaced by other features concerning the count values. More specifically, whereas the deleted feature was open to different interpretations, e.g. that the count value indicated at which point in time the associated alternative frequency was received or at which chasing operation the alternative frequency was received, the present claim specifically defines when the count value is changed and what the value represents: one count is added to each of the count values "every time the alternative frequencies are renewed through the operation of chasing the same broadcast program" and the count values for each of the alternative frequencies of the currently received broadcasting station are set to zero, whereby "the larger the count values are the older the alternative frequencies data are". In other words, the larger the count value, the more renewals of alternative frequencies data through the chasing operation have occurred since the associated alternative frequency was received for the last time. This is a more specific indication of how recently the alternative frequency was received, thereby limiting the scope of the claim as compared to claim 1 according to the impugned decision.

2.3 Consequently, the amendment did not put the appellant in a worse position than under the impugned decision and, hence, the principle of the prohibition of *reformatio in peius* has not been contravened.

2.4 Even if for the sake of argument it were assumed that the amendment of claim 1 led to an extension of the scope beyond that of the claims held allowable in the decision under appeal, the Board notes that in accordance with G 1/99 (OJ EPO 2001, 381, point 15) an exception to the principle of the obligation to reject an amended claim, which would otherwise have put the opponent and sole appellant in a worse situation than if it had not appealed, may be made in order to meet an objection put forward by the opponent/appellant during the appeal proceedings, in circumstances where the patent as found by the Opposition Division to comply with the EPC would otherwise have to be revoked as a direct consequence of an unallowable amendment held allowable by the Opposition Division in its interlocutory decision. In the present case, in the Board's view, the deleted feature did not comply with Article 123(2) EPC, as was also argued by the appellant. Hence, the above-mentioned circumstances would have applied to the present case and would thus have permitted the exception.

3. *Clarity (Article 84 EPC)*

3.1 At the oral proceedings the appellant argued that the word "uniformly" introduced in claim 1 rendered the claim unclear, since it did not have a well-defined meaning. It was also unclear whether "every time the

alternative frequencies data are renewed" related to the event of changing the received frequency of the same program or of selecting a different program.

3.2 On reading the claim as a whole, the expression "uniformly" is understood by the Board as to indicate that the step of adding one count to the count value is applied to **each** of the count values associated with the alternative frequencies stored in the new list. This understanding is supported by the description (see page 5, lines 2 to 4, and Figure 7A of the patent as published). Hence, the expression "uniformly" does not render claim 1 unclear. The same applies to the wording "every time the alternative frequencies data are renewed", since it is immediately followed by the wording "through the operation of chasing the same broadcast program", rendering it clear that the count values are incremented by one count after every chasing operation that resulted in a retuning of the radio to another broadcasting station within the group of broadcasting stations.

3.3 The appellant further argued that the feature of setting the count value to zero for each of the alternative frequencies of the currently received broadcasting station as introduced in present claim 1 contradicts the counter values as shown in Figure 7A. However, as follows from the passage in the description concerning Figure 7A (page 4, last line, to page 5, line 2 of the patent as published), Table 1 and the corresponding text on page 2, lines 41 to 45, the currently received alternative frequencies in the service area of station E are f_b , f_d , f_v and f_w , and for

each of these frequencies the count value is set to zero, which is as illustrated in Figure 7A.

3.4 A further objection raised by the appellant concerning a lack of clarity arising from an alleged contradiction between the preamble and the characterizing portion as to the number of stored lists is inadmissible, since it does not arise out of the amendments made (following T 301/87 (OJ EPO 1990, 335, point 3.8)).

3.5 The Board thus does not consider valid the appellant's objections under Article 84 EPC.

4. *Inventive step*

4.1 It was common ground between the parties that the receiving frequency selecting method according to both claim 1 and D3 was based on a radio data system in which alternative frequencies (AF) data for currently and previously received broadcasting stations were stored in a memory together with count values for each of the alternative frequencies.

4.2 More specifically, according to the method disclosed in D3, through the operation of chasing the same program, the count value of a specific alternative frequency stored in the working memory 21 (Figure 1) is incremented each time the radio is retuned to another station which broadcasts the same program, **provided that** the specific alternative frequency is also found in the list of the alternative frequencies transmitted by that station (D3, column 2, lines 30 to 39). Newly received alternative frequencies are stored with their corresponding count values set to 1 (column 2, lines 39

to 40). Hence, the count values each indicate the number of times the associated stored alternative frequency has so far, *i.e.* after every chasing operation, been found in the AF-lists of the received stations; the higher the count value the more often the alternative frequency was found in these successively received AF-lists.

4.3 The method according to present claim 1 particularly differs from the method according to D3 by the step of adding one count to each of the stored count values every time the alternative frequencies data are renewed through the operation of chasing the same broadcast program and of setting the count value to zero for each of the alternative frequencies of the currently received broadcasting station. Hence, the larger the count value the more renewals of AF data through the chasing operation have occurred since the associated alternative frequency was received for the last time.

4.4 In both methods, the count values constitute weight factors for the associated alternative frequencies and may, for example, be used in order to determine which of the stored alternative frequencies is to be deleted first when account is to be taken of the limited memory capacity (see D3, column 2, line 51 to column 3, line 9, and the patent specification, page 5, lines 12 to 15). As compared to the method according to D3, due to the different counting steps, the claimed method provides an alternative weighting of the stored alternative frequencies. D3 does not hint at any alternative weighting of the stored alternative frequencies.

- 4.5 At the oral proceedings the appellant argued that in the method according to D3 each time the received frequency was changed, each of the count values in memory 21 was incremented by one, which was equal to the adding step according to claim 1.
- 4.6 The Board cannot follow this argument. In D3, not all of the stored count values are incremented, as required in present claim 1, but only those which are also found in the AF-list of the currently received station (see point 4.2). The other count values are not incremented and, in the Board's view, there is no suggestion in D3 to do so.
- 4.7 The appellant further argued that according to the method of D3, in practice, frequent travelling between the service areas of two broadcasting stations automatically resulted in the count values associated with alternative frequencies of a third service area visited a long time ago to be the lowest and, therefore, its associated AF-data to be the oldest ones. Hence, like in the claimed method, the count values provided an indication of how old the AF-data are. Furthermore, these oldest AF-data would be the first ones to be deleted when their corresponding count values reached the value zero after having selected another program as described in D3 (column 2, lines 51 to 59). This was also in line with the well-known general principle of deleting the oldest entries in a memory first (first-in-first-out principle).
- 4.8 The Board however notes that whereas in the above case the lower the count values the older the AF-data are, the claimed method requires the opposite: the larger

the count values the older the data. Further, according to the claimed method the setting to zero concerns the count values of the alternative frequencies of the **currently** received broadcasting station, whereas according to D3 the count values of these alternative frequencies are either incremented by one or, if the associated alternative frequency had not been registered before, given the value 1 (see point 4.2). In the method according to D3 the count values associated with the stored alternative frequencies of the currently received broadcasting station are never all set to zero, since any alternative frequency having a corresponding count value equal to zero is deleted (D3, column 2, lines 51 to 59). Further, whether or not the same principle is followed when deleting AF-data in the patent in suit is not relevant here, since the claimed method does not include any steps relating to the deletion of AF-data.

- 4.9 In the statement of grounds of appeal the appellant additionally referred to D6, which discloses an RDS receiver in which a list of alternative frequencies is stored in the order of distance to the broadcasting station which is currently received (column 7, lines 32 to 41 and Figure 7). After each successful chasing, the AF-list is overwritten by the alternative frequencies transmitted by the newly received station broadcasting the same program (column 7, lines 60 to 66 and column 8, line 57, to column 9, line 3). Hence, there is no suggestion to keep previously received alternative frequencies or to maintain, in any way, count values associated with the alternative frequencies.

4.10 Consequently, the appellant's objections under Article 56 EPC to present claim 1 are not convincing.

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 on the basis of:
 - claim 1 as submitted during the oral proceedings;
claims 2 to 5 as submitted on 8 March 2001;
 - description pages 2 to 4 and 6 as filed on 8 March 2001 with insert as filed during the oral proceedings on page 3, line 45; page 5 as granted;
and
 - drawings as granted.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland