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**D E C I S I O N**  
**of 25 June 2004**

**Case Number:** T 0861/02 - 3.5.1

**Application Number:** 95300304.3

**Publication Number:** 0664646

**IPC:** H04N 5/926

**Language of the proceedings:** EN

**Title of invention:**

Digital video and audio signal recording and/or reproducing devices

**Applicant:**

SONY CORPORATION

**Opponent:**

-

**Headword:**

Recording devices/SONY

**Relevant legal provisions:**

EPC R. 67, 68(2)

**Keyword:**

"Decision reasoned (no)"

"Decision on the file as it stands"

"Substantial procedural violation (yes)"

**Decisions cited:**

T 0897/03

**Catchword:**

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Case Number: T 0861/02 - 3.5.1

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

**Appellant:**

SONY CORPORATION  
7-35, Kitashinagawa 6-chome  
Shinagawa-ku  
Tokyo (JP)

**Representative:**

Cotter, Ivan John et al.  
D. YOUNG & CO.  
21 New Fetter Lane  
London EC4A 1DA (GB)

**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 15 March 2002  
refusing European application No. 95300304.3  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

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

## Summary of Facts and Submissions

I. The appeal is against the decision of the examining division to refuse European patent application No 95300304.3.

II. Claims 1 to 3 as originally filed (out of a set of 13 claims) read:

"1. A digital video and audio signal recording and/or reproducing device comprising:

a recording format having a first recording area for recording a coded video signal, a second recording area for recording a coded audio signal, and a third recording area for recording an audio associated data constructed in pack form;

means for coding the video signal and recording it in said first recording area;

means for coding the audio signal and recording it in said second recording area;

means for forming in pack the audio-associated information inserted in a vertical blanking period of said video signal and recording it in said third recording area;

means for reproducing the coded video signal from said first recording area and decoding the video signal;

means for reproducing the coded audio signal from said second recording area and decoding the audio signal; and

means for reproducing the audio-associated information formed in pack from said third recording area and reading out said associated information.

2. A digital video and audio signal recording and/or reproducing device according to Claim 1, wherein the third recording area has a major zone and a sub-zone, records the audio-associated information in the sub-zone of said third recording area and said audio-associated information having a high degree of importance is recorded in the main zone in said third recording area.

3. A digital video and audio signal recording and/or reproducing device according to Claim 2, wherein when the content of the sub-zone can be understood during a reproducing operation, the associated information in said sub zone is superposed on the vertical blanking period of the video signal and in turn when the content in the sub-zone can not be understood, only the associated information in the major zone having a high degree of importance is superposed on the vertical blanking period of the video signal."

III. On the basis of the claims as originally filed the examining division issued a first communication on 15 May 1998. Objections under Article 84 EPC (clarity) were raised *inter alia* against claims 1 to 3. According to the examining division, in claim 2 the expression "having a high degree of importance" was obscure, in claim 3 the expression "understood". Furthermore, the subject-matter of claim 1 was not new or at least did not involve an inventive step over D1 (EP-A-0 574 892). As to the dependent claims (including claims 2 and 3) it was stated (at point III.4) that their subject-matter did "not appear to add anything new (Article 54 EPC) or inventive (Article 56 EPC) to the claims on which they depend".

IV. By letter dated 25 February 1999, the appellants filed a new set of amended claims 1 to 11 intended to overcome the objections raised.

V. Claim 1 of 25 February 1999 (excluding the reference signs) reads:

1. A digital video and audio signal recording and reproducing device for recording on and reproducing from a recording medium having a recording format with a first recording area for recording a coded video signal, a second recording area for recording a coded audio signal, and a third recording area for recording associated data, the device comprising:

means for coding the video signal and recording it in said first recording area;

means for coding the audio signal and recording it in said second recording area;

means for recording associated information inserted in a vertical blanking period of said video signal in said third recording area;

means for reproducing the coded video signal from said first recording area and decoding the video signal;

means for reproducing the coded audio signal from said second recording area and decoding the audio signal; and

means for reproducing the associated information from said third recording area and reading out said associated information;

characterised in that:

the associated data is audio-associated data constructed in packs, each pack having a predetermined length;

the device includes means for forming audio-associated information from the vertical blanking interval into said packs for recording in said third recording area; and

said second recording area and said third recording area are both within an overall audio area in between pre-sync and post-sync areas.

- VI. On 14 September 1999, the examining division issued a second communication, which dealt only with claim 1. Stating that "some deficiencies still remain", the examining division raised new objections concerning the clarity of claim 1 (with respect to the expressions "pre-sync" and "post-sync areas"). The subject-matter of claim 1 was still found to be obvious in respect of D1.
- VII. Amended claims 1 to 11 were filed with a letter of 14 March 2000. Following this, the examining division summoned the appellants to oral proceedings. In the annex to the summons, dated 11 July 2001, it was stated that the appellants should expect a refusal of the application and drew their attention "to the possibility to request an appealable decision according to the state of the file". The examining division might "make use of its discretion under Rule 86(3) EPC not to accept any further amendments to the application documents". Nothing was said about the merits of the invention.
- VIII. By letter dated 13 November 2001, the appellants filed a new set of claims. Claim 1 formed the basis for the main request, claim 2 for the auxiliary request.

Claims 1 and 2 read (excluding reference signs):

1. [Preamble as of 25 February 1999]

characterised in that:

the associated data is video-associated and/or audio-associated data constructed in packs, each pack having a predetermined length;

the device has means for forming video-associated and/or audio-associated information from the vertical blanking period into said packs for recording in said third recording area;

said third recording area is arranged before said first recording area or said second recording area and forms a header area;

said second recording area and said third recording area are both within an overall video or audio area; and

said third recording area has a main zone and a sub-zone, and wherein audio-associated information significant for correct operation of the device is recorded in the main zone in said third recording area.

2. A digital video and audio signal recording and reproducing device according to Claim 1, wherein when the content of the sub-zone can be read during a reproducing operation, the associated information in said sub-zone is superposed on the vertical blanking period of the video signal, whereas when the content in the sub-zone cannot be read, only the associated information in the main zone is superposed on the vertical blanking period of the video signal.

- IX. It was pointed out in the accompanying statement that claim 1 had been "amended by the inclusion of the subject-matter of previous claim 2, thereby specifying that the third recording area has a main zone and a sub-zone... This represents a further advantageous distinction over prior art...", followed by an explanation of the new technical effects achieved by these means.
- X. By letter dated 16 November 2001, the appellants withdrew their request for oral proceedings. An appealable decision was requested on the basis of the preceding submission. In the alternative, the examination should be reopened.
- XI. On 21 November 2001 the oral proceedings were cancelled.
- XII. The decision to refuse the application was issued on 15 March 2002. The complete grounds for the decision read:

"In the communications dated 15.05.1998, 14.09.1999 and 20.06.2001 /sic/ the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed comments and two requests by a letter dated 13.11.2001. In the main request, claim 1 was amended so as to include the subject matter of previous claim 2. As an auxiliary request, the applicant requested to consider a claim 1 being an effective combination of newly filed claims 1 and 2. It is thus apparent that these main and auxiliary requests



are strictly based on subject matter which has already been evaluated in the above mentioned communications. The applicant requested an appealable decision on the basis of the further submissions dated 13.11.2001 by a letter received in due time on 16.11.2001.

The European Patent application is therefore refused on the basis of Article 97(1) EPC."

XIII. In the statement setting out the grounds of appeal, the appellants requested that a patent be granted on new claims 1 to 10, which were said to correspond to the auxiliary request proposed in the letter of 13 November 2001. As an auxiliary measure, oral proceedings were requested.

XIV. By communication dated 14 October 2003, the Board expressed the opinion that the decision was not reasoned within the meaning of Rule 68(2) EPC. The appellants were invited to comment on the two alternatives open to the Board under Article 111(1) EPC, namely that the Board either examines the case itself or remits it to the examining division for further prosecution.

In reply, the appellants indicated that they would prefer the case to be remitted with reimbursement of the appeal fee. They moreover clarified that the claims filed with the grounds of appeal corresponded to the previous main (not auxiliary) request.

## Reasons for the Decision

1. The appellants' main request at the time the decision was taken was for grant of a patent on the basis of claim 1 as filed with the letter dated 13 November 2001. This claim had never been commented on by the examining division. The examining division's last detailed communication, dated 14 September 1999, was concerned with claim 1 in the version of 25 February 1999. Against this previous claim there had been clarity objections concerning the subsequently replaced expressions "pre-sync" and "post-sync areas" (cf point I of the communication), and an objection as to obviousness (cf point II of the communication). Because of the amendments made, the clarity objections against claim 1 (and also against claims 2 and 3 as originally filed) were effectively removed. It is therefore likely that the main objection against the final version of claim 1 was that its subject-matter was obvious with respect to D1. It is therefore assumed that the decision, which does not explicitly indicate which requirements of the EPC the patent application or the invention do not meet, concerns inventive step.
  
2. The final version of claim 1 of 13 November 2001 contained a number of features which were not present in claim 1 in the version of 25 February 1999. In particular, its last feature - concerning the main and sub-zones of the third recording area - was based on claim 2 as originally filed. This feature had never been discussed in a communication. The appellants had argued in some detail that it represented an advantageous distinction over the prior art (cf point IX above). Therefore, a properly reasoned

- obviousness argument must take the feature into consideration. Since the decision under appeal does not, it is not reasoned within the meaning of Rule 68(2) EPC.
3. The examining division also refused the appellants' auxiliary request. Claim 1 of this request includes the subject-matter of claim 3 as originally filed. Also against this claim there had never been a reasoned objection as to inventive step. Therefore the argument outlined above as to the main request applies even more strongly to the auxiliary request.
  4. In accordance with the established jurisprudence of the boards of appeal, it follows that the case should be remitted to the examining division for further prosecution and that the appeal fee should be reimbursed under Rule 67 EPC by reason of the substantial violation of the stipulations of Rule 68(2) EPC.
  5. The Board observes that if the examining division in their decision had not merely referred to the previous communications but actually tried to puzzle together the various arguments on file, ie if the decision had been self-contained, they may have been in a better position to notice that some features of claim 1 had not previously been commented on. As Technical Board of Appeal 3.3.8 has stated in similar circumstances (T 897/03, not published in the OJ EPO):

"...due to the numerous objections raised with respect to different sets of claims and the partly inconsistent reasoning given in the communications referred to in the decision, the decisive reasons for the refusal remain unclear..." (point 5).

The "Guidelines for Examination in the European Patent Office" E-X, 4.4 explicitly allow a decision to consist of references to "previous communication(s)", "e.g. when all arguments have been sufficiently put forward in the proceedings". The Board notes that, whether or not this is good advice, Rule 68(2) EPC must always be complied with.

6. Since the appellants' request that the case be remitted with reimbursement of the appeal fee has been granted there is no need to hold oral proceedings before the Board in accordance with its auxiliary request.

**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 for further prosecution.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:

M. Kiehl

S. Steinbrener