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D E C I S I O N
of 17 May 2006

Case Number: T 0281/03 - 3.5.01

Application Number: 92100124.4

Publication Number: 0494624

IPC: H04N 7/087

Language of the proceedings: EN

Title of invention:

Method and receiver for teletext transmission

Patentee:

EDICO S.r.l.

Opponents:

Koninklijke Philips Electronics N.V.
Interessengemeinschaft für Rundfunkschutzrechte GmbH
Schutzrechtsverwertung & Co. KG

Headword:

Teletext transmission/EDICO

Relevant legal provisions:

EPC Art. 24(3)(4), 54, 113(1)
EPC R. 67

Keyword:

"Suspected partiality (no)"
"Novelty (yes)"
"Substantial procedural violation (yes)"
"Reimbursement of appeal fee (yes)"

Decisions cited:

T 0131/01

Catchword:

1. Delaying detailed substantiation of the ground of inventive step raised in the notice of opposition to the last moment of opposition proceedings should be avoided if possible since it creates an unexpected situation for the other parties and the opposition division.

2. However, in the special case where an inventive step argument is based on the same document as the novelty argument, and the novelty of the features in question cannot be answered with a simple yes or no, but depends on how the document is interpreted as a whole, it may be difficult if not impossible for an opponent to argue lack of inventive step without a precise statement of how the document is understood, and the features actually found to be different by the opposition division.

3. In order to guarantee the right to be heard (Article 113(1) EPC), there should in any case be an explicit step during oral proceedings, recorded in the minutes, giving an opponent an opportunity to comment on inventive step on the basis of the opposition division's finding with respect to novelty before deciding against the opponent.

(See points 13 to 15 of the reasons).



Case Number: T 0281/03 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 17 May 2006

Appellant: Interessengemeinschaft für
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Further party: Koninklijke Philips Electronics N.V.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 16 January 2003
rejecting the opposition filed against European
patent No. 0494624 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: S. Steinbrener
Members: W. Chandler
G. Weiss

Summary of Facts and Submissions

- I. This appeal is against the decision of the opposition division to reject the opposition against European patent No. 0 494 624.
- II. The opposition division reasoned that the back-group function disclosed in D1 (RUNDFUNKTECH. MITTEILUNGEN, vol. 31, no. 2, 1987, pages 83-94, G. Eitz et al.: "TOP - Ein Verfahren zur vereinfachten Anwahl von Fernsehtext-Tafeln durch den Zuschauer") would result in the display of a group page that had been viewed previously, and not the group index page of the page currently being viewed, as claimed (points 37 and 38 of the decision). Furthermore, D1 did not unambiguously disclose that the searching, acquiring and memorising of the relevant group index page was performed while the chosen page was displayed (point 40 of the decision). The subject-matter of claim 1 was therefore novel.
- III. The appellant (opponent 02) lodged an appeal against the decision and paid the prescribed fee. The respondent (proprietor) filed a response to the appeal. Opponent 01 withdrew its opposition and thereby ceased to be a party to the appeal proceedings.
- IV. In a letter received 29 September 2004, the respondent objected *inter alia* to the Chairman of the Board under Article 24(3) EPC because of suspected partiality. The Chairman was replaced by his alternate for examining the objection (Article 24(4) EPC), which was subsequently refused by decision of 18 March 2005.

- V. In a communication, dated 15 December 2005, the Board with the original Chairman set out the issues to be discussed at the oral proceedings. In a response, dated 28 February 2006, the respondent filed claims of a first to eleventh auxiliary request.
- VI. Oral proceedings, requested by both parties, were held on 30 March 2006. At the beginning of the oral proceedings, the Chairman summarised the facts relevant to the substantive part of the proceedings, and then asked the parties to confirm their requests. At this point, one of the respondent's representatives, Mr K, dictated the following objection (second partiality objection):

"The proprietor requests to refuse all members of the Appeal Chamber to suspected partiality.

Reasons:

In the proceedings of the appeal the proprietor has already filed the claim to refuse the members of the Appeal Chamber due to suspected partiality.

This previous claim has been filed by the letter dated 29 September 2004. This claim has been rejected by the decision of the EPO dated 5 September 2005. The doubts of the proprietor in the objectivity of the Board are continued.

In the introduction into the case made today by the Chairman Mr Steinbrener he ignored the part of the appeal proceedings relating to the rejected claim of suspected partiality.

This brings the proprietor to the impression that Mr Steinbrener has personal problems of referring to this part of this appeal proceedings.

In the interim communication dated 15 December 2005 the Board has introduced new prior art by saying the following: 'The Board notes that the idea of returning to the previous group index appears to be analogous to the return function in a standard menu system as found in a mobile telephone or a set-up arrangement in a television'.

The Board does not have presented any written document covering such general technical knowledge. Such citation of general technical knowledge without written proof is a procedural violation since according to the jurisdiction of the EPO substantiation of such allegation has to be made by written document, as can be seen for example from decision T 766/91 dated September 29, 1993.

The above mentioned violation of procedural rules brings the proprietor to the opinion that the Board does not have the necessary objectivity for a decision in this case. Such doubt in the objectivity has to be considered also in relation and in continuation to the previous doubts as expressed by the claim to refuse the members by request of 29 September 2004."

VII. While Mr K was dictating the above objection, another of the representatives, Mr G, made various loud remonstrations of disapproval towards the Board, including the expression "scandal".

VIII. The appellant considered that the second reason for this objection was not admissible under Article 24(3) EPC, second sentence, because the respondent had taken a procedural step, i.e. replied to the communication,

after being aware of the reason. The Board considered that the objection as a whole was admissible, and announced that the members were to be replaced by their alternates to decide on it. In reply, Mr G commented that these alternates were no doubt to be "special friends" of the Chairman.

IX. The Board in the alternate composition refused the objection by decision of the same date as the oral proceedings. The Board in its original composition then attempted to continue the oral proceedings, but was again interrupted by further aggressive comments from Mr K and Mr G, including an accusation from Mr G that the Chairman was bent on a revenge campaign against the respondent. After the Chairman reminded Mr G of Point 6 of the Code of Conduct of the Institute of Professional Representatives before the European Patent Office, and indicated that the oral proceedings would have to be adjourned under these circumstances, the representatives calmed down and the proceedings ran smoothly from that point on.

X. The Chairman again asked the parties for their requests.

The appellant maintained the request that the decision under appeal be set aside and that the patent be revoked. The appellant also requested reimbursement of the appeal fee on the grounds that the opposition division had committed a substantial procedural violation during the first instance proceedings.

The respondent formulated the following requests:

1. "In case that the Board of Appeal will not prove the existence of the prior art alleged in the interim communication dated Dec. 15, 2005 on page 5 chapter 11 it is requested to refuse the members of the Board due to a violation of Art. 113(1) EPC."

2. "The Enlarged Board of Appeal is presented the following case for a decision:

'Is it allowable according to the European Patent Convention (EPC) - in particular under consideration of Art Art. (sic) 113 (1) EPC - to base a decision on an assumption which is not proved by documents on file?'

The Board of Appeal in its Interim Communication dated 15 December 2006 on page 5, 11. is making the following statement:

'The Board notes that the idea of returning to the previous group index appears to be analogous to the return function in a standard manual, as found in a mobile telephone, or a set up arrangement in a television.'

The patent in dispute refers to a priority date of 7 January 1991.

In the proceedings there is no prior art disclosing any return function of mobile telephones or set-up arrangements in the television in the year 1991. Thus, the patent proprietor has to fear that the Board will base its decision on technical assumptions (see statement above) which are not substantiated by prior art documents which have been introduced into the file."

3. The appeal be dismissed, or in the alternative, that the decision under appeal be set aside and the patent be maintained in amended form in accordance with one of the auxiliary requests filed with the letter received on 28 February 2006.

XI. At the end of the oral proceedings, the Chairman declared that the debate was closed and that the decision would be given in writing.

XII. Claim 1 as granted reads as follows:

"Method for receiving teletext transmissions in the form of a plurality of pages inserted in the television signal and divided and (sic) into groups, for each of which a group index page (201) is available and for immediately displaying upon user's request the group index page (201) to which a chosen page (229) belongs, said displaying being obtained by:

- storing in a memory a table of all the teletext page numbers transmitted in a cycle;
- searching in said memorized table for identifying the number of said group index page (201) to which a chosen page (229) belongs;
- acquiring said group index page (201) whose number has been identified;
- memorizing said acquired group index page (201);
- said searching, acquiring and memorizing being performed while the chosen page (229) is displayed."

The first to tenth auxiliary requests add to claim 1 of the main request various combinations of granted claims 2 to 5. Claim 1 of the eleventh auxiliary request adds to claim 1 of the main request that "said

group index page (201) is displayed after a specific key (G), which is realized on a remote control device (50), has been depressed."

XIII. The appellant argued as follows:

In terms of the example in Figure 1 at page 86 of D1, there were various possibilities ("Möglichkeiten", M) for what would be displayed if, starting from page 122: "Wetter morgen", the "Zurück-Taste" (back) and "Gruppen-Taste" (group) were pressed together:

M1: The group index page of the present group, namely page 120: "Übersicht: Wetter", as claimed.

M2: A previously viewed group index page.

M3: The group index page of the previous group, namely page 115: "Lotto".

M4: The group index page of a previously viewed group.

D1 clearly disclosed possibility M1. This was because the passage at page 92, left column, lines 9 to 17 stated that the back functions operated analogously to the forward functions. Since, as explained at page 85, right column, lines 5 to 7, the forward-group function led to the next group index page in the cycle of pages, the analogous back function would have led to the previous group index page in the cycle of pages, as claimed.

None of the other possibilities operated analogously to the forward functions as required by D1, nor made any sense.

Given that the operation of the back-group function was as claimed, D1 also disclosed the last three features

of the claim. Firstly, acquiring and memorising the identified group index page were implicit. Secondly, doing this while the previous page was displayed, was implicit from the passage at page 85, end of paragraph 3.2, which stated that the receiver was in a position to memorise related pages for probable recall while the viewer was still watching the last selected page.

In the oral proceedings the opposition division had deliberated and announced the decision that claim 1 was new, and then immediately announced the decision to reject the oppositions. The reasons given for this were that opponent 02 had not substantiated the objection of lack of inventive step, and that such an objection was not prima facie apparent (points 48 to 51 of the decision). The fact that the opponent was not given the opportunity to discuss inventive step either before or after the final deliberation was a substantial procedural violation that justified the refund of the appeal fee. The opponent had raised the ground of lack of inventive step in the notice of opposition and stated that if claim 1 were new then it would not involve an inventive step. Moreover, the opponent had explicitly asked the opposition division, at point 4 of the reply to the summons to the oral proceedings, to indicate which features they considered to be novel so that he could show that they did not involve an inventive step. This course of action was supported by T 131/01 - Fresh ground for opposition / MATHER SEAL COMPANY (OJ EPO 2003, 115), which stated at point 3.1 that an opponent who based his opposition on lack of novelty was not in a position to, and thus did not immediately need to argue on lack of inventive step over the same prior art without contradicting the

assertion that there was no difference. In fact, in that case inventive step was actually discussed, but the opposition division did not admit the ground, whereas in the present case, the opposition division did not even give the opponent the chance to discuss inventive step.

XIV. The respondent argued as follows:

The passage in D1 that stated that the back functions operated analogously to the forward functions meant exactly what it said. Thus the back-group function would navigate back to the previous group; starting from page 122: "Wetter morgen", it would lead to group index page 115: "Lotto", i.e. possibility M3. It was well known that the TOP system kept pointers to the current page, group and block. When the back-group function was carried out, the receiver would be able to decide the previous group from the group pointer.

Even if the back-group function operated in the way suggested by the appellant, this was not exactly equivalent to the claimed function. The difference occurred in the case that the current page was a group index page. Since the forward-group function would search the TOP table for the next group index page, the respondent's interpretation meant that the back-group function would search the TOP table for the previous group index page. Claim 1, however, specified displaying "the group index page to which a chosen page belongs". In the case that a group index page was the chosen page, the system would remain on this page because it belonged, by definition, to its own group.

Regarding the right to be heard on inventive step, opponent 02 had been in no way prevented from presenting arguments on inventive step and could have based them on the preliminary opinion of the opposition division, which indicated the features that it did not consider to be disclosed in D1.

Reasons for the Decision

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

Admissibility of the second partiality objection

2. The Board has some doubts that the failure to mention the previous partiality objection in the Chairman's summary at the beginning of the oral proceedings was an admissible reason for suspected partiality; one could imagine a similar objection in the converse case if the previous objection of partiality *had* been mentioned since it would not have been relevant to the substantive part of the proceedings. The Board nevertheless considered at least this reason to go beyond the formal requirements implied by Article 24(3) EPC, and thus need some substantive consideration. The Board therefore judged that the objection as a whole was admissible, so that the members concerned had to be replaced by their alternates.

Admissibility of the third partiality objection

3. The Board finds the various interruptions from the respondent's representatives, in particular Mr G, totally unacceptable, both from a procedural and a factual point of view. Nevertheless, in view of the fact that they ceased after a warning from the Chairman, the proceedings could resume on a sensible and fair basis, enabling the Board to understand and judge the arguments presented by the parties.

The Board can interpret the sentiment of the remarks together with the subsequent request "to refuse the members of the Board due to a violation of Article 113(1) EPC" as another objection of suspected partiality under Article 24 EPC since no other mechanism exists to remove members from a Board. However, the reason for this objection is essentially the same as that already decided by the replacement Board in connection with the second partiality objection. Since the new objection was made directly upon the resumption of the oral proceedings after the respondent's previous objection to partiality was refused, no new reason for objection can exist, so that the objection is simply a repeat of the previous objection and amounts to an abuse of the proceedings. Hence, the Board judges that this request is inadmissible.

Question for referral to the Enlarged Board

4. The respondent's question for referral to the Enlarged Board of Appeal asks whether it is allowable to base a decision on an assumption which is not proved by

documents on file. The Board judges this is a question of fact to be decided on a case by case basis, and not a question of law, as required by Article 112(1) EPC. In any case, the question is not relevant to the present appeal because no such decision has been taken. This request is therefore refused.

Novelty of claim 1 as granted

5. The patent relates to the TOP (table of pages) teletext system, which provides functions for navigating through the teletext pages. It is common ground that the standard TOP system provides "forward" navigation functions that operate as disclosed in D1 in Figure 1 and the associated text. These are the "next page" (to go to the next page, usually having similar content), "next group" (to go to the next group index page, having related content) or "next block" (to go to the next block overview page, having different content).

6. The dispute is whether the back-group function, resulting from pressing a back key in combination with the next group key described at page 92, left column, line 9 to 17 of D1, falls under the claimed feature of returning to the group index page to which the current page belongs. In particular, by searching through the TOP table (feature b) in the decision and grounds of appeal).
It is also disputed whether this group index page is searched, acquired and memorised in advance while the chosen page is displayed (feature e)).

7. Starting with the latter point (feature e), the Board agrees with the opposition division that D1 does not unambiguously disclose that the searching, acquiring and memorising of the relevant group index page is performed while the chosen page is displayed. As stated by the opposition division at point 40 of the decision, the passage cited by the appellant only states that pages that will *probably* be selected are stored. This falls short of being an unambiguous disclosure, required by Article 54 EPC, that the relevant group index page will be stored.

8. Similarly, the Board judges that D1 does not unambiguously disclose either the appellant's or the respondent's interpretation of the operation of the back-group function (possibility M1 and M3, respectively). The fact that the back-group function is said to operate "analogously" to the forward-group function is a rather loose expression. It could relate to an analogous operation at a functional level, in which case, going back would indeed go back to the previous group as argued by the respondent. On the other hand, it could relate to an analogous implementation of the function, in which case it would work as described by the appellant and go back to the index page of the current group. Since no other basis was put forward for the interpretation of the operation of the back function, the Board judges that one is forced to speculate which interpretation is correct, so that there is no unambiguous disclosure how the function actually operates.

9. The Board also disagrees with the opposition division's interpretation of D1, according to which the back-group function in D1 must inevitably result in correction of a viewer's input error, and would therefore cause the system to go back to a group page that has already been viewed (possibility M2). Apart from the fact that, as pointed out by the appellant, this possibility would not operate in analogy with the forward-group function, the Board judges that it also does not follow from the description in D1. The back functions are described as an improvement over existing arrangements to return to a previous page after an error. In other words, after an error the user would only have to navigate forward from a previous group index page or block overview page instead of all the way back from index page 100. However, there is no disclosure that the back functions should actually return to any pages actually viewed and one is again forced to speculate that this is the case. Moreover, the possibility of returning to previously viewed pages is specifically dealt with in the next paragraph in the form of a return ("Zurück wie gekommen") function, for which only a single key would be required anyway.
10. Finally, even if the back-group function operates in the way suggested by the appellant, the Board agrees with the respondent (see point XIV, above) that this is not exactly equivalent to the claimed function. Starting from a group index page the respondent's interpretation would go to the previous group index page, whereas the claimed function would remain where it is.

11. The Board therefore judges that the subject-matter of claim 1 as granted is novel (Article 54 EPC), and differs from D1 by:

(i) displaying upon a user's request the group index page to which a chosen page belongs by searching in the memorized table, and

(ii) searching, acquiring and memorizing the group index page being performed while the chosen page is displayed.

Substantial procedural violation

12. There is no dispute about the facts concerning this aspect of the proceedings. The appellant raised the ground of lack of inventive step in the notice of opposition and stated that if the subject-matter of claim 1 were new then it would not involve an inventive step. He also asked the opposition division in reply to the summons to oral proceedings, to indicate which features they considered to be novel so that he could show that they did not involve an inventive step. Although the opposition division had given in the summons a provisional opinion on the differences that it saw, it is apparent from the minutes of the oral proceedings that this was not repeated and that inventive step was not discussed. After deliberating and announcing the decision in the oral proceedings that the subject-matter of claim 1 was new, the division immediately announced the decision to reject the oppositions.

13. The question is therefore whether the appellant had "had an opportunity" to present his comments as

required by Article 113 EPC. The appellant invokes decision T 131/01, which indeed supports the contention that an opponent who bases his opposition on lack of novelty is not in a position to, and thus need not immediately, argue on lack of inventive step over the same prior art without contradicting the assertion that there is no difference (see point 3.1). However, the Board judges that, irrespective of the particular problem arising from the transition from novelty to inventive step (see points 14 and 15, below), the above facts alone constitute a substantial procedural violation. This is because it is a well established principle that the "opportunity" to present comments is meant to ensure, as the Case Law of the Boards of Appeal of the European Patent Office, 4th edition 2001, section VI.B. "Right to be heard", 1. "Introduction" puts it, that "no party is caught unawares by reasons given in a decision turning down his request on which he has not had the opportunity to comment." In the present case, it is apparent from the above-mentioned facts that the appellant wanted to comment on inventive step if novelty was established, and would therefore have been surprised by the immediate rejection of the opposition after the decision on novelty. It is therefore not relevant that the appellant *could* have commented on inventive step earlier as argued by the respondent. Nor is it relevant that "it would have been possible for opponent II to substantiate an objection ..." as stated at point 50 of the decision. The Board judges that, in order to guarantee the right to be heard, there should have been an explicit step, recorded in the minutes, giving opponent 02 an opportunity to comment on inventive step before the final deliberation, or alternatively an opportunity

after the deliberation to comment on the opposition division's conclusion that such an objection was not prima facie apparent. The fact that before the final deliberation "the floor was given to the opponent again" or that the opponent made a "last submission", reported at point 6 of the minutes, is not enough to meet this requirement, regardless of whether an experienced representative might have perceived a certain risk of an imminent final decision.

14. Regarding reimbursement of the appeal fee, it is apparent that the appellant's appeal is at least in part caused by the substantial procedural violation, and hence would be equitable within the meaning of Rule 67 EPC. However, it must also be determined whether the appellant had contributed to the particular problem by continually delaying his case on inventive step until the last possible moment.

On the one hand, in the Board's view, delaying an important element of substantiation of an opposition or appeal to the last moment is undesirable and should be avoided if possible since it creates an unexpected situation for the other parties and the division or board. Indeed, in appeal proceedings such a situation could be governed by Article 10a(2) of the Rules of Procedure of the Boards of Appeal, which states that the grounds of appeal should specify expressly all the facts, arguments and evidence relied on. Article 10b(1) states that the Board has a discretion to allow any subsequent amendments to a party's case.

Furthermore, in the present case, the opposition division did state at points 6.1 and 6.2 of the summons

to oral proceedings its provisional interpretation of D1 and the features of claim 1 that were not thought to be disclosed in D1. The Board therefore does not understand the appellant's request after this summons to indicate which features were considered to be novel so that he could show that they did not involve an inventive step. It appears to the Board that it would have been a sensible precaution to have provided at least one argument based on this provisional opinion since this represented at least one specific possibility for the final decision.

15. However, the present case is special not just in that the inventive step argument is based on the same document as the novelty argument, but that the novelty of the features in question cannot be answered with a simple yes or no, but depends on how D1 is interpreted as a whole as can be seen from the above analysis. Indeed the Board's conclusion is different from that of the appellant, the respondent and the opposition division. Thus, the Board sympathises with the appellant that in such a case it is difficult if not impossible to argue why claim 1 might lack an inventive step. This is particularly so if the problem-solution approach is to be used, which requires a precise statement of the differences in order to formulate the correct technical problem. It does not seem to the Board efficient to expect an opponent to provide a multitude of speculative arguments covering each possibility, nor does it seem sensible to place a formal requirement to provide at least one argument, which may turn out to be completely wrong.

16. Thus considering all the circumstances of the case, the Board judges that not providing an argument against inventive step in the present case does not detract from the fact that equity requires an order for reimbursement of the appeal fee (Rule 67 EPC).

17. The Board notes in conclusion that, whilst not going as far as saying an opponent is entitled to demand an exact statement of the differences from the division or board, some direction for the opponent would be helpful in particular cases (as provided in this case by the opposition division in the provisional opinion), especially if the view differs from that presented by the parties. Similarly, the opponent would be generally best advised to provide a provisional argument based on this information. Moreover, these arguments and the demarcation between the discussion of novelty and inventive step should be clear and minuted at the oral proceedings to avoid misunderstandings and procedural difficulties.

18. Article 10 of the Rules of Procedure of the Boards of Appeal requires the Board to remit a case to the first instance if it finds fundamental deficiencies in the first instance proceedings unless special reasons exist for doing otherwise. In the present case, the substantial procedural violation clearly amounts to a fundamental deficiency - the oppositions were rejected without any discussion of inventive step. No reason was advanced as to why remittal would not be appropriate.

Order

For these reasons it is decided that:

1. The conditional request to refuse the members of the Board due to a violation of Article 113(1) EPC is inadmissible.
2. The request for referral to the Enlarged Board of Appeal of the question presented at the oral proceedings is refused.
3. The decision under appeal is set aside.
4. The case is remitted to the first instance for further prosecution.
5. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

P. Guidi

S. Steinbrener