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**Datasheet for the decision
of 15 June 2007**

Case Number: T 0411/04 - 3.5.04

Application Number: 97106458.9

Publication Number: 0802673

IPC: H04N 5/445

Language of the proceedings: EN

Title of invention:

Broadcasting and communication receiver apparatus

Patentee:

Hitachi, Ltd.

Opponent:

IGR GmbH & Co. KG

Headword:

-

Relevant legal provisions:

EPC Art. 56

EPC R. 67

Keyword:

"Inventive step - (no) common general knowledge"

"Substantial procedural violation (no)"

Decisions cited:

T 1039/00, T 0567/06

Catchword:

-



Case Number: T 0411/04 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 15 June 2007

Appellant: IGR GmbH & Co. KG
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 17 February 2004
rejecting the opposition filed against European
Patent No. 0802673 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: B. Müller
Members: A. Teale
M. Paci

Summary of Facts and Submissions

I. The appeal is against the decision by the opposition division rejecting the opposition, the appealed decision mentioning the following documents, amongst others:

D2: WO 96 07270 A1

D4(1): Extract from "MacWEEK", vol. 9, no. 11, page 18(1), 13 March 1995, ISSN: 0892-8118, Harris, Scott.

D4(2): "VideoGuide™, User's Manual", Printed in the U.S.A., Part #030-10 011 rev. 1.0, 28 pages, bearing the copyright notice on the last page "Copyright © 1995 VideoGuide, Inc."

II. The opposition was based on Article 100a EPC (inventive step) in view of the combination of D2 and D4(2). Approximately eight months after the patentee had responded to the notice of opposition the opposition division issued the appealed decision finding that D4(2) was not prior art, so that the ground for opposition did not prejudice the maintenance of the patent as granted.

III. The opponent appealed, arguing that D4(2) was indeed prior art in view of the copyright notice on its last page. The subject-matter of claim 1 consequently lacked inventive step in view of the combination of D2 and D4(2). The appellant also filed the following document

D5: US 5 479 268 A

and argued that the subject-matter of claim 1 also lacked inventive step in view of the combination of D2 and D5.

The appellant moreover requested that the appeal fee be reimbursed, asserting that the opposition division had committed a substantial procedural violation in only explaining in the appealed decision that D4(2) was not regarded as prior art.

- IV. Responding to the appeal, the respondent (proprietor) argued that D4(2) was not prior art and that D5 was not only late filed but also of little relevance.
- V. In a letter dated 26 October 2006 the appellant submitted a change of name and filed a copy of the corresponding extract from the German commercial register.
- VI. In an annex to a summons to oral proceedings the board expressed doubts whether the copyright notice on the last page of D4(2) could be seen as anything more than an intention to publish in 1995.
- VII. In a submission dated 15 May 2007 the respondent filed an auxiliary request containing amended claims 1 and 4 in a clean copy and a copy indicating amendments. Regarding D4(2), the respondent argued that in 1995 the US Copyright Act did not require a copyright notice to be placed on a work in order to enjoy copyright protection.

VIII. In a submission also dated 15 May 2007 the appellant argued that under US copyright law notices such as that on the last page of D4(2) were obligatory and indicated the year of first publication of a work. The appellant also referred to decision 4 W (pat) 49/96 of the 4th Senate of the German Federal Patent Court ("Bundespatentgericht"), arguing that in that case a copyright notice had been accepted as evidence of prior publication of a service manual.

IX. In the oral proceedings held on 15 June 2007 the board questioned whether the auxiliary request satisfied Article 123(2) EPC, since the "demultiplexer means (102) for separating video signal, audio signal and program-associated information from the received signal" mentioned in claim 1 did not appear to be directly and unambiguously derivable from the application as originally filed, figure 3 and page 7, lines 13 to 19, of the original application showing the demultiplexer separating the received signal into a program-associated information signal on the one hand and an audio/video signal on the other. The respondent then filed an amended text for claim 1 of the auxiliary request up to feature "g".

The appellant requested that the decision under appeal be set aside, that the patent be revoked and that the appeal fee be reimbursed. The appellant also requested that the amendment to the auxiliary request not be admitted, since it was late filed.

The respondent requested that the appeal be dismissed and, as an auxiliary request, that the patent be maintained with claim 1 up to feature "g" filed in the

oral proceedings, and the remainder of claim 1 and claim 4 as filed in the clean copy of the auxiliary request with the letter of 15 May 2007, and the remaining claims as granted.

The board admitted D5 into the proceedings and allowed the amendment to the auxiliary request.

- X. The text of claim 1 as granted reads as follows, the board essentially adopting the labelling of features used by the respondent in the response to the grounds of appeal:

"A broadcasting and communication receiver apparatus comprising:

- a. receiver means (118) for receiving program-associated information (S_p) including title, start and end times of a broadcast program together with a video signal (S_v) and a audio signal (S_A);
- b. decoder means (119) for decoding the program-associated information (S_p) from the received signal;
- c. screen display means (105) for displaying the decoded program-associated information thereon;
- d. command receiver means (106) for receiving an input signal from a remote controller or from a key or keys provided to a main body of the receiver apparatus; and
- e. display controller means (109) for controlling the display screen based on the input signal, and

f. wherein a first display zone (401, 503) in which a plurality of character information strings are displayed is provided in the display screen means for displaying program-associated information (S_p),

characterized in that

g. the display controller means (109) has data quantity comparator means (112, 116) for comparing a magnitude of the first display zone with the quantity of display data and,

h. when the data quantity is judged to be larger than the first display zone, then the displayable part of the character string of the display data of the display controller means (109) as well as a symbol (301) indicative of omission attached to a last tail part of the character string are displayed."

The text of claim 1 of the auxiliary request reads as follows:

"A digital broadcasting and communication receiver apparatus, comprising:

a) receiver means (118) for receiving digitally multiplexed signals including program-associated information (S_p), which specifies title, start and end times of a broadcasting program together with a video signal (S_v) and an audio signal (S_a);

aa) demultiplexer means (102) for separating program-associated information from the received signal;

b) decoder means (119) for decoding the program-associated information from the separated signal;

c) screen display means (105) for displaying the decoded program-associated information thereon;

d) command receiver means (106) for receiving an input signal from a remote controller or from a key or keys provided to a main body of the receiver apparatus; and

e) display controller means (109) for controlling the display screen based on the input signal, and

f) wherein a first display zone (401, 503) in which a plurality of character information strings are displayed is provided in the display screen means for displaying program-associated information (Sp),

characterized in that

g) the display controller means (109) has data quantity comparator means (112, 116) for comparing a magnitude of the first display zone with the quantity of display data and,

h) means to generate a symbol (301) indicative of omission when the data quantity is judged to be larger than the first display zone and to display the displayable part of the character string of the display data of the display controller means (109) as well as the symbol (301) indicative of omission attached to a last tail part of the character string."

XI. The appellant's arguments in the oral proceedings may be summarized as follows. D2 disclosed feature "b" of claim 1 as granted; see VBI decoder 53 in figure 20. D2 also contained hints at data comparison means in the light of references to displaying a list of the actors in a particular show (see page 22, lines 21 to 24) and to displaying a recipe (see figure 21). Such lists and recipes would have to be edited to divide them up into several pages, this implying omission of the pages not currently being displayed. Although not disclosed in D2, it also made sense to compare the quantity of data in the receiver, since the transmitter did not know the capabilities of the receiver. Also the claimed invention did not display all the data and thus did not solve the problem mentioned in the patent at column 2, lines 38 to 40. Instead, the technical problem was to display data in a more user-friendly manner. The skilled person would thus find D5. By combining D2 and D5 the skilled person would arrive at the subject-matter of claim 1 as granted. It was also common general knowledge in the field of text processing to use an "ellipsis" ("...") to indicate that text had been omitted.

Regarding the auxiliary request, the appellant argued that the transmission of digital rather than analogue signals was in itself trivial, digital television standards such as MPEG being well known at the priority date (i.e. 19 April 1996). Moreover, although D2 concerned analogue television, the program information was still transmitted digitally. The signal transmission method was also unrelated to data quantity comparison and the display of a symbol indicative of

omission. Thus two technically unrelated partial problems were being solved in claim 1.

Regarding the request for reimbursement of the appeal fee, the appellant argued that he had been genuinely surprised by the opposition division's finding in the appealed decision that D4(2) was not prior art. He conceded however that, although he could have responded to the argument by the patentee in the response to the notice of opposition that D4(2) was not prior art, he had chosen not to. According to the appellant, the opposition division should however have issued a communication indicating their opinion that D4(2) was not prior art in spite of its copyright notice. The appellant could then have made further submissions regarding the prior publication of D4(2).

- XII. The respondent's arguments in the oral proceedings may be summarized as follows. It was conceded that feature "b" of claim 1 as granted was known from D2. Although, strictly speaking, the claimed invention did not display all the data and thus did not solve the problem mentioned in the patent at column 2, lines 38 to 40, the disclosure of the patent as a whole did solve the problem. The heart of the invention lay in receiver-side data formatting, rather than merely in the use of an omission symbol such as an ellipsis ("..."). At the priority date data formatting was not feasible at the receiver. This was inconvenient, since one could not adapt to the different environments in various global markets. Formatting data at the transmitter or at the receiver were not equal choices, since formatting at the receiver offered greater flexibility (e.g. the

display of Kanji characters), albeit at the cost of more expensive receiver hardware.

Regarding the auxiliary request, claim 1 related to the digital transmission of television signals, whereas D2 related to analogue television. The fact that the features relating to digital transmission had been placed in the preamble of claim 1, claim 1 having been originally delimited against D2, was not intended to be tacit admission that these features were known from D2. Digital signal transmission and the formatting of data in the television receiver were technically related, since in digital transmission the data were in an eminently processable form.

Regarding the request for reimbursement of the appeal fee, the respondent argued that, according to the case law of the boards of appeal, the question of whether or not a document formed prior art was always carefully scrutinized, and the appellant should have expected this.

XIII. At the end of the oral proceedings the board announced its decision.

Reasons for the Decision

1. The appeal is admissible.

2. *The main request*

2.1 The closest prior art

It is common ground between the parties that D2 forms the closest prior art. D2 relates to an apparatus for displaying a television program schedule; see figures 1 and 2. The program schedule information contains program title, start time and length and can be updated by a continuous data link in the vertical blanking interval (VBI) of one television channel; see page 5, lines 5 to 8 and 12 to 14. Figure 20 shows that the output of the television tuner 11 is connected to a "VBI decoder" 53 which is connected to a microprocessor 24. The microprocessor is coupled to a "Viewer input device" 28, such as an infra red remote control (see page 5, lines 18 to 19), and controls a video processor 30 where program listings are formatted for display in a "program schedule area" 46; see page 5, lines 19 to 22.

It is common ground between the parties that D2 discloses an apparatus having all the features of the preamble of claim 1, namely features "a" to "f", set out above.

2.2 The use of symbols indicative of omission

It is common ground between the parties that at the priority date it was generally known in the field of text processing to use an "ellipsis" ("...") to indicate that text had been omitted. The board regards the use of the ellipsis in this way to be notorious common general knowledge at the priority date.

2.3 Novelty

The subject-matter of claim 1 differs from the disclosure of D2 in the following features:

g. the display controller means has data quantity comparator means for comparing a magnitude of the first display zone with the quantity of display data and,

h. when the data quantity is judged to be larger than the first display zone, then the displayable part of the character string of the display data of the display controller means as well as a symbol indicative of omission attached to a last tail part of the character string are displayed.

The subject-matter of claim 1 is consequently new, Article 54(1,2) EPC.

2.4 The objective technical problem

It is common ground between the parties that the claimed invention does not display all the data and thus does not solve the problem mentioned in the patent at column 2, lines 38 to 40, which is stated as being to allow the display data to be presented within a limited display zone of a display screen. The board is not convinced by the respondent's argument that it suffices for the disclosure of the patent as a whole to solve the objective technical problem, since, according to Rule 29(1) EPC, the claims shall define the matter for which protection is sought. Following the "problem and solution approach" to assessing inventive step, it is the features of the claimed invention which must

solve the objective technical problem; see "Case Law of the Boards of Appeal of the European Patent Office", 5th edition, I.D.2.

The board concurs with the appellant and regards the objective technical problem as being to display data in a more user-friendly manner, as is derivable from column 2, lines 38 to 40 of the patent. This problem was usual in the technical field to which D2 belongs at the priority date of the claimed invention.

2.5 Inventive step

The skilled person starting from D2 and seeking to display data in a more user-friendly manner would, as a usual matter of design, realize that the situation must inevitably arise where the program titles for display in the program schedule area are too long to fit in the available space. The most obvious solution to the problem would be to truncate the program titles and display a symbol indicative of omission. This functionality could be realized in the signal transmitter or the receiver, the patent giving no hint at any technical advantage accruing from choosing to realize this functionality in the receiver. The respondent has moreover produced no evidence to support the claim that data formatting in the receiver was not feasible at the priority date. Hence the board cannot see an inventive step being involved in choosing to realize this functionality in the receiver. The use of data quantity comparator means for comparing a magnitude of the first display zone with the quantity of display data and, when the data quantity is judged to be larger than the first display zone, displaying

the displayable part of the character string of the display data of the display controller means as well as a symbol indicative of omission attached to a last tail part of the character string are matters of usual design to implement this functionality.

The board consequently finds that the subject-matter of claim 1 does not involve an inventive step, Article 56 EPC.

3. *The auxiliary request*

3.1 Admissibility of the amendments

The amendments to claim 1 of the auxiliary request were in reaction to objections by the board under Article 123(2) EPC. Since the amendments did not raise complex technical issues and did not prolong the proceedings unduly, the board allowed the amendments under Article 10b(1) RPBA.

3.2 The effect of the amendments

Editorial amendments aside, claim 1 differs from that of the main request in now specifying a "digital broadcasting and communication receiver apparatus" (emphasis added by the board) and feature "aa", namely "demultiplexer means (102) for separating program-associated information from the received signal".

In view of figure 3 and page 7, lines 16 to 19, and page 15, lines 15 to 22, of the application as originally filed, the board is satisfied that the amendments comply with Article 123(2,3) EPC.

3.3 Novelty

The subject-matter of claim 1 differs from the disclosure of D2 in features "g" and "h", set out in section 2.3 above, and the features set out in section 3.2 above. The subject-matter of claim 1 is consequently new, Article 54(1,2) EPC.

3.4 Inventive step

The board does not accept the argument that there is a technical relationship between the difference features relating to digital signal transmission (see section 3.2 above) and the difference features relating to the display of the symbol indicative of omission (see section 2.3 above), since, in general, both analogue and digital signals are eminently processable, albeit in different ways. The patent also contains no hint that digital data transmission yields any unexpected technical advantage when processing the program-associated information to display the symbol indicative of omission. Moreover the program-related information in D2 is sent in digital form, just as in the invention. Hence the inventive step of the difference features relating to digital signal transmission (see section 3.2 above) must be considered separately from that of the difference features relating to the display of the symbol indicative of omission (see section 2.3 above), already considered in section 2.5 above to not involve an inventive step.

The difference features relating to digital signal transmission solve the problem, derivable from the

patent at paragraph [0012], of providing a broadcasting and communication receiver apparatus. This problem was usual in the technical field to which D2 belongs at the priority date. The realization of the apparatus as a digital apparatus incorporating a demultiplexer to separate program-associated information from the received signal is regarded as notorious common general knowledge at the priority date and a usual matter of design.

The board consequently finds that the subject-matter of claim 1 does not involve an inventive step, Article 56 EPC.

4. Conclusion regarding the main and the auxiliary requests

The respondent's main request is not allowable, since the grounds for opposition mentioned in Article 100 EPC prejudice the maintenance of the European patent. The respondent's auxiliary request is also not allowable because, taking into consideration the amendments made by the respondent, the patent and the invention to which it relates do not meet the requirements of the EPC. Since the respondent had no further requests, the patent was revoked according to the appellant's request.

As a consequence, there is no need for the purpose of assessing patentability to discuss the issues surrounding documents D4(1), D4(2) and D5.

5. The request for reimbursement of the appeal fee

Pursuant to the provisions of Article 113(1) EPC, that concern the right to be heard, the decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. The "grounds or evidence" are to be understood as meaning the essential legal and factual reasoning on which the EPO has based its decision. The right to be heard also encompasses the duty to consider in the decision-making process specific facts, evidence or arguments that were the subject of the proceedings and are relevant to the outcome of the case (see T 0567/06, point 2.1 of the reasons). Non-compliance with Article 113(1) EPC may amount to a substantial procedural violation and thus require the reimbursement of the appeal fee pursuant to Rule 67 EPC (cf. T 1039/00, point 2.4 of the reasons).

The appellant contends that the opposition division committed a substantial procedural violation in failing to inform the appellant before taking the impugned decision that they might not consider D4(2) as prior art in spite of the copyright notice on that document. Thus the decision under appeal was based on grounds on which the appellant had not had an opportunity to present its comments.

The board notes that in section 2 of the reasons of the impugned decision the opposition division considered whether D4(2) constituted prior art and summarised the respective submissions of the parties. It is said in the summary that the appellant asserted in the notice of opposition that D4(1), D4(2) and D4(3) were

acknowledged in another opposition procedure before the EPO. The appellant did not comment on the respondent's arguments in its response to the grounds of opposition (in section II of which the respondent argued that D4(2) was not prior art). The opposition division decided not to acknowledge D4(2) as prior art. As the appellant pointed out in the statement of grounds of appeal (at page 12), the division made no mention at all of the copyright notice in the reasons of the impugned decision.

It follows that the appellant had an opportunity to comment on the issue of whether D4(2) was prior art, the decision being based on this issue, and the appellant has conceded this. It was only approximately eight months after the respondent's reply to the notice of opposition challenging the prior art status of D4(2) that the impugned decision was taken. But the appellant decided not to reply to the response to the statement of grounds of opposition in which the respondent contested that D4(2) was prior art. It also follows that the decision was not based on the significance of the copyright notice. Thus the appellant's claim that by not having been informed before the taking of the impugned decision that D4(2) might not be considered prior art despite the copyright notice it was deprived of an opportunity to comment on a ground on which the decision was based must fail. In this regard therefore the opposition division has not committed a violation of Article 113(1) EPC.

Nor has the division infringed the right to be heard by not considering the copyright notice in the decision. The reason is that the relevance of the copyright

notice for the prior art status of D4(2) was not the subject of the proceedings. The appellant did not make any comments in the notice of opposition, which was his sole submission in the opposition procedure, as to the significance of the copyright notice on D4(2) regarding the prior art status of that document. It merely mentioned the copyright notice as part of the citation of D4(2).

In the light of the foregoing, the appellant's contention that he should have been informed beforehand about the opposition division's stance in relation to the prior art status of D4(2) would presuppose an obligation on the part of the opposition division to provide its analysis of the facts, evidence and arguments that were the subject of the proceedings before delivering its decision. However, while the right to be heard covers all the factual and legal aspects which form the basis for the decision-making process, the right to be heard does not cover the final position which the EPO intends to adopt. Rather, in the present situation, where the prior art status of a document was contested, the party concerned must anticipate an adverse decision on that point made on the basis of the division's assessment of the facts, evidence and arguments in the procedure. In such a situation it is up to the party to make any respective submissions of its own motion.

Finally, the board wishes to point out that had the division, in not basing its decision on the significance of the copyright notice, erred in law, as the appellant alleges, this would not amount to a procedural error but to a substantive one. However,

under Rule 67 EPC, reimbursement of the appeal fee can only be ordered where a procedural error was made.

It follows from the foregoing that the requirements of Article 113(1) EPC were complied with and that the right to be heard was respected. No procedural error occurred, let alone a substantial procedural violation within the meaning of Rule 67 EPC. As a consequence, the appellant's request for reimbursement of the appeal fee had to be refused.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

D. Sauter

B. Müller