

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 8 August 2007**

Case Number: T 0426/04 - 3.5.04

Application Number: 90916885.8

Publication Number: 0500680

IPC: H04N 5/44

Language of the proceedings: EN

Title of invention:

Cable television decoder to television accessory interfacing

Patentee:

STARSIGHT TELECAST, INC.

Opponent:

IGR GmbH & Co. KG

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Amendments - added subject matter (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0426/04 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 8 August 2007

Appellant: STARSIGHT TELECAST, INC.
(Patent Proprietor) 6922 Hollywood Boulevard
Los Angeles
California 90028 (US)

Representative: Kinsler, Maureen Catherine
Kilburn & Strode
20 Red Lion Street
London WC1R 4PJ (GB)

Former respondents: IGR GmbH & Co. KG
(Opponent) Bahnstraße 62
D-40210 Düsseldorf (DE)

Representative: Eichstädt, Alfred
Maryniok & Eichstädt
Kuhbergstraße 23
D-96317 Kronach (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 2 February 2004
revoking European patent No. 0500680 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: F. Edlinger
Members: A. Teale
P. Mühlens

Summary of Facts and Submissions

I. The appeal is against the decision by the opposition division to revoke European patent 0 500 680, which derived from international patent application WO 91/07050, because the subject-matter of the independent claims lacked inventive step, Articles 52(1) and 56 EPC, in the light of the combination of the following documents:

D1: 1986 NCTA Technical Papers, Richard G. Merrell, "TAC-Timer", pages 203 to 206.

D2: DE 38 15 579 A1.

II. The patentee appealed, requesting cancellation of the decision in its entirety. The appellant subsequently filed a statement of grounds of appeal dated 11 June 2004 accompanied by amended claims according to a main and an auxiliary request.

III. The respondent (opponent) requested that the appeal be dismissed. In a letter dated 26 October 2006 the respondent submitted a change of name and filed a copy of the corresponding extract from the German commercial register. In a further letter dated 12 April 2007 the respondent withdrew the opposition.

IV. In an annex to a summons to the appellant to attend oral proceedings the board expressed its preliminary opinion that the claims according to the main and auxiliary requests did not satisfy Article 123(2) EPC regarding added subject-matter. It was, *inter alia*, doubtful whether it was directly and unambiguously derivable from the application as originally filed that

there was a "single remote control", as mentioned in the independent claims. Page 6, lines 23 to 25, of the original application as published merely spoke of the remote control emulator 22 replacing the conventional cable decoder remote controller.

V. In a submission dated 6 July 2007 the appellant stated that he would not be represented at the oral proceedings. The appellant also filed amended claims according to a main and four auxiliary requests, arguing that the expression "single remote control" merely served to make clear the functional limitation of one remote control performing the relevant functions recited in the claim. Nevertheless the expression "remote control" had been amended to "remote controller", as used in figure 2 of the application as originally filed, the same figure showing a "single remote controller."

VI. Claim 1 of the main and four auxiliary requests reads as follows.

Main request:

"A system (10) for interfacing a cable television decoder (12) having an input for receiving television signals including a plurality of channels and an output for directing a selected channel from the television signals to a television or a television accessory (14), which comprises:

a programmable tuning means (26), connected to the output of said television cable decoder (12) to receive the selected channel on a fixed channel from said

television cable decoder, for selecting a desired television channel signal,

a single remote controller (20) having an output for making television channel selections, which remote controller (20) supplies television channel selections directly to a remote receiver (24) for supply to the programmable tuning means (26) when the cable television decoder (12) is not selected,

means (22), responsive to the output of the remote controller (20), for emulating the channel selecting commands of said cable television decoder (12) when the cable television decoder (12) is selected, and

a remote control transmitter means (54), connected to the said means (12) for emulating, for transmitting emulated channel selection commands from said means for emulating to said cable television decoder (12), characterised in that there is further provided

a television schedule responsive to channel selection commands from the remote controller (20) and, when the channel selected is a cable channel, arranged to coordinate with the means for emulating in order to generate said emulated channel selection commands for said cable television decoder,

means for setting a desired activation time for a channel selection, said means being included in said single remote controller (20) for making television channel selections, and

a memory, connected to said means (22) for emulating, for storing television channel selections and desired activation times for the television channel selections."

First auxiliary request:

"A system (10) for interfacing a cable television decoder (12) having an input for receiving television signals including a plurality of channels and an output for directing a selected channel from the television signals to a television or a television accessory (14), which comprises:

a programmable tuning means (26), connected to the output of said television cable decoder (12) to receive the selected channel on a fixed channel from said television cable decoder, for selecting a desired television channel signal,

means, connected to said programmable tuning means (26), for inhibiting said programmable tuner means from tuning to the selected television channel when said cable television decoder is operational

a single remote controller (20) having an output for making television channel selections, which remote controller (20) supplies television channel selections directly to a remote receiver (24) for supply to the programmable tuning means (26) when the cable television decoder (12) is not selected,

means (22), responsive to the output of the remote controller (20), for emulating the channel selecting commands of said cable television decoder (12) when the cable television decoder (12) is selected, and

a remote control transmitter means (54), connected to the said means (12) for emulating, for transmitting emulated channel selection commands from said means for emulating to said cable television decoder (12), characterised in that there is further provided

a television schedule responsive to channel selection commands from the remote controller (20) and,

when the channel selected is a cable channel, arranged to coordinate with the means for emulating in order to generate said emulated channel selection commands for said cable television decoder,

means for setting a desired activation time for a channel selection, said means being included in said single remote controller (20) for making television channel selections, and

a memory, connected to said means (22) for emulating, for storing television channel selections and desired activation times for the television channel selections."

Second auxiliary request:

"A system (10) for interfacing a cable television decoder (12) having an input for receiving television signals including a plurality of channels and an output for directing a selected channel from the television signals to a television or a television accessory (14), which comprises:

a programmable tuning means (26), connected to the output of said television cable decoder (12) to receive the selected channel on a fixed channel from said television cable decoder, for selecting a desired television channel signal,

means, connected to said programmable tuning means (26), for inhibiting said programmable tuner means from tuning to the selected television channel when said cable television decoder is operational

a single remote controller (20) having an output for making television channel selections, which remote control (20) supplies television channel selections directly to a remote receiver (24) for supply to the

programmable tuning means (26) when the cable television decoder (12) is not selected,

means (22), responsive to the output of the remote controller (20), for emulating the channel selecting commands of said cable television decoder (12) when the cable television decoder (12) is selected, and

means, preferably, an infrared remote control transmitter (54), connected to the said means (12) for emulating, for transmitting emulated channel selection commands from said means for emulating to said cable television decoder (12),

characterised in that there is further provided

a television schedule responsive to channel selection commands from the remote controller (20) and, when the channel selected is a cable channel, arranged to coordinate with the means for emulating in order to generate said emulated channel selection commands for said cable television decoder,

means for setting a desired activation time for a channel selection, said means being included in said single remote controller (20) for making television channel selections, and

a memory, connected to said means (22) for emulating, for storing television channel selections and desired activation times for the television channel selections."

Third auxiliary request:

"A system (10) for interfacing a cable television decoder (12) having an input for receiving television signals including a plurality of channels and an output for directing a selected channel from the television

signals to a television or a television accessory (14) which comprises:

a programmable tuning means (26), connected to the output of said television cable decoder (12) to receive the selected channel on a fixed channel from said cable television decoder, for selecting a desired television channel signal,

a single remote controller (20) for making television selections, which remote controller (20) supplies television channel selections directly to a remote receiver (24) for supply to the programmable tuning means (26) when the cable television decoder (12) is not selected,

means (22), coupled to said remote controller (20), for emulating the channel selecting commands of said cable television decoder (12) when the cable television decoder is selected, and

a remote control transmitter means (54), connected to the said means (22) for emulating, for transmitting emulated channel selection commands from said means for emulating to said cable television decoder (12),

characterised in that there is further provided a television schedule for receiving channel selection commands from the remote controller (20) and, when system (10) includes said cable television decoder, automatically co-ordinating with the means for emulating in order to generate codes that are recognisable by the cable television decoder and automatically maintaining said programmable tuning means tuned to said fixed channel,

means for setting a desired activation time for a channel selection, said means being included in said means (20) for making television channel selections, and

a memory, connected to said means (22) for emulating, for storing television channel selections and desired activation times for the television channel selections."

Fourth auxiliary request:

"A system (10) for interfacing a cable television decoder (12) having an input for receiving television signals including a plurality of channels and an output for directing a selected channel from the television signals to a television or a television accessory (14) which comprises:

a programmable tuning means (26), connected to the output of said television cable decoder (12) to receive the selected channel on a fixed channel from said cable television decoder, for selecting a desired television channel signal,

a single remote controller (20) for making television selections, which remote controller (20) supplies television channel selections directly to a remote receiver (24) for supply to the programmable tuning means (26) when the cable television decoder (12) is not selected,

means (22), coupled to said remote controller (20), for emulating the channel selecting commands of said cable television decoder (12) when the cable television decoder is selected, and

means, preferably, an infrared remote control transmitter (54), connected to the said means (22) for emulating, for transmitting emulated channel selection commands from said means for emulating to said cable television decoder (12)

characterised in that there is further provided

a television schedule for receiving channel selection commands from the remote controller (20) and, when system (10) includes said cable television decoder, automatically co-ordinating with the means for emulating in order to generate codes that are recognisable by the cable television decoder and automatically maintaining said programmable tuning means tuned to said fixed channel,

means for setting a desired activation time for a channel selection, said means being included in said means (20) for making television channel selections, and

a memory, connected to said means (22) for emulating, for storing television channel selections and desired activation times for the television channel selections."

VII. Oral proceedings were held on 8 August 2007. As announced in advance, the appellant was not represented. At the end of the oral proceedings the board announced its decision.

Reasons for the Decision

1. The appeal is admissible.
2. *The appellant's final requests*

The appellant has requested in writing that the decision under appeal be set aside and that the patent be maintained in accordance with the main request or one of the auxiliary requests filed with the letter

dated 6 July 2007. All these requests involve amendments to the granted claims.

3. *The amendments*

3.1 *The main request*

Amongst other amendments, claim 1 has been amended to now refer twice to a "single remote controller (20) [having an output] for making television channel selections", the term "single" being understood by the board to mean "only one".

The application as originally filed makes no explicit mention of there being only one remote controller for making television channel selections, the term itself "single" only being used in other contexts, namely when discussing a "single descrambler" (page 3, line 8) and a "single tuning arrangement" (see, for instance, page 3, line 32).

It is also not directly and unambiguously derivable from the application as originally filed that there is only one remote controller for making television channel selections. The original description mentions the VCR receiving commands from its remote controller (page 5, lines 35 to 36), the user communicating with the system using the VCR remote controller (page 6, lines 25 to 26) and the TV schedule system being set to cable mode by a command from the remote controller (page 7, lines 33 to 35). It is also stated that the remote control emulator replaces the conventional cable decoder remote controller (page 6, line 23 to 25). However none of these statements excludes the presence

of other remote controllers for making television channel selections. It is true that figure 2 shows a remote controller, but again this does not exclude the presence of other remote controllers for making television channel selections in the VCR or in the cable decoder. Hence there is no implicit disclosure in the original application of a single remote controller for making television channel selections either.

A person skilled in the art **might** derive from the overall disclosure of the application as filed that one remote controller **could** perform the relevant functions recited in the claim and thus need not supply separate remote controllers for the VCR and the cable decoder. However this is not directly and unambiguously disclosed in this general sense, and the feature which allows a person skilled in the art to possibly arrive at this conclusion, namely setting a cable mode by a command from said remote controller, is not specified in claim 1.

Consequently the introduction of the expression "single remote controller" in claim 1 causes the patent to contain subject-matter extending beyond the content of the application as originally filed, contrary to Article 123(2) EPC.

3.2 *The four auxiliary requests*

Claim 1 of all four auxiliary requests also contains the expression "a single remote controller". The various amendments in claim 1 according to the requests do not lend a different meaning to the expression in the claimed combination, indeed the appellant has not

argued this. Thus claim 1 of all four auxiliary requests fails to satisfy Article 123(2) EPC for the same reasons as are given for the main request.

4. *Conclusion*

The patent amended according to all of the appellant's main and four auxiliary requests fails to comply with the requirements of the EPC. None of these requests is consequently allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

D. Sauter

F. Edlinger