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**Datasheet for the decision
of 6 October 2009**

Case Number: T 0844/05 - 3.5.04

Application Number: 00980635.7

Publication Number: 1232651

IPC: H04N 7/173

Language of the proceedings: EN

Title of invention:

Interactive television targeted message system

Applicant:

United Video Properties, Inc.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 108
EPC R. 99(2)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Form of appeal - grounds - sufficient substantiation (no)"

Decisions cited:

J 0003/06, J 0010/07, T 0220/83, T 0809/06, T 0358/08

Catchword:

see point 6.



Case Number: T 0844/05 - 3.5.04

DECISION
of the Technical Board of Appeal 3.5.04
of 6 October 2009

Appellant: United Video Properties, Inc.
7140 South Lewis Avenue
Tulsa, OK 74136 (US)

Representative: Hibbert, Juliet Jane Grace
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20 Red Lion Street
London WC1R 4PJ (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 17 December 2004
refusing European application No. 00980635.7
pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: F. Edlinger
Members: A. Dumont
B. Müller

Summary of Facts and Submissions

I. The appeal is directed against the decision by the examining division to refuse European patent application 00 980 635.7.

II. The impugned decision is based on the grounds of lack of novelty (Article 54 EPC 1973) and lack of inventive step (Article 56 EPC 1973) of the claims of both (main and auxiliary) requests filed with a letter of 11 June 2004, in view of the prior art disclosed in the documents:

D1: WO 99/52285 A1 and

D5: EP 0 905 985 A2.

The decision was further based on the ground of unallowable amendments (Article 123(2) EPC) of the claims of the main request.

III. The appellant lodged an appeal against the decision in its entirety. In a letter dated 25 April 2005 he maintained that the arguments submitted in the three responses filed in the examination proceedings dated 10 April 2003, 5 March 2004 and 11 June 2004, respectively, remained sound. The appellant requested that the board reconsider these arguments and also filed copies of these three responses. He further requested that the board reconsider the examining division's reasons for refusal under Article 123(2) EPC in the light of decision G 1/03 of the Enlarged Board of Appeal and made submissions in respect of this ground for refusal.

- IV. In a communication accompanying the summons to oral proceedings the board observed that a statement of grounds of appeal merely referring generally to previous submissions was in principle not considered sufficient to render an appeal admissible, and that such submissions might be considered possible grounds for an admissible appeal if the arguments already submitted therein adequately addressed the reasons underlying the contested decision. The board noted that it was not readily apparent how the arguments of the examining division relating to the essential features of the claims were addressed by the appellant, and how the arguments provided with the response dated 5 March 2004 addressed the objections of lack of novelty and inventive step based on D5 against the claims of both requests.
- V. In a letter dated 31 July 2009 the appellant withdrew the request for oral proceedings and requested that the appeal be heard on the face of the papers only.
- VI. Oral proceedings before the board took place on 6 October 2009 in the absence of the appellant.

Reasons for the Decision

1. Article 108, third sentence, EPC provides that "[w]ithin four months of notification of the decision, a statement setting out the grounds of appeal shall be filed in accordance with the Implementing Regulations". Pursuant to Rule 99(2) EPC, "[i]n the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the decision impugned, or the

extent to which it is to be amended, and the facts and evidence on which the appeal is based." Article 108 of the EPC 2000 applies according to Article 1, No. 1, of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the EPC Revision Act (see special edition No. 1/2007 OJ EPO, at pp. 197 *et seq.*). Rule 99(2) of the EPC 2000 applies because it is related to Article 108, third sentence, EPC (*cf.* J 3/06, OJ 2009, 170, point 3).

The board considers that Rule 99(2) EPC is in line with the established case law (summarised in Case Law of the Boards of Appeal of the EPO, 5th edition 2006, VII.D.7.5.1; T 358/08 seems to arrive at the same conclusion, see points 3.13.3 and 4.11). The board therefore sees no difference in substance to the corresponding legal situation under the EPC 1973, where the pertinent provisions were limited to those set out in Article 108, third sentence, and the required content of the statement of grounds was not expressly specified. Therefore there would have been no difference in substance if the board had followed the approach taken by the Legal Board in J 10/07 (OJ 2008, 567) which considered that those provisions applied where, as in the present case, on expiry of the time limits set out in Article 108 EPC 1973, the EPC 2000 had not yet entered into force.

Under the established case law the grounds for appeal should specify the legal or factual reasons on which the case for setting aside the decision is based. If the appellant submits that the decision under appeal is incorrect, the statement setting out the grounds of appeal must enable the board to understand immediately

why the decision is alleged to be incorrect and on what facts the appellant bases its arguments, without first having to make investigations of their own (cf. T 220/83, OJ EPO 1986, 249, point 4, affirmed by numerous decisions and more recently by T 809/06, at point 2). In principle, a statement of grounds which merely refers generally to previous submissions is not considered sufficient. An exception to this principle has been acknowledged where the arguments presented at first instance already adequately addressed the grounds underlying the contested decision (see Case Law of the Boards of Appeal, *ibid.*, VII.D.7.5.4). Similarly, a brief statement may be considered sufficient where a substantial violation of the first-instance proceedings occurred or where a reading of the impugned decision itself reveals that it cannot be upheld (see T 809/06, at point 4, and the cases cited there).

2. The admissibility of the appeal depends in the present case on whether the letter of 25 April 2005, together with the annexed copies of three submissions previously filed during the examination proceedings, can be regarded as a valid statement of grounds of appeal. That letter, qualified by the appellant as "Grounds of Appeal", does not contain any specific arguments regarding novelty and inventive step but only arguments in respect of Article 123(2) EPC. Given that there are no indications of any substantial procedural violation and that a reading of the impugned decision itself does not reveal that it cannot be upheld, it must be immediately apparent from the attached copies of the three earlier responses which are the arguments in the light of which the board should reconsider the reasons for refusal. The board is of the opinion that this

- requirement is not met in the present case, for the following reasons.
3. The impugned decision identifies and discusses the essential possible differences between the subject-matter claimed in both requests and the prior art according to D1 in order to assess novelty and inventive step (see in particular the differences i) and ii) dealt with on pages 6 and 8 of the impugned decision). It is not immediately apparent to the board to which extent the arguments in the applicant's responses of 10 April 2003 and 11 June 2004, which are the submissions dealing with D1, address the differences as finally identified in the decision.
 4. The impugned decision also contains findings of lack of novelty and inventive step based on D5 for both requests. It is also not immediately apparent to the board to which extent the arguments in the applicant's response of 5 March 2004, which is the only response dealing with D5, address the objections to the subject-matter of the claims amended with the later letter of 11 June 2004. Concrete arguments for an inventive step in view of a combination of D1 and D5, in particular following the problem/solution approach adopted in the impugned decision, are totally absent from the applicant's responses.
 5. The board drew the appellant's attention to these issues in a communication. The appellant however did not comment on these observations.
 6. It follows from the above that the letter of 25 April 2005, read together with its attached annexes, does not

enable the board to understand immediately why the decision is alleged to be incorrect as regards the findings of lack of novelty and inventive step for both (main and auxiliary) requests. This would have been necessary because these grounds constitute a sufficient basis for the refusal of the application. It was therefore not sufficient to only make submissions in relation to Article 123(2) EPC, which is a further ground on the basis of which the present application was refused independently of the two other grounds.

7. In conclusion, the appellant did not file any submission that can be regarded as a sufficient statement of grounds of appeal within the meaning of Article 108, third sentence, EPC. Therefore the appeal is inadmissible.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar

The Chairman

L. Fernández Gómez

F. Edlinger