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**Datasheet for the decision
of 14 January 2009**

Case Number: T 1424/05 - 3.5.04

Application Number: 99915108.7

Publication Number: 1068617

IPC: G11B 27/034

Language of the proceedings: EN

Title of invention:

Multimedia System

Patentee:

AVID TECHNOLOGY, INC.

Opponent:

Interessengemeinschaft für Rundfunkschutzrechte e.V.

Headword:

-

Relevant legal provisions:

RPBA Art. 12(4), 13(1)

Relevant legal provisions (EPC 1973):

EPC Art. 114(2), 56

Keyword:

"New facts submitted with the statement of appeal - admitted"
"New facts submitted in oral proceedings - not admitted"
"Inventive step - yes"

Decisions cited:

G 0009/91, G 0010/91, G 0001/95, T 0624/04

Catchword:

See points 4 and 6.



Case Number: T 1424/05 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 14 January 2009

Appellant: Interessengemeinschaft
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 13 September 2005
rejecting the opposition filed against European
patent No. 1068617 pursuant to Article 102(2)
EPC 1973.

Composition of the Board:

Chairman: F. Edlinger
Members: C. Kunzelmann
B. Müller

Summary of Facts and Submissions

I. The appeal is against the decision of the opposition division rejecting the opposition filed against European patent No. 1 068 617.

II. Claim 1 of the opposed patent reads as follows.

"A method of sharing data in a multimedia system (1) comprising the steps of:
receiving a multimedia composition which references data;
transferring the multimedia composition to a first location (3) for playback;
creating a list of data referenced by the multimedia composition in order of playback at the first location;
determining whether the data referenced by the multimedia composition is contained in a storage area (17) associated with the first location; and
transferring the data referenced by the multimedia composition to the storage area (17) only when the data is not already in the storage area (17)."

Claim 8 of the opposed patent reads as follows.

"A multimedia system (1) comprising:
at least one workstation (3) to create a multimedia composition which references data;
a playback device (7) coupled to said at least one workstation (3) to store and play multimedia compositions created by said workstation (3); and
a transfer tool (11) to transfer said multimedia composition and the data referenced by the multimedia composition from said at least one workstation (3) to

said playback device (7), wherein the transfer tool (11) is adapted to only transfer data referenced by the multimedia composition that is not stored in the playback device (7)."

Claims 2 to 7 and 9 to 14 are dependent on claims 1 and 8, respectively.

III. The decision under appeal can be summarised as follows.

The opposition was based on documents D1 to D12, and the opponent requested revocation of the patent on the grounds of Article 100 EPC 1973 in combination with Articles 52 to 57 EPC 1973. However the opponent's facts and arguments concerning lack of novelty and inventive step were only based on the disclosure of

D10: EP 0 420 474 B1.

According to D10, "index tables" (which corresponded to the multimedia compositions in the opposed patent) and "audio data files" (which corresponded to the data referenced by the multimedia compositions in the opposed patent) could be transferred between different storage devices. The transfer was always unconditional, that is no check was previously made whether the receiving storage device had already stored some part of the data to be transferred. The system and method according to claims 1 and 8 of the opposed patent however were adapted to only transfer data referenced by the multimedia composition that was not already stored in the receiving playback device. Thus the opposition division considered that the subject-matter

of claims 1 and 8 of the opposed patent was new and involved an inventive step.

IV. The opponent filed an appeal. According to the statement of grounds of appeal, the subject-matter of claims 1 and 8 neither involved an inventive step over the disclosure of D10 nor over the disclosure of

D1: EP 0 601 749 A1.

The appellant's argumentation on the factual basis relating to the evidence D10 can be summarised as follows.

The workstation known from D10 produced a multimedia composition which referenced data to be transferred from the workstation to the playback device. The transfer was performed by means of a table of indices referencing segments of the original audio data contained in the original audio data file. The playback device comprised the workstation's computer and the loudspeaker and/or the monitor shown in figure 1 of D10. The computer was so arranged that a segment of original audio data was only copied into the edited audio data file if the index being processed did not fall within one of the plurality of ranges of contiguous indices to the segments of original audio data copied into the edited audio data file. Thus the opposition division's finding that the transfer was unconditional was incorrect, and both the method of claim 1 and the multimedia system of claim 8 did not involve an inventive step. The claims of the opposed patent did not specify that the workstation and the playback device and the transfer tool were decoupled devices,

since these expressions only defined functionalities. The system known from D10 had the same functionalities and solved the same problem as the subject-matter of the opposed patent. The claims of the opposed patent only used other names for the features.

The appellant's argumentation on the factual basis submitted with the statement of grounds of appeal and relating to the evidence D1 can be summarised as follows.

D1 had been cited in the notice of opposition and in the search report and had been considered as the closest prior art in the examination proceedings leading to the grant of the opposed patent. D1 disclosed the HARRY and HENRY video editing systems of the patentee. According to D1, column 2, lines 36 to 48, a problem occurring in these systems was that a newly created clip could have such a size that it could not be transferred back to a disk store of the editing system. D1, column 2, line 53, to column 3, line 15, disclosed the receiving of a multimedia composition. D1, column 1, lines 18 to 51, disclosed the transferring of the multimedia composition to the editing system's monitor for playback. Furthermore it was a matter of course that the newly created clips were intended for playback on a playback device. The feature of creating a list of data referenced by the multimedia composition in order of playback was implied by the fact that the newly created clip had to be played back in the correct order. The features of determining whether the data referenced by the multimedia composition was contained in the disk store and of transferring the data referenced by the multimedia composition to the disk

store only when the data was not already in the disk store resulted from the problem mentioned in column 2, lines 36 to 48, of D1 (not enough disk size at the relevant date of D1). Thus the opposed patent concerned the problem of providing a more effective transfer of a newly created clip for playback than the transfer described in D1. For a person skilled in the art commonly known file-sharing techniques were an obvious solution to this problem. Thus both the method of claim 1 and the multimedia system of claim 8 did not involve an inventive step over the disclosure of D1. The following paragraphs of D1 were additionally cited in the statement of grounds of appeal: column 8, line 56, to column 9, line 3; column 14, lines 54 to 58, and figures 1 to 3.

- V. The respondent (patentee) replied with a letter dated 26 May 2006. Concerning the argumentation relating to D10, the respondent argued that the appellant's submissions were essentially a repetition of the arguments set out in the notice of opposition to which the respondent had replied in detail. The respondent further submitted that the opponent had raised a new ground for opposition in appeal proceedings, namely lack of inventive step over the disclosure of D1. According to the respondent, this new ground for opposition had not been sufficiently substantiated in the notice of opposition and was not *prima facie* relevant for the reasons stated in the international preliminary examination report, and should therefore not be admitted at this late stage of the proceedings. According to the respondent, the notice of opposition had not comprised an indication of the facts, evidence and arguments presented in support of this ground for

opposition concerning D1, contrary to the requirement given in Rule 55(c) EPC 1973. Instead, the opponent had merely stated in the notice of opposition that D1 to D9 appeared no more relevant than D10 to D12.

- VI. In a communication annexed to a summons to oral proceedings the board made a distinction between a fresh ground for opposition and a new factual basis and informed the parties that the admissibility of the appellant's new factual basis derived from D1, and consequently the argumentation developed on this factual basis, would be discussed in the context of Article 114(2) EPC 1973 and Article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA).
- VII. In a letter dated 22 December 2008 the respondent (patentee) confirmed that he would not attend the oral proceedings.
- VIII. Oral proceedings before the board were held on 14 January 2009 in the absence of the respondent (patentee) in accordance with Rule 71(2) EPC 1973. The board admitted the debate of the appellant's case concerning D1 in so far as it related to the factual basis submitted with the statement of grounds of appeal. But the board refused to admit an amendment to the appellant's case which related to a different set of facts and passages derived from D1. At the end of the oral proceedings the chairman pronounced the board's decision.
- IX. The appellant's argumentation submitted in oral proceedings concerning D1 can be summarised as follows. The principal idea of saving memory space and thus the

relevance of D1 were clear from the introductory part of D1 and column 9, lines 29 to 35, column 10, line 13, to column 11, line 10, column 12, lines 10 to 24, and column 13, lines 16 to 20, in conjunction with figure 1. In D1 both the workstation and the transfer tool were represented by reference sign 3, and the playback device was a video tape recorder represented by reference sign 2. D1 disclosed that the same data should not be recorded twice, both in the context of recording on the video tape recorder as well as recording on the disk store.

The set-up data referencing the video frames (representing a multimedia composition) were stored on a magneto-optic disk. The playback device was a combination of the video tape recorder and the magneto-optical disk drive.

- X. The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked in its entirety.

- XI. The respondent (patentee) had requested in writing that the appeal be dismissed.

Reasons for the Decision

- 1. The appeal is admissible.

- 2. *Claim construction*
 - 2.1 It follows from the parties' submissions that the parties disagree on the meaning of the claims, in

particular on whether the claims concern the sharing of data within a multimedia system comprising different devices or whether they likewise cover data transfer between functional units of a (single) device, such as a computer.

2.2 Claim 1 specifies a method of sharing data in a multimedia system. Claim 1 implies that the multimedia system comprises a device adapted for "receiving a multimedia composition which references data". It further implies a device for "creating a list of data referenced by the multimedia composition" at "a first location (3) for playback". A storage area is associated with the first location and is thus also associated with the playback device. Claim 1 further specifies that the multimedia composition and referenced data are transferred from the location where the composition is received to the playback device located at the first location (where also the list is created). It follows from the receiving and transferring steps that these data have to be stored before they are transferred. Thus data are shared among different storage locations of a multimedia system which includes at least one location where the composition is received and a location for playback where also the list of data referenced by the multimedia composition is created. An essential characteristic of the method is that the transfer of the data referenced by the multimedia composition from the location of the receiving device to the storage area associated with the first location only takes place "when the data is not already in the storage area".

2.3 Claim 8 specifies a multimedia system. The multimedia composition is created on (and thus received by) a workstation which is "coupled to" the playback device. The playback device is adapted "to store and play multimedia compositions created by said workstation". A transfer tool is adapted to transfer "the multimedia composition and the data" from the workstation to the playback device. The transfer tool has the functionality that the transfer of the data referenced by the multimedia composition from the workstation to the playback device only takes place when the data "is not stored in the playback device". Thus data transfer in the multimedia system takes place via a suitable connection ("coupled to"), such as a network, which allows for both data transfer from "at least one workstation" to the playback device and the required check as to the presence of data in the playback device.

2.4 This claim construction is consistent with the presentation of the invention in view of the background explained in the specification of the opposed patent (see paragraphs [0002] and [0003]). Namely the description makes clear that the invention relates to the transferring of edited (news) clips to the playback device, over a network, for broadcast of the clips. Thus the invention is not concerned with the creation of the clips and their handling within an editing workstation. Instead the invention attempts to increase the system bandwidth, or in other words not to waste bandwidth during an individual data transfer, and available playback memory by avoiding duplicate storage in the playback device for broadcast (see paragraphs [0004], [0005] and [0007]).

2.5 The appellant's argument that the claims of the opposed patent only used other names for a transfer of data which may take place within an editing device, such as a computer and monitor, did not convince the board for the following reasons.

It is true that the wording of claim 1 only specifies a first location for playback and is silent about the location of receiving the multimedia composition with respect to the location(s) for playback. But, when read in the context of the patent as a whole, the features of receiving a multimedia composition and transferring said multimedia composition and referenced data for playback have the meaning that the multimedia composition is already created (or edited) before it is transferred for broadcast. Thus the playback specified in claim 1 concerns the playback of referenced data of a composition which are both transferred to the playback location and stored at this location. It does not concern the reproduction of a clip on the monitor and/or speaker of an editor's editing system before the multimedia composition is made available to the producer for broadcast.

Also in claim 8, when read in the context of the patent as a whole, the meaning of the workstation "to create a multimedia composition" is that of an editing workstation (including creating a new composition). The meaning of the "playback device" is that of a device suitable for storing and playing multimedia compositions and referenced data, such as a playback device for broadcast. This playback device is coupled to the editing workstation. Thus the multimedia system

comprises both at least one editing workstation and a playback device, such as a device for broadcast.

3. *Inventive step having regard to D10 (Article 56 EPC 1973)*

3.1 D10 discloses a method and system for editing digitized audio information. The editing is performed by means of a digital audio editing system including a computer (preferably a PC), a keyboard and a monitor. A microphone may be used as an audio input device and a speaker may be used as an audio output device (see figure 1A). The computer comprises an audio processor for *inter alia* converting analogue audio input to digital form and for converting the edited digital audio signals to analogue form for output to the speaker. The computer also comprises an audio editor which includes the audio editor program being executed. Furthermore the computer comprises a disk or RAM storage and a buffer storage (cache) that interfaces between the disk or RAM storage and the audio processor (see figure 1B). The editing is carried out by changing an index table, each index in the table being a pointer to an audio segment (i.e. an addressable unit of audio data) in the audio data file being edited. Only at the end of an editing session is the audio data file updated to reflect the changes which have occurred. D10 is, in particular, concerned with this updating process ("resequencing" or "garbage collection" in the terminology of D10). Namely it avoids copying those audio segments to the updated audio data file to which an index is no longer pointing, and it also avoids copying any audio segment twice to the updated audio data file, thereby saving memory space (see page 2,

line 30, to page 3, line 1, in conjunction with the description of figures 2 and 3, in particular page 9, lines 11 to 13 and 37 to 39).

- 3.2 D10 does not disclose a playback device within the meaning of the term as it is used in the opposed patent (see points 2.2 to 2.5 above) and is not concerned with the problem of transferring a composition and referenced data to the playback device which could waste system bandwidth and available playback memory. Thus D10 relates to a field different from that of the invention of the opposed patent and is concerned with a different problem. Hence D10 would not have been an appropriate starting point for a person skilled in the art faced with the problem set out in the opposed patent. Furthermore, as correctly found in the decision under appeal, the general functionality of saving memory space is achieved according to D10 by performing a check within an audio data file to be copied. It would not be consistent with the teaching of D10 to perform a check whether a duplicate of an audio segment of the audio data file to be copied is already stored in a further storage device, since D10 is concerned with "resequencing" or "garbage collection" within the editing device. Hence the subject-matter of the independent claims 1 and 8 of the opposed patent is not obvious having regard to the state of the art disclosed in D10.

4. *Admissibility of the facts submitted in the statement of grounds of appeal and relating to the evidence D1 (Articles 114(2) EPC 1973 and 12(4) RPBA)*

4.1 The appellant substantiated the ground for opposition of lack of inventive step in the notice of opposition within a factual framework relating to document D10. In the statement of grounds of appeal the appellant in addition substantiated this ground for opposition within a factual framework relating to evidence D1. The respondent objected that the opponent had thereby raised a new ground for opposition in appeal proceedings. According to the case law of the Boards of Appeal, a "ground for opposition" must be interpreted as meaning an individual legal basis for objection to the maintenance of a patent (see G 1/95, OJ EPO 1996, 615, point 4.6). A fresh ground for opposition may be considered in appeal proceedings only with the approval of the patentee (see point 3 of the opinion G 10/91, OJ EPO 1993, 420). In the present case, however, no fresh ground for opposition was introduced in the appeal proceedings, as the opposition had been based on lack of inventive step from the outset. Rather, by relying on D1 in connection with this ground, a new factual basis was introduced, which constitutes a different issue not covered by the aforementioned case law. In the present case the appellant could have presented the new facts relating to evidence D1 in support of this ground in the first instance proceedings, inter alia because D1 is a document cited in the opposed patent (see paragraph [0006] of the specification). In these circumstances Article 114(2) EPC 1973 and Article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA, OJ EPO 2007, 536) apply. Thus the board had to exercise the discretion conferred upon it by the aforementioned legal provisions to admit or not to admit these new facts.

4.2 The board took into consideration that D1 is the only document cited under the heading "background of the invention" in the opposed patent and was considered in examination proceedings before grant, so that the patentee had already had good reason to analyse this document before the appeal proceedings. The submissions made with the statement of grounds of appeal also allowed the board and the respondent to assess the appellant's case, so that the board, subject to the oral proceedings, could take a decision. Thus the board admitted the new facts of the appellant's case made in the statement of grounds of appeal.

5. *Inventive step having regard to the state of the art relating to evidence D1, as submitted with the statement of grounds of appeal (Article 56 EPC 1973)*

5.1 The passages of D1 mentioned in the statement of grounds of appeal disclose a video editing system which can be used to combine video clips. The clips are transferred from a video recorder to a random access disk store of the video editing system, where they are stored in a digitally encoded form. During editing the video editing system produces set-up data (a multimedia composition in terms of the opposed patent) which define the manner in which video data for the new video clip are created from the video data in the initial video clips. The video data for the new video clip once created are also stored in the disk store. The set-up data associated with the video data for the new video clip are stored in an editing memory. A problem that can sometimes occur is that the newly created clips are of such a length that it is not possible to load all the data representing the clip back into the disk store.

According to D1, this problem is solved by creating the set-up data so that each selected initial frame of the initial video clips is stored only once. Data of a video frame for the newly created video clip which is already stored in the disk store is not stored therein again. The edited video is transferred to a video tape recorder or other storage device. The editing system also comprises a monitor which allows the previewing of an initial video clip or the concurrent viewing of different reduced size frames of the clips being edited at different portions of the monitor.

5.2 D1 does not disclose a playback device within the meaning of the term as it is used in the opposed patent (see points 2.2 to 2.5 above) and is not concerned with the problem of wasting system bandwidth and available playback memory in the playback device for broadcast. Thus D1 relates to a different field from that of the invention of the opposed patent and is concerned with a different problem. It follows that, considering the factual framework of the appellant's case in the statement of grounds of appeal, D1 is not more relevant than D10 (as stated by the opponent in the notice of opposition, see point V above). This assessment is not changed if one takes into account the fact that file sharing techniques were common general knowledge because, similar to what is said in point 3.2 above, this part of D1 relates to avoiding duplicate segments of a file during editing within an editing device. Hence the subject-matter of the independent claims 1 and 8 of the opposed patent is not obvious having regard to the state of the art derived from the evidence D1, as submitted with the statement of grounds of appeal.

6. *Admissibility of the facts submitted in oral proceedings relating to the evidence D1 (Articles 114(2) EPC 1973 and 13(1) RPBA)*

6.1 During oral proceedings the appellant shifted the factual framework relating to evidence D1. A submission made in oral proceedings was that the problem to be solved concerned saving memory space of the video tape recorder when transferring the newly created clip to the tape recorder. According to the statement of grounds of appeal, the monitor of the editing system was the relevant playback device, whereas, according to a submission in oral proceedings, the video tape recorder was the relevant playback device. In a further modification of this factual framework the video tape recorder in combination with a magneto-optical device storing the set-up data was the relevant playback device. However no arguments were presented as to the distinguishing features of the invention with respect to D1 and the objective problem solved by the invention.

6.2 The new facts submitted during the oral proceedings constituted an amendment to the appellant's case after the filing of the statement of grounds of appeal. Thus the board had to exercise its discretion under Article 13(1) RPBA as to whether the new facts were to be admitted and considered. The board took into consideration that the appeal proceedings were already at an advanced stage and that the appellant could have submitted the new facts in the statement of grounds of appeal. Furthermore the board took into consideration that the presentation of the new line of attack constituted an amendment of the appellant's case which

the respondent did not have to expect when he decided not to attend the oral proceedings.

- 6.3 The board considers that the appellant's piecewise approach is contrary to an opponent's duty to set out in the notice of opposition the legal and factual framework in order to give the patentee a fair chance to consider his position at an early stage of the proceedings (see G 9/91, point 6).

The board takes the view that this piecewise approach is also contrary to the purpose of the appeal proceedings *inter partes*, which is mainly to give the losing party the possibility of challenging the decision of the Opposition Division on its merits (see G 9/91, point 18).

Furthermore such an approach runs counter to the objective of making appeal proceedings more efficient and shorter underlying Articles 12 and 13 RPBA (see, for instance, T 624/04, point 1.9 of the reasons, which analyzes the legislative intent behind Articles 10a and 10b, later renumbered as Articles 12 and 13 RPBA).

- 6.4 The appellant argued that document D1 had been cited in the notice of opposition and in the search report and had been considered as the closest prior art in pre-grant examination proceedings. Given that the board had admitted the new facts made in the statement of grounds of appeal, the board understands the appellant's arguments to mean that submissions relating to document D1 should be admitted as a whole in the appeal proceedings. However this view confuses facts and evidence which both have to be presented in support of

a ground for opposition (cf. Rule 55(c) EPC 1973). The appellant submitted new facts (and a new line of argument) relating to D1 during the oral proceedings which constituted an amendment to the appellant's case after the filing of the statement of grounds of appeal. Thus the board had to decide whether these new facts could also be admitted and considered (see point 6.2 above). Taking this discretionary decision concerning late filed facts required *inter alia* that the criteria specified in Article 13(1) RPBA be considered. The criterion considered by the appellant, that is whether the documentary evidence (D1) for the late filed facts was previously cited (in the notice of opposition) and admitted in the appeal proceedings as evidence for other facts, was not a decisive criterion to be considered.

- 6.5 In the light of the above considerations the board decided not to admit the amendment to the appellant's case during the oral proceedings which started from a different set of facts and passages of the documentary evidence D1.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

L. Fernández Gómez

F. Edlinger