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**Datasheet for the decision
of 17 March 2010**

Case Number: T 1560/05 - 3.5.04

Application Number: 95916248.8

Publication Number: 0756797

IPC: H04N 1/00

Language of the proceedings: EN

Title of invention:

Method and apparatus for providing interactive electronic programming guide

Patentee:

SCIENTIFIC-ATLANTA, INC.

Opponent:

IGR GmbH & Co. KG.

Headword:

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Relevant legal provisions:

-

Relevant legal provisions (EPC 1973):

EPC Art. 54, 56
RPBA Art. 13(1)(3)

Keyword:

"Novelty - yes"
"Inventive step - no"

Decisions cited:

T 0172/03

Catchword:

Allegedly non-technical document (no) (see point 3.3)



Case Number: T 1560/05 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 17 March 2010

Appellant: SCIENTIFIC-ATLANTA, INC.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 2 November 2005
revoking European patent No. 0756797 pursuant
to Article 102(1) EPC 1973.

Composition of the Board:

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

Summary of Facts and Submissions

- I. This is an appeal by the patent proprietor against the decision by the opposition division revoking European patent 0 756 797, the opposition having been based on the ground for opposition under Article 100(a) EPC 1973 of inventive step.
- II. According to the reasons for the appealed decision, the subject-matter of all the independent claims as granted, namely claims 1, 17, 27 and 33, lacked inventive step, Articles 52(1) and 56 EPC 1973, in view of the combination of documents E3 and E2, these documents being:

E2: US 4 706 121 A

E3: Funkschau 24/1993, pages 54 to 59; F. Schönborn:
"USA-Kabelfernsehen: Führend in der Technik".

The reasons for the decision also stated that the claimed subject-matter was novel over *inter alia* the disclosure of document

E1: WO 92/04801 A1,

since E1 did not mention either PPV (pay-per-view) or NVOD (near-video-on-demand) programs.

- III. In the notice of appeal the appellant requested that the appealed decision be set aside.
- IV. With a subsequently filed statement of grounds of appeal the appellant filed a substitute set of claims 1 to 48.

V. The respondent (opponent) requested that the appeal be dismissed and argued in a submission dated 22 June 2006 that the claimed subject-matter lacked inventive step in view of E3 combined with either E2 or E1. The claimed subject-matter also lacked novelty, Article 54 EPC 1973, over E1, since recording a program was the same technically as purchasing it. As evidence of this, the respondent filed the following documents, referred to as the "further documents" below:

EP 0 969 665 A1

EP 0 968 608 B1

EP 0 706 291 A2

EP 1 095 511 B1.

VI. In a letter dated 26 October 2006 the respondent informed the board of a change of name and provided a corresponding extract from the German commercial register.

VII. With a letter dated 14 December 2006 the appellant filed a substitute set of claims 1 to 48. The appellant also argued that there was no technical teaching in E3 and, citing decision T 172/03, that E3 could not be used as a starting point for assessing inventive step.

VIII. The set of claims comprises four independent claims, namely claims 1, 17, 27 and 33, these reading as follows:

"1. A subscription television system for supplying television signals to a plurality of subscribers, said subscription television system comprising: an

electronic programming guide (EPG) listing a plurality of television programs by date, time and channel in a grid format, said plurality of television programs including: (1) at least one of a pay-per-view and a near-video-on-demand program and (2) another television program that is not a pay-per-view or a near-video-on-demand program, , [sic] said grid format having slots arranged in columns and rows and identifying said television programs where each slot represents a television program at a certain time interval and on a certain channel; a first transmitting means (10, 12) for transmitting the television signals comprising said plurality of television programs to said subscribers on a plurality of television channels, said first transmitting means also transmitting to said subscribers said electronic programming guide; a subscriber terminal (14) for receiving the television signals and providing the television signals to a user of said subscription television system, said subscriber terminal including: means (20, 132) for displaying said electronic programming guide in said grid format and providing a cursor to highlight said slots for identifying said television. [sic] programs said cursor being activated by a remote control; a first selecting means (126) for directly selecting said television programs from said displayed programming guide by highlighting said television program slot, said first selecting means including means for directly purchasing after said user highlights said television slot said at least one of said pay-per-view or said near video-on-demand program from said electronic programming guide by activating said highlighted television slot via said remote control; and tuning means (100) connected to

said display means (20) to tune to said highlighted television program."

"17. A subscriber terminal (14) for receiving television signals comprising a plurality of television programs and an electronic programming guide, from a subscription television provider, at least one of said television programs being one of a pay-per-view or a near-video-on-demand program provided only to subscribers who purchase said program, said subscriber terminal (14) comprising: means for displaying (20, 132) said electronic programming guide listing said television programs by date, time and television channel in a grid format having slots arranged in columns and rows for identifying said television programs where each slot represents a television program at a certain time interval and on a certain channel and including: (1) at least one of said pay-per-view or near video-on-demand television program and (2) another television program that is not a pay-per-view or a near-video-on-demand program; a first selecting means (126) for directly selecting said television programs from said displayed programming guide by highlighting said television program slot, said first selecting means including means for directly purchasing after highlighting said television slot, said at least one of said pay-per-view and said near video-on-demand program from said electronic programming guide."

"27. The method of selecting one of a pay-per-view and near-video-on-demand program in a subscription television system, including the following steps: displaying an electronic programming guide transmitted

by a subscription television provider wherein said programming guide list television programs by date, time, and television channel in a grid format, said grid format having slots arranged in columns and rows for identifying said television programs where each slot represents a television program at a certain time interval and on a certain channel and including: (1) at least one of a pay-per-view or near-video-on-demand television program and (2) another television program that is not a pay-per-view or a near-video-on-demand program; using a user interface (128) to select and purchase directly said pay-per-view or said near video-on-demand program from said electronic programming guide."

"33. A method for supplying television signals to a plurality of subscribers of a subscription television system and selecting a television program comprising the steps of: transmitting television signals to said subscribers on a plurality of television channels wherein the television signals comprises a plurality of television programs and further transmitting to said subscribers an electronic programming guide; receiving the television signals by a subscriber terminal and providing the television signals to a user of said subscription television system; displaying said electronic programming guide in a grid format wherein said grid format has slots arranged in columns and rows for identifying said television programs where each slot represents a television program at a certain time interval and on a certain channel and displaying a cursor wherein said cursor moves about said programming guide and highlights said television program slots, said cursor being activated by a remote control;

listing said plurality of television programs by date, time and channel in said grid format on said electronic programming guide, said plurality of television programs including: (1) at least one of a pay-per-view and a near-video-on-demand television program and (2) another television program that is not a pay-per-view or a near-video-on-demand program; selecting said television programs directly from said displayed programming guide by highlighting said television program slot; and purchasing, by activating said highlighted slot via said remote control after said user highlights said television program slot, said at least one of said pay-per-view and said near video-on-demand program directly from said electronic programming guide."

- IX. In an annex to a summons to oral proceedings the board stated *inter alia* that it had doubts as to the admissibility of the further documents submitted by the respondent, since they appeared unsuitable for providing evidence of the technical meaning of terms at the relevant date of the opposed patent and thus did not appear to relate to the case under appeal, Article 12(4) RPBA (see OJ EPO 2007, 536). E3 appeared to relate to technical matter and seemed to disclose the purchasing of pay-per-view programs (see page 55, column 3, line 7, to column 4, line 4, and page 57, left column, lines 30 to 37). The board also expressed doubts as to the clarity and support in the description, Article 84 EPC 1973, for the expressions in claims 1 and 17 "directly purchasing", in claim 27 "purchase directly" and in claim 33 "purchasing ... directly".

- X. Oral proceedings were held before the board on 17 March 2010, during which the inventive step of claim 27 was first discussed. The board then gave its preliminary opinion that the subject-matter of claim 27 lacked inventive step in view of E1 and common general knowledge. The subject-matter of claim 17 and further distinguishing features in claim 1 were then discussed. At the end of the oral proceedings the appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 to 48 filed with the letter dated 14 December 2006 (main request) and, as an auxiliary request, on the basis of these claims with claim 27 being deleted. The respondent requested that the appeal be dismissed.
- XI. In the oral proceedings the board drew attention to the background of the invention of E1 (pages 1 to 3) which stated that viewers had encountered problems when programming VCRs. One of the teachings of E1 was to use the EPG as a user interface for selecting a program when programming the VCR. The opposed patent mentioned (see column 2, line 4 onwards) that viewers had encountered problems in using impulse-pay-per-view systems to purchase programs, these problems being similar in nature to those encountered when programming a VCR.
- XII. The appellant's arguments in the oral proceedings may be summarized as follows.

Main request

Regarding the meaning of the expressions in the independent claims such as "directly purchasing", the appellant emphasised that purchasing occurred directly

from the electronic programming guide (EPG), as opposed to from a separate sub-menu of PPV/NVOD programs. The purchasing step could merely involve selecting the program and activating a "buy" button, but could also involve confirming the intention to buy or giving an identification number. The invention integrated the list of PPV/NVOD programs into the EPG, thus better informing the user of the availability of these programs and making their selection easier.

The appellant maintained that E3 was non-technical, but, given the board's preliminary opinion on this point (see point IX above), did not expand on it.

E1 disclosed an EPG with a scrollable grid for viewing TV programs and for programming a VCR to record them. The EPG did not however include information on PPV or NVOD programs, indeed E1 did not mention PPV or NVOD programs at all. In particular, E1 did not disclose a "method of selecting one of a pay-per-view and near-video-on-demand program in a subscription television system" (see the designation of claim 27), nor did it disclose the last feature, i.e. "using a user interface (128) to select and purchase directly said pay-per-view or said near video-on-demand program from said electronic programming guide."

Regarding inventive step, E1 formed the closest prior art because it disclosed the presentation of TV programs in a grid format. Program selection from such a grid was technically different from selecting from a list. Starting from E1, the objective technical problem was how to offer all available programs to the viewer. Although the patent acknowledged (see column 2, lines 4

to 34) that "impulse-pay-per-view" systems, which allowed a viewer to choose an event directly from the subscriber terminal for immediate viewing, were known at the priority date, the patent also set out the difficulties encountered in using such systems. Including PPV/NVOD programs in the EPG of E1 posed technical difficulties. Firstly, the data relating to these programs had to be acquired. Secondly, modifications were required to the viewer terminal to implement the purchasing step.

Auxiliary request

Claim 17 set out displaying free and PPV/NVOD programs in an EPG, followed by program selection and purchasing directly from the EPG. Beyond the features set out in claim 27 of the main request, claim 17 of the auxiliary request set out means for receiving free and PPV/NVOD programs and combining both types of programs in a grid. The respondent's arguments on inventive step merely concerned what the skilled person "could" have done, but did not show why the skilled person "would" have done so.

XIII. The respondent's arguments in the oral proceedings may be summarized as follows.

Main request

E1 showed the selection of TV programs from an EPG, but did not disclose a mixture of free and PPV/NVOD programs, or the purchase of PPV/NVOD programs from an EPG. However the fact that PPV/NVOD programs had to be paid for whilst free TV programs did not was a commercial difference rather than a technical one; the information presented in the EPG was the same in both

cases, and the two sorts of program were in competition with each other for the viewer's attention.

"Purchasing" did not necessarily imply communication via a backchannel with the cable network operator. It was conceivable that the viewer might have a pre-paid card with units which were debited by the cable decoder when programs were purchased.

E3 (see page 56, lower figure) showed that at the priority date of the present patent a great variety of free and PPV/NVOD programs were broadcast. There would have been no reason not to include all available programs in an EPG, particularly because the viewer typically wanted to know what was being shown now or tomorrow. Programs that were not free were usually scrambled, this requiring some sort of purchasing step in order to be able to unscramble and watch them.

Either E1 or E3 could be seen as a starting point for assessing inventive step. Starting from E3, the objective technical problem was how to select programs in the mixed "bouquet" of free and PPV/NVOD programs and, if they had to be paid for, how to pay. Starting from E1, the objective technical problem, knowing that PPV/NVOD programs existed, was to incorporate these into the programs offered to a user for viewing. Integrating PPV/NVOD programs into the EPG known from E1 would not have posed any technical difficulties and would have been obvious.

Auxiliary request

The respondent had no objection regarding the admissibility of the auxiliary request. The EPG grid was not transmitted, but was created by the viewer

terminal. The highlighting set out in claim 17 was known from E1. Claim 17 set out essentially the same features as claim 27 of the main request and lacked inventive step for essentially the same reasons.

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

Reasons for the Decision

1. *Admissibility of the appeal*

The appeal is admissible.

2. *Admissibility of the "further documents"*

These documents, which were cited by the respondent as evidence of the technical meaning of "purchasing" a television program (see point V above), are neither prior art (indeed the respondent has emphasized that he is not asserting this), nor do they relate to case law. In the annex to the summons to oral proceedings the board expressed doubts (see point IX above) as to whether these documents should be admitted into the appeal proceedings, since they appeared unsuitable for providing evidence of the technical meaning of terms at the relevant date of the opposed patent and thus did not appear to relate to the case under appeal. The appellant has not provided any counterarguments. The board comes to the final view that these documents do not relate to the case under appeal and are consequently not admitted into the proceedings.

3. *The appellant's main request*

It is common ground between the parties, and the board agrees, that claim 27 is the broadest independent claim.

3.1 *The invention*

The invention relates to the selection, purchase and viewing of pay-per-view (PPV) and near video-on-demand (NVOD) television programs (which are received together with other television programs). As explained in paragraph [0004] of the published patent, PPV programs are available for purchase individually for a fee. The viewer selects the program, and his account is charged. The viewer's equipment (normally referred to as a subscriber terminal) then tunes to the program and performs any necessary descrambling. The viewer can then watch the program. Near video-on-demand programs are broadcast on several channels simultaneously with a time difference between the various instances of the same program; see paragraph [0008] of the published patent. As now claimed, the invention concerns presenting the viewer with an electronic programming guide (EPG) containing PPV/NVOD programs and programs that are not PPV/NVOD in a grid format. The viewer can then select a PPV/NVOD program and purchase it from the EPG.

3.2 *Claim construction*

The appellant has argued that the expression "directly purchasing" means that purchasing occurs directly from the EPG, as opposed to from a separate sub-menu of PPV/NVOD programs. The respondent has not commented on

this point. In the light of the appellant's argument, the board finds that the expression "directly" relates to the manner of program selection in the purchasing step, rather than to the manner in which the subsequent purchase occurs. The board is consequently satisfied that claims 27 and 17 define the matter for which protection is sought sufficiently clearly for the purposes of assessing inventive step.

3.3 *The common general knowledge*

As paragraphs [0004] and [0008] of the published patent acknowledge, PPV and NVOD programs were known at the priority date of the opposed patent. Moreover, according to paragraphs [0005] and [0006] of the published patent, at the priority date "impulse-pay-per-view" systems were known which allowed viewers to choose a program directly from the subscriber terminal for immediate viewing. However they had met with limited viewer acceptance due to their complexity; viewers had to call a certain telephone number and enter information such as a code indicating the program choice, a customer identification number and, typically, also a security number.

E3 reviews cable television networks in the USA before the priority date. In the board's view, the skilled person would derive technically relevant information from such a review, such as information on the different kinds of television programs transmitted in the USA and on the (interactive) services offered for subscription or purchase using, for instance, a back channel. Thus the circumstances differ from those referred to in case T 172/03 (see reasons, point 10).

Consequently the board does not accept the appellant's argument that there is no technical teaching in E3. In the judgement of the board E3 is comprised in the state of the art as defined in Article 54(2) EPC 1973.

According to E3, television programs transmitted by cable networks in the USA were typically divided up into several packages. The "basic" packages were unscrambled and could be received by any television; see page 56, lower figure and right-hand column. Other "premium" and "pay" packets were scrambled and had to be paid for separately. E3 also mentions the purchase of PPV programs involving communication between the subscriber terminal and the program provider via a cable "back channel"; see page 55, column 3, line 7, to column 4, line 4, and page 57, left column, lines 30 to 37.

3.4 *Document E1*

E1 concerns an EPG which presents TV programs in a grid format and indicates the date, time and television channel of each program; see figure 1. The viewer selects a program by highlighting it using a cursor; see page 6, lines 4 to 10 and page 9, lines 7 to 8. E1 aims to overcome the problems encountered in manually programming a VCR by using an EPG to program the VCR instead; see the paragraph bridging pages 1 and 2 and page 2, line 18, to page 3, line 19. As explained on page 13, lines 28 to 34, the user can record the program by moving the cursor to the desired program and using the "Record It" command. Programming of a VCR is thus achieved by a simple selection of program title in the EPG and a record command even for recording at a

future date and time (E1, page 1, lines 12 to 16). E1 does not mention either PPV or NVOD programs.

3.5 *Novelty with respect to E1, Article 54 EPC 1973*

In terms of claim 27, E1 discloses a method of selecting a program, including the following steps: displaying an electronic programming guide (see figure 1) transmitted by a subscription television provider wherein said programming guide lists television programs by date, time, and television channel in a grid format, said grid format having slots arranged in columns and rows for identifying said television programs where each slot represents a television program at a certain time interval and on a certain channel and including at least a television program that is not a pay-per-view or a near-video-on-demand program and using a user interface (see page 6, lines 4 to 10, and page 9, lines 7 to 8) to select said program from said electronic programming guide.

Thus the subject-matter of claim 27 differs from the disclosure of E1 in the EPG comprising one of a pay-per-view and near-video-on-demand program and in the step of selecting and purchasing one of these programs directly from the EPG. This step of claim 27 implies further technical measures going beyond a simple selection and viewing (or recording) of one of the other television programs. In particular, for both PPV and NVOD programs, there must be some processing steps to verify authorization and to debit the selected event. Whilst the board agrees with the respondent that such processing steps do not necessarily have to include communication via a back channel, the board finds that

the system disclosed in E1 would have required at least some modification, such as the use of a pre-paid card as suggested by the respondent, to carry out the difference features set out above.

Hence the board finds that the subject-matter of claim 27 is novel, Article 54 EPC 1973.

3.6 *Inventive step, Article 56 EPC 1973*

It is common ground between the parties, and the board agrees, that the objective technical problem starting from E1 can be formulated as how to offer to the user all available programs for viewing. It was common general knowledge at the priority date that the available programs could include at least PPV programs. In adding PPV programs to the subscriber terminal known from E1 the skilled person would have been aware that E1 taught using the EPG as the user interface for selecting television programs for particular functions, E1 disclosing a recording function. The reception of PPV programs would have implicitly required a purchasing function. Although simple, non-selectable information or a separate program guide would also have been feasible, incorporation into an existing EPG would have offered straightforward advantages. For the program provider it would have increased the chances that an offered program would not be overlooked and for the user it would have eased the access to any available program. Hence the board finds that the skilled person would have chosen to implement purchasing of the selected program directly from the EPG as the simplest extension of the teaching of E1. Starting from E1 and acting on the hint that

information on programs (future date and time, etc.) presented in an EPG may be used for the simple selection of a program to provide an additional function (in E1 recording), the skilled person would have arrived at the subject-matter of claim 27 without inventive step.

The board consequently finds that the subject-matter of claim 27 does not involve an inventive step, Article 56 EPC 1973.

4. *The appellant's auxiliary request*

4.1 *The amendment*

The claims according to the auxiliary request differ from those according to the main request only in that independent claim 27 has been deleted, no claims being dependent on claim 27. The claims have not been renumbered. It is common ground between the parties, and the board agrees, that claim 17 is the broadest independent claim, setting out a subscriber terminal for receiving television signals.

4.2 *Admissibility*

This request relates to an amendment to the appellant's case after the grounds of appeal have been filed and thus may be admitted and considered at the board's discretion, Article 13(1) RPBA, this discretion being exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. Moreover the request concerns an amendment after oral

proceedings have been arranged, Article 13(3) RPBA, and thus shall not be admitted if it raises issues which the board or the other party cannot reasonably be expected to deal with without adjournment of the oral proceedings.

In the present case the effect of the deletion of claim 27, in reaction to the board's preliminary view given in the oral proceedings on the patentability of claim 27 of the main request, was immediately apparent to the respondent and the board. Moreover the deletion did not substantially change the matters under discussion, since the subject-matter of claim 17 does not differ significantly from that of the previously discussed claim 27. Furthermore the respondent did not raise any objection to the admissibility of the request.

The auxiliary request was consequently admitted into the proceedings, Article 13(1) RPBA.

4.3 *Novelty with respect to E1, Article 54 EPC 1973*

In terms of claim 17, E1 discloses a subscriber terminal for receiving television signals comprising a plurality of television programs and an electronic programming guide (see figure 1), from a subscription television provider, said subscriber terminal comprising: means for displaying said electronic programming guide listing said television programs by date, time and television channel in a grid format having slots arranged in columns and rows for identifying said television programs where each slot represents a television program at a certain time interval and on a certain channel and including a

television program that is not a pay-per-view or a near-video-on-demand program and a first selecting means for directly selecting said television programs from said displayed programming guide by highlighting said television program slot (see page 6, lines 4 to 10, and page 9, lines 7 to 8).

Hence the subject-matter of claim 17 differs from the disclosure of E1 in at least one of said television programs being one of a pay-per-view or a near-video-on-demand program provided only to subscribers who purchase said program and in said first selecting means including means for directly purchasing after highlighting said television slot, said at least one of said pay-per-view and said near video-on-demand program from said EPG. Regarding the technical measures implied by these features, the observations made above under point 3.5 equally apply.

Hence the board finds that the subject-matter of claim 17 is novel, Article 54 EPC 1973.

4.4 *Inventive step, Article 56 EPC 1973*

As with the main request, it is common ground between the parties, and the board agrees, that the objective technical problem starting from E1 can be formulated as how to offer to the user all available programs for viewing. It was common general knowledge at the priority date that the available programs could include at least PPV programs, such programs being provided only to subscribers who purchased said programs. In adding PPV programs to the subscriber terminal known from E1 the skilled person would have been aware that

E1 taught using the EPG as the user interface for selecting television programs for particular functions using a selection means, E1 disclosing a recording function. The reception of PPV programs would have implicitly required a purchasing function. For the reasons set out in point 3.6 above the skilled person would have chosen to provide first selecting means with means for directly purchasing the PPV program after highlighting it in the EPG (see E1, page 13, lines 28 to 34) as the simplest extension of the teaching of E1. Starting from E1 and by applying common general knowledge, the skilled person would thus have arrived at the subject-matter of claim 17 without inventive step.

The board consequently finds that the subject-matter of claim 17 does not involve an inventive step, Article 56 EPC 1973.

5. In the oral proceedings before the board the other independent claims 1 and 33 according to the main and auxiliary requests were also briefly discussed as to whether they set out any additional features which would make a difference to the above assessment of inventive step. The appellant did not convince the board that any of these features went beyond a further clarification of features already contained in claims 17 and 27 and commonly known means or steps.

6. *Conclusion*

Since the patent amended according to the appellant's main and auxiliary requests does not meet the requirements of the EPC, the appealed decision cannot be set aside.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

C. Rodríguez Rodríguez

F. Edlinger