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**Datasheet for the decision  
of 31 May 2007**

**Case Number:** T 0567/06 - 3.5.04

**Application Number:** 00971376.9

**Publication Number:** 1149491

**IPC:** H04N 7/00

**Language of the proceedings:** EN

**Title of invention:**

Method and apparatus for swapping the video contents of  
undesired commercial breaks or other video sequences

**Applicant:**

Koninklijke Philips Electronics N.V.

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

EPC Art. 113(1), 123(2)

EPC R. 67, 68(2)

**Keyword:**

"Right to be heard (no)"

"Decision reasoned (no)"

"Decision on the file as it stands"

"Substantial procedural violation (yes)"

"Reimbursement of appeal fee (yes)"

**Decisions cited:**

G 0010/93, T 0740/93, T 0135/96, T 0508/01, T 0571/03,

T 1309/05, T 1379/05

**Catchword:**

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Case Number: T 0567/06 - 3.5.04

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.04  
of 31 May 2007

**Appellant:** Koninklijke Philips Electronics N.V.  
Groenewoudseweg 1  
NL-5621 BA Eindhoven (NL)

**Representative:** Damen, Daniel Martijn  
Philips Intellectual Property & Standards  
P.O. Box 220  
NL-5600 AE Eindhoven (NL)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 21 November 2005  
refusing European application No. 00971376.9  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** F. Edlinger  
**Members:** M. Paci  
B. Müller

## Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division dated 21 November 2005 refusing European patent application No. 00 971 376.9 on the ground that claim 1 contained subject-matter extending beyond the content of the application as filed (Article 123(2) EPC).
- II. In a first official communication the examining division had raised an objection that the subject-matter of claims 1 and 3 lacked novelty having regard to the disclosure of
- D1: US 5 774 170 A.
- III. In reply to the first communication the applicant filed amendments, *inter alia* a new set of claims, and presented arguments as to novelty and inventive step.
- IV. In a further official communication dated 8 April 2005 annexed to the summons to oral proceedings the examining division objected that claim 1 was not clearly worded and that its subject-matter still lacked novelty.
- V. In a letter of response dated 8 August 2005 the applicant again filed an amended set of claims as main request for consideration at the oral proceedings. The letter indicated the basis for the amendments to claim 1 and presented arguments as to the patentability of the claim. As an auxiliary request, the applicant requested "*that each of the claims be considered separately, such that an adverse decision in respect of*

*an individual claim shall not prejudice the allowability of the application as a whole unless adverse decisions are rendered in respect of each and every claim."*

VI. On 24 October 2005, this being one day prior to the oral proceedings, the applicant informed the examining division via a telefax received by the EPO at 2:45 p.m. that he would not attend the oral proceedings and that he requested *"a decision based in the file as it stands, in particular including the comments and amendments filed with our letter of 8<sup>th</sup> August 2005"*.

VII. At the end of the oral proceedings held on 25 October 2005 before the examining division and not attended by the applicant, the decision to refuse the application was announced.

VIII. The examining division's reasoning in the written decision regarding the ground for refusing the application reads as follows:

*"After discussion, it was found that the last version of claim 1 included a new feature, an indefinite "generation of information" (see lines 5 and 7 of the claim) which is not included in the application documents as originally filed.*

*It was found therefore that the present application does not meet the requirements of Art. 123(2) EPC, so that it was decided in the Oral Proceedings to refuse the application."*

The decision also observed that in the absence of the unallowable amendment the subject-matter of claim 1 "could also lack novelty" and that a "full decision"

had been established contrary to the applicant's request because the new set of claims "lacked at the time of the request a substantive examination".

IX. Claim 1 on appeal (identical to claim 1 considered by the examining division) reads as follows:

"A method for in a user device swapping an undesired video sequence received in a video signal for a desired video sequence, said method comprising the steps:

- receiving (50) a video signal at a user device;
- detecting (52) a specific video sequence within said received video signal;
- generating (58) information representing the characteristics of said specific video sequence;
- comparing (60) said generated information with stored characteristics of other video sequences, said stored characteristics including indicators specifying whether the respective other video sequences are desired;
- determining (62) whether said specific video sequence is desired based on said stored characteristics; and
- substituting (70) a desired video sequence in place of said specific video sequence if said specific video sequence is not desired."

X. In the statement of grounds of appeal the appellant essentially argued as follows.

*Right to be heard*

The appellant had sought to amend the claims to express the distinction over D1 in accordance with the

arguments which had been presented. The examining division had throughout the procedure made no comment as to the inventiveness of this distinction. The appellant expected that these issues would be discussed at the oral proceedings and a reasoned decision issued thereafter. Instead, the claims submitted by the appellant for consideration at the oral proceedings were immediately dismissed by the examining division during the oral proceedings as adding subject-matter, contrary to Article 123(2) EPC. The appellant was given no opportunity to comment on this objection raised for the first time during the oral proceedings, in violation of Article 113(1) EPC (right to be heard), which constituted a substantial procedural violation. There was no indication before the oral proceedings that an objection under Article 123(2) EPC would be discussed during the oral proceedings. Had the appellant been made aware of such an objection before the oral proceedings, then a choice could have been made between attending and commenting on the objection, or not attending and availing himself of the right to comment.

Moreover, the examining division had not commented on the appellant's auxiliary request that each and every claim be considered separately (see point V *supra*).

*Added subject-matter*

The application as originally filed stated that "the video sequence needed to be analysed in order to detect known characteristic features" and described various examples of information generated by this analysis, such as video signatures (page 2, line 31 to page 3,

line 18) and audiovisual/textual features (page 5, lines 11-13). The step of analysing the video sequence to detect its characteristics thus always implied the generation of information representing the characteristics of the video sequence. Hence the expressions "generating information" and "generated information" presented the skilled reader with no new information and did not violate the provisions of Article 123(2) EPC.

The appellant requested in the notice of appeal that the appealed decision be set aside and that a European patent be granted. The subsequently filed statement of grounds of appeal contained the following set of requests:

- to overturn the examining division's decision on Article 123(2) EPC and to remit the case to the examining division for further prosecution;
- to remit the case to the examining division for full consideration of all the issues pertinent to the application, and to reimburse the appeal fee; and
- as a last resort, to hold oral proceedings.

## **Reasons for the Decision**

1. The appeal is admissible.
2. *Right to be heard and duty to state reasons*
  - 2.1 In accordance with the established jurisprudence of the boards of appeal, the opportunity to present comments guaranteed by Article 113(1) EPC is a fundamental right enjoyed by parties to examination, opposition or appeal

proceedings. It is not "merely a right to speak, but a **right to be heard**, ie not only the right to present comments, but also the right to have those comments duly considered" (see T 508/01, point 4, not published in OJ). According to T 135/96 (not published in OJ), it is established jurisprudence of the boards of appeal that the right to be heard in accordance with Article 113(1) EPC guarantees the right to have the relevant grounds fully taken into account in the written decision. A failure to do so has been considered a substantial violation of the right to be heard. (See point 2 of the Reasons and the decisions cited there.) In the view of the present board there is a violation of Article 113(1) EPC in any case when it is clear from the wording of the decision that specific facts, evidence or arguments that are relevant to the outcome of the case were not considered in the decision-making process.

- 2.2 Moreover, Rule 68(2) EPC provides that decisions of the European Patent Office which are open to appeal shall be reasoned. According to the established jurisprudence of the boards of appeal, this requirement is understood as meaning that the reasoning in the decision must contain, in logical sequence, those arguments which justify the order; see for instance T 571/03 (point 13), T 1309/05 (section 3) and T 1379/05 (points 10 and 11), all not published in OJ. Reasoning does not mean that every argument requires a detailed answer, or even in some cases an answer at all. However, as pointed out in decision T 740/93 (under point 5.4, not published in OJ), it is "a general principle of good faith and fair proceedings that reasoned decisions contain, in addition to the logical chain of facts and reasons on



which every decision is based, at least some motivation on crucial points of dispute in this line of argumentation in so far as this is not immediately apparent from the reasons given, in order to give the party concerned a fair idea of why his submissions were not considered convincing". The Guidelines for Examination in the EPO, E-X,5 (version of June 2005) also emphasise that "(t)he need for complete and detailed reasoning is especially great when dealing with contentious points which are important for the decision" and that "special attention should be paid to important facts and arguments which may speak against the decision made. If not, the impression might be given that such points have been overlooked". The board agrees.

2.3 In the examination proceedings the appellant explained in some detail in the letter accompanying amended claim 1 where support for the expressions "generating information" and "generated information" could be found in the original application. The appellant pointed in particular to page 3, lines 17 to 18, which contains the word "information" used in the same context as in present claim 1. He also referred to the part of the description extending from page 2, line 31, to page 3, line 16, which discloses several examples of such information (video signature, video index, classification and purpose of the commercial) and to page 5, lines 11-13, which mentions the step of comparing these examples of information to a stored database of such characteristics.

2.4 Nevertheless, none of the above arguments submitted by the appellant were addressed in the decision. The board

does not even know whether they were deliberately ignored by the examining division or simply overlooked. In any case, these arguments were not without relevance and should have been considered by the examining division and dealt with, at least briefly, in the written decision.

2.5 In fact, the reasoning of the examining division regarding the ground for refusal of the application is contained in a single sentence: *"After discussion, it was found that the last version of claim 1 included a new feature, an indefinite "generation of information" (see lines 5 and 7 of the claim) which is not included in the application documents as originally filed."*

2.6 The reasoning in the decision under appeal is thus limited to noting that the expression "generation of information", and by way of extension the expressions "generating information" and "generated information", as they appear in claim 1, were not present in the application as filed. The provisions of Article 123(2) EPC, however, concern not whether amendments introduce **an expression** not present in the application as filed, but whether they introduce **subject-matter** which extends beyond the content of the application as filed. The difference is important. Merely stating, as the examining division did, that a new expression has been introduced does not by itself suffice to conclude that subject-matter has been added in violation of Article 123(2) EPC. Indeed, the new expression could simply have changed the wording of the claim without even changing its subject-matter (and thus extending the content of the application as filed). Alternatively, the new expression could include technical information

which, in the same context, was **implicit** in the original application, in which case an explicit mention of this information would not change the content of the application.

2.7 Given that it is clear from the wording of the decision that the examining division failed to consider arguments that were relevant to the outcome of the case, the board finds that the examining division violated the appellant's right to be heard under Article 113(1) EPC. The fact that the decision is silent on these relevant submissions also means that it lacks sufficient reasoning for the ground of refusal. It thus does not comply with Rule 68(2) EPC either.

2.8 As a last observation, the board is aware that the appellant's request for a "decision based in the file as it stands" and the fact that the Guidelines for Examination in the EPO (version of June 2005), E-X,4.4, state in such cases that "(t)he decision will be of a standard form, simply referring to the previous communication(s) for its grounds and to the request of the applicant for such a decision" might have incited the examining division to write a very short reasoning. On this point, the board would like to make clear that, whether or not the above sentence quoted from the Guidelines is good advice, the provisions of Article 113(1) EPC and Rule 68(2) EPC must always be met (see also T 1309/05, *supra*, points 3.6 and 3.7 of the Reasons).

3. *Remittal to the first instance*

3.1 The first instance proceedings thus show fundamental deficiencies in that Article 113(1) and Rule 68(2) EPC were not complied with, which amounts to a substantial procedural violation. Pursuant to Article 10 RPBA, a board shall remit a case to the department of first instance in such circumstances, unless special reasons present themselves for doing otherwise.

3.2 Special reasons have not been submitted by the appellant. Rather, one of the appellant's requests is to remit the case to the examining division for full consideration of all the issues pertinent to the application. The board considers that this is the appropriate procedure in the present case because proceedings before the boards of appeal in ex parte cases are primarily concerned with examining the contested decision (G 10/93, point 4). In view of a lack of reasoning and due consideration of the applicant's arguments, the board would effectively have to carry out the task of the examining division with the consequence that the applicant may not have the issues considered at two instances. Therefore the board did not allow the appellant's higher ranking requests (to decide on Article 123(2) EPC, which would be a precondition for considering a grant of the patent as requested in the notice of appeal). Since oral proceedings were only requested as a last resort, the board saw no need to summon the appellant to oral proceedings.

4. *Reimbursement of the appeal fee*

4.1 In view of the substantial procedural violation, the board considers it equitable in the present case to reimburse the appeal fee (Rule 67 EPC).

5. *Other alleged procedural errors*

5.1 Since the case is remitted to the department of first instance for further prosecution because of the two substantial procedural violations discussed above and the appeal fee is reimbursed, the board need not examine whether other substantial procedural violations were committed (see point X *supra*).

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The appeal fee shall be reimbursed.

The Registrar:

The Chairman:

D. Sauter

F. Edlinger