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**Datasheet for the decision  
of 3 May 2011**

**Case Number:** T 0711/07 - 3.5.04

**Application Number:** 00906014.6

**Publication Number:** 1153508

**IPC:** H04N 5/445

**Language of the proceedings:** EN

**Title of invention:**

Electronic program guide with support for rich program content

**Patentee:**

United Video Properties, Inc.

**Opponent:**

IGR GmbH & Co. KG.

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 123(2)  
RPBA Art. 12(4), 13(1), 15(3)

**Relevant legal provisions (EPC 1973):**

EPC Art. 56

**Keyword:**

"Inventive step - no"  
"Extension of subject-matter - yes"  
"Admission of late filed request - no"

**Decisions cited:**

-

**Catchword:**

See point 5.9 of the reasons.



Case Number: T 0711/07 - 3.5.04

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.04  
of 3 May 2011

**Appellant:** United Video Properties, Inc.  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 28 February 2007  
rejecting the opposition filed against European  
patent No. 1153508 pursuant to Article 102(1)  
EPC 1973.

**Composition of the Board:**

**Chairman:** F. Edlinger  
**Members:** R. Gerdes  
B. Müller

## Summary of Facts and Submissions

- I. The present appeal arises from the decision of the opposition division revoking European patent No. 1153508.
- II. Opposition had been filed against the patent as a whole, based on the grounds of lack of inventive step (Article 100(a) together with Article 56 EPC 1973). During the opposition proceedings the patent proprietor requested that the patent be maintained in amended form and submitted claims of a main request and an auxiliary request.
- III. In its decision dated 28 February 2007 the opposition division found that the subject-matter of claim 1 according to the proprietor's main request complied with Article 123(2) and (3) EPC 1973. The opposition division held that the subject-matter of the independent claims according to the main and the auxiliary request did not involve an inventive step (Article 56 EPC 1973) in view of the following prior art documents:
- E1: WO 96/41477 A1  
E2: DE 19733016 A1.
- IV. The sole opponent withdrew his opposition with letter of 12 April 2007.
- V. By letter dated 30 April 2007 the appellant (patent proprietor) lodged an appeal against this decision and paid the prescribed appeal fee. The statement setting out the grounds of appeal was filed on 27 June 2007.

The appellant requested that the impugned decision be set aside and that the patent be maintained on the basis of the claims according to the main request attached to the decision of the opposition division. The appellant also submitted a further set of claims as an auxiliary request.

VI. In a communication annexed to the summons to oral proceedings, the board *inter alia* expressed doubts that the subject-matter of the independent claims of the main request and of the auxiliary request was disclosed in the application as originally filed (Article 123(2) EPC). The board also indicated that, according to its provisional opinion, the claimed subject-matter of the main request lacked an inventive step (Article 56 EPC 1973). Regarding the claims of the auxiliary request, the board questioned why this request had not been submitted in the first instance proceedings and expressed doubts as to whether this request should be admitted in application of Article 12(4) RPBA (Rules of Procedure of the Boards of Appeal of the European Patent Office, OJ EPO 2007, 536). The appellant was also reminded of the provisions of Article 13 RPBA.

VII. In reply to the summons the appellant confirmed his request to maintain the patent on the basis of the claims according to the main request attached to the decision of the opposition division and filed two sets of claims according to a first and second auxiliary request, replacing the auxiliary request filed together with the statement setting out the grounds of appeal.

VIII. Oral proceedings were held on 3 May 2011. As announced beforehand the appellant was not represented at the oral proceedings. At the end of the oral proceedings the board announced its decision.

IX. Independent claim 1 according to the appellant's **main request** reads as follows (letters in bold typeface and brackets have been added by the board and correspond to the breakdown of features as provided in the decision of the opposition division):

"A method for having an

**[a]** interactive television program guide arrange  
television content retrieved from

**[b]** digital television feeds on

**[c]** user television equipment (40) having a display,  
wherein

**[d]** black areas (22, 24, 42, 44) are present either on  
the top and bottom, or the left and right of a  
displayed program that is broadcast in an aspect  
ratio that does not match the aspect ratio of the  
display of the user television equipment (40),  
characterised by:

**[e]** placing interactive content in the black areas (22,  
24, 42, 44),

**[f]** the interactive content having all the  
functionality of non-black area interactive content;

**[g]** allowing the user to navigate an indicator  
displayed on the display among the content;

**[h]** providing the user with an opportunity to use the  
interactive television program guide to select  
particular content when the user has navigated the  
indicator to the particular content; and

[i] performing an operation associated with the particular content when the user selects the particular content."

- X. Claim 1 according to the appellant's **first auxiliary request** differs from claim 1 according to the main request by the deletion of feature [f].

Claim 1 according to the appellant's **second auxiliary request** reads as follows:

"A method for having an interactive television program guide arrange television content retrieved from digital television feeds on user television equipment (40) having a display, wherein black areas (22, 24, 42, 44) are present either on the top and bottom, or the left and right of a displayed program that is broadcast in an aspect ratio that does not match the aspect ratio of the display of the user television equipment (40), characterised by:  
placing interactive content in the black areas (22, 24, 42, 44);  
allowing the user to navigate an indicator displayed on the display among the content;  
providing the user with an opportunity to use the interactive television program guide to select particular content when the user has navigated the indicator to the particular content; and  
displaying a preview pane in the black area providing a preview image, textual information, or video of a currently highlighted black area content, where the currently highlighted black area content comprises a program listing."

XI. The reasons given in the decision under appeal may be briefly summarised as follows:

Interactive content in the normal viewing area of a television screen was prior art, as set out for instance in paragraph [0005] of the patent specification. The whole application dealt with "interactivity of program guides, as known from the prior art, and placing this into the black areas of the screen". When placing interactive content into the black areas all the functionality of normal "non-black area content" was provided. Consequently feature [f] had sufficient basis in the description and the requirement of Article 123(2) EPC was met.

The only "substantive difference" over E1 was feature [e]. E2 solved the problem of improving visibility by placing interactive content in the black portions of the screen when a format mismatch occurred. Even if it were accepted that the content in the black areas in E2 did not have the same functionality, this would be a "normal trivial measure". For, when content was shifted to an outside area of the display screen it kept its functionality. It was also known from normal PC operating systems that windows could be shifted on the screen without a change in their functionality. Therefore, the subject-matter of claim 1 of the main request was obvious in view of E1 and E2.

XII. Essentially the appellant argued as follows:

*Re: "main request"*

Feature [f] is disclosed on page 20, lines 1 to 16 of the application as filed. This passage is to be understood in its context, which refers to the aim to avoid obstructing the main television feed.

In the context of this passage reference is made to the term "additional information" and to the sentence that "[t]he possible combinations of features that may be implemented in the black areas are almost limitless", with examples given for preview panes, advertisements, etc.

The skilled person would understand the scope of the invention to encompass interactive content in general, with paragraphs [0005] and [0013] of the granted patent and the passage on page 4, lines 28 to 34 of the published application referring to types of interactive content.

*Re: "first auxiliary request"*

Document E1 does not disclose the features [b], [d] or [e]. The objective technical problem resulting from these distinguishing features is "to provide interactive content alongside a displayed program that is broadcast" (see statement setting out the grounds of appeal, page 2 and letter of 1 April 2011, section headed as 5.3). In E2 there is no suggestion of any interactivity in the content provided in the black areas of the display. What appears on the screen is



only passive content in the form shown in E2, figure 5b. Even if content in the non-black area were interactive, then it could not be concluded that content in the black area was interactive. E2 suggests that if content is moved from a non-black area to a black area then it loses functionality and will become passive content.

*Re: "second auxiliary request"*

The second auxiliary request is a clarification of the main request in which feature [i] has been replaced by the expression "display a preview pane in the black area providing a preview image, textual information, or video of a currently highlighted black area content, where the currently highlighted black area content comprises a program listing" (see letter of 1 April 2011, page 5, fourth paragraph). The claims address the same problem and provide a corresponding solution. Both requests achieve the purpose of keeping content in view with respect to other content, with both requests improving provision of additional information with a displayed broadcast program. The subject-matter of the two requests is therefore not divergent.

With respect to the admissibility of amendments under Article 12(4) RPBA it was argued that in the time since the opposition was filed the practice of the boards had changed significantly. It used to be the case that a party to an appeal could rely on being able to submit amendments at various points in the procedure without being questioned as to why the amendments had not first been introduced in the opposition procedure. The appellant should not now be penalised because the practice of the boards had changed, when the

considerable delay in processing appeals had created the period in which such a significant change in practice had been allowed to evolve.

## **Reasons for the Decision**

1. The appeal is admissible.

### *Main request*

2. According to Article 123(2) EPC the European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. An amendment should be regarded as introducing subject-matter which extends beyond the content of the application as filed, if the overall change in the content of the application results in the skilled person being presented with information which is not directly and unambiguously derivable from the application as originally filed.

In the following, references to the original disclosure apply to the published international application WO 00/46988 A2.

- 2.1 Independent claim 1 according to the appellant's main request was amended during the opposition proceedings to contain the additional feature "the interactive content having all the functionality of non-black area interactive content" (feature [f]).

The opposition division in the decision under appeal (see section 2 of the reasons) referred to

paragraph [0005] of the patent specification and the whole application as a basis for the amendment. The division held that "the whole application deals with interactivity of program guides, as known from the prior art, and placing this into the black areas of the screen". It found that consequently the requirement of Article 123(2) EPC 1973 was met.

The board cannot agree with this finding. Paragraph [0005] of the patent specification was not part of the international application as filed and hence cannot be used as a basis for the amendment. The argument that the whole application deals with the interactivity of program guides is correct and the board does not contest the fact that content in the black areas may be interactive. However, this does not necessarily mean that the content placed in the black areas has "all the functionality" of content which is placed in non-black areas. The opposition division did not indicate any other passage from which feature [f] may be directly and unambiguously derived.

- 2.2 The basis for the amendment indicated by the appellant (page 20, lines 1 to 16) refers to listings in the black areas, which "may have all the functionality of listings that are displayed in a separate window". Program listings are, however, only one example of interactive content. The specific disclosure of program listings having all the functionality of listings in a separate window cannot be generalised to interactive content which may consist of advertisements, web browsers, chat applications, etc. (see, for instance, claims 3 to 6).

2.3 Hence the added feature cannot be directly and unambiguously derived from the application documents as originally filed. As a result, the claims of the main request contain subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC). The main request is therefore not allowable.

*First auxiliary request*

3. Claim 1 of the first auxiliary request corresponds to claim 1 of the main request, except for the deletion of feature [f]. In the following reference will be made to the features of claim 1 of the first auxiliary request using the denomination of features of the main request.

3.1 In its communication annexed to the summons to oral proceedings the board indicated that feature [f] was considered to contain subject-matter extending beyond the content of the application as filed. The board considers the appellant's submission of an auxiliary request, in which this feature was omitted to revert to claim 1 of the opposed patent as granted, as a response to an objection raised by the board. The first auxiliary request is, therefore, admissible.

4. It is common ground that E1 constitutes the closest prior art with respect to the claimed subject-matter and that E1 discloses features [a], [c] and [g] to [i].

4.1 The subject-matter of claim 1 differs from E1 in that there is no digital television feed explicitly disclosed (feature [b]), and in that there are no black areas disclosed, in which interactive content is placed (features [d] and [e]).

4.2 Feature [b], according to which the content is retrieved from a digital television feed, is considered as an obvious choice because standards relating to digital TV transmission were already well-known at the priority date. This fact was not contested by the appellant. The remaining features [d] and [e] provide for the simultaneous display of a program and interactive content at least where black areas are present due to a diverging aspect ratio of broadcast and user display. By using the black area to display the interactive content, an unobstructed view of the main program feed can be achieved (see opposed patent, paragraphs [0004] and [0036]).

The desire to arrange television content such that a user may view a broadcast program on a portion of a display while simultaneously viewing interactive content such as program schedule information is disclosed in E1 (see page 5, lines 9 to 14 and page 6, lines 4 to 7).

4.3 Starting from E1 as the closest prior art, the board considers that the objective technical problem should be defined as being "how to improve the visibility of the main feed program in a simultaneous display of a main feed program and additional interactive content". The board prefers to use "simultaneous display" rather than "alongside a displayed program" as argued by the appellant, because "alongside" might already point to a particular location, i.e. next to the displayed program, which is part of the solution as taught by the opposed patent.

4.4 Document E2 provides a solution to this problem under the condition of different aspect ratios of broadcast and user display (see E2, column 1, lines 23 to 42). This solution entails placing content in the black areas which are present due to different aspect ratios (E2, column 4, lines 35 to 47). Hence, starting from E1, the skilled person would have considered incorporating a display mode using the black areas as disclosed in E2 into the interactive television program guide of E1. The skilled person would, therefore, have arrived at the subject-matter of claim 1 without the exercise of an inventive step (Article 56 EPC 1973).

4.5 The appellant argued that E2 only disclosed passive content in the black areas. The board notes that E2 refers to the display of internet information, information originating from PC applications and menu-based applications for in-house control of heating, etc. (see column 5, lines 6 to 10). The board considers that at least menu-based applications suggest interactivity. A skilled person would derive from E2 that - in order to be of full utility for the user - information from these applications should be interactive. However, even if the skilled person understood this passage in the sense that only passive content were displayed, then he/she would nevertheless get the incentive from E2 that content can be placed into areas of the screen which would normally remain black due to the different aspect ratios. The fact that content may be interactive is already known from E1 and included in the technical problem. In other words, when trying to improve the visibility of a main feed program and additional interactive content such as program schedule information, the skilled person would consult E2 and

receive the information that the program schedule information which is overlaid either partially or in a full screen display in E1 (see e.g. figures 11 and 18 and page 58, lines 21 to 24) can be placed in the black areas. It would not make sense to change the program schedule information to passive information when it is moved to the black area, since interactivity of the content may be achieved independently of its location and of whether the content is overlaid on the main feed program or arranged alongside of it.

*Second auxiliary request*

5. According to Article 13(1) RPBA, any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the board's discretion. The discretion shall be 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. Further, according to Article 15(3) RPBA, the board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned, who may then be treated as relying only on its written case.

- 5.1 Claim 1 of the second auxiliary request when compared with claim 1 of the first auxiliary request contains the following additional displaying step:

"displaying a preview pane in the black area providing a preview image, textual information, or video of a currently highlighted black area content, where the

currently highlighted black area content comprises a program listing".

The appellant filed two versions of the claims of the second auxiliary request, a clean copy and a version showing the amendments made. In the version showing the amendments made, this displaying step is added after the last feature ("performing step") of claim 1 according to the auxiliary request. In the clean copy, this feature replaces the performing step, namely:

"performing an operation associated with the particular content when the user selects the particular content".

In his reply to the summons to oral proceedings the appellant referred to the displaying step as a "replacement recitation" of the performing step (see letter of 1 April 2011, page 5, fourth paragraph). The board therefore assumes that the appellant's true intention was to replace the performing step by the displaying step.

For the board's decision on the admissibility of the second auxiliary request it is not relevant whether the displaying step comes in addition to the performing step or replaces the performing step.

- 5.2 On a cursory view of both versions, the amendment leads to a more restricted interpretation of the kind of operation performed "when the user selects particular content". The manner of selecting particular content in the performing step is defined as "highlighting an item in a program listing" in the displaying step, whereas the kind of operation in the performing step is



expressed in more restrictive terminology as "displaying a preview pane ..." in the displaying step.

5.3 However, the addition of the displaying step to claim 1 raises new issues in addition to those addressed by the board in the communication in relation to the auxiliary request then on file and which led the board to express doubts as to whether such a request may be admitted, since it could have been presented in the first instance proceedings (Article 12(4) RPBA; see point VI above).

5.4 It is doubtful whether "highlighting" an entry in a program listing is to be regarded as a replacement with equivalent scope or even a limitation of the operation of "selecting" an entry, if the added feature is interpreted in the context of the description. According to the terminology in the opposed patent the operations of "selecting" and "highlighting" are distinguished from each other (see paragraphs [0042] and [0052]). In the example presented in paragraph [0042], an entry in a listing is highlighted by navigating a cursor to the entry using arrow keys on the remote control, whereas selection of an entry requires using the enter key of the remote control. Hence it is doubtful whether the displaying step of claim 1 can replace the performing step without extending the claimed subject-matter (Article 123(3) EPC). It is noted that the board referred to this distinction in its communication annexed to the summons to the oral proceedings (see third paragraph of section 7).

Furthermore, claim 1 refers to "currently highlighted black area" content, but does not specify under which conditions or in reaction to which operation content is highlighted in the claimed method. Dependent claim 3 specifies a list of possible content, with program listings being only one of the several options. Hence, at least dependent claim 3 would have to be adapted to amended claim 1.

- 5.5 The board also notes that the amendments in claim 1 relating to the highlighting operation and the display of a preview pane were neither contained in the requests submitted together with the statement setting out the grounds of appeal nor in any of the dependent claims of the granted patent.
- 5.6 It follows from the above that the subject-matter of the second auxiliary request introduced a number of new complex issues at a time when this was not appropriate from the point of view of procedural economy and the state of the proceedings and could not be dealt with in the absence of the appellant.
- 5.7 In view of the above the board has decided not to admit the second auxiliary request into the appeal proceedings in application of Article 13(1) RPBA.
- 5.8 The appellant's argument that the subject-matter of the second auxiliary request is not divergent from the other requests did not convince the board for the reasons stated under point 5.5 above.
- 5.9 In his letter of 1 April 2011 the appellant argued with respect to the admissibility of the second auxiliary

request under Article 12(4) RPBA that in the time since the opposition had been filed the practice of the boards had changed significantly. It used to be the case that a party to an appeal could rely on being able to submit amendments at various points in the procedure without being questioned as to why the amendments had not been first introduced in the opposition procedure.

In respect of this argument it is sufficient to note that the board declined to admit the second auxiliary request into the appeal proceedings in application of Article 13(1) RPBA, and not of Article 12(4) RPBA referring to the power of the boards "to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings". The latter provision had been cited by the board in respect of the auxiliary request filed with the statement setting out the grounds of appeal. However, the appellant submitted further amendments in reply to the board's communication accompanying the summons to oral proceedings which introduced a number of new complex issues at a time when this was not appropriate from the point of view of procedural economy and the state of the proceedings and could not be dealt with in the absence of the appellant (see point 5.6 above).

It is therefore only for the sake of completeness that the board adds that the provisions of Article 12(4) RPBA, previously numbered Article 10a(4), have applied to proceedings before the boards in which the notice of appeal was received after 1 May 2003, i.e. long before the opposition was filed in February 2005, see Articles 2 and 3 of the decision of the Presidium of

28 October 2002 (OJ EPO 2003, 62) in conjunction with Article 2 of the decision of the Administrative Council of 12 December 2002 (OJ EPO 2003, 61). Article 10a was renumbered as Article 12 by the decision of the Presidium comprising the amended RPBA of 12 September 2007 (OJ EPO 2007, 537), with the wording of paragraph 4 left unchanged. This decision was approved by the decision of the Administrative Council of 25 October 2007 (OJ EPO 2007, 536). Pursuant to Article 24 RPBA, "[t]hese Rules of Procedure shall enter into force upon entry into force of the revised text of the European Patent Convention in accordance with Article 8 of the Revision Act". The date of entry into force of the revised text of the EPC was 13 December 2007. Thus the renumbering of Article 10a as Article 12 became effective as of 13 December 2007.

### *Conclusion*

6. The main request contains subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC). The subject-matter of claim 1 of the first auxiliary request does not involve an inventive step (Article 56 EPC 1973). Consequently, these requests are not allowable. The second auxiliary request was not admitted into the proceedings (Article 13(1) RPBA).

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

K. Boelicke

F. Edlinger