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**Datasheet for the decision
of 6 June 2011**

Case Number: T 1874/07 - 3.5.04

Application Number: 02794576.5

Publication Number: 1415476

IPC: H04N 7/24

Language of the proceedings: EN

Title of invention:
MPEG-4 remote communication device

Applicant:
Thomson Licensing

Headword:
-

Relevant legal provisions:
-

Relevant legal provisions (EPC 1973):
EPC Art. 111(1)

Keyword:
"Claims amended on appeal - fresh case"
"Remittal (yes)"

Decisions cited:
G 0010/93

Catchword:
-



Case Number: T 1874/07 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 6 June 2011

Appellant: Thomson Licensing
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Representative: Kohrs, Martin
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 28 June 2007
refusing European patent application
No. 02794576.5 pursuant to Article 97(1) EPC
1973.

Composition of the Board:

Chairman: F. Edlinger
Members: M. Paci
C. Vallet

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division refusing European patent application No. 02 794 576.5 published as WO 03/015413 A1.
- II. The decision under appeal was based on the grounds that independent claims 1 and 9 were unduly broad to the point of being unclear (Article 84 EPC 1973) and that their subject-matter lacked novelty (Article 54(1) and (2) EPC 1973) over a conventional personal computer having an ISDN interface for communicating with the Internet.
- III. With the statement of grounds of appeal, the appellant filed a set of amended claims 1 to 16 replacing all previous claims.
- IV. The appellant requests "the setting aside of the decision refusing the patent application" and "the resumption of the examination procedure". Moreover, in the statement of grounds of appeal, the appellant wrote: "should the Examining Division consider rejection of the application based on the current state of the application, oral proceedings according to Article 116 EPC are requested".
- V. Independent claims 1 and 9 read as follows:
- "1. Apparatus comprising:
means for receiving a data signal comprising a data system stream including data encoded in a first format for representing a video program and comprising data encoded in a second format indicating the

availability of additional information related to the video program, wherein the data encoded in said second format is embedded in the data stream representing the video program;

means for providing the data encoded in a first format for representing a video program to a display device;

means for extracting the data indicating the availability of additional information from the data system stream; and

means for providing the data indicating the availability of additional information to at least one predetermined remote communication unit for display on said remote communication unit."

"9. A method of processing a signal comprising the steps of:

receiving a data signal comprising a data system stream including data encoded in a first format for representing a video program and comprising data encoded in a second format indicating the availability of additional information related to the video program, wherein said data encoded in the second format is embedded in the data stream representing the video program;

providing the data encoded in the first format for representing a video program to a display device;

extracting the data indicating the availability of additional information from the data system stream of the video program; and

providing the data indicating the availability of additional information to at least one predetermined remote communication unit for display on said remote communication unit."

Claims 2 to 8 are dependent on claim 1 and claims 10 to 16 are dependent on claim 9.

VI. The examining division's reasoning in the decision under appeal regarding independent claims 1 and 9 then on file can be summarised as follows:

Article 84 EPC 1973 - Clarity

Although one would gain the impression from the title of the application that the application is related to MPEG-4 video transmission and compression, the subject matter of claims 1 and 9 is merely defined in the most generic terms (e.g. "means for receiving a data signal", "data encoded in a first format representing an event", "data encoded in a second format", "additional information related to the event"), which are in no way limited to the field of video processing. Since the wording is so generic, it is not clear to which technical fields the subject-matter of these claims pertains and thus there is unacceptable doubt as to the extent of protection sought.

The generalisation, in the examining division's view, is unduly broad as is apparent from the fact that the subject-matter of claims 1 and 9 can be read onto ISDN transmission of web content.

Article 54(1) and (2) EPC 1973 - Novelty

A personal computer (PC) having an ISDN interface (as commonly used in the 1990s, see e.g. telecommunication standard Q.931) used for communicating with the

Internet belonged to the general knowledge of the person skilled in the art.

Such an apparatus comprised means for receiving a data signal comprising a data system stream (ISDN interface) including data encoded in a first format (D-channel connect message) for representing an event (B-channel Internet connection) and comprising data encoded in a second format (HTTP URL) indicating the availability of additional information related to the event, wherein the data encoded in said second format was embedded in the data stream representing the event (the URLs were part of the payload data transported via the Internet B-channel(s) and thus occupied part of the ISDN stream time slots reserved for the B-channels); means for extracting the data indicating the availability of additional information from the data stream of the event (URL extraction); and means for providing the data indicating the availability of additional information to at least one predetermined remote communication unit (the B-channel connected PC).

The purpose of an URL (Uniform Resource Locator) was to indicate the location of additional data. The intent of the creation of an URL was to indicate the existence and the availability of additional data. The term "event" in claim 1 was interpreted by the examining division to cover the setup of the B-channel and the phase during which the B-channel remains connected.

The above reasoning also applies to the method of claim 9.

The subject-matter of each of claims 1 and 9 thus lacks novelty.

- VII. The appellant's arguments regarding the reasons for the appealed decision can be summarised as follows:

Article 84 EPC 1973 - Clarity

The wording of claim 1 has been amended to make it less generic. In particular, the term "event" has been replaced by "video program", a feature reading "means for providing the data encoded in a first format for representing a video program to a display device" has been added, and the last feature of claim 1 has been clarified by adding the expression "for display on said remote communication unit".

The wording of the method of claim 9 has been amended correspondingly.

These amendments deal with all the objections of the examining division based on Article 84 EPC 1973 in the reasons for the decision.

Article 54(1) and (2) EPC 1973 - Novelty

A PC having an ISDN interface used for communicating with the Internet does not comprise "means for receiving a data signal comprising a data system stream including data encoded in a first format for representing a video program and comprising data encoded in a second format indicating the availability of additional information related to the video program". URLs do not relate to the data relating to the video

program. URLs relate to a different event, namely the webpage on which the URLs are located. Thus URLs display a link to a second source of information, not information related to the main video program to facilitate an interactive audio-visual experience as in the apparatus of claim 1.

A PC having an ISDN interface used for communicating with the Internet does not comprise receiving means, wherein the data encoded in the second format is embedded in the data stream representing the video program.

A PC having an ISDN interface used for communicating with the Internet does not comprise means for providing the data encoded in a first format for representing a video program to a display device, and for providing the data indicating the availability of additional information to at least one predetermined remote communication unit for display on the remote communication unit.

Therefore claim 1 is new within the meaning of Article 54(1) and (2) EPC 1973.

The same arguments apply *mutatis mutandis* to claim 9.

Reasons for the Decision

1. The appeal is admissible.

2. *Clarity (Article 84 EPC 1973)*

Present claim 1 differs from claim 1 considered in the appealed decision by *inter alia* the following amendments:

- the term "event" has been replaced by the term "video program";
- "means for providing the data encoded in a first format for representing a video program to a display device" have been added; and
- the expression "for display on said remote communication unit" has been added at the end of the claim.

The board considers that the apparatus for which protection is now sought comprises features relating to an interaction between the data encoded in the first format representing a video program (as an "event"), which are provided to a display device, and the data encoded in the second format which indicate the availability of "additional information" related to the video program. The data encoded in the second format are embedded in the data stream representing the video program and have to be extracted for display on the remote communication unit. Hence the examining division's objections that the subject-matter of claim 1 is defined in most generic terms and is not limited to the technical field of video processing have become obsolete with the filing of amended claim 1 with the statement of grounds of appeal.

Since the method of claim 9 has been amended in line with the apparatus of claim 1, the above considerations also apply to claim 9.

The board is therefore satisfied that the objections under Article 84 EPC 1973 raised in the reasons of the appealed decision have been overcome by the amendments made to claims 1 and 9.

3. *Novelty (Article 54(1) and (2) EPC 1973)*

In the reasons for the decision under appeal, the examining division argued that the apparatus of claim 1 lacked novelty over a PC with an ISDN interface used for communicating with the Internet. In the examining division's reasoning the "data encoded in a first format" could be read onto an ISDN D-channel connect message, the "event" onto an ISDN B-channel Internet connection and the "data encoded in a second format" onto an HTTP URL.

As set out under point 2 *supra*, the term "event" has been replaced in amended claim 1 filed with the statement of grounds of appeal by the expression "video program". An ISDN B-channel Internet connection (comprising the setup of the B-channel and the phase during which the B-channel remains connected) cannot be equated to a video program (encoded in a first format and provided to a display device). In some cases, the data transmitted from the Internet via the B-channel may contain a video program, for instance a video program on a webpage. However, even in these cases, there is no evidence that an URL would be "embedded in the data stream representing the video program" and that the "data indicating the availability of additional information" would be provided "to at least

one predetermined remote communication unit for display on said remote communication unit".

Hence, for the above reasons alone, the objections under Article 54(1) and (2) EPC 1973 raised in the reasons of the appealed decision no longer apply to present claim 1.

The same conclusion is reached for the method of amended claim 9.

4. *Remittal*

4.1 As stated by the Enlarged Board of Appeal in its decision G 10/93, OJ EPO 1995, 172 (see point 4 of the Reasons), the power of a board of appeal to include new grounds in *ex parte* proceedings does not however mean that boards of appeal carry out a full examination of the application as to patentability requirements. This is the task of the examining division. Proceedings before the boards of appeal in *ex parte* cases are primarily concerned with examining the contested decision. If however there is reason to believe that a condition for patentability may not have been satisfied, the board either incorporates it into the appeal proceedings or ensures by way of referral to the examining division that it is included when examination is resumed.

4.2 In the present appeal, independent claims 1 and 9 have been amended during the appeal proceedings to such an extent that the reasons in the appealed decision for refusing the application no longer apply. The subject-matter of these claims has not been examined by the

examining division in the light of documents D1 to D4 cited in the International Search Report and in the International Preliminary Examination Report. As explained in the previous paragraph, it is the task of the examining division to carry out a full examination as to the patentability requirements, including the question whether there are any other issues of lack of clarity of the claims and whether they are sufficiently supported by the description.

- 4.3 Under these circumstances, the board considers it appropriate to exercise the power conferred upon it by Article 111(1) EPC 1973 and to remit the case to the department of first instance for further prosecution, as requested by the appellant.

5. *The appellant's request for oral proceedings*

Since the appellant's request for oral proceedings is conditional on the "rejection of the application" (see point IV above) there is no necessity to hold oral proceedings under Article 116 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

L. Fernández Gómez

F. Edlinger