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Datasheet for the decision of 30 May 2012

Case Number: T 1653/08 - 3.5.04

Application Number: 00204781.9

Publication Number: 1111912

IPC: H04N5/445

Language of the proceedings: EN

Title of invention:
A television schedule system

Patentee:
Starsight Telecast, Inc.

Opponents:
Interessengemeinschaft
für Rundfunkschutzrechte GmbH
Schutzrechtsverwertung & Co. KG
Velocity 303 Limited
Philips GmbH
Sharp Electronics GmbH

Headword:

Relevant legal provisions:
EPC 1973 Art. 100(c), 76(1)

Keyword:
Divisional application - subject-matter extends beyond content of earlier application (yes)

Decisions cited:
G 1/93, G 1/06, G 1/07

Catchword:

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European Patent Office
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Case Number: T1653/08 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 30 May 2012

Appellant: (Patent Proprietor)	Starsight Telecast, Inc. 2830 De La Cruz Boulevard Santa Clara, CA 95050 (US)
Representative:	Kinsler, Maureen Catherine Kilburn & Strode LLP 20 Red Lion Street London WC1R 4PJ (UK)
Respondent: (Former Opponent 1)	Interessengemeinschaft für Rundfunkschutzrechte GmbH Schutzrechtsverwertung & Co. KG Bahnstraße 62 40210 Düsseldorf (DE)
Representative:	Eichstädt, Alfred Maryniok & Partner, Kuhbergstraße 23 96317 Kronach (DE)
Respondent: (Opponent 2)	Velocity 303 Limited Orchard Court Orchard Lane Bristol BS1 5WS (UK)
Representative:	Sunderland, James Harry Haseltine Lake LLP Lincoln House 300 High Holborn London WC1V 7JH (UK)
Respondent: (Former Opponent 3)	Philips GmbH Lübeckertordamm 5 20099 Hamburg (DE)
Representative:	Eisenführ, Speiser & Partner Postfach 10 60 78 28060 Bremen (DE)

Respondent: (Former Opponent 4)	Sharp Electronics GmbH Sonnenstraße 3 20097 Hamburg (DE)
Representative:	Zinke, Thomas Müller Hoffmann & Partner Patentanwälte Innere Wiener Straße 17 81667 München (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted 3 July 2008 revoking European patent No. 1111912 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman: F. Edlinger
Members: R. Gerdes
C. Vallet

Summary of Facts and Submissions

I. The appeal is against the decision of the opposition division revoking European patent No. 1 111 912, which was filed as divisional application No. 00 204 781.9 of European patent application No. 99 202 116.2, which in turn had been filed as a divisional application of European patent application No. 91 919 325.0 (hereinafter "grandparent application"). The grandparent application had been filed as an international application and was published as WO 92/04801 A1.

II. Oppositions were filed against the patent, *inter alia* based on the ground of Article 100(c) EPC 1973 in conjunction with Article 76(1) EPC 1973. The patent proprietor requested as a main request to reject the opposition or as an auxiliary measure to maintain the patent based on the claims of one of the first to fourth auxiliary requests. Opponents 1 and 3 withdrew their oppositions by letter dated 12 April 2007 and 15 November 2006, respectively.

III. The opposition division revoked the patent because the subject-matter of claims 1 and 10 according to the main request, the first auxiliary request and the second auxiliary request as well as that of claims 1 of the third and fourth auxiliary requests extended beyond the content of the grandparent application as filed.

IV. The appellant lodged an appeal against this decision and maintained the requests underlying the decision under appeal.

V. The opposition filed by opponent 4 was withdrawn on 9 September 2008.

VI. In a communication annexed to a summons to oral proceedings, the board *inter alia* expressed doubts as to whether the claims fulfilled the requirements of Article 76(1) EPC 1973.

VII. Oral proceedings were held on 30 May 2012. As announced beforehand the patent proprietor was not represented at the oral proceedings. The board noted that the appellant had requested in writing that the decision under appeal be set aside. The only remaining respondent (opponent 2) requested that the appeal be dismissed.

VIII. Claim 1 of the **main request** reads as follows:

"A method for accessing information about television programs, the method comprising the steps of:

storing in electronic memory of a program guide controller, a plurality of television program listings, each listing including title, telecast time and channel;
storing in electronic memory of the program guide controller program notes that correspond to the program listings;
displaying on the monitor screen some of the program listings;
moving a cursor (32) on the screen to mark one of the displayed program listings; and
displaying simultaneously with the program listings the program note (52) corresponding to the marked program listing, the method being such that the program note displayed on the screen changes as the cursor moves."

IX. Claim 1 of the **first auxiliary request** reads as follows (amendments to claim 1 of the main request have been

indicated by "underlining" the new or amended passages and by "striking through" the omitted passages):

"A method for accessing information about television programs, the method comprising the steps of:

storing in electronic memory of a program guide controller, a plurality of television program listings, each listing including title, telecast time and channel;
storing in electronic memory of ~~the~~a program guide controller program notes that correspond to the program listings;
displaying on the monitor screen some of the program listings in a plurality of cells;
moving a cursor (32) on the screen to mark one of the displayed program listings in response to a user selection of one of the cells; and
displaying simultaneously with the program listings the program note (52) corresponding to the ~~marked~~ program listing marked by the user, the method being such that the program note displayed on the screen changes as the cursor moves."

Claim 1 of the **second auxiliary request** is identical to claim 1 of the first auxiliary request.

X. Claim 1 of the **third auxiliary request** reads as follows:

"A microprocessor programmed to operate with a display monitor and a RAM so as to:

generate signals that display television program listings stored in the RAM on the display monitor in a time and channel guide format having a plurality of

cells in which the television program listings are displayed;
generate signals that highlight one of the cells in response to a user selection of one of the cells, and generate signals that display, simultaneously with the television program listings, a program note (52) corresponding to the television program listing displayed in the cell highlighted by the user."

XI. Claim 1 of the **fourth auxiliary request** reads as follows (amendments to claim 1 of the third auxiliary request have been indicated by "underlining" the new or amended passages and by "striking through" the omitted passages):

"A microprocessor programmed to operate with a display monitor and a RAM, and being responsive to user inputs so as to:

generate signals that display television program listings, stored in the RAM on the display monitor in a ~~time and channel~~ guide format indicating title, telecast time and channel for each television listing,~~having a plurality of cells in which the television program listings are displayed~~the program listings being displayed in a plurality of cells;
generate signals that highlight one of the cells in response to a user selection of one of the cells, and generate signals that display, simultaneously with the television program listings, a program note (52) each program note corresponding to the television program listing displayed in the cell highlighted by the user."

XII. With respect to the main request and the first and second auxiliary requests, the opposition division stated in the decision under appeal that "there is no

clear disclosure" for the feature of claim 1 "that the program note changes as reaction of movement of the cursor" (see point 1.3 of the decision under appeal).

Regarding the third and fourth auxiliary requests the opposition division stated that "the whole schedule system/controller (ref. sign 180) shown in figure 22A and described on pages 24-28 is involved in order to generate the signals for the program listings, for highlighting a cell and for the program note ... There is no disclosure in the earlier application as filed that the signals are generated by a microprocessor only" (see point 2.4 of the decision under appeal).

XIII. The appellant's arguments as presented in the statement of grounds may be summarised as follows.

Re: main request, first and second auxiliary requests

Regarding the feature "that the program note changes as reaction of movement of the cursor" the appellant argued that there was ample disclosure in the grandparent application as filed of a cursor which is moved under user command. The invention was about presenting the user with the most amount of information while obscuring a minimum amount of information (see page 3, lines 20 to 29 and page 4, lines 11 to 18 of the grandparent application). To cope with the need to provide more information on each entry on-demand overlays could be toggled on/off using a SELECT command (see page 11, line 30 to page 12, line 26 and figure 6). Usage of the word "toggled" implied that the user may choose a "program note mode", in which the program note was stably displayed. The grandparent application thus disclosed the idea that, when toggled on, the program note changes as the cursor moves. The

passage on page 12, lines 21 to 26 stated that the note automatically positioned itself on movement of the cursor. The passage on page 14, line 30 to page 15, line 16 disclosed "channel grazing overlays" which are analogous to the program notes of figure 6. This passage and figure 11 confirmed that the program notes mode was either enabled or disabled.

Re: third and fourth auxiliary requests

Referring to figures 22A, 22B and page 25, line 1 to page 26, line 10, the appellant argued that peripheral devices of the CPU such as the VBI decoder, memories and the video display generator were subservient to the microprocessor and only served to implement its signals, as required. The basic elements of a system required to perform the invention were the CPU itself and the memory in which the listings are stored. Components such as the VBI decoder were well-known constituents of a basic television system and, hence, could not be considered as integral components of the system.

XIV. The respondent argued *inter alia* as follows:

Re: main request, first and second auxiliary requests

The grandparent application as filed only disclosed "on-demand overlays", i.e. overlays that were activated when required for a specific program entry. There was no disclosure that the displayed program note changed as the cursor moved. The last feature of claim 1 required that mere movement of the cursor caused marking one of the program listings and simultaneous display of the associated program note. There was no

basis for this feature in the grandparent application as filed.

Re: third and fourth auxiliary requests

The terms "microprocessor" and "CPU" have different meanings, in particular a CPU could be designated as a special form of microprocessor, but a microprocessor was not necessarily a CPU. More importantly, there was no basis in the grandparent application for isolating the features of claim 1 from their context as presented on page 24, line 34 to page 28, line 16 and figures 22A and 22B. The embodiments of figures 22A and 22B refer to a television schedule system which is either used together with a VCR or even integrated in a VCR. There was no indication in the grandparent application that protection could be sought for a microprocessor in isolation. Several features were eliminated from the embodiment of figure 22A whereas others were generalised. For example, according to the wording of the claim, user input was not restricted to a remote control, but could be effected via voice input or even by accessing the microprocessor's program.

Reasons for the Decision

1. The appeal is admissible.

2. According to Article 76(1), second sentence, EPC 1973 a European divisional application "may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed".

3. In the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor, it is

a necessary and sufficient condition for a divisional application of that sequence to comply with Article 76(1), second sentence, EPC [1973] that anything disclosed in that divisional application be directly and unambiguously derivable from what is disclosed in each of the preceding applications as filed (see G 1/06, OJ EPO 2008, 307; Headnote). It follows that it is a necessary condition for the present application that the claimed subject-matter must be directly and unambiguously derivable from the grandparent application.

4. In the following the compliance of the claimed subject-matter with the latter condition will be evaluated. If not otherwise indicated references to the description, claims or drawings therefore relate to the grandparent application as filed, which was published as WO 92/04801 A1.

Main request, first and second auxiliary requests

5. The grandparent application as filed relates to a television schedule system which is configured to resolve problems associated with abrupt cursor movement in a grid TV guide (see page 3, lines 4 to 19 and page 4, lines 2 to 10). Moreover, the application aims at providing a user interface which - within the limitations of a television display - presents the most amount of schedule information to a user in an easily understood manner. As a solution to the latter problem "supplemental schedule information is presented in overlays that obscure a minimum amount of useful other information" (see page 3, lines 20 to 35 and page 4, lines 11 to 22). According to a first embodiment "[p]rogram notes for a selected program are overlaid over the grid guide upon request". "The program note

can be toggled off/on using a SELECT command." An auto-roving note is used to minimise concealment of the guide. The auto-roving program note "will overlay either the top half or bottom half of the screen, as necessary to avoid masking the title of the selected listing" (see page 11, line 30 to page 12, line 26 and figure 6). According to a second embodiment "channel grazing overlays" are employed to "provide information on current programs when switching channels while watching television". These overlays display the title of each program, the name of the TV service, the cable channel number, the current date, day of week and time in a channel information field. The channel grazing overlays may also include program notes, which are accessed by pressing the SELECT key (see page 14, line 30 to page 15, line 16 and figures 9 to 11).

6. The appellant relied on these embodiments as a basis for the disputed feature in claim 1 according to the main request and the first and second auxiliary requests that "the program note displayed on the screen changes as the cursor moves". The board accepts that according to the embodiment of figure 6 the cursor can be moved between listings of the progam guide and that upon issuing a SELECT command a program note containing supplemental schedule information is presented. The board also accepts that according to the embodiment of figures 9 to 11 channel grazing overlays are presented which provide information on current programs when switching channels. However, according to both embodiments program notes are displayed "on-demand" (see page 11, line 34 and page 15, line 7). A "grazing" functionality of program notes similar to that of channel grazing overlays so as to change information content when switching channels is not unambiguously disclosed in these embodiments. The board

notes that the passage from page 14, line 30 to page 15, line 16 only refers to "Grazing Titles" and does not mention "grazing program notes". Also, a "program note mode", in which a (changing) program note remained displayed cannot be derived from these embodiments. The passage cited in support of this argument by the appellant (see page 12, lines 14 to 16) refers to an individual program note which is toggled on/off, i.e. "[t]he program note" and not to changing notes in a program note mode. Also the flow diagram of figure 11 seems to confirm that a select operation is required when a program note is displayed (on-demand display).

7. Hence, the disputed feature cannot be derived directly and unambiguously from the grandparent application as filed. The subject-matter of claim 1 therefore extends beyond the content of the grandparent application as filed (Article 76(1) EPC 1973).

Third and fourth auxiliary requests

8. Even though it is not excluded by Article 76(1) EPC 1973 to claim in a divisional application subject-matter which only finds a basis in an embodiment of the invention as disclosed in the earlier application, the claimed subject-matter must be directly and unambiguously derivable from what is disclosed in the earlier application as filed (see G 1/06, OJ EPO 2008, 307; Order of the decision). Added matter may be generalisations of specific features or embodiments and the introduction of new alternatives (see G 1/93, OJ EPO 1994, 541, Reasons, point 11, and G 1/07, Reasons, point 4.3.3).

9. Both claims 1 of the third and fourth auxiliary requests arguably relate to the embodiments presented from page 24, line 34 to page 28, line 16 together with figures 22A and 22B. These embodiments concern television schedule systems/tape controllers which are either integrated into a VCR or employed together with a VCR so as to implement the user interface presented in the previous embodiments. According to figures 22A and 22B listing information and other support information is received at the television schedule system by a VBI decoder and processed by a CPU. The listing data is stored in a schedule memory and retrieved on user request by the CPU to be processed and output to a video display generator. User requests are input via a remote controller or emulated by an infrared remote driver.

10. The embodiments from page 24, line 34 to page 28, line 16 are referred to in the description as "block diagrams of television schedule systems/tape controllers ... in which the user interface is used." Details concerning the specific features of the user interface which are implemented in the system are not given. In particular, the display of a program note is not referred to in this passage. The independent claims as originally filed for the grandparent application also did not relate to the display of a program note. Instead they focussed on other features of the user interface such as the movement of the cursor in equal length steps (see claims 1 and 26), display of a recording media indicator (claims 51 and 58), display of an index for a recording medium (claims 63 and 67) and display of a subset of channels (claims 69 and 92).

In addition, claim 1 of both requests is directed to a "microprocessor programmed to operate with a display

monitor and a RAM". Apart from the fact that only a CPU (see reference number 228) and not a microprocessor is explicitly disclosed in the cited passages, the embodiments of figures 22A and 22B relate to television schedule systems/tape controllers which are either integrated or at least employed together with a VCR. A remote control or an infrared remote driver is consistently presented in these embodiments as a user input means. In contrast, the independent claims according to both requests are neither limited to television schedule system/tape controllers to be employed together with a VCR nor are they restricted in the way in which user input is effected. Nor does the description disclose special features of CPU 228, let alone of a general microprocessor, which make the claimed microprocessor as such suitable for generating the signals in response to user inputs as specified in claim 1 of both requests. The board holds that a skilled person, on the basis of the grandparent application as filed and without reflections of its own, would not have combined the display of a program note with the specific elements of figures 22A and 22B that are referred to in claim 1, generalising some while omitting others. It follows that neither the embodiments of figures 22A and 22B nor any other part of the grandparent application as filed directly and unambiguously discloses a microprocessor programmed according to the general terms of claim 1 of each of these requests. The subject-matter of claim 1 according to the third and fourth auxiliary requests, therefore, extends beyond the content of the earlier application as filed (Article 76(1) EPC 1973).

Conclusion

11. Claim 1 of both the main request and the first to fourth auxiliary requests contains subject-matter which extends beyond the content of the earlier application as filed (Article 76(1) EPC 1973). Consequently, these requests are not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

K. Boelicke F. Edlinger

Decision electronically authenticated