

Internal distribution code:

- (A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 11 October 2012**

Case Number: T 1945/08 - 3.5.04

Application Number: 06076553.4

Publication Number: 1722551

IPC: H04N7/173, G06Q10/00,
H04N5/445, H04N5/00

Language of the proceedings: EN

Title of invention:

Internet television program guide system

Applicant:

United Video Properties, Inc.

Headword:

Relevant legal provisions:

EPC 1973 Art. 83, 56

Keyword:

Sufficiency of disclosure (yes - all requests)
Inventive step (no - all requests)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1945/08 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 11 October 2012

Appellant: United Video Properties, Inc.
(Applicant) 2830 De La Cruz Boulevard
Santa Clara, CA 95050 (US)

Representative: Neobard, William John
Kilburn & Strode LLP
20 Red Lion Street
London WC1R 4PJ (GB)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted 15 May 2008
refusing European patent application No.
06076553.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division to refuse European patent application No. 06 076 553.4, published as EP 1 722 551 A2.
- II. The decision under appeal is, as requested by the applicant, a decision according to the state of the file (EPO FORM 2061), referring for its grounds to the previous communications dated 23 May 2007 and 28 January 2008 (the former communication referring in turn to the European search opinion dated 31 October 2006 issued in accordance with Rule 44a EPC 1973). In those communications the following prior-art documents had been cited:

D1: WO 96/34491 A1
D2: EP 0 276 425 A2.

The objections raised in those two communications were mainly based on insufficiency of disclosure (Article 83 EPC 1973). Other objections of lack of novelty/inventive step in view of D1 and/or D2 were also raised in the first communication, but neither explicitly maintained nor withdrawn in the second communication, in which it was merely stated with regard to these objections that they "need to be discussed for the purposes of the decision to be taken". An objection of lack of clarity (Article 84 EPC 1973) raised in the first communication was apparently no longer maintained in the second communication.

- III. With the statement of grounds of appeal the appellant filed amended claims according to a main and an auxiliary request.

IV. In a communication annexed to the summons to oral proceedings the board expressed the provisional opinion that *inter alia*

- it was inclined to agree with the appellant that the claimed invention was sufficiently disclosed as required by Article 83 EPC 1973; however,
- the requirements of Article 84 EPC 1973 and Article 123(2) EPC were not met; and
- the subject-matter of claim 1 of each request lacked novelty in view of D2 and inventive step in view of D1 and common general knowledge.

V. With a letter dated 11 September 2012, the appellant filed amended claims according to a main request and first to seventh auxiliary requests, replacing all previous claims on file.

VI. Oral proceedings were held before the board on 11 October 2012. At the end of the oral proceedings the board announced its decision.

VII. The appellant's final requests are that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request, or on one of auxiliary requests 1 to 7, all filed with letter of 11 September 2012.

VIII. Independent claim 1 according to the **main request** reads as follows:

"A method of providing reminder messages, using a system (10) comprising a user multimedia system (28; 30; 32; 58) having a processing unit (60), the processing unit being connected to a web server (20), the method comprising

the processing unit (60) providing a user with an opportunity, at the multimedia system (28; 30; 32; 58), to set up at least one reminder for at least one television program;

the web server (20) responding to the reminder by:
prior to the transmission time of the at least one television program, generating a reminder message at a location other than the multimedia system;
and

transmitting the reminder message to the user of the user multimedia system (28; 30; 32; 58) over a communication link (26; 34; 36; 38; 62) to remind the user when the at least one television program is to be transmitted."

IX. Independent claim 1 according to the **first auxiliary request** differs from claim 1 according to the **main request** in that the expression "A method of providing reminder messages, using a system (10) [...]" has been replaced by the expression "A method of providing reminder messages, to remind a user when at least one television program is to be transmitted, using a television program guide system (10) [...]".

X. Independent claim 1 according to the **second auxiliary request** differs from claim 1 according to the **main request** by
the addition of the following two steps:
- "providing a plurality of television program listings;
- providing the user with the opportunity to select at least one television program listing;"
and in that the expression "to set up at least one reminder for at least one television program" has been replaced by the expression "to set up at least one

reminder for the selected at least one television program listing".

- XI. Independent claim 1 according to the **third auxiliary request** combines the amendments of the first and second auxiliary requests.

- XII. Independent claim 1 according to the **fourth, fifth, sixth and seventh auxiliary requests** differs from claim 1 according to the main request, first, second and third auxiliary requests, respectively, by the addition of the following text at the end of the claim: "
", wherein transmitting the reminder message comprises transmitting the reminder message via e-mail."

- XIII. The remaining claims according to the above requests have no bearing on the present decision.

- XIV. The examining division's reasoning in the decision under appeal (by reference to the communications dated 23 May 2007 and 28 January 2008) regarding sufficiency of disclosure can be summarised as follows:

The claimed invention relates to the provision of a server-based reminder method/system in a television environment. The information included in the application documents, on page 22, lines 19 et seq. and in the paragraph bridging pages 38 and 39, discloses no more than a coarse concept which requires substantial additional technical information in order to be implemented. The application is completely silent on essential points such as how to implement a reminder system in a multimedia environment, how a request for a reminder is processed by the multimedia system and transmitted to and processed by the server, and how the

server manages synchronisation between the reminder message and the delivery of the television program.

Hence the method of claim 1 does not meet the requirement of sufficiency of disclosure of Article 83 EPC 1973.

XV. The appellant essentially argued as follows:

Sufficiency of disclosure

It is not essential to the operation of the invention precisely how the reminder is processed by the multimedia system and transmitted to the server. What is important is that the processing unit provides a user with an opportunity, at the multimedia system, to set up at least one reminder for at least one television program. A skilled person in the art would readily appreciate that there is a sufficient disclosure of a multimedia system in a communication link with the server via communication links 34, 36 and 38. Moreover, page 22, lines 16 to 23, and page 38, line 19, to page 39, line 11, teach that the reminder can be set up by the user interacting with a web page. Claim 1 does not specify that there is synchronisation between the reminder message and the delivery of the television program. Indeed, the claim just recites that a reminder message is generated and transmitted by the server to the user prior to the transmission time of the TV program. Furthermore, the application (page 10, lines 4 to 9) discloses that the web server uses standard protocols to make the television program information available over the Internet to users. Page 22, lines 19 to 23, states that the reminder can be provided as a pop-up on the television screen or sent to the user as an email reminder or to the user

via a predetermined pager number. By virtue of the fact that the reminder is generated at a server and not at the multimedia system itself, the reminder could be sent to the user himself and need not just be sent to the multimedia system.

Accordingly, the claimed invention is sufficiently disclosed.

Inventive step in view of D1 and common general knowledge

a) Main request

The point is not whether the skilled person could have arrived at the invention by modifying the closest prior art, but whether he would have done so because the prior art incited him to do so in the hope of solving the objective technical problem or in expectation of some improvement or advantage. D1 does not contain even a suggestion that the reminder message could be generated by a web server at a location other than the multimedia system, nor any recognition of the advantages of doing so.

At the priority date of the present application, it was not common practice to provide services remotely, as it is today in the era of "cloud" technology. While the provision of remote services was certainly known as such, it was clearly not as ubiquitous as today. While the skilled person may therefore be aware of the possibility of providing services remotely where needed, there was certainly not the same drive to do so in all cases as there is today.

The skilled person's mindset would have been very much that local services that do not require interaction

with the outside world, such as generating a reminder, should be provided locally. The reminder system of D1 is implemented on television equipment. At the priority date, there was nothing which would have incited the skilled person to remotely implement what was known as a locally implemented service. While this was technically feasible, nothing would have prompted the skilled person in the field of television and related services to provide reminders remotely, let alone using a web server.

As the board pointed out, there is a disclosure of remote requests in D1. However, in the method of D1, the user "requests" that are sent to the cable system headend via the telephone lines relate to requests for tangible products and externally provided services such as banking. Such requests must necessarily be transmitted to an external server in order for the requests to be acted upon and for the tangible products or services to be supplied by the external provider. The reminder messages of D1 are not provided externally, but rather generated locally by the electronic program schedule system. A teaching that a remote request can be used to provide a remote service gives no hint that remote requests should also be used for the provision of what is, in essence, a local service. Therefore, in spite of the disclosure of some remote services, it would not have been obvious at the priority date to modify D1 to use a server at a location other than the multimedia system to generate reminder messages, bearing in mind that the reminder messages of D1 are set up at the multimedia system itself and do not require interaction with the outside world.

Moreover, several features of the local reminder function disclosed on page 24 of D1 teach away from the method of claim 1. First, the system of D1 displays a reminder message "at a predetermined time" before the start time of the selected program. Such a time accuracy is possible only with a local solution, not with a web-based solution. Second, the feature that the number of minutes until the program starts is updated every minute implies some real-time accuracy incompatible with a web-based solution. Finally, the presence next to the reminder message of a TUNE button (see figure 14) for allowing the user to tune to the selected program would teach away from a web-based reminder message solution.

Although it would not have been too difficult for the skilled person to adapt the system of D1 to arrive at the method of claim 1, the disclosure of D1 would have dissuaded the skilled person from doing so. In the field of program guides, the skilled person's mindset was such that he would not have done it. Furthermore, an adaptation of the system of D1 to a web-based reminder system would have had the detrimental effect of rolling back some functionalities such as the reminder at a predetermined time, the countdown counter and the TUNE button. The inventive step of the method of claim 1 lies in particular in the mental leap to decide to implement a program reminder function on a web server, i.e. non-locally.

Thus, the method of claim 1 according to the **main request** is inventive in view of D1 and common general knowledge.

b) First to seventh auxiliary requests

The above reasoning also applies to claim 1 according to each of the **first, second and third auxiliary requests** which comprises additional features making more explicit the field of the invention (first and third auxiliary requests) and/or further distinguishing the method from the disclosure of D2, which relates to a different technical field (second and third auxiliary requests).

Claim 1 according to the **fourth, fifth, sixth and seventh auxiliary requests** differs from claim 1 according to the main request, first, second and third auxiliary requests, respectively, by the additional feature that the reminder message is transmitted via email. There is no suggestion in D1 to transmit the reminder message by email. The disclosure of D1 underlines the skilled person's mindset which, at the priority date, saw television reminders as a local service of the television system. Furthermore, if the system of D1 were to be adapted so that television reminders were sent by email, several functionalities, such as the reminder at a predetermined time, the countdown counter and TUNE button, would have to be rolled back.

Hence the methods of claim 1 according to the **first to seventh auxiliary requests** involve an inventive step in view of D1 and common general knowledge (and also in combination with D2).

Reasons for the Decision

1. The appeal is admissible.

All requests - sufficiency of disclosure (Article 83 EPC 1973)

2. The board concurs with the examining division that the application as filed discloses only a general concept of a method/system for providing reminder messages for television programs, without describing the technical details necessary for its implementation (see page 22, lines 16 to 26, and from page 38, line 19, to page 39, line 11, of the application as filed).

Sufficiency of disclosure (Article 83 EPC 1973) for the claimed method thus boils down to the question of whether the skilled person would have been able to carry out such a method, without inventive effort and without undue burden, on the basis of common general knowledge and the information disclosed in the application as filed (see Case Law of the Boards of Appeal of the EPO, 6th edition 2010, II.A).

The board is not convinced by the examining division's reasoning as to why the skilled person would not have been able to implement a web server based reminder system for television programs without inventive effort or undue burden. An embodiment of the disclosed multimedia system is based on a personal computer running a standard web browser with plug-ins (page 3, lines 28 to 30). This allows the use of widely adopted protocols and standards enabling a user to access this information at remote locations linked to the Internet (page 4, lines 19 to 30). Since, at the priority date (the valid priority date for the claimed subject-matter being the second priority date of 18 September 1997

because the first priority document does not disclose any reminder), the Internet, its standard protocols, web servers and web browsers were already well known and in widespread use, the board sees no specific technical obstacle which would have stopped the skilled person from being able, without inventive effort or undue burden, to add a web-based television program reminder to the Internet television program guide system otherwise described in the application as filed.

Main request - inventive step (Article 56 EPC 1973)

3. Closest prior art and distinguishing features

The board agrees with the appellant that D1 represents the closest prior art.

D1 discloses an electronic television program guide schedule system in which a television program reminder can be set up by the user so that the system sends a reminder message to the user at a predetermined time before the start of a selected television program (see page 24, and figures 13 and 14). The reminder message is generated by a user multimedia system (shown in figure 1) comprising a processing unit (16, 23) which provides the user with an opportunity to set up a reminder for a selected program (see page 24, lines 1 to 9).

The method of claim 1 differs from the method disclosed in D1 in that the reminder message is generated by a "web server" and "at a location other than the user multimedia system" and is transmitted to the user multimedia system "over a communication link".

4. Objective technical problem and obviousness

The appellant submitted that the objective technical problem is the provision of a flexible television program reminder system (see statement of grounds, page 4, penultimate paragraph). The board has no objection to this formulation of the objective technical problem.

D1 states that the user multimedia system shown in figure 1 (called an "electronic program schedule system" in D1) can be in a user's set-top box or, for instance, part of a personal computer equipped with a transmission link and a video graphics card (see the paragraph bridging pages 12 and 13, and page 16, lines 19 to 22). D1 further discloses that this system may also have a return channel, such as a telephone line or a two-way cable line for sending user requests for interactive services such as home shopping, banking or Pay-Per-View programs to the cable system headend or another program provider location (see e.g. page 8, lines 27 to 35; page 25, lines 17 to 26; page 30, line 24 to 29; page 56, lines 19 to 24; page 60, lines 22 to 37; claims 3, 4 and 13).

Besides, at the priority date of the application, the World Wide Web, web servers and web browsers (e.g. Mosaic, Netscape Navigator and Microsoft's Internet Explorer) had already existed for several years. The advantages of these in term of flexibility, ease of use, robustness, use of standard protocols, etc., which contributed to the spectacular success of the Web, were well known to the skilled person and belonged to his common general knowledge. That this was notoriously known, is evident from the present application which refers to standard web browsers and protocols (see e.g.

page 3, lines 28 to 30; page 4, line 19 to page 5, line 2; page 10, lines 4 to 14 and page 16, line 18 to page 17, line 8) and has not been disputed by the appellant.

In the board's view, because the multimedia system of D1 (e.g. a personal computer) comprised means for sending user requests for interactive services to a remote server at the headend (or at another location) over telephone lines, as one example of a return channel, the skilled person would have realised that transmission via the World Wide Web constituted a suitable return channel. In these circumstances and in view of the well-known advantages of providing remote access to a web server, the board considers that it would have been an obvious choice for the skilled person to implement a similar reminder function as described on page 24 of D1 on a web server at the headend (as an alternative to implementing it locally in the user multimedia system). This is because the electronic program schedule information necessary for the reminder function is available both at the headend and at the user's system and, by choosing access to a web server, the person skilled in the art would have solved the problem of providing more flexibility, by making access possible via any link to the Internet.

Each of these two alternative solutions had their pros and cons, as the skilled person would have realised. Implementing the reminder function locally at the user multimedia system had the advantage that the user would not incur any telecommunication expenses for the connection with a remote server. Implementing the reminder function remotely at a web server would not only make the system more flexible but also ensure that the reminder function was always based on an up-to-date

version of the program schedule in case of a last-minute change of schedule.

Moreover, it should also be noted that the goal of the invention of D1 as stated in the first paragraph of the description is to provide the user with the capability to order products and services remotely at the user location simply by pressing a button on a remote control device. To provide more flexibility, D1 proposes different categories of products and services (D1, page 58, lines 17 to 20). In view of this teaching, it would have been all the more straightforward to offer the service of reminding the user that a program was about to start via a distant web server instead of locally in the user multimedia system.

For the above reasons, the board considers that the method of claim 1 does not involve an inventive step in view of D1 and the skilled person's common general knowledge.

5. The appellant's arguments

The appellant's arguments (see longer version in section XV *supra*) are essentially that

- the skilled person could have adapted D1 to arrive at the method of claim 1, but would not have done so;
- providing services remotely was not common practice;
- the skilled person's mindset was that what could be done locally was done locally;
- the remote requests in D1 are only for ordering tangible products or services, such as banking, not for reminder messages; and

- several functionalities associated with the local reminder system of D1 would have to be rolled back if the reminder messages were generated remotely.

The board does not find these arguments convincing, for the following reasons:

In view of the disclosure of a wide variety of services that may be requested via a suitable return channel in D1, the board cannot share the appellant's view that adapting the system of D1 to replace a local reminder function (among other functions) by a web-based reminder function would not have crossed the skilled person's mind or, even if it had, would have gone against his mindset. Rather, well-known advantages of using a computer (as disclosed in D1) to access a web server were prodding the skilled person to move in this direction. The appellant has not disputed that the advantages of the Internet, such as its flexibility, its easy access from anywhere via web browsers, and its use of standard protocols, were well known. The skilled person would thus have been well aware of the advantages and disadvantages of moving the reminder function to a web server. In view of the considerable advantages of a web-based solution and the attraction of the Internet at the relevant time, the board is not convinced by the appellant's argument that the skilled person would have been dissuaded from undertaking such a move by the fact that some other functionalities of the system of D1 would have had to be adapted or, in some cases, rolled back.

6. Conclusions on the main request

For the above reasons, the subject-matter of claim 1 according to the main request does not involve an

inventive step in view of D1 and common general knowledge.

Hence the appellant's main request is not allowable.

First to seventh auxiliary requests - inventive step

7. The appellant explained during the oral proceedings that the additional features of claim 1 according to each of the **first, second and third auxiliary requests** were meant to make more explicit the field of the invention (first and third auxiliary requests) and/or to further distinguish the claimed method from the disclosure of D2 (second and third auxiliary requests). The appellant did not dispute that these additional features were disclosed in D1. These additional features thus do not change the board's reasoning.

Claim 1 according to the **fourth, fifth, sixth and seventh auxiliary requests** differs from claim 1 according to the main request, first, second and third auxiliary requests, respectively, by the additional feature that the reminder message is transmitted via email. This additional feature is not disclosed in D1. However, a personal computer as disclosed in D1 would generally have offered such a facility for exchanging messages via the web. The board cannot see anything inventive in transmitting reminder messages by email in a web-based reminder system. The appellant has not disputed that emails were a well-known and widely used method of exchanging digital messages via the Internet at the priority date. For the skilled person, emails would thus have been a straightforward choice of transmission means for sending reminder messages from a web-based reminder system to a user.

For the above reasons, the subject-matter of claim 1 according to each of the first to seventh auxiliary requests does not involve an inventive step in view of D1 and common general knowledge.

8. Accordingly, the first to seventh auxiliary requests are not allowable.

Conclusions

9. Since none of the appellant's main request and first to seventh auxiliary requests is allowable, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



K. Boelicke

F. Edlinger

Decision electronically authenticated