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**Datasheet for the decision  
of 5 February 2013**

**Case Number:** T 1418/09 - 3.5.04

**Application Number:** 03007120.3

**Publication Number:** 1335594

**IPC:** H04N5/765, H04N5/775, H04N5/445

**Language of the proceedings:** EN

**Title of invention:**  
A system for unattended recording of television programs

**Applicant:**  
Starsight Telecast, Inc.

**Headword:**

**Relevant legal provisions:**  
EPC 1973 Art. 76(1)

**Keyword:**  
Divisional application - added subject-matter (yes)

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

**Catchword:**



**Beschwerdekammern  
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Case Number: T 1418/09 - 3.5.04

**D E C I S I O N  
of Technical Board of Appeal 3.5.04  
of 5 February 2013**

**Appellant:** Starsight Telecast, Inc.  
(Applicant) 2830 De La Cruz Boulevard  
Santa Clara, CA 95050 (US)

**Representative:** Hale, Peter  
Kilburn & Strode LLP  
20 Red Lion Street  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted on 30 January 2009  
refusing European patent application No.  
03007120.3 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** F. Edlinger  
**Members:** R. Gerdes  
T. Karamanli

## Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division refusing European patent application No. 03 007 120.3, which was filed as a divisional application of European patent application No. 98 201 449.0, which in turn had been filed as a divisional application of European patent application No. 90 916 885.8 (hereinafter "grandparent application"). The grandparent application had been filed as an international application and was published as WO 91/07050 A1.
- II. The examining division refused the present application on the grounds that claims 1 and 4 of the main request contained subject-matter extending beyond the content of the grandparent application (Article 76(1) EPC), that claim 1 of the first auxiliary request lacked clarity (Article 84 EPC) and that the subject-matter of claims 1 and 4 of the second auxiliary request lacked novelty (Article 54(1) and (2) EPC).
- III. The appellant lodged an appeal and with the statement of grounds of appeal re-filed the claims of the main request considered by the first-instance department, as well as claims 1 to 7 of an auxiliary request.
- IV. In a communication annexed to a summons to oral proceedings, the board *inter alia* expressed doubts as to whether the claims of the appellant's requests fulfilled the requirements of Article 76(1) EPC 1973.
- V. Oral proceedings were held on 5 February 2013. As announced beforehand, the appellant was not represented at the oral proceedings. The appellant had requested in writing that the decision under appeal be set aside and

that a patent be granted on the basis of the claims of either the main request or the auxiliary request, both filed with the statement of grounds of appeal.

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

"A system for co-ordinating channel selection information between one of a plurality of different cable decoders and a television schedule system, the system including:  
a television schedule system utilizing a central processing unit for receiving a user input indicative of a selected television program on a television channel;  
an emulator responsive to the user input for emulating the said channel of the selected television program to produce a channel tuning command recognisable by the cable decoder; and  
means for transmitting the channel tuning command to the cable decoder, thereby to change the television channel;  
wherein the emulator is operable to produce channel tuning commands recognisable by any one of a plurality of different cable decoders by using a stored conversion code."

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

"A system for co-ordinating channel selection information between one of a plurality of different cable decoders and a television schedule system, the system including:  
a television schedule system utilizing a central processing unit, the central processing unit arranged to: receive schedule information; output said schedule information for display; and to receive a user input

indicative of a selected television program on a television channel;  
an emulator responsive to the user input for emulating the said channel of the selected television program to produce a channel tuning command recognisable by the cable decoder; and  
means for transmitting the channel tuning command to the cable decoder, thereby to change the television channel;  
wherein the emulator is operable to produce channel tuning commands recognisable by any one of a plurality of different cable decoders by using a stored conversion code."

VIII. As regards the objection under Article 76(1) EPC 1973, the decision under appeal may be summarised as follows:

The description, the claims and the drawings of the grandparent application as filed describe and show the system and the method exclusively with the "programmable tuning means" and the "inhibiting means", or the corresponding method steps, which have now been omitted. There is no hint in the earlier application that a digital input signal could be used and how the system shown in figures 1 and 2 should be adapted in order to enable the programmable tuning means and the inhibiting means to be omitted. Therefore, the programmable tuning means and the inhibiting means are essential features which cannot be omitted.

IX. In the statement of grounds the appellant argued essentially as follows with respect to the objection under Article 76(1) EPC 1973:

The invention relates not only to a VCR but may be generally applied to a television accessory. There is

no suggestion that the television accessory must have a built-in tuner. The skilled person would appreciate this from reading the application as filed. The embodiment in the application refers to a VCR with a programmable tuner. To limit the scope of protection to embodiments where a programmable tuner is required unjustly penalises the appellant for providing a detailed description of a particular embodiment of the invention.

Since the programmable tuner is not an essential feature, the inhibiting means for disabling the tuner are likewise optional for a television accessory that has no programmable tuner. The skilled person would have understood that the inhibiting means are present to disable the programmable tuner. From a technical point of view it is not reasonable to suggest that these are essential features, when one serves to cancel the other out.

### **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". 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).
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. Unless otherwise indicated, references to the description, claims or drawings therefore relate to the grandparent application as filed, which was published as WO 91/07050 A1.
  
5. The grandparent application as filed relates to an interface for connecting a cable television decoder to a television accessory such as a video cassette recorder (VCR). According to the application, "Cable television decoders typically operate by requiring a television set and a VCR connected to the decoder to be set to a predetermined channel, such as channel 2, 3 or 4, and all channel selection is accomplished by the decoder." This usually implies the disadvantage "that not all of the advanced features available on state-of-the-art VCRs", such as on-screen VCR programming, "can be used while the VCR is under control of the decoder", see page 1, line 3 to page 2, line 13.

To overcome this disadvantage the invention aims at providing "a single tuning arrangement which will coordinate channel selection information between a

cable decoder and a television schedule system, a VCR or any television device" (see page 3, lines 31 to 35). According to the invention, "A programmable tuning means is connected to the output of the cable television decoder to receive the selected channel on a fixed channel from the cable television decoder, for selecting a desired television channel signal. A means is connected to the programmable tuning means for inhibiting the programmable tuning means from tuning to the selected television channel when the cable television decoder is operational" (see page 4, lines 1 to 31).

The only embodiment of the invention discloses corresponding components, i.e. a cable decoder (12), a VCR (14), programmable tuning means (26) and inhibiting means (70).

Claim 1 of the grandparent application as originally filed also specifies "programmable tuning means, connected to the output of said cable television decoder to receive the selected channel on a fixed channel from said cable television decoder, for selecting a desired television channel signal", and "means, connected to said programmable tuning means, for inhibiting said programmable tuning means from tuning to the selected television channel when said cable television decoder is operational". The further independent claim 10 relating to a "method of interfacing" is limited by corresponding method features.

6. It follows that the concept of the invention as consistently presented in the claims of the earlier application as filed, in the general part of the description and in the only embodiment requires the



presence of programmable tuning means and inhibiting means.

7. The board also notes that the technical problem to "provide a single tuning arrangement which will **coordinate** channel selection information between a cable decoder and a television schedule system, a VCR or any television device" (see page 3, lines 31 to 35, emphasis added by the board) implies setting operations of the cable decoder as well as of the television schedule system, the VCR or the television device, such that the programmable tuner is "non-responsive to ... channel commands ... , so that the tuner will remain tuned to the fixed channel for the cable decoder" (see figure 2 and page 7, line 27 to page 8, line 5). Hence, the programmable tuning means and inhibiting means are essential elements of the invention as disclosed in the earlier application as filed.
8. Since these features were omitted from claim 1 of the main request and claim 1 of the auxiliary request, these claims present the skilled person with subject-matter which is not directly and unambiguously derivable from the earlier application as filed.
9. The subject-matter of claim 1 of the main request and of the auxiliary request therefore extends beyond the content of the grandparent application as filed. Thus, the requirements of Article 76(1) EPC 1973 are not fulfilled in the present case.
10. The appellant's arguments did not convince the board. The fact that, in general, a television accessory does not necessarily have a programmable tuner is not decisive for the question as to what was directly and unambiguously disclosed in the grandparent application.

Its overall content does not even give a hint, let alone an unambiguous disclosure, that a programmable tuner might be omitted and what the invention would be in that case.

11. It follows from the above that neither the main request nor the auxiliary request is allowable.

### **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



L. Fernández Gómez

F. Edlinger

Decision electronically authenticated