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**Datasheet for the decision
of 11 May 2011**

Case Number: T 0648/10 - 3.5.04

Application Number: 95917756.9

Publication Number: 0757873

IPC: H04N 5/445

Language of the proceedings: EN

Title of invention:

Video mix program guide

Patentee:

United Video Properties, Inc.

Opponent:

Velocity 303 Limited
Sawodny Michael

Headword:

-

Relevant legal provisions:

EPC Art. 104(1), 108, 123(2)
RPBA Art. 12(4), 13(1), 16(1)
EPC R. 99, 100

Relevant legal provisions (EPC 1973):

EPC Art. 100(c), 111(1)

Keyword:

"Amendments - deletion of feature (not allowed)"
"Late filed request admitted (yes)"
"Decision re appeals - remittal (yes)"
"Costs - apportionment (no)"

Decisions cited:

G 0003/89, G 0001/93, T 0331/87, T 0404/03, T 0455/03,
T 0509/07, T 0358/08

Catchword:

See section 3.



Case Number: T 0648/10 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 11 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 26 January 2010
revoking European patent No. 0757873 pursuant
to Article 101(2) EPC.

Composition of the Board:

Chairman: F. Edlinger
Members: C. Kunzelmann
B. Müller

Summary of Facts and Submissions

- I. The appeal is against the decision of the opposition division to revoke European patent No. 0 757 873.
- II. The patent was opposed on the grounds for opposition under Articles 100(a), 100(b) and 100(c) EPC 1973. In the opposition proceedings the patent proprietor requested as a main request that the patent be maintained as granted. The patent proprietor also filed independent claims of auxiliary requests 1 to 9. With the decision under appeal the patent was revoked because the opposition division found that the ground for opposition under Article 100(c) EPC 1973 prejudiced the maintenance of the patent as granted as well as the maintenance of the patent as amended in accordance with auxiliary requests 1 to 9. The opposition division took no decision on the grounds for opposition under Articles 100(a) and 100(b) EPC 1973.
- III. The patent proprietor filed an appeal against this decision and requested that the patent be maintained as granted. The appellant further requested accelerated processing of the appeal in view of litigation proceedings. In the statement of grounds of appeal the patent proprietor/appellant defended the main request as well as auxiliary requests 1 to 9.
- IV. With a letter dated 18 October 2010 opponent 1/respondent 1, as the only opponent/respondent making submissions in appeal proceedings, expressed his agreement with the opposition division's conclusion that the patent as granted as well as the patent as amended in accordance

with auxiliary requests 1 to 9 added subject-matter to the application as filed. Regarding the auxiliary requests, respondent 1 objected that the relationship between the features of the new independent claims and those of the remaining dependent claims was "obtuse".

- V. The board issued a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), annexed to a summons to oral proceedings dated 7 February 2011. In this communication the board indicated its intention to limit the appeal procedure to the issues dealt with in the reasons for the decision under appeal, namely added subject-matter and, if the appellant requested maintenance in amended form, also issues under Article 84 EPC 1973. The board indicated that it intended to remit the case to the first instance for further prosecution if it came to the conclusion that the decision under appeal was to be set aside. The board also indicated its preliminary opinion that the characterising feature of claim 1 of the patent as granted in its generality was not directly and unambiguously derivable from the application as filed.
- VI. Oral proceedings before the board were held on 11 May 2011. In the oral proceedings the patent proprietor/appellant filed claims 1 and 6 of an auxiliary request 10. The patent proprietor/appellant withdrew auxiliary requests 2, 3, 4 and 8 and requested that the decision under appeal be set aside and the case remitted to the first instance on the basis of the main request (patent as granted), or alternatively, on the basis of auxiliary requests 1, 5, 6, 7, 9 (underlying the decision under appeal) or auxiliary

request 10 (submitted in the oral proceedings before the board), in that order. Opponent 1/respondent 1 requested that the appeal be dismissed and that he be reimbursed the costs of the entirety of the appeal proceedings. At the end of the oral proceedings the chairman announced the board's decision.

VII. Claim 1 of the main request reads as follows:

"A system interactively controlled by a remote control (35) for displaying a program guide on a display screen (33) comprising a tuner (17) for receiving television signals corresponding to a plurality of television channels and providing an output television signal corresponding to a selected television channel of the plurality of television channels, computer circuitry (11) for receiving control signals from the remote control (35) and for receiving program guide data for said program guide, the computer circuitry (11) generating a program guide output signal corresponding to at least a portion of the program guide data, characterized by:
superimposing circuitry (29) for displaying said program guide with a perceived transparency on top of said selected television channel on said display screen (33) by combining said program guide output signal and said output television signal such that said selected television channel appears visible through said program guide."

VIII. Concerning the auxiliary requests, only the text of two independent claims each are on file. The relevant passages of claim 1 of the auxiliary requests read as follows.

Claim 1 of **auxiliary request 1** is claim 1 of the main request with the following text added at the end, before the full stop:

", wherein the computer circuitry (11) is responsive to control signals from the remote control (35) to activate and deactivate the program guide, the computer circuitry (11) setting the weight of the program guide output signal upon activation of the program guide to the weight set at the time of the most recent deactivation of the program guide"

Claim 1 of **auxiliary request 5** reads as follows, amendments with respect to claim 1 of auxiliary request 1 being set out in *italics*:

"A system interactively controlled by a remote control (35) for displaying a program guide on a display screen (33) comprising a tuner (17) for receiving television signals corresponding to a plurality of television channels and providing an output television signal corresponding to a selected television channel of the plurality of television channels *and* computer circuitry (11) for receiving control signals from the remote control (35) and for receiving program guide data for said program guide, the computer circuitry (11) generating a program guide output signal corresponding to at least a portion of the program guide data, characterized by:

superimposing circuitry (29) for displaying said program guide *as the program guide output signal* with a perceived transparency on top of said selected *one of any of said plurality of* television channels on said display screen (33) by combining said program guide

output signal and said output television signal such that said selected television channel appears visible through said program guide, wherein the computer circuitry (11) is responsive to control signals from the remote control (35) to activate and deactivate the program guide, the computer circuitry (11) setting the weight of the program guide output signal upon activation of the program guide to the weight set at the time of the most recent deactivation of the program guide."

Claim 1 of **auxiliary request 6** is claim 1 of auxiliary request 5 with the last feature (wherein the computer circuitry (11) is responsive ...) replaced so as to read: "wherein the computer circuitry is responsive to control signals to cause the superimposing circuitry to change the weight of the program guide output signal in relation to the output television signal."

Claim 1 of **auxiliary request 7** is claim 1 of auxiliary request 6 with the following text added at the end, before the full stop:
" and wherein the computer circuitry (11) is responsive to control signals from the remote control (35) to activate and deactivate the program guide, the computer circuitry (11) setting the weight of the program guide output signal upon activation of the program guide to the weight set at the time of the most recent deactivation of the program guide"

Claim 1 of **auxiliary request 9** is claim 1 of the main request with the following text added at the end, before the full stop:

", wherein the computer circuitry (11) is responsive to control signals from the remote control (35) to activate the program guide, to select the weight of the program guide output signal in relation to the output television signal and to deactivate the program guide."

Claim 1 of **auxiliary request 10** reads as follows, amendments with respect to claim 1 of the main request being set in *italics*:

"A system interactively controlled by a remote control (35) for displaying a program guide on a display screen (33) comprising a tuner (17) for receiving television signals corresponding to a plurality of television channels and providing an output television signal corresponding to a selected television channel of the plurality of television channels, computer circuitry (11) for receiving control signals from the remote control (35) and for receiving program guide data for said program guide, the computer circuitry (11) generating a program guide output signal corresponding to at least a portion of the program guide data, characterized by:

superimposing circuitry (29) for displaying said program guide with a perceived transparency on top of said selected television channel on said display screen (33) by combining said program guide output signal and said output television signal such that said selected television channel appears visible through said program guide, *wherein said computer circuitry (11) is responsive to control signals from the remote control (35) that cause the superimposing circuitry (29) to change the weight of the program guide output signal in relation to the output television signal, such that*

when the computer circuitry (11) increases the weight of the program guide output signal, the display signal generated by the superimposing circuitry (29) causes a decrease in the perceived transparency of the displayed portions of the program guide on the display screen (33), thereby causing the selected television channel to appear less visible through the program guide."

Claim 6 of **auxiliary request 10** reads as follows, amendments with respect to claim 7 of the main request being set out in *italics*:

"A method for displaying a program guide on a display screen (33) comprising the steps of receiving television signals corresponding to a plurality of television channels and providing an output television signal corresponding to a selected television channel of the plurality of television channels, receiving control signals and receiving program guide data for said program guide with computer circuitry (11), and generating a program guide output signal with said computer circuitry (11) corresponding to at least a portion of the program guide data, characterized by: displaying said program guide with a perceived transparency on top of said selected television channel on said display screen (33) by combining said program guide output signal and said output television signal using superimposing circuitry (29) such that said selected television channel appears visible through said program guide, *wherein the program guide output signal has a viewer selectable weight in relation to the output television signal, the method further comprising the step of increasing the weight of the*

program guide output signal, thereby causing a decrease in the perceived transparency of the displayed portions of the program guide on the display screen (33) and causing the selected television channel to appear less visible through the displayed portions of the program guide."

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

In the application as filed, it was an essential feature for achieving the perceived transparency of the displayed program guide that the viewer was allowed to change the weight of the program guide output signal in relation to the output television signal. A fixed transparency value was not disclosed in the application as filed. According to the description the program guide was at least once displayed in a non-transparent form when the viewer selected the "video mix" condition. The next step allowed the viewer to change the weight of the program guide signal in relation to the basic programming signal. This essential feature had been present in original independent claim 1. However, it was not present in the independent claims of the main request and auxiliary requests 1 to 7. Hence these independent claims did not meet the requirements of Article 123(2) EPC.

With respect to auxiliary request 9 the opposition division was of the opinion that the expression "the weight of the program guide output signal in relation to the output television signal" as specified in claim 1 was not previously defined, leading to a lack of clarity (Article 84 EPC 1973). Moreover, "the

weight" implied a fixed value not disclosed in the application as filed (Article 123(2) EPC). Also the original independent claims 7 and 13 referred to "a viewer selectable weight in relation to the output television signal". This meant that a change of weight was involved, as disclosed in the description.

X. The appellant's arguments may be summarised as follows:

The opposition division had applied the wrong criteria for assessing compliance with Article 123(2) EPC. It had placed too much emphasis on the subject-matter of claim 1 as filed, whereas the proper approach would have been to determine whether the subject-matter under consideration was directly and unambiguously derivable from the application as filed as a whole. Original claim 1 had focussed on a preferred but unessential aspect. An unessential feature had been deleted from original claim 1 and hence the appropriate test was that given in the Guidelines for Examination, C-VI, 5.3.10, and T 331/87. This test was more generous to applicants than the test applied when an undisclosed feature was added, as explained in T 404/03. Whereas original claim 1 had focussed on the adjustability of the weight of one signal with respect to the other, present claim 1 of the main request focussed on the aspect that the program guide was transparent. The application involved two interrelated but distinct concepts, namely controlling the properties of the program guide (illustrated in figures 2 to 4) and using the program guide as a program guide (illustrated in figures 5, 6, 8 and 9). In particular, the three "objects of the invention" (pages 1 and 2, bridging paragraph, of the application as filed) were

disjunctive. The first two "objects of the invention" concerned the first concept and the third "object of the invention" concerned the option of adjusting the degree of transparency when using the program guide. Claim 1 of the main request related to the first concept and covered the condition of transparency. According to the description the weight of the program guide signal (corresponding to the degree of transparency) was fixed until it was adjusted by the user.

Also, claim 1 of auxiliary requests 1 to 7 did not recite the change of weight by the user, but the omission of this feature did not add subject-matter for the reasons given in the context of the main request.

Claim 1 of auxiliary request 9 maintained the feature of activating the program guide at which time the selection of the weight was made. The viewer was not involved when the "video mix" was first invoked. Instead the weight was maintained at the level at which it was previously set. The weight was not necessarily viewer-changeable, and the selection of the weight merely reflected the fact that the transparency was invoked.

With respect to admissibility of the auxiliary requests, auxiliary requests 1 to 9 had been filed in the first-instance proceedings and defended in the statement of grounds of appeal. It was clearly the appellant's intention to maintain these requests in appeal proceedings.

In particular, auxiliary requests 8 and 9 had been filed in the first-instance proceedings in an attempt to find a solution acceptable to the opposition division even though the patent proprietor considered the opposition division's reasoning with respect to added subject-matter to be flawed.

Auxiliary request 10 had been filed when the appellant recognised that the board might not be convinced by the appellant's arguments concerning the opposition division's approach to assessing the issue of added subject-matter. It merely combined claims of the patent as granted. It would be harsh for the patentee not to be given a chance to obtain such a reduced monopoly.

An apportionment of costs was not justified because the patent proprietor might have filed an appeal against the opposition division's decision even if auxiliary request 10 had been filed in opposition proceedings. It was not uncommon that opposition proceedings entailed two appeal proceedings.

XI. Respondent 1's arguments may be summarised as follows:

As far as the issue of added subject-matter in the claims according to the main request was concerned, respondent 1 agreed with the reasons given in the decision under appeal. A viewer-selectable weight of the program guide output signal in relation to the weight of the output television signal was at the heart of the originally filed application. Removing this feature from the independent claims added subject-matter. Furthermore, in the application as filed, the perceived transparency effect was directly linked to

the superimposition and the relative weight of the program guide output signal in relation to the base programming signal. Also, this link was an essential feature of the invention which was missing in the independent claims as granted. The independent claims of auxiliary requests 1 to 9 added subject-matter for the same reasons as the main request.

Auxiliary requests 1 to 10 should not be admitted into the appeal proceedings. The appellant had not made clear in the notice of appeal that auxiliary requests 1 to 9 were maintained. This had only become clear in the oral proceedings before the board. Hence these requests were late-filed.

Auxiliary request 10 was filed far too late. It could have been presented in the first-instance proceedings and should not be admitted under Article 12(4) RPBA. No justification had been given for filing this request so late. Furthermore, this request could have been filed earlier in the appeal proceedings. The filing of this request amounted to a tactical abuse for the reasons indicated in T 455/03, point 2.1. At least, respondent 1 could not be expected to react to auxiliary request 10 at this late stage in the oral proceedings. If auxiliary request 10 had been filed in the first-instance proceedings, future second appeal proceedings, which were to be expected, could have been avoided. If the case were remitted to the first instance, a final decision would not be reached before the lapse of the patent, contrary to the public's and the respondent's interest in legal certainty.

Contrary to Article 84 EPC 1973, the claims of the auxiliary requests were not clear. Their text was not

clear because only the independent claims had been filed and the term "the weight" as used without antecedent was not clear. In particular, the meaning of "the weight of the program guide output signal" was not clear when not defined in relation to the underlying TV signal. Furthermore, the relationship between features of the independent claims and those of dependent claims of the patent as granted was not clear. Hence the auxiliary requests were clearly unallowable.

Auxiliary request 10 added complexity to the case. It led to clarity problems, for instance because dependent claims of the patent as granted may be contradictory to the independent claims of auxiliary request 10. It would be contrary to the need for procedural economy to admit this request. The public's and the respondent's interest in legal certainty was at least as important as the patent proprietor's interest in being given a chance to maintain a reduced monopoly.

With respect to the request for apportionment of costs, respondent 1 submitted that he would not have incurred the costs for replying to the statement of grounds of appeal, for responding to the summons to the oral proceedings before the board and for attending those proceedings had the appellant submitted auxiliary request 10 in the proceedings before the opposition division. In that case, the division would have examined that request for compliance with Articles 54 and 56 EPC, and the costs of separate appeal proceedings for the added subject-matter issue would have been avoided.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request: added subject-matter (Article 100(c) EPC 1973)*
 - 2.1 It is common ground that the decisive criterion for assessing whether claim 1 contains subject-matter which extends beyond the content of the application as filed is whether a person skilled in the art would derive directly and unambiguously the subject-matter of claim 1, using common general knowledge and seen objectively and relative to the date of filing, from the description, claims and drawings of the application as filed. This is also in line with the established case law (see, for instance, opinion G 3/89 of the Enlarged Board of Appeal, OJ EPO 1993, 117, points 2 and 3 in conjunction with points 1.3 and 1.4). Concerning the replacement or removal of a feature from a claim it is established case law that a feature consistently presented as an essential feature of the invention may not be deleted from an independent claim, since this would add subject-matter (see Case Law of the Boards of Appeal of the European Patent Office, 6th edition 2010, III.A.7.2).
 - 2.2 Although the opposition division did not explicitly mention in the decision under appeal a particular test which they applied in their judgment on Article 100(c) EPC 1973, it is not apparent to the board that they wrongly applied the law and the decisive criterion developed in the case law. The EPC does not require the use of any particular tests when assessing whether

subject-matter has been added. Instead, such tests are tools which may be helpful, in certain situations, in the assessment of whether subject-matter has been added. The opposition division's reasoning, setting out facts and arguments to show that a feature was deleted from original claim 1, which feature was considered as essential in view of the disclosure of the application as filed, is in line with established case law that added matters may be generalisations and that the claims are no doubt the most important element concerning the amendment (see G 1/93, OJ EPO 1994, 541, point 11). Likewise, this reasoning is consistent with a finding that one of the conditions set out in the Guidelines for Examination, C-VI, 5.3.10, and in T 331/87 (OJ EPO 1991, 22) is not fulfilled, namely that the feature was not explained as essential in the disclosure of the application as filed.

- 2.3 It is not contested by the appellant that claim 1 of the main request does not require that the weight of the program guide output signal in relation to the output television signal can be changed by the viewer and is thus viewer-selectable to obtain a desired perceived transparency. The degree of transparency may thus be fixed. Hence the decisive question for the assessment of whether subject-matter has been added in the present case is whether a person skilled in the art would derive directly and unambiguously from the description, claims and drawings of the application as filed, using common general knowledge and seen objectively and relative to the date of filing, that it is not essential for the invention disclosed in the application as filed that the perceived transparency

can be changed by the viewer by selecting the relative weight.

- 2.4 The board considers that this feature specifying how the result of a perceived transparency is achieved is consistently presented as a feature of the invention in the application as filed for the following reasons:

Independent claim 1 of the application as filed comprised a feature "the computer being responsive to control signals from the remote control to cause the superimposing circuitry to change the weight of the program guide output signal in relation to the output television signal". The other independent claims, i.e. method claim 7 and system claim 13 of the application as filed, comprised a feature "the program guide output signal having a viewer selectable weight in relation to the output television signal". Since in the context of the present application the remote control specified in claim 1 is intended for operation by the viewer, all the independent claims specified that it was a feature of the invention that the weight of the program guide output signal in relation to the output television signal was viewer-selectable.

This viewer-selectable weight of the program guide signal in relation to the output television signal is also referred to in the section "background of the invention", specifying *inter alia* the objects of the invention. For instance, the paragraph bridging pages 1 and 2 of the application as filed specifies that it is "an object of this invention to provide a process and in-home scrolling hardware **by which a home viewer may interactively control a channel program guide**" (as

opposed to a non-interactive scroll on a single channel which was conventionally displayed to the home TV viewer, see page 1, lines 7 to 10), and that "[a]nother object of this invention is to provide a process and in-home scrolling hardware **by which a home viewer may control the comparative weight of the programming guide or superimposed signal in relation to the basic programming signal over which it is superimposed**" (emphasis added by the board).

This viewer-selectable weight of the program guide signal in relation to the output television signal is also referred to in the summary of the invention, according to which "[t]he computer is responsive to a control signal from the remote to change the weight of the superimposed signal in relation to the base or normal programming signal" (see page 2, lines 30 to 33).

Finally, it is also referred to in the "detailed description of the invention". In particular, "[t]he combiner 29 permits the viewer to select the weight of the scroll information picture signal 27 in relation to the base programming signal 23" (see page 4, line 33, to page 5, line 2). "Thus, each individual viewer will be provided with a scroll program guide in which the home viewer can interactively determine whether the program guide scroll should be displayed and, if so, its weight relative to the basic program data" (see page 7, lines 3 to 7). More precisely, the single detailed embodiment first presents the viewer with an electronic program guide and an option to simultaneously view the guide and the television program (see page 5, lines 13 to 20). The weight of the initially non-transparent ("solid", "100%") program

guide signal may then be adjusted by selecting the "video mix" condition (page 6, line 27, to page 7, line 2; figures 3 to 9). There is no other disclosure of entering a **transparent** program guide display (such as a separate key or a multi-function key).

2.5 On the other hand, there is no explicit disclosure of the relative weight having, for instance, a fixed value which the viewer may not change, or a variable value which changes automatically. In particular, according to the paragraph bridging pages 6 and 7, "[i]f the video mix routine is exited and later reselected, the weight of the programming guide signal 27 will automatically be the weight last opted by the viewer". The board notes that this does not disclose that the weight is selected only once (at setup or whenever a user expressly desires to change the selected value) because "exited" and "later" refer to the "video mix routine" which can be selected several times while watching a television program. Exiting the "video mix routine" does not imply switching off the television set. In any case, since the video mix routine is selected by the viewer (see page 5, lines 23 to 32), the viewer must have made a selection before an automatic re-selection of the same weight may take place.

2.6 There remains the question whether a person skilled in the art would have considered the feature of a viewer-selectable weight of the program guide signal in relation to the output television signal as essential, in the meaning of being explained as essential in view of the overall disclosure (see e.g. point 6 of

T 331/87), for solving the problem underlying the invention disclosed in the application as filed.

2.6.1 In the present case, the problem underlying the invention is not identified *expressis verbis*. But it may be deduced from the three objects of the invention which are disclosed in the paragraph headed "background of the invention" (see pages 1 and 2), when read in the context of the entire application as filed. These include individual interactive control of the programming guide, simultaneous superimposition and control of the comparative weight. The last object of providing a process and in-home scrolling hardware by which a home viewer may control the comparative weight of the programming guide or superimposed signal in relation to the basic programming over which it is superimposed is achieved by the combination of features set out in the independent claims, the summary of the invention and the detailed description (see point 2.4 above). Hence the feature which allows the viewer to change the weight of the program guide signal in relation to the basic programming signal is consistently set out as being comprised in the features solving the three objects. Thus the viewer-selectable weight of the program guide signal in relation to the output television signal is explained as an essential feature for solving the problem underlying the invention.

2.6.2 The appellant's argument that the three objects of the invention were disjunctive did not convince the board. For the present case it is not decisive whether the three objects *per se* are cumulative or disjunctive objects of the invention. The formulation of these

objects as such does not directly and unambiguously disclose the essential features which in combination achieve these objects taken individually. The objects are presented as achievable in a cumulative process, and the application as filed discloses an invention which solves all three objects. The application does not disclose any individualised feature combinations which correspond to the three individual objects of the invention. In particular, it does not disclose an individualised feature combination in which the weight of the program guide output signal in relation to the output television signal is not viewer-selectable. Thus, even if the problem to be solved were deduced from the first two objects of the invention, disregarding the third object of the invention, there is no direct and unambiguous disclosure of a corresponding solution as a specific feature combination in the application as filed.

- 2.6.3 The further argument that two distinct concepts were disclosed in the application as filed, with only the first concept (i.e. transparency of the program guide) being relevant for determining the problem underlying the invention, did not convince the board either. The two concepts are consistently presented in combination and are closely interrelated in the application as filed. In particular, the viewer option to simultaneously view the program guide together with the programming being watched (see page 5, lines 13 to 20) requires the viewer to press a predetermined key to select the (non-transparent) program guide (illustrated in figure 3), manipulate the program guide menu to a "video mix condition" (illustrated in figure 4) in which the program guide is still non-transparent and

then either change the weight of the program guide signal in relation to the basic programming signal or exit the video mix condition (see page 5, line 32, to page 6, line 9).

2.7 Thus the viewer-selectable weight of the program guide output signal in relation to the output television signal, in the meaning of a weight that can be changed by the viewer (via the remote control as in original claim 1), was consistently presented as an essential feature of the invention in the application as filed, in particular in independent claims 1, 7 and 13 as filed. Independent claim 1 as granted (main request) no longer contains this feature. Hence subject-matter has been added to the application as filed and the ground for opposition under Article 100(c) EPC 1973 prejudices the maintenance of the patent as granted.

3. *Auxiliary requests 1, 5, 6, 7, 9 and 10: admissibility (Articles 12 and 13 RPBA)*

Auxiliary requests 1, 5, 6, 7 and 9

3.1 Respondent 1 argued that auxiliary requests 1 to 9 should not be admitted into the appeal proceedings. In support he contended that (i) the notice of appeal did not clearly specify which requests were being maintained in appeal proceedings and that (ii) the claims were clearly unallowable because the auxiliary requests did not contain dependent claims and thus the relationship between features of the independent claims and those of dependent claims of the patent as granted was not clear. The arguments of respondent 1 did not convince the board for the following reasons.

3.2 Re (i): The appellant defended auxiliary requests 1 to 9 in the statement of grounds of appeal. These requests had already been filed and admitted in the first-instance proceedings, and the decision under appeal is based on these requests. The board therefore does not see any reason to hold these requests inadmissible under Article 12(4) RPBA. Rather, given that the conditions of this provision are complied with, under this very provision, the board shall take into account those auxiliary requests that the appellant did not withdraw in the oral proceedings, i.e. auxiliary requests 1, 5, 6, 7 and 9.

3.3 This finding cannot be called into question on the basis of the fact that the appellant's request in the notice of appeal was limited to maintenance of the patent as granted and it was only in the statement of grounds of appeal that the appellant also defended auxiliary requests 1 to 9.

A board may, independently of Article 12 RPBA, decline to admit a request into appeal proceedings in relation to which the admissibility requirements are not met, in particular where sufficient grounds within the meaning of Article 108, third sentence, EPC have not been furnished (see T 509/07, point 2). Pursuant to Article 108, first sentence, EPC, "Notice of appeal shall be filed, in accordance with the Implementing Regulations ...". Pursuant to Article 108, third sentence, EPC, "... a statement setting out the grounds of appeal shall be filed in accordance with the Implementing Regulations." Rule 99 EPC deals with the content of the notice of appeal and the statement of

grounds (see its title). In this respect the board concurs with the view expressed in T 358/08 (see point 5) that Rule 99 EPC has not altered the previous law as to the requirements of either the notice of appeal or the statement of the grounds of appeal as regards the appellant's requests. Rule 99(1)(c) EPC is satisfied if the notice of appeal contains a request, which may be implicit, to set aside the decision in whole or (where appropriate) only in part. Such a request has the effect of "defining the subject of the appeal" within the meaning of Rule 99(1)(c) EPC. Nor is it necessary in the case of an appeal by a proprietor for the notice of appeal to contain a request for maintenance of the patent in any particular form. This is something which relates to "the extent to which [the decision] is to be amended", and which is therefore a matter for the statement of grounds of appeal under Rule 99(2) EPC.

In the case at hand it is clear from the notice of appeal that the decision under appeal should be set aside. Furthermore, from the fact that the appellant defended auxiliary requests 1 to 9 in the statement of grounds, it is equally clear which were the requests on the basis of which the patent should be maintained, i.e. the main request and auxiliary requests 1 to 9. Rule 99 EPC thus being complied with, there is no basis for the board not to admit any of the residual auxiliary requests 1, 5, 6, 7 and 9 for lack of compliance with Article 108, third sentence, EPC, in conjunction with Rule 99 EPC.

3.4 Re (ii): As for the arguments by respondent 1 pertaining to the lack of dependent claims, the board notes that, in the present case, the fact that the

dependent claims of the auxiliary requests had not been filed was not decisive for the decision under appeal, which deals with only one of the several grounds for opposition on which the oppositions were based, namely added subject-matter, and more particularly is limited to the issue of added subject-matter in independent claims. Hence the fact that the dependent claims have not been filed is also not decisive for the board's review of the decision under appeal. In the present case, in view of the appellant's request that the case be remitted to the first instance, the board considers that presenting complete sets of claims is not a necessary precondition for admitting them and deciding on the limited issue of added subject-matter. The respondents' right to be heard is safeguarded in that any objection not dealt with in the decision under appeal and decided by the board can be raised before, and may be dealt with by, the opposition division within the framework of the oppositions and in the exercise of the division's discretion. As a consequence, the board sees no basis for refusing admittance of the residual auxiliary requests 1, 5, 6, 7 and 9 into the proceedings on this strand of reasoning by respondent 1.

Auxiliary request 10

- 3.5 Auxiliary request 10 was filed only during the oral proceedings before the board. Respondent 1's argument that, for reasons of procedural economy, the appellant had had an obligation to file auxiliary request 10 in the first-instance proceedings and therefore auxiliary request 10 should not be admitted on appeal did not convince the board. The board agrees with respondent 1 that the appellant **could** have presented this request in

the first-instance proceedings because it is a simple combination of claims as granted which do not have the defect which was the ground for revocation of the opposed patent. Article 12(4) RPBA explicitly gives a board of appeal the power not to admit such requests.

In the present case, the patent proprietor made an attempt in the oral proceedings before the opposition division to seek a wording of the independent claims which was acceptable to the opposition division and submitted auxiliary requests 8 and 9. It is a matter of speculation which decision(s) the opposition division would have taken if auxiliary request 10 had been filed in the first-instance proceedings, as the patent was opposed on the basis of several grounds for opposition and the opponents presented several chains of arguments referring to a large number of documents.

Thus the board sees no reason not to admit auxiliary request 10 on the basis of Article 12(4) RPBA.

- 3.6 This request, however, still faces scrutiny under Article 13(1) RPBA. This is because it was filed only during the oral proceedings before the board. Therefore, it also constitutes an amendment to the appellant's case, admittance and consideration of which are subject to the board's discretion pursuant to Article 13(1) RPBA.

In this respect the board notes that the appellant defended auxiliary requests 1 to 9 made in the first-instance proceedings in the statement of grounds of appeal to convince the board that the opposition division was wrong and that the appellant was entitled

to a broader scope of claims. It was only when the appellant noticed in the oral proceedings that the board was not convinced by the arguments that he chose a combination of claims as granted as a last chance to overcome the ground for revocation. Claim 1 of auxiliary request 10 is a combination of claims 1 and 2 as granted, and claim 6 of auxiliary request 10 is a combination of claims 7 and 8 as granted. Hence these claims relate to feature combinations which were recognisable as potential fallback options and do not introduce any new amendment that would need further extensive consideration. Furthermore, these claims 1 and 6 do not have the defect which was the sole ground in the decision under appeal for revoking the patent. Therefore, the subject-matter of these claims is not so complex that a decision on the limited issue of whether or not the decision under appeal should be set aside and the case remitted to the first instance for further prosecution could not have been taken in the oral proceedings before the board. Furthermore, the filing of auxiliary request 10 only during oral proceedings before the board is unlikely to have caused a prolongation of the appeal proceedings, because the appeal proceedings including the board's decision might have been similar if auxiliary request 10 had already been filed with the statement of grounds of appeal.

- 3.7 Also, for the reasons given above, in the context of Article 12(4) RPBA (see point 3.5) respondent 1's argument that the late filing of auxiliary request 10 without giving a proper justification constituted a tactical abuse did not convince the board. It is established case law that a patent proprietor has the right to defend his request before the board of appeal

and that, under the discretion of the board pursuant to Article 13 RPBA, the appellant may file amendments to his case, in particular amendments which remove deficiencies in response to observations made by the board and which do not introduce new complex subject-matter. In the present case, an earlier filing of auxiliary request 10 in the appeal proceedings would possibly have led to the same decision of the board, so that filing auxiliary request 10 only in oral proceedings did not necessarily improve the appellant's situation. And in the present case respondent 1 did not need to respond in detail to the filing of auxiliary request 10 since the board did not take a final decision as to the substantive issues of this request.

3.8 The argument that auxiliary request 10 was not clearly allowable and infringed Articles 84 EPC 1973 and 123(2) EPC concerns features which were already present in the claims of the patent as granted and in particular their meaning in the light of the dependent claims which have not been filed (see also point 3.4 above). However, since the board remits the case to the first instance, this objection as well as any objections against dependent claims may be dealt with by the opposition division in the exercise of their discretion. In this respect the board had informed the parties with the communication dated 7 February 2011 that the present case might be remitted to the first instance for further prosecution if it came to the conclusion that the decision under appeal was to be set aside.

3.9 In the light of the considerations set out above, the board has admitted auxiliary request 10 into the proceedings pursuant to Article 13(1) RPBA.

4. *Auxiliary requests 1, 5, 6 and 7: added subject-matter (Article 100(c) EPC 1973)*

It is common ground that the feature of a viewer-selectable weight of the program guide signal in relation to the output television signal is not present in claim 1 of each of auxiliary requests 1, 5, 6 and 7. The board agrees that the amendments made to claim 1 in these requests do not re-introduce the removed essential feature. Hence the ground for opposition under Article 100(c) EPC 1973 also prejudices the maintenance of the patent, taking into consideration the amendments made in auxiliary requests 1, 5, 6 and 7.

5. *Auxiliary request 9: added subject-matter (Article 100(c) EPC 1973)*

5.1 Claim 1 of auxiliary request 9 comprises the feature "wherein the computer circuitry (11) is responsive to control signals from the remote control (35) to activate the program guide, to select the weight of the program guide output signal in relation to the output television signal and to deactivate the program guide."

5.2 The expression "to select the weight" in claim 1 is ambiguous in that it could relate to a viewer selection of a fixed weight value, i.e. that the weight was not viewer-selectable in the meaning of allowing the viewer to change the weight (and the perceived transparency). This interpretation is also consistent with that intended by the appellant (see point X above).

5.3 If follows from the reasons given in the context of the main request, in particular in the context of the lack of disclosure of a fixed weight value (see for instance point 2.5 above), that also in claim 1 of auxiliary request 9 subject-matter has been added to the application as filed. Hence the ground for opposition under Article 100(c) EPC 1973 also prejudices the maintenance of the patent, taking into consideration the amendments made in auxiliary request 9.

6. *Auxiliary request 10*

Claim 1 of auxiliary request 10 comprises the feature "wherein said computer circuitry (11) is responsive to control signals from the remote control (35) that cause the superimposing circuitry (29) to change the weight of the program guide output signal in relation to the output television signal ...". This is almost *verbatim* the last feature of claim 1 as originally filed (see point 2.6 above). Similarly, claim 6 of auxiliary request 10 comprises the feature "wherein the program guide output signal has a viewer selectable weight in relation to the output television signal", which is almost *verbatim* the last feature of claim 7 as filed. In the judgment of the board both claims 1 and 6 now specify that the weight of the program guide output signal in relation to the output television signal can be changed by the viewer and is thus viewer-selectable to obtain a desired perceived transparency. This was not contested by respondent 1 in the oral proceedings. Hence the objection on which the reasons for the decision under appeal were based does not apply to claims 1 and 6 of auxiliary request 10.

7. *Remittal (Article 111(1) EPC 1973)*

Thus the appeal is allowable. However, the opponents in their notices of opposition had raised other grounds for opposition which at least partly also concern the combination of granted claims 1 and 2 and of claims 7 and 8, respectively. These objections were not the subject of the decision under appeal and of the appeal proceedings. In this situation, the board considers it appropriate to exercise its discretion pursuant to Article 111(1) EPC 1973 to remit the case to the first instance for further prosecution, to give the parties the opportunity to present their case to the first instance.

8. *Apportionment of costs (Article 104(1) EPC)*

8.1 Pursuant to Article 104(1) EPC, "[e]ach party to the opposition proceedings shall bear the costs it has incurred, unless the Opposition Division [or, in appeal proceedings, the board of appeal; see Rule 100(1) EPC], for reasons of equity, orders ... a different apportionment of costs". In this respect, Article 16(1)(e) RPBA mentions abuse of procedure as a possible reason for ordering payment of costs.

8.2 The board considers that there is no causal link between the patent proprietor's failure to submit auxiliary request 10 in the proceedings before the opposition division and the need for oral proceedings before the board. Had the patent proprietor filed auxiliary request 10 before the opposition division, the patentee would still have been entitled to appeal the refusal of the main request and auxiliary

requests 1 to 9, independently of whether the division would have accepted auxiliary request 10 or not. In the absence of a causal link in the above sense, there are no reasons of equity for a different apportionment of costs.

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.
3. The request for apportionment of costs is refused.

The Registrar:

The Chairman:

D. Meyfarth

F. Edlinger