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**Datasheet for the decision
of 26 February 2015**

Case Number: T 1305/10 - 3.5.04
Application Number: 00308415.9
Publication Number: 1089564
IPC: H04N7/16, H04N7/173, G06F17/30,
G06F17/00, H04L29/06, G06F17/60
Language of the proceedings: EN

Title of invention:

Enhanced video programming system and method utilizing user-profile information

Applicant:

OpenTV, Inc.

Headword:

Relevant legal provisions:

EPC 1973 Art. 84
RPBA Art. 13(1), 13(3)

Keyword:

Late-filed request -
amendments after arrangement of oral proceedings
Late-filed request - change of subject-matter
Claims - clarity - auxiliary request (no)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1305/10 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 26 February 2015

Appellant: OpenTV, Inc.
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 22 January 2010
refusing European patent application
No. 00308415.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman F. Edlinger
Members: C. Kunzelmann
T. Bokor

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division to refuse European patent application No. 00 308 415.9 under Article 97(2) of the European Patent Convention (EPC).
- II. The application was refused in a "decision according to the state of the file" referring to the grounds set out in the communications dated 22 April 2009 and 13 December 2007, namely that claim 1 of the single request then on file was not clear (Article 84 EPC) and, as far as the claims could be understood, their subject-matter lacked inventive step (Article 56 EPC).
- III. The reasons for the decision under appeal relating to Article 84 EPC 1973 may be summarised as follows:
- The difference between "content", "content information" and the "uniform resource identifier" (see claim 1 of the present auxiliary request) was not clear. Nor was it clear how the "information" in the first line of claim 1 related to the "user profile", the "uniform resource locator", the "data" or the "content". In addition it was not clear which steps were carried out by whom. Thus the claims were not clear.
- IV. The applicant appealed and requested that the decision be set aside. With the statement of grounds of appeal, the appellant filed claims 1 to 24 according to an auxiliary request. It also indicated that claim 1 of the auxiliary request reorganised the features of claim 1 underlying the decision under appeal without altering the claimed subject-matter in any way (see page 3 of the statement of grounds of appeal, last paragraph).

- V. The appellant's arguments in the statement of grounds of appeal, as far as they are relevant for the present decision, may be summarised as follows:

The term "universal resource identifier" URI was known to a person skilled in the art. It identified a resource by location, by name, or both. A "universal resource locator" URL was a specialisation of the broader term URI which defined the network location of a specific resource. The term "content" referred to a resource that was identified by the URI. "Content information" was information that formed part of the content. For example, "content" could include video content as well as content information that took the form of web pages (referenced by URLs) related to the video content.

Content information enhanced the content in which it was included, namely an audio video program.

- VI. 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 23 October 2014. In this communication the board indicated its provisional opinion that it tended to agree with the finding in the first-instance proceedings that claim 1 of the main request was not clear within the meaning of Article 84 EPC 1973, and set out detailed objections concerning the claims of the main request. The board also indicated that the clarity objections raised in points 1.1.2, 1.2, 1.3 and 1.5 of the board's communication seemed to apply also to claim 1 of the auxiliary request.

VII. With a letter dated 20 January 2015 the appellant filed claims 1 to 24 according to a new main request. The appellant explained that the wording of the claims had been modified in view of the clarity objections raised in the board's communication. The appellant indicated the basis for the amendments in the description and argued that the amended claims involved an inventive step. However, the appellant did not submit any arguments as to why the board's objections under Article 84 EPC 1973 relating to the wording of the claims of the auxiliary request filed with the statement of grounds of appeal were incorrect.

The appellant also explained that although the description did not always use consistent terminology it was clear that there was a video program (sometimes called video content) and web content (sometimes called content). The video program and the web content formed an integrated presentation. The web content was identified or addressed via the URL.

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

"A method to enhance a video program displayed on a machine (16) used by a user, the method comprising the steps of:
transmitting (232), to a database (78), user profile information (206) of said user further comprising user activity information, and
accessing (224), via a network connection, for said user a profile file specifying user characteristics, said profile file being organized as a hierarchically organized database and being stored on the database (78),
determining based on the user profile, web content identified by a uniform resource locator;

transmitting the video program and the uniform resource identifier (254) to a server URL decoder (24);
extracting the uniform resource locator by the server URL decoder (24);
transferring the uniform resource locator to an Internet server (28);
transmitting the video program to the machine (16);
transferring the uniform resource locator from the Internet server (28) to the machine (16);
retrieving by the machine (16) web content addressed by the uniform resource locator;
displaying the web content with the video program."

IX. Claim 1 of the auxiliary request filed with the statement of grounds of appeal reads as follows:

"A method of accessing information for use in routing and transmitting content to a machine (16) via a network (94), the method comprising the steps of:
accessing (224), via a network connection, a user profile (202)
characterized by
the user profile comprising at least one hierarchical attribute value-pair data structure (210, 212) stored in a computer-readable medium on a server (4);
and further comprising the steps of:
transmitting (232), to the server (4), data comprising user profile information (206) further comprising user activity information, wherein the data is stored on the server (4) in the at least one hierarchical attribute value-pair data structure (210, 212); and
determining a uniform resource identifier (254),
wherein the uniform resource identifier (254) identifies content information enhancing an audio video program, wherein the content information is selected

- according to the user profile information (206) for inclusion in the content."
- X. In a further letter dated 20 February 2015 the appellant informed the board that it would not be attending the oral proceedings, and requested "a decision on the file in writing".
- XI. A communication of the board was faxed to the appellant on 24 February 2015, asking it to inform the board before the oral proceedings if it intended to maintain the auxiliary request filed with the statement of grounds of appeal.
- XII. No answer to this communication was received.
- XIII. Oral proceedings were held by the board on 26 February 2015 in the appellant's absence, in application of Rule 71(2) EPC 1973 and Article 15(3) RPBA. The chairman noted that the appellant had requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 24 filed with letter dated 20 January 2015, as main request. The chairman established that in the absence of an answer to the board's communication faxed on 24 February 2015 the status of the auxiliary request filed with the grounds of appeal needed to be established by the board during the deliberation. At the end of the oral proceedings the chairman announced the board's decision.

Reasons for the Decision

1. The appeal is admissible.
2. *Claims of the main request:
admission into the appeal proceedings
(Article 13(1) RPBA)*
 - 2.1 According to Article 13(1) RPBA, "Any amendment to a party's case after it has filed its grounds of appeal ... may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy."
 - 2.2 In the present case, the claims of the main request were filed long after the statement of grounds of appeal and even after the appointment of oral proceedings. Thus the board had to examine whether the request was admissible under Article 13(1) RPBA.
 - 2.3 Claim 1 of the main request has been completely redrafted and differs in a number of substantive aspects from the previous claims, in particular from claim 1 underlying the decision under appeal. (The subject-matter of claim 1 underlying the decision under appeal largely corresponds to that of claim 1 of the present auxiliary request.) Examples are as follows:
 - 2.3.1 Claim 1 of the main request relates to "A method to enhance a video program displayed on a machine (16) used by a user", whereas claim 1 underlying the decision under appeal related to "A method of accessing

information for use in routing and transmitting content to a machine (16) via a network (94)".

2.3.2 Claim 1 of the main request comprises a number of features relating to the extraction and transmission of the uniform resource locator URL (or the uniform resource identifier URI, both expressions being used in claim 1), in particular:

- transmitting (the video program and) the uniform resource identifier to a server URL decoder;
- extracting the uniform resource locator by the server URL decoder;
- transferring the uniform resource locator to an Internet server;
- transferring the uniform resource locator from the Internet server to the machine used by the user.

It is clear from the description that these features relate to the system design of the embodiment illustrated in figure 2.

2.3.3 These features were not present in previous claim versions, in particular not in the claims underlying the decision under appeal. Claim 1 underlying the decision under appeal did not specify the system design in which the claimed method, in particular the transmitting and extracting of the uniform resource locator, took place. There was only an indication of a computer-readable medium on a server for storing the user profile and a reference to the machine to which content was routed and transmitted via a network.

2.3.4 Claim 1 of the main request specifies the user's profile file, which specifies the user characteristics, as "being organized as a hierarchically organized

- database** and being stored on the database (78)" (emphasis by the board). The data making up the profile file are only functionally defined ("specifying user characteristics"), and the user profile information is specified as "further comprising user activity information".
- 2.3.5 In contrast, claim 1 underlying the decision under appeal was mainly characterised by "the user profile comprising at least one hierarchical **attribute value-pair data structure** (210, 212)..." (paraphrasing the "donut" described in paragraphs [0077] to [0091] and illustrated in figure 10, emphasis by the board). Hence the user profile comprising a structure of specific data pairs, namely attributes with values, is no longer present in amended claim 1.
- 2.4 In view of the above differences, the board finds that the claims of the main request constitute a substantial amendment to the appellant's case.
- 2.5 The clarity objections which ultimately led to the refusal of the application were the central issues in the first-instance proceedings. The applicant reacted to these objections with arguments, but maintained claim wording (using *inter alia* the expressions "content" and "content information") which the examining division considered to be unclear. This claim wording was maintained upon filing the statement of grounds of appeal. Claim 1 of the auxiliary request filed with the statement of grounds of appeal also merely reorganised the features of claim 1 underlying the decision under appeal, without altering its subject-matter (see page 3 of the statement of grounds of appeal, last paragraph). In addition, the board's communication unambiguously indicated that the board

tended to agree with the objections raised in the first-instance proceedings (at least as far as clarity issues were concerned). Thus the board considers that the filing of the substantially amended claims of the main request only in preparation for the oral proceedings before the board was a very late reaction to objections which had been raised from the beginning of the examination proceedings.

2.6 In view of the complete redrafting of the claims and the amendment of the generic term (see point 2.3.1 above), the reasons given in the decision under appeal concerning Article 84 EPC no longer apply. However, the subject-matter of the claims has also been substantially amended, in that claim 1 now for the first time concerns a method including transmitting and extracting steps carried out in a system with the design of the embodiment illustrated in figure 2 (see point 2.3.2 above), whereas the previous method claims did not include such method steps. These new features and the complete redrafting of the claims increase the complexity of the case since the assessment of the claimed method raises new questions, for instance whether these aspects are disclosed in combination in the application as filed, or which embodiments are covered by the completely redrafted claims. Inventive step too would have to be reconsidered from scratch.

2.7 Thus, the admission of the claims of the main request would not only necessitate examination of the amended claims, but would also require further procedural steps such as further communications or a remittal to the department of first instance in order to arrive at application documents which might allow a patent to be granted. This would be contrary to the need for

procedural economy, and would also contravene Article 13(3) RPBA.

2.8 In view of the above, the board, exercising its discretion under Article 13(1) RPBA, decides not to admit the claims of the main request into the appeal proceedings.

3. *Auxiliary request: clarity (Article 84 EPC 1973)*

As a preliminary remark, the board notes that the appellant did not make clear in the letter dated 20 January 2015 whether the substantially amended claims of the main request (see section 2 above) replaced only the claims of the previous main request (i. e. the claims underlying the decision under appeal) or also the very similar claims of the auxiliary request filed with the statement of grounds of appeal. The board interprets the appellant's submissions in the letter dated 20 January 2015 in favour of the appellant to mean that the appellant's intention was to maintain the auxiliary request filed with the statement of grounds of appeal.

3.1 In its communication under Article 15(1) RPBA, the board set out a number of clarity objections relating to claim 1 of the auxiliary request (see point VI above). The appellant did not address these objections in its reply of 20 January 2015, except by filing a completely redrafted set of claims of the main request. The board sees no reason to depart from its provisional opinion expressed in the communication.

3.2 It is unclear how the accessed "information" in line 1 relates to the features and method steps of claim 1. According to claim 1, only a user profile is accessed;

- the other method steps do not concern accessing information.
- 3.3 The wording of claim 1 does not make clear which method steps are carried out by whom. For instance, in the example of a student/instructor environment (see the embodiment of figures 7 and 8), it is not clear which steps of claim 1 are carried out by the student and which by the instructor.
- 3.4 Also, the feature "transmitting (232), to the server (4), data comprising user profile information (206) ..." is not clear because of the reference to "user profile information". The difference between this "user profile information" and the "user profile" in the feature "accessing (224), via a network connection, a user profile (202)" is not clear. The reference sign 232 seems to indicate that this transmitting step paraphrases the generation of the "donut" (see figure 11A) which may comprise the user profile. This is however at odds with the first method step according to which an (already generated) user profile is accessed.
- 3.5 In view of the above, the board finds that claim 1 of the auxiliary request does not meet the requirements of Article 84 EPC 1973.
4. Thus the appellant's main request is not admitted and the auxiliary request is not allowable. Hence the appeal is to 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