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**Datasheet for the decision
of 28 July 2011**

Case Number: T 2426/10 - 3.5.04

Application Number: 07075668.9

Publication Number: 1850594

IPC: H04N 7/173

Language of the proceedings: EN

Title of invention:

Access to internet data through a television system

Applicant:

Gemstar Development Corporation

Opponent:

-

Headword:

-

Relevant legal provisions:

RPBA Art. 13(1)

Relevant legal provisions (EPC 1973):

EPC Art. 76(1)

Keyword:

"Subject-matter extending beyond the content of the earlier application as filed (yes)"

"Admission of request submitted in oral proceedings - (no)"

Decisions cited:

G 0001/93, G 0001/06, G 0001/07

Catchword:

-



Case Number: T 2426/10 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 28 July 2011

Appellant: Gemstar Development Corporation
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Santa Clara CA 95050 (US)

Representative: Hale, Peter
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 30 July 2010
refusing European patent application
No. 07075668.9 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: F. Edlinger
Members: R. Gerdes
B. Müller

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division refusing European patent application No. 07 075 668.9, which was filed as a divisional application from the earlier European patent application No. 97 910 985.7 published as WO 98/17064 A1.
- II. The present application was refused by the examining division in accordance with Article 97(2) EPC because the subject-matter of the independent claims according to the applicant's main and first to fourth auxiliary requests was found to lack clarity (Article 84 EPC).
- III. The appellant lodged an appeal and requested that the decision of the examining division be set aside. He initially maintained the requests on which the appealed decision was based.
- IV. In a communication annexed to the summons to oral proceedings, the board provisionally agreed with the examining division that the claimed subject-matter of all requests was not clear. Additionally, the board expressed doubts as to whether the claims according to the appellant's requests fulfilled the requirements of Article 76(1) EPC 1973.
- V. With a letter of reply dated 27 June 2011 the appellant filed new sets of claims as main, first and second auxiliary requests, these replacing all previous requests.

- VI. Oral proceedings were held on 28 July 2011. During the oral proceedings the appellant submitted a further new set of claims as a third auxiliary request.
- VII. The appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of the claims of the main request, or one of the first, second and third auxiliary requests, in that order.
- VIII. Claim 1 of the **main request** and claim 1 of the **first auxiliary request** are identical and read as follows.

"A method for recording a television program using an internet access apparatus and a television system, the method comprising:
displaying information about a television program on a web page on the internet access apparatus;
displaying a link on the web page, wherein the link is associated with programming data corresponding to the television program;
receiving a selection of the link from a user;
transmitting, in response to the selection of the link, the programming data corresponding to the television program that is associated with the link to the television system using an internet connection to cause the television system to schedule a recording of the television program in response to receiving the programming data."

- IX. Claim 1 of the **second auxiliary request** differs from claim 1 of the main and first auxiliary requests in its last feature. The final phrase in claim 1 of the main and the first auxiliary request starting with the words

"to cause the television system ..." is replaced by the following expression:

"; and the television system scheduling a recording of the television program in response to receiving the programming data."

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

"A method for recording a television program using a television system comprising an internet access apparatus, the method comprising:
displaying information about a television program on a web page on the television system;
displaying a link on the web page, wherein the link is associated with programming data corresponding to the television program;
receiving a selection of the link from a user;
transmitting, in response to the selection of the link, the programming data corresponding to the television program that is associated with the link to the internet access apparatus of the television system using an internet connection to cause the television system to schedule a recording of the television program in response to receiving the programming data."

XI. The appellant's arguments may be summarised as follows.

The subject-matter of claim 1 of all requests is based on the embodiment disclosed on page 11, line 24 to page 12, line 4 of the earlier application. The system shown in figure 7 only represents one of several possible interactive television systems which are suitable for implementing the invention. In particular,

the web page containing information about a television program need not be displayed on a WebTV (see page 11, lines 24 to 26 and page 6, lines 22 to 25). Instead, it could be shown on a typical PC or portable computer web browser "at an Internet site" (see page 11, line 24). The embodiment described on page 13, line 35 to page 14, line 20 discloses the use of a portable device or PC operable to connect to the internet. The term "user's location" on page 11, line 36 refers to the location of the WebTV terminal, e.g. the user's home, and not the location of the user when selecting a television program for viewing or recording.

The transmission of embedded data in the television signal as well as the simultaneous display of the TV signal and information relating to the embedded data is not essential for recording a television program. Instead of receiving embedded data, the internet access terminal may receive "user input regarding particular data to be received over the Internet", for example via a keyboard (see page 8, lines 12 to 16).

The programming data are "transmitted by the Internet connection to the WebTV terminal at the user's location" (see page 11, lines 35 and 36). There is no explicit disclosure of how the WebTV terminal is addressed so as to receive the programming data via the internet connection. However, such addressing was well-known to the skilled person at the effective date of the present application. The fact that the WebTV terminal may be in stand-by mode when the programming data are sent to it would not prevent it from receiving the data via the internet.

The third auxiliary request should be admitted because the claims were amended in reaction to the debate in the oral proceedings and are intended to overcome the objection of the board with respect to Article 76(1) EPC 1973. The amendment clarifies that the internet access apparatus receives the programming data via the internet.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. In the following references to the description, claims or drawings relate to the earlier application as filed, which was published as WO 98/17064 A1.
3. According to Article 76(1), second sentence, EPC 1973 a European divisional application "may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed".
 - 3.1 The appellant argued that the subject-matter of claim 1 of the main request was based on the embodiment disclosed on page 11, line 24 to page 12, line 4 of the description. He did not indicate any other embodiment as a basis for the combination of the features of claim 1 in this general form, or any claims in the earlier application as filed.
 - 3.2 Even though it is not excluded by Article 76(1) EPC 1973 to claim in a divisional application subject-

matter, which only finds a basis in an embodiment of the invention as disclosed in the earlier application, the claimed subject-matter must be directly and unambiguously derivable from what is disclosed in the earlier application as filed (see G 1/06, OJ EPO 2008, 307; Order of the decision). Added matter may be generalisations of specific features or embodiments and the introduction of new alternatives (see G 1/93, OJ EPO 1994, 541, Reasons, point 11, and G 1/07, Reasons, point 4.3.3; see also Case Law of the Boards of Appeal of the European Patent Office, 6th edition, 2010, sections III.A.2 and IV.3).

- 3.3 The earlier application as filed relates to interactive television systems capable of two-way communication with information service providers, in particular internet service providers (see page 1, lines 13 to 15). The system "includes a number of user interface units in individual homes, each having a tuner, a display device and a modem or other data interface device for communicating with a data service provider" (page 2, lines 2 to 5). In particular, it concerns the transmission and reception of television signals comprising data embedded in the television signals. Data corresponding to the internet addresses of a plurality of internet sites are included in the embedded data so that the simultaneous display of a television program and the internet site is made possible at the user's location (see summary of the invention, page 2, line 1 to page 3, line 2 and claims 1, 4 and 15). Apart from internet site information the embedded data may contain directly addressed data such as email data or programming data of a television program (channel, day, time and length data,

abbreviated as CDTL data). Directly addressed data units uniquely designate a particular viewer's apparatus (see page 12, lines 6 to 30). Such data units contained in the embedded data may also be used to address a particular receiver apparatus for recording of a program selected by a user who is not present at the receiver location (page 12, line 37 to page 13, line 8).

- 3.4 The appellant relied on the embodiment on page 11, line 24 to page 12, line 4 as a basis for claim 1. In the following, references to this embodiment are abbreviated as "the embodiment on pages 11/12". Being an embodiment "of the present invention" (see page 11, line 24) it implicitly includes transmission of embedded data together with the television signal and the simultaneous display of a television program and information relating to an internet site as well as two-way communication with information service providers, in particular internet service providers (see point 3.3 above). Page 11, lines 33 to 34 discloses that "[i]f the Internet user wishes to watch or record a television program, the user clicks on the icon with a mouse". In reaction to the selection of the icon "the CDTL data is transmitted by the Internet connection to the WebTV terminal at the user's location" (see page 11, lines 33 to 36). In this case, the WebTV at the user's location is equipped with an internet connection and CDTL data are transmitted by this ("the") internet connection from the internet service provider to the WebTV at the user's location. The embodiment on pages 11/12 does not disclose how the CDTL data are directed via the internet service provider and the internet to the television apparatus.

One possibility which derives from this embodiment is that the WebTV "at the user's location" (page 11, line 36) is employed to run a web browser. In this case the CDTL data can be routed to the WebTV terminal, because the WebTV terminal also represents the source of the request to the internet service provider. The above interpretation of the embodiment on pages 11/12 is supported by figure 7, which according to page 12, lines 5 and 6 is capable of performing these functions. In addition, the system shown in figure 7, as "another embodiment of the invention" (see page 8, lines 7 to 11), has means for receiving both the video signal and embedded data for simultaneous display of a television program and information relating to an internet site (see page 9, lines 8 to 34). Although the transmission of CDTL data in the embodiment of pages 11/12 is not effected using embedded data units which are directly addressed to that television apparatus (as appears to be the case in the embodiment of page 12, line 37 to page 13, line 8), the earlier application does not disclose that this is a different embodiment of the invention, which does not transmit embedded data for simultaneous display of a television program and information relating to an internet site.

- 3.5 Claim 1 does not contain a feature of receiving embedded data which are transmitted together with the television signal. Nor does it define the simultaneous display of a television program and information relating to an internet site on the user's television terminal. Moreover, it does not refer to a two-way communication with an information service provider. By contrast, the subject-matter of claim 1 encompasses new alternatives to features of the disclosed embodiment,

such as the selection of a link on a web page displayed on a PC and directing the PC, in a manner which is not disclosed, to send programming data using an internet connection to a particular television system. Claim 1 further encompasses embodiments in which a remote PC running a web browser acts as internet access apparatus and according to which the CDTL data are transferred to the television system over a connection different from the one used to retrieve the web page.

Neither the embodiment on pages 11/12 nor any other part of the earlier application as filed directly and unambiguously discloses a general method which covers such new alternatives to the disclosed embodiment of the invention. The subject-matter of claim 1, therefore, extends beyond the content of the earlier application as originally filed (Article 76(1) EPC 1973).

- 3.6 The appellant's arguments (see point XI above) did not convince the board for the following reasons.

The embodiment on pages 11/12 can be realised on the system shown in figure 7 (see point 3.4 above referring to page 12, lines 5 and 6). The appellant's argument that the skilled person would understand that the web page containing information about a television program need not be displayed on the WebTV is not disputed in view of the embodiment shown in figure 9. However, the embodiment of figure 9 also discloses that the television signal comprises embedded data including an internet site address and that all the components of the interactive television system are arranged at the user's location. The passage on page 6, lines 22 to 25, is to be understood in the context of figure 1. It

relates to the type of user interface on the television and not to a presentation on a PC separate from a television. Hence, the invention is consistently presented in the earlier application with the features set out in point 3.3 above. Concerning the method steps which are not explicitly mentioned in the embodiment on pages 11/12, a person skilled in the art would have deduced that they were the same as those which are consistently described in the remainder of the earlier application as filed.

The appellant's argument that the transmission of embedded data in the television signal is not essential for the recording of television programs is based on the presence of a keyboard (figure 7: 86), which could be used to enter an internet site address. Keyboard input of a web address, however, does not find support in the earlier application as filed. More importantly, the fact that a television program could be recorded without using embedded data is based on an ex-post interpretation of the earlier application after its effective filing date. This interpretation does not fulfil the criterion of direct and unambiguous disclosure of such subject-matter, which is the relevant criterion for the question under consideration (see point 3.4 above).

First and second auxiliary requests

4. Claim 1 according to the first auxiliary request is identical to claim 1 of the main request. The reasoning given with respect to the main request does not change in the light of the last feature, which was added to

claim 1 of the second auxiliary request. This was not disputed by the appellant.

5. Hence, claim 1 of each of the first and second auxiliary requests also contains subject-matter extending beyond the content of the earlier application as filed (Article 76(1) EPC 1973).

Third auxiliary request

6. According to Article 13(1) RPBA (Rules of Procedure of the Boards of Appeal of the European Patent Office, OJ EPO 2007, 536) any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the board's discretion.

- 6.1 The board's discretion is to 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. Claims that are clearly not allowable will not normally be admitted during oral proceedings (see Case Law of the Boards of Appeal of the European Patent Office, 6th edition, 2010, section VII.E.16.3.3).

- 6.2 In the communication accompanying the summons to oral proceedings the appellant was informed that according to the board's provisional view claim 1 of all requests lacked essential features. In particular, it was considered essential that the method was realised on a television at the user's location providing internet access and connected via the internet to a data service provider (see communication accompanying the summons, sections 6.3 and 6.4). This was also the reason for the

rejection of the main, first and second auxiliary requests (see above).

6.3 On a *prima facie* evaluation claim 1 of the third auxiliary request is clearly not able to overcome this objection. According to the amended claim 1 the television system comprises an internet access apparatus. The feature in lines 3 and 4 of claim 1 "displaying information about a television program on a web page on the television system" comprises the possibility that the web page is displayed on the internet access apparatus of the television system. Hence, the feature constitutes no limitation of the claim. Moreover, claim 1 does not include a feature of receiving embedded data which are transmitted together with the television signal.

6.4 In view of the above the board decided not to admit the third auxiliary request into the appeal proceedings in application of Article 13(1) RPBA.

Conclusion

7. Claim 1 of the main, first and second auxiliary requests contains subject-matter which extends beyond the content of the earlier application as filed (Article 76(1) EPC 1973). Consequently, these requests are not allowable. The third auxiliary request was not admitted into the proceedings (Article 13(1) RPBA).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

K. Boelicke

F. Edlinger